

**UNITED STATES PATENT AND TRADEMARK OFFICE  
REGISTRATION EXAMINATION  
FOR PATENT ATTORNEYS AND AGENTS**

**OCTOBER 15, 2003**

**Morning Session (50 Points)**

**Time: 3 Hours**

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**DIRECTIONS**

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the patent laws, rules and procedures as related in the Manual of Patent Examining Procedure (MPEP). Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. **YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.**

**DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO**

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1. Assuming that a rejection has been properly made final, which of the following statements is not in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) An objection and requirement to delete new matter from the specification is subject to supervisory review by petition under 37 CFR 1.181.
- (B) A rejection of claims for lack of support by the specification (new matter) is reviewable by appeal to the Board of Patent Appeals and Interferences.
- (C) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the primary examiner, the new matter issue should be decided by petition, and is not appealable.
- (D) If both the claims and the specification contain the same new matter, and there has been both a rejection and objection by the examiner, the new matter issue is appealable, and should not be decided by petition.
- (E) None of the above.

2. A claim in a pending patent application stands rejected under 35 USC 103(a) as being obvious over Kim in view of Lance. The Kim and Lance references are both U.S. Patents issued on respective applications filed before the date of the application in question. In the rejection, the primary examiner asserted that no determination of the level of ordinary skill in the art was necessary because the subject matter of the application and of Kim and Lance were so easily understandable; and that the Kim reference relates to the applicant's endeavor. The examiner properly found motive in Kim and Lance for combining the references, but the motive would produce a benefit different from that offered by applicant's invention. Neither reference teaches or suggests the ambiguous limitation. In the rejection under 36 USC 103(a), the examiner did not address an ambiguous limitation in the claim. However, the examiner separately rejected under 35 USC 112, second paragraph as indefinite due to the ambiguity. According to the patent laws, rules and procedures as related in the MPEP, which of the following arguments, if true, would overcome the rejection?

- (A) The examiner asserted that because the subject matter of the application and of Kim and Lance were so easily understandable, a factual determination of the level of skill in the art was unnecessary.
- (B) The Kim reference is nonanalogous art because, although it relates to the field of the applicant's endeavor, it is not pertinent to the particular problem with which the applicant was concerned.
- (C) The reason given by the examiner to combine Kim and Lance is to obtain a benefit different from that offered by the applicant's invention.
- (D) Neither the Kim nor Lance references teaches or suggests the ambiguous claimed limitation that the examiner separately rejected as indefinite.
- (E) All of the above.

3. Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of the invention. Which of the following are consistent with the patent law, rules and procedures as related by the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

4. Claim 1 of an application recites "[a]n article comprising: (a) a copper substrate; and (b) a electrically insulating layer on said substrate." The specification defines the term "copper" as being elemental copper or copper alloys. In accordance with the patent laws, rules and procedures as related in the MPEP, for purposes of searching and examining the claim, the examiner should interpret the term "copper" in the claim as reading on:

- (A) Elemental copper only, based on the plain meaning of "copper."
- (B) Copper alloys only, based on the special definition in the specification.
- (C) Elemental copper and copper alloys, based on the special definition in the specification.
- (D) Any material that contains copper, including copper compounds.
- (E) None of the above.

5. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following does not constitute prior art upon which a primary examiner could properly rely upon in making an obviousness rejection under 35 USC 103?

- (A) A U.S. patent in the applicant's field of endeavor which was issued two years before the filing date of applicant's patent application.
- (B) A non-patent printed publication in a field unrelated to the applicant's field of endeavor but relevant to the particular problem with which the inventor-applicant was concerned, which was published the day after the filing date of applicant's application.
- (C) A printed publication published more than 1 year before the filing date of applicant's patent application, which publication comes from a field outside the applicant's field of endeavor but concerns the same problem with which the applicant-inventor was concerned.
- (D) A printed publication in the applicant's field of endeavor published 3 years before the filing date of applicant's patent application.
- (E) A U.S. patent which issued more than 1 year before the filing date of applicant's patent application, which the Office placed in a different class than the applicant's patent application, but which concerns the same problem with which the applicant-inventor was concerned, and which shows the same structure and function as in the applicant's patent application.

6. In a reexamination proceeding a non-final Office action dated November 8, 2001 set a shortened statutory period of 2 months to reply. The patent owner, represented by a registered practitioner, filed a response on March 7, 2002, which included an amendment of the claims. No request for an extension of time was received. As of May 8, 2002, which of the following actions would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The registered practitioner should file a request and fee for an extension of time of two months.
- (B) The registered practitioner should file a petition for revival of a terminated reexamination proceeding showing the delay was unavoidable or unintentional, and the appropriate petition fee for entry of late papers.
- (C) The primary examiner responsible for the reexamination should mail a Notice of Allowance and grant a new patent. The patent owner's failure to timely respond to the outstanding Office action does not affect the allowability of the claims in the patent.
- (D) The examiner should provide an Office action based upon the claims in existence prior to the patent owner's late amendment, and mail a Final Office action.
- (E) The registered practitioner should request an extension of time of four months, and file a Notice of Appeal.

7. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Bloc. The application includes a specification and a single claim to the invention which reads as follows:

1. Compound Y.

In the specification, Bloc explains that compound Y is an intermediate in the chemical manufacture of synthetic Z. With respect to synthetic Z, the specification discloses its structural formula and further states that synthetic Z is modeled on the natural form of Z to give it the same therapeutic ability to alleviate pain. The specification goes on to state that synthetic Z is also a cure for cancer. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 U.S.C. 101 as being inoperative; that is, the synthetic Z does not operate to produce a cure for cancer (i.e., incredible utility). Bloc believes he is entitled to a patent to his compound Y. In accordance with the patent laws, rules and procedures as related in the MPEP, how best should the practitioner reply to the rejection of the claim?

- (A) Advise Bloc that he should give up because a cure for cancer is indeed incredible and is unproven.
- (B) File a reply arguing that a cure for cancer is not incredible and he can prove it if given the chance.
- (C) File a reply arguing that whether or not a cure for cancer is incredible is superfluous since Bloc has disclosed another utility – alleviating pain, which is not incredible.
- (D) File a reply arguing that the claim is directed to compound Y, not synthetic Z.
- (E) File a reply arguing that synthetic Z is modeled on the natural form of Z.

8. 35 USC 102(d) establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not one of the four conditions established by 35 USC 102(d)?

- (A) The foreign application must be filed more than 12 months before the effective U.S. filing date.
- (B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
- (C) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
- (D) The foreign patent or inventor's certificate must be actually granted and published before the U.S. filing date.
- (E) The same invention must be involved.

9. Smith's first invention is a new method of fabricating a semiconductor capacitor in a dynamic random access memory (DRAM) cell. Smith filed a first patent application on December 13, 2001 disclosing and claiming the first invention. Smith's later, second invention, is an improved semiconductor capacitor in a DRAM cell and a method of making it. Smith filed a second application on December 16, 2002, claiming the benefit of the filing date of the copending first application. The second application contains claims 1-20, and a specification that provides support for the claimed subject matter in compliance with 35 USC 112, first paragraph. In the second application, claims 1-10 are drawn to Smith's first invention, and claims 11-20 are drawn to Smith's second invention. The primary examiner found a non-patent printed publication authored by Jones published on February 4, 2002. The article discloses the both of Smith's inventions. Which of the following courses of action by the examiner would be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner can reject claims 1-20 in the second application using the article because the publication date of the article is earlier than the filing date of the second application.
- (B) The examiner cannot reject any of the claims in the second application using the article because the second application claims the benefit of the filing date of the first application.
- (C) The examiner can reject claims 1-20 in the second application using the article because the second application is not entitled to the benefit of the filing date of the first application since the second application was filed more than one year from the filing date of the first application.
- (D) The examiner can reject claims 1-10, but cannot reject claims 11-20 in the second application because the first application did not disclose the improved capacitor set forth in claims 11-20.
- (E) The examiner cannot reject claims 1-10, but can reject claims 11-20 in the second application because the first application did not disclose an improved capacitor set forth in claims 11-20.

10. In accordance with the patent laws, rules and procedures as related in the MPEP, definiteness of claim language under 35 U.S.C. 112, second paragraph must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure.
- (B) The teachings of the prior art.
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- (D) The claim interpretation that would be given by one possessing expert skill in the pertinent art at the time the invention was made
- (E) (A), (B) and (C).

11. Application A was filed after November 29, 2000. Reference X and application A were commonly owned at the time the invention of application A was made. In accordance with the patent laws, rules and procedures as related in the MPEP the prior art exclusion of 35 USC 103(c) can be properly invoked to obviate which of the following rejections?

- (A) A rejection under 35 USC 102(e) based on reference X, if reference X is prior art only under 35 USC 102(e).
- (B) A double patenting rejection based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (C) A rejection under 35 USC 103(a) based on reference X, if reference X is available as prior art only under 35 USC 102(e).
- (D) (B) and (C).
- (E) All of the above.

12. Inventors B and C are employed by Corporation D, which authorized registered practitioner E to prepare and file a patent application claiming subject matter invented by B and C. Inventor B signed the oath, an assignment to Corporation D, and a power of attorney authorizing practitioner E to prosecute the application. Inventor C refused to sign the oath and any assignment documents for the application. The employment contract between inventor C and Corporation D contains no language obligating C to assign any invention to Corporation D. A patent application was properly filed in the USPTO under 37 CFR 1.47 naming B and C as inventors, but without inventor C signing the oath. C has now started his own company competing with Corporation D producing a product with the invention in the application. Inventor B is a friend of inventor C and wants C to have continued access to the application. Which of the following statements is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Inventor C, who has not signed the oath or declaration, may revoke the power of attorney to practitioner E and appoint practitioner F to prosecute the application.
- (B) Inventor C cannot be excluded from access to the application because inventor B has not agreed to exclude inventor C. In order to exclude a co-inventor from access to an application, all the remaining inventors must agree to exclude that co-inventor.
- (C) Inasmuch as one of the named joint inventors has not assigned his or her rights to Corporation D, the corporation is not an assignee of the entire right and interest, and therefore cannot exclude inventor C from access to the application.
- (D) An inventor who did not sign the oath or declaration filed in an application can always be excluded from access to an application.
- (E) An assignee filing an application can control access to an application and exclude inventors who have not assigned their rights and other assignees from inspecting the application.

13. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following fees may not be reduced by 50 percent for “small entities”?

- (A) The basic filing fee for a design patent application.
- (B) The fee for a disclaimer.
- (C) The fee for a petition for an extension of time.
- (D) The fee for recording a document affecting title.
- (E) The maintenance fee due at 3 years and six months after grant.

14. The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed such as bacteria, yeast, and other cellular organisms.” All of the original claims in the application are broadly directed to the application of antisense technology to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The claims are rejected under 35 USC 112, first paragraph, for lack of enablement. In support of the rejection, a publication is cited that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor’s own articles (published after the application was filed) that include examples of the inventor’s own failures to control the expressions of other genes in *E. coli* and other types of cells. In accordance with the patent laws, rules and procedures as related in the MPEP, the rejection is:

- (A) appropriate because the claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.
- (B) appropriate because the claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.
- (C) inappropriate because the claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed.”
- (D) inappropriate because the claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate because the claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

15. A utility application filed in May 2001 has been prosecuted through a second action final rejection. In the final rejection some claims were allowed and other claims were finally rejected. Which of the following accords with the patent laws, rules and the procedures as related in the MPEP for a proper reply to a second action final rejection in the utility application?

- (A) An amendment canceling all rejected claims and complying with 37 CFR 1.116.
- (B) Only a Notice of Appeal.
- (C) The appropriate fee for a request for continued examination (RCE).
- (D) A continued prosecution application (CPA) under 37 CFR 1.53(d).
- (E) All of the above.

16. Tribell files a patent application for her aroma therapy kit on November 29, 1999, which issues as a patent on August 7, 2001. She tries to market her kit but all of her prospects are concerned that her patent claims are not sufficiently broad. On September 5, 2001, Tribell asks a registered practitioner for advice on what to do to improve her ability to market her aroma therapy kit. At the consultation the practitioner learns that in the original patent application, Tribell had a number of claims which were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. The practitioner also determines that the claims in the patent obtained by Tribell were narrower than the broader invention disclosed in the specification, and the cited references may not preclude patentability of the broader invention. Which of the following is the best course of action to pursue in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tribell should file a reissue application under 35 USC 251 within two years of the issuance of the patent, broadening the scope of the claims of the issued patent.
- (B) Tribell should file a reissue application under 35 USC 251 any time during the period of enforceability of the patent to broaden the scope of the claims of the issued patent, and then file a divisional reissue application of the first reissue application on the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (C) Tribell should simultaneously file two separate reissue applications under 35 USC 251, one including an amendment of broadening the claims in the original patent, and the other including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as a patent.
- (D) Tribell should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the original application.
- (E) Tribell should immediately file a reissue application under 35 USC 251, including the nonelected claims that were subjected to a restriction requirement in the original application.

17. Inventor files an application containing the following original Claim 1:

1. A widget comprising element A, and element B.

In a first Office action on the merits, a primary examiner rejects claim 1 under 35 USC 103 as being obvious over reference X. Reference X explicitly discloses a widget having element A, but it does not disclose element B. The examiner, however, takes official notice of the fact that element B is commonly associated with element A in the art and on that basis concludes that it would have been obvious to provide element B in the reference X widget. In reply to the Office action, the registered practitioner representing the applicant makes no amendments, but instead requests reconsideration of the rejection by demanding that examiner show proof that element B is commonly associated with element A in the art. Which of the following actions, if taken by the examiner in the next Office action would be in accord with the patent laws, rules and procedures as related in the MPEP?

- I. Vacate the rejection and allow the claim.
  - II. Cite a reference that teaches element B is commonly associated with element A in the art and make the rejection final.
  - III. Deny entry of applicant's request for reconsideration on the ground that it is not responsive to the rejection and allow applicant time to submit a responsive amendment.
- (A) I and II only.
  - (B) II only.
  - (C) II and III only.
  - (D) I, II, and III.
  - (E) I and III only.

18. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding operability or enablement of a prior art reference is the most correct?

- (A) The level of disclosure required for a reference to be enabling prior art is no less if the reference is a United States patent than if it is a foreign patent.
- (B) A reference is not presumed to be operable merely because it expressly anticipates or makes obvious all limitations of an applicant's claimed apparatus.
- (C) A non-enabling reference may not qualify as prior art for the purpose of determining anticipation or obviousness of the claimed invention.
- (D) A reference does not provide an enabling disclosure merely by showing that the public was in possession of the claimed invention before the date of the applicant's invention.
- (E) All of the above are correct.

19. In accordance with patent laws, rules and procedures as related in the MPEP, a rejection under 35 USC 102 can be overcome by demonstrating:

- (A) the reference is nonanalogous art.
- (B) the reference teaches away from the claimed invention.
- (C) the reference disparages the claimed invention.
- (D) (A), (B) and (C).
- (E) None of the above.

20. On January 3, 2003, a registered practitioner filed a continuation application that includes a benefit claim to a prior-filed application. The practitioner simultaneously filed in the prior-filed application an express abandonment in favor of a continuing application. The prior application contained five drawing figures described in the specification. However, the continuation application contains only four of the five drawing figures. The specification of the continuation application did not include a complete description of the missing drawing figure. A postcard from the USPTO, listing the contents of the continuation application, contains a note that only four drawing figures were received. The practitioner inadvertently omitted one of the drawing figures mentioned in the specification when he filed the continuation application. The missing drawing figure shows a claimed feature of the invention. On February 10, 2003, the practitioner received a Notice of Omitted Item(s) properly according a filing date of January 3, 2003 for the continuation application without the missing drawing figure and notifying the applicant that the drawing is missing. Which of the following procedures for filing the missing drawing would comply with the patent laws, rules and procedures as related in the MPEP for according the continuation application a January 3, 2003 filing date with the five drawing figures that were present in the application?

- (A) The practitioner files the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (B) The practitioner files the missing drawing figure and an amendment to the specification to add a complete description of the missing drawing figure in response to the Notice of Omitted Item(s) within the time period set forth in the notice.
- (C) The practitioner files an amendment to cancel the description of the missing drawing figure from the specification of the continuation application.
- (D) If the continuation application as originally filed includes an incorporation by reference of the prior-filed application to which the benefit is claimed, the practitioner can file the missing drawing figure any time prior to the first Office action.
- (E) The practitioner files the missing drawing figure accompanied by a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h) only alleging that the drawing figure indicated as omitted was in fact deposited with the USPTO with the application papers.

21. Patent application A was filed on January 12, 1995, containing claims 1-10. A primary examiner rejects the claims under 35 USC 102(b) as being anticipated by a U.S. patent issued on June 2, 1992. The rejection also relies on a technical paper published March 12, 1993 to show that a characteristic is inherent in the patent, although not expressed in its disclosure. According to the patent laws, rules and procedures as related in the MPEP, which of the following actions is most likely to overcome the rejection?

- (A) Filing a declaration and exhibits under 37 CFR 1.131 to antedate the reference U.S. patent.
- (B) Filing evidence under 37 CFR 1.132 tending to show commercial success of the invention.
- (C) Filing evidence under 37 CFR 1.132 tending to show unexpected results of the invention.
- (D) Amending the specification of application A to claim priority under 35 USC 120 by a specific reference to a prior copending application B that was filed before June 2, 1992 by the same inventor and discloses the invention claimed in at least one claim of application A in the manner provided by the first paragraph of 35 USC 112.
- (E) Submitting arguments pointing out that the rejection under 35 USC 102(b) relies on more than one reference.

22. Application Number A was published as U.S. Patent Application Publication Number B. A member of the public reviewed the listing of the file contents of the application on the Patent Application Information Retrieval system and determined that the application was still pending, that a final Office action was mailed, and that the application file is in the Technology Center where it is being examined. The member of the public does not have a power to inspect, but would like a copy of the final Office action as well as the other papers in the patent application. In accordance with the patent laws, rules and procedures as related in the MPEP, can a copy of these papers be obtained by the member of the public, and if so, how can the copy be obtained?

- (A) No, a copy cannot be obtained because patent applications are maintained in confidence pursuant to 35 USC 122(a).
- (B) No, a copy cannot be obtained because the patent application is still pending.
- (C) Yes, a member of the public can go to the Technology Center and ask for the file for copying at a public photocopier.
- (D) Yes, the member of the public can complete a "Request for Access to an Application Under 37 CFR 1.14(e)" and, without payment of a fee, order the file from the File Information Unit. Upon the Unit's receipt of the application, the member of the public can use a public photocopier to make a copy.
- (E) Yes, the member of the public can order a copy from the Office of Public Records, with a written request and payment of the appropriate fee.

23. Applicant files a claim which includes the following limitation: “a step for crossing the road.” The specification recites the following acts: “(1) go to the curb, (2) look both ways, (3) if the road appears safe, walk across the road, (4) step up onto the far curb, (5) continue walking.” The primary examiner properly construes the step limitation to cover the foregoing acts. A prior art reference, published two years before the application was filed, expressly describes acts (1)-(4), but not (5). This same reference also discloses the remaining limitations recited in applicant’s claim, i.e., those other than the step plus function limitation. The examiner rejects the claim under 35 USC 102(b) as being anticipated by the prior art reference. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most complete reply to overcome the rejection under these circumstances?

- (A) An argument explaining that since act (5) is not disclosed in the reference, it does not anticipate the claim.
- (B) An amendment to the specification deleting act (5) – continue walking.
- (C) An argument showing that neither the equivalent of act (5) nor act (5) is disclosed in the reference, which therefore does not anticipate the claim.
- (D) An amendment to the claim by adding a negative limitation to expressly exclude act (5) from crossing the road.
- (E) (B) and (D).

24. A registered practitioner filed an application for an applicant claiming a “a means for pulling the door open.” The specification describes a handle and a knob as being used together as a corresponding structure for pulling the door open. A prior art patent discloses a door opened by pulling on an attached bar. The primary examiner issued an Office action rejecting the claim under 35 USC 102 as being anticipated. In the action, the examiner properly identified the corresponding structure described in applicant’s specification as the means for pulling the door open, and properly explained why the prior art attached bar is the equivalent of the structure described in applicant’s specification. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is the most correct reply to overcome the rejection under these circumstances?

- (A) An amendment to the claim changing the pulling means to expressly include an attached bar.
- (B) Only argue that the claimed pulling means is not found in the prior art relied-upon reference and therefore the claim is patentable.
- (C) An amendment to the specification that adds an attached bar to correspond to the prior art.
- (D) An amendment to the claim substituting for the term “means for pulling the door open” the structure of a handle and a knob.
- (E) An amendment to the specification that excludes an attached bar as a pulling means.

25. A registered practitioner filed a utility patent application on May 15, 2000 pursuant to 35 USC 111(a) claiming a detergent composition. On May 15, 2002 the Office mailed a non-final Office action setting a 3-month period for reply. A proper reply was mailed on August 15, 2002 by first-class mail with sufficient postage to the USPTO. The reply was received by the USPTO on September 15, 2002. On September 30, 2002, the Office mailed a final Office action. On October 15, 2002, the Office received a Request for Continued Examination (RCE) meeting all of the requirements of 37 CFR 1.114. On October 30, 2002, the USPTO mailed a Notice of Allowance in view of the RCE and amendment. The utility application issued on February 11, 2003. Which of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP concerning the amount of additional term applicant X would receive because of Patent Term Adjustment (PTA)?

- (A) The patentee would earn PTA because the Office failed to mail at least one notification under 35 USC 132 or notice of allowance under 35 USC 151 no later than fourteen months after the date the application was filed under 35 USC 111(a) but would lose some earned PTA because applicant did not file a response to the non-final rejection within three months.
- (B) The patentee would earn PTA because the Office failed to mail at least one notification under 35 USC 132 or notice of allowance under 35 USC 151 no later than fourteen months after the date the application was filed under 35 USC 111(a) and would not lose any earned PTA because applicant filed a response to the non-final rejection within three months.
- (C) The patentee would not earn any additional time under the provisions of PTA because the application is utility application, not a design application.
- (D) The patentee would not earn any additional time because the application was filed prior to May 29, 2000 and the filing of the RCE would not make the application eligible for PTA.
- (E) The patentee would earn PTA because the filing of the RCE on October 15, 2002 makes the application eligible for PTA and the Office did not mail at least one notification under 35 USC or notice of allowance under 35 USC 151 within 14 months of the date the application was filed under 35 USC 111(a).

26. When, in accordance with the patent laws, rules and procedures as related in the MPEP, is a supplemental oath or declaration treated as an amendment under 37 CFR 1.312?

- (A) When filed in a nonprovisional application after the Notice of Allowance has been mailed.
- (B) When filed in a reissue application at any point during the prosecution.
- (C) When filed in a nonprovisional application after the payment of the Issue Fee.
- (D) When filed in a reissue application after the Notice of Allowance has been mailed.
- (E) (A) and (D).

27. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is patentable subject matter under 35 USC 101?

- (A) A novel and unobvious abstract idea.
- (B) A previously undiscovered law of nature.
- (C) A billing process containing mathematical algorithms producing a written invoice.
- (D) A novel and unobvious discovery of a physical phenomenon.
- (E) All of the above.

28. A registered practitioner files a patent application with the following claim:

1. A plastic insert for the bottom of a shopping cart comprising circular receptacles to receive wine bottles and to maintain them in an upright and stable position even while the shopping cart is moved about a store so that they do not fall and break.

Patent A discloses a plastic insert for the bottom of a shopping cart comprising rectangular receptacles to receive cereal boxes and to maintain them in an upright and stable position even while the shopping cart is moved about a store in order to keep them organized in the cart. Patent A also discloses that the receptacles could be any circular diameter to receive complementary shaped bottles or jars such as to securely hold 2-liter soft drink bottles or mayonnaise jars. A primary examiner rejected the claim as being obvious under 35 USC 103 over Patent A reasoning that Patent A suggests to one of ordinary skill in the art an insert for a shopping cart with circular receptacles for the purpose of stably maintaining any bottle, including wine bottles, while pushing the cart about a store so that the cart remains organized. Assume the examiner has made a sufficient *prima facie* case of obviousness. Following receipt of the rejection, the practitioner filed a timely reply. The practitioner argued that Patent A does not render obvious the claimed subject matter because there is no suggestion of a plastic insert to keep a wine bottle from falling and breaking in a shopping cart. Which of the following best explains why, in accordance with the patent laws, rules and the procedures as related in the MPEP, the examiner should or should not be persuaded by the practitioner's argument?

- (A) No, because Patent A suggests circular receptacles for any complementary bottle, albeit for a different purpose.
- (B) Yes, because there is no suggestion in Patent A that the plastic insert can hold a wine bottle.
- (C) Yes, because the claim uses the insert to keep the bottles from falling and breaking while Patent A uses the insert to keep the cart organized.
- (D) Yes, because Patent A is more interested in organizing boxes than holding bottles.
- (E) Yes, because the prevention from breakage is an unexpected property of the plastic insert.

29. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding publications as references is incorrect?

- (A) A doctoral thesis indexed and shelved in a library can be sufficiently accessible to the public to constitute prior art as a printed publication.
- (B) Evidence showing routine business practices is never sufficient to establish the date on which a publication became accessible to the public.
- (C) A paper which is orally presented in a forum open to all interested persons can constitute a “printed publication” if written copies are disseminated without restriction.
- (D) Documents distributed only internally within an organization, which has an existing policy of confidentiality or agreement to remain confidential are not “printed publications” even if many copies are distributed.
- (E) A publication disseminated by mail is not available as prior art until it is received by at least one member of the public.

30. A registered practitioner receives an Office action for Application X, a patent application filed after November 29, 1999. The action contains a rejection of all the claims as being obvious under 35 USC 103(a) over Patent A in view of Patent B. Patent A is only available as prior art under 35 USC 102(e). Patent B is available under 35 USC 102(b). The practitioner seeks to disqualify Patent A as prior art under 35 USC 103(c). Which of the following would be sufficient evidence to disqualify Patent A as prior art in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A declaration signed by an employee of Corporation K, who is not empowered to act on behalf of Corporation K, stating that at the time the invention claimed in Application X was made, the claimed invention and Patent A were commonly owned by Corporation K.
- (B) A declaration signed by the inventor of Patent A stating that at the time the invention claimed in Application X was made, the invention claimed in Application X and the invention claimed in Patent A were both subject to an obligation of assignment to the same person.
- (C) A statement by the inventor Jones, the sole inventor of Application X, saying that at the present time, Application X and Patent A are commonly owned.
- (D) A statement by the practitioner stating that Application X and Patent A were, at the time the invention claimed in Application X was made, commonly owned by the same person.
- (E) A statement by inventor Jones, the sole inventor of Application X, saying that at the time the invention claimed in Application X was made, Jones owned a majority interest in Patent A.

31. Reexamination has been ordered following receipt of a request for reexamination of U.S. Patent X, filed by the patentee. Patent X contains independent claims 1 through 4, each directed to a hydrocyclone separator apparatus. They are the only claims that were ever presented during prosecution of the application that matured into Patent X. In the first Office action during reexamination, claims 1 through 4 are rejected as being obvious under 35 USC 103 over U.S. Patent Z. The apparatus is used for separating material, including fibers suspended in a liquid suspension, into a light fraction containing the fibers, and a heavy fraction containing rejects. Assume there are no issues under 35 USC 102, 103, or 112, and that any dependent claim is properly dependent. Recommend which of the following claims, if any, would be subject to rejection under 35 USC 305 for improperly enlarging the scope of the original claim in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein said blades are configured in the form of generally plane surfaces curved in one plane only.
- (B) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the outlet duct is in the form of two frusto-conical portions joined at their narrow ends.
- (C) Claim 5. A method of separating material including fibers suspended in a liquid suspension comprising the steps of separating the material into a light fraction containing the fibers and a heavy fraction containing rejects, and converting the light fraction into a pulp and paper stock suspension.
- (D) Claim 5. A hydrocyclone separator apparatus according to claim 4, wherein the separator chamber is conical in shape having at the narrow end an outlet for the heavy fraction and at its wide end an outlet for the light fraction.
- (E) None of the above.

32. With respect to the examiner's burden in making an enablement rejection under 35 USC 112, first paragraph, which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The examiner may properly make an enablement rejection before construing the claims.
  - (2) The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.
  - (3) The examiner need not give reasons for the uncertainty of the enablement when there is no evidence of operability beyond the disclosed embodiments.
- 
- (A) Statement (1) only
  - (B) Statement (2) only
  - (C) Statement (3) only
  - (D) Statements (1) and (2)
  - (E) Statements (1) and (3)

33. Which of the following phrases taken from an independent claim has an antecedent basis problem according to the patent laws, rules and the procedures as related in the MPEP?

- (A) “the center of the circle having ...,” where the claim does not previously recite that the circle has a “center.”
- (B) “the major diameter of the ellipse being ...,” where the claim does not previously recite that the ellipse has a “major diameter.”
- (C) “the outer surface of the sphere being ...,” where the claim does not previously recite that the sphere has an “outer surface.”
- (D) “the lever of the machine being located ...,” where the claim does not previously recite a “lever.”
- (E) “the area of the rectangle being ...,” where the claim does not previously define an “area.”

34. A registered practitioner filed a utility application on February 11, 2002. On April 4, 2002, the practitioner filed an information disclosure statement (IDS) in the application. The practitioner received a notice of allowance dated January 3, 2003 soon after it was mailed. When discussing the application with the practitioner on January 21, 2003, and before paying the issue fee, the client notices for the first time that a reference, which is one of many patents obtained by the client’s competitor, was inadvertently omitted from the IDS. The client has been aware of this reference since before the application was filed. The client is anxious to have this reference appear on the face of the patent as having been considered by the USPTO. Which of the following actions, if taken by the practitioner, would not be in accord with the patent law, rules and procedures as related by the MPEP?

- (A) Before paying the issue fee, timely file an IDS citing the reference, along with the certification specified in 37 CFR 1.97(e), and any necessary fees.
- (B) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a Request for Continued Examination (RCE) under 37 CFR 1.114, accompanied by the fee for filing an RCE, and an IDS citing the reference.
- (C) Within three months of the mail date of the notice of allowance, without paying the issue fee, timely file a continuing application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (D) After paying the issue fee, timely file a petition to withdraw the application from issue to permit the express abandonment of the application in favor of a continuing application, a continuation application under 37 CFR 1.53(b), an IDS citing the reference, and any necessary fees.
- (E) After paying the issue fee, timely file a petition to withdraw the application from issue to permit consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114, the fee for filing an RCE, and an IDS citing the reference.

35. A registered practitioner files an amendment to the client's claim which inserts language into the claim. The primary examiner improperly rejects the claim under 35 USC 112, first paragraph, description requirement. The examiner's rejection states that the amendment inserted new matter which does not have descriptive support in the original specification. The examiner correctly points out that there is no literal support for the amendatory claim language in the original specification, but erroneously concludes that it constitutes new matter. Assume that there is support for the amendment in the original disclosure. In accordance with the patent laws, rules and procedures as related in the MPEP, a proper reply would include which of the following argument(s) to show the examiner is in error?

- (A) The original specification would enable one of ordinary skill in the art to practice the invention as now claimed.
- (B) Literal support for new claim language is not required.
- (C) The original specification reasonably conveys to one of ordinary skill in the art that the inventor had the claimed invention in his/her possession as of the filing date of the application.
- (D) The new claim language is described in a related application filed by the inventor that is now a U.S. patent.
- (E) (B) and (C).

36. A registered practitioner filed a patent application in the Office in 1999. Following examination and a final rejection, the practitioner timely filed a proper notice of appeal and a proper appeal brief in the application wherein claims 1-3 stand rejected, claims 4 and 5, which depend from claim 1, stand objected to as depending from a rejected claim but are otherwise allowable, and claims 6-10 stand allowed. The appeal involves claims 1-3. After the brief was filed but prior to a decision by the Board of Patent Appeals and Interferences, the practitioner filed a request for continued examination (RCE) with a submission in accordance with 37 CFR 1.114 without paying the fee set forth in 37 CFR 1.17(e). In accordance with the patent laws, rules and procedures as related in the MPEP, what effect does the filing of the RCE without the fee set forth in Rule 1.17(e) have on the application under appeal?

- (A) The application is abandoned.
- (B) The application is still pending and under appeal awaiting a decision by the Board of Patent Appeals and Interferences, because the RCE was improper.
- (C) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-3 canceled and claims 4-10 allowed.
- (D) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-5 canceled and claims 6-10 allowed.
- (E) The appeal is withdrawn; the application is returned to the primary examiner and prosecution is reopened as to claims 1-10.

37. Applicant filed an application containing a claim directed to a polishing wheel coated with diamond grit particles. The application discloses, but does not claim, a diamond grit particle size of 5-7 microns. The examiner rejected the claim under 35 USC 102(b) as being anticipated by a U.S. patent which disclosed as its invention a polishing wheel in accordance with the claim of the application but coated with glass grit particles instead of diamond grit particles. The applied patent, which issued more than 1 year prior to the effective filing date of the application, also disclosed that diamond grit particles were known for coating on polishing wheels but were inferior to glass grit particles because they were more expensive and did not adhere as well to the polishing wheel. The applied patent disclosed a grit particle size of 50-100 microns. Which of the following timely taken courses of action would comply with the patent laws, rules and procedures as related in the MPEP for overcoming the rejection?

- (A) Argue that the patent teaches away from the use of a diamond grit particle coating on a polishing wheel and thus does not teach the claimed invention.
- (B) File a declaration under 37 CFR 1.132 showing unexpected results using diamond grit rather than glass grit.
- (C) Antedate the applied patent by filing a declaration under 37 CFR 1.131 showing that applicant invented the claimed subject matter prior to the effective date of the applied patent.
- (D) Argue the applied patent is nonanalogous art.
- (E) Amend the claim by adding a limitation that the diamond grit particle size is 5-7 microns, and arguing that the claimed invention differs from applied patent by limited the diamond grit particle size to 5-7 microns.

38. Prosecution before the primary examiner results in the rejection of claim 1. Claim 2 was objected to as being allowable except for its dependency from claim 1. Independent claim 3 has been allowed. The rejection of claim 1 is properly appealed to the Board of Patent Appeals and Interferences. The Board properly affirms the rejection of claim 1. Appellant has filed no response to the decision of the Board, the appellant has taken no action, and the time for filing an appeal to the court or a civil action has expired. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following actions is the most appropriate response by the examiner?

- (A) The examiner should hold the application abandoned.
- (B) The examiner should cancel claim 1, convert dependent claim 2 into independent form by examiner's amendment, and allow the application.
- (C) The examiner should set a 1-month time limit in which appellant may rewrite the dependent claim in independent form.
- (D) The examiner should cancel claims 1 and 2 and allow the application with claim 3 only.
- (E) None of the above.

39. On May 1, 2001, a complete patent application was filed with the USPTO naming H as the sole inventor. A primary examiner rejected all the claims in the application under 35 USC 102(e) as being anticipated by a U.S. Patent granted to inventors H and S. The patent was granted on September 25, 2001 on an application filed on December 7, 2000. The claims of the patent application and U.S. patent define the same patentable invention as defined in 37 CFR 1.601(n). The U.S. patent and the application have common ownership. Which of the following, if properly submitted by applicant, would overcome the rejection in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) File a terminal disclaimer in accordance with 37 CFR 1.321(c).
- (B) File a declaration under 37 CFR 1.131 to establish the inventor invented the subject matter of the rejected claim prior to the effective date of the reference X.
- (C) File a declaration stating that the application and patent are currently owned by the same party, and that the inventor named in the application is the prior inventor under 35 USC 104.
- (D) (A) and (C).
- (E) All of the above.

40. In accordance with patent laws, rules and procedures as related in the MPEP, which of the following transitional phrases exclude additional, unrecited elements or method steps from the scope of a claim?

- (A) Comprising;
- (B) Containing;
- (C) Characterized by;
- (D) Including; or
- (E) None of the above.

41. Assume that each claim 5 is in a different patent application. Recommend which, if any, of the following wording is in accord with the patent laws, rules and procedures as related in the MPEP for a multiple dependent claim.

- (A) Claim 5. A gadget according to claims 1-3, in which ...
- (B) Claim 5. A gadget as in claims 1, 2, 3, and/or 4, in which ...
- (C) Claim 5. A gadget as in claim 1 or 2, made by the process of claim 3 or 4, in which ...
- (D) Claim 5. A gadget as in either claim 6 or claim 8, in which ...
- (E) None of the above are proper multiple dependent claims.

42. A registered practitioner filed a first patent application wherein claims 1-10 claims are directed to a widget and claims 11-20 are directed to a method of making a widget. Following a proper restriction requirement, claims 1-10 were elected for prosecution. The primary examiner rejected claims 1-10. The practitioner filed a reply that only consisted of argument. The examiner was unpersuaded by the argument, and entered a final rejection of claims 1-10. In reply, the practitioner filed a continuing application containing claims 1-10 directed to a widget, and claims 11-20 directed to a method of using a widget. In the continuing application, the examiner enters a new written restriction requirement requiring a provisional election between claims 1-10 and claims 11-20. The practitioner believes the new restriction requirement is improper and would like the rejection in the parent application reviewed as well. The new restriction requirement has not been made final. Which of the following best describes whether and why, in accordance with the patent laws, rules, and procedures as related by the MPEP, the reply to the restriction requirement may be by appeal to the Board of Patent Appeals and Interferences?

- (A) Yes. An immediate appeal to the Board can be filed to review the restriction requirement if any claims have been twice rejected.
- (B) No. An immediate appeal cannot be filed to the Board because the new claims directed to a method of using a widget have not been twice rejected.
- (C) Yes. An immediate appeal can be filed for any claims that have been twice rejected because the Board can also review any second restriction requirement made against the same claims.
- (D) No. An immediate appeal to the Board cannot be lodged because a provisional election has not been made of either the claims to a widget or claims to a method of use of the widget.
- (E) No. An immediate appeal cannot be taken because no claims are currently under rejection. Review of a final restriction requirement is only possible as a petitionable matter before a Technology Center Director. It is not an appealable matter to the Board.

43. In accordance with the patent laws, rules and procedures as related in the MPEP, where the independent claim in an application is to an article of manufacture, then a dependent claim to the article of manufacture does not comply with 35 USC 112, fourth paragraph, if:

- (A) the further limitation changes the scope of the dependent claim from that of the claim from which it depends.
- (B) the further limitation of the dependent claim is not significant.
- (C) it does not refer back to and further limit the claim from which it depends.
- (D) it relates to a separate invention.
- (E) it is separately classified from the claim from which it depends.

44. A registered practitioner filed in the USPTO a client's utility patent application on December 30, 2002. The application was filed with a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application in another country, or under a multilateral international agreement, that requires eighteen month publication. Subsequently, the client files an application in Japan on the invention and some recent improvements to the invention. The improvements are not disclosed or supported in the utility application. Japan is a country that requires eighteen month publication. Two months after filing the application in Japan, and before filing any other papers in the USPTO, the client remembers that a nonpublication request was filed and informs the practitioner about the application that was filed in Japan. Which of the following courses of action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The application is abandoned because the practitioner did not rescind the nonpublication request and provide notice of foreign filing within 45 days of having filed the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (B) The application is abandoned because the applicant did not rescind the nonpublication request before filing the application in Japan. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (C) The applicant should file an amendment to the specification of the U.S. application, adding the recent improvements to the disclosure in the specification.
- (D) The application is abandoned because the applicant did not rescind the nonpublication request by notifying the Office under 37 CFR 1.213(c) within the appropriate time. The applicant must now file a petition and fee to revive under 37 CFR 1.137(b).
- (E) The applicant could today notify the USPTO of the foreign filing. It is not necessary to file a petition and fee to revive for the application to continue to be examined in the USPTO.

45. In accordance with patent laws, rules and procedures as related in the MPEP, an abandoned U.S. patent application:

- (A) is never available as evidence of prior art.
- (B) may become prior art only when it is properly incorporated by reference in the disclosure of a U.S. patent.
- (C) may become prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a U.S. patent.
- (D) may become evidence of prior art as of its filing date, but only if it is properly incorporated by reference in the disclosure of a U.S. patent or U.S. application publication.
- (E) may become prior art when it is properly incorporated by reference in the disclosure of a U.S. application publication.

46. In accordance with the patent law, rules and procedures as related by the MPEP, which of the following is not a “printed publication” under 35 USC 102(b), with respect to a patent application filed June 1, 2002?

- (A) A paper that was orally presented at a meeting held May 1, 2001, where the meeting was open to all interested persons and the paper was distributed in written form to six people without restriction.
- (B) A doctoral thesis that was indexed, cataloged, and shelved May 1, 2001, in a single, university library.
- (C) A research report distributed May 1, 2001, in numerous copies but only internally within an organization to persons who understood the organization’s unwritten policy of confidentiality regarding such reports.
- (D) A reference available only in electronic form on the Internet, which states that it was publicly posted May 1, 2001.
- (E) A technical manual that was shelved and cataloged in a public library as of May 1, 2001, where there is no evidence that anyone ever actually looked at the manual.

47. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding claim interpretation during patent prosecution is incorrect?

- (A) A claim is to be given its broadest reasonable interpretation in light of the supporting disclosure in the specification.
- (B) Because a claim is read in light of the specification, the claim may properly be narrowed by interpreting it as including elements or steps disclosed in the specification but not recited in the claim.
- (C) If an applicant does not define a claim term in the specification, that term is given its ordinary meaning in the art.
- (D) When an explicit definition of a claim term is provided in an applicant’s specification, that definition controls the interpretation of the term as it is used in the claims.
- (E) Means plus function language in claims which defines the characteristics of a machine or manufacture includes only the corresponding structures or materials disclosed in the specification and equivalents thereof.

48. Buddy is a recent father and a machinist at a local machine shop. One day while driving to work, Buddy conceived an idea for an improved baby stroller. He quickly worked out many of the details of how to build such an improved stroller, but he still had questions. Buddy later explained his idea to his employer and showed the employer detailed preliminary drawings of the stroller without any agreement as to confidentiality. Buddy wanted use of his employer's machine shop to build a model. Buddy's employer was also excited about the stroller idea and its commercial potential, and the two quickly reached an oral agreement. Buddy would have free use of the machine shop equipment and supplies after regular business hours to work on his model. In exchange, Buddy agreed to assign any patent rights in his invention to the employer for \$1,000.00. Only Buddy and, occasionally, his employer were ever present in the shop when Buddy was working on the stroller. Buddy finalized the design just over a year later, and a nonprovisional patent application was on file within a month of finalization along with a recently executed written assignment of the rights in the invention to Buddy's employer. During prosecution of the patent application, the examiner learned of the oral agreement between Buddy and his employer, and rejected the claims on the basis that the invention was on sale more than one year before the application filing date. Determine which of the following would provide the most reasonable basis for traversing the rejection in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) The examiner cannot properly make the rejection because it is not based on prior art patents or printed publications.
- (B) The oral agreement was a private transaction between Buddy and his employer and no private transaction can provide a basis for an on-sale bar.
- (C) An assignment or sale of the rights in an invention and potential patent rights is not a sale of "the invention" that would operate as a bar to patentability under 35 USC 102(b).
- (D) There can be no on-sale bar even though there was no express requirement of confidentiality because no one other than Buddy's employer was present in the shop when Buddy was working on the stroller and the oral agreement was not public.
- (E) Although the oral agreement to assign the patent to Buddy's employer was made more than a year before the filing date, the written assignment was less than a year before the filing date, and under the Statute of Frauds, sales for more than \$500.00 require a written agreement. A rejection based on the on-sale bar can never be made unless there is an actual sale.

49. Inventor files an application for a non-theoretical metal alloy. The application as originally filed contains the following Claim 1:

1. A metal alloy comprising at least 20% by volume of iron; at least 10% by volume of gallium, and at least 10% by volume of copper.

In accordance with the patent law, rules and procedures as related by the MPEP, which of the following claims would be properly held indefinite under 35 USC 112(2)?

- (A) Claim 2: The alloy of claim 1 containing 66% by volume of gallium and 14% by volume of copper.
- (B) Claim 2: The alloy of claim 1 containing at least 21% by volume of iron, 11% by volume of gallium, and 10.01% by volume of copper.
- (C) Claim 2: The alloy of claim 1 containing 20% by volume of iron, 10% by volume of gallium, and 10% by volume of copper.
- (D) Claim 2: The alloy of claim 1 containing 54% by volume of copper and 27% by volume of gallium.
- (E) Claim 2: The alloy of claim 1 containing at least 1% by volume of silver.

50. Ben hires a registered practitioner to prosecute his patent application. The practitioner drafted an application having fifteen claims. Claim 1 is independent, and each of claims 2-15 are singularly dependent upon claim 1. A proper non-final Office action is mailed to the practitioner. Following consultation with Ben, the practitioner timely prepared, signed, and filed a reply to the Office action containing an amendment that does not add new matter, but does add claims 16-27. Each of claims 16-27 is directed to the same invention sought to be patented through claims 1-15. The dependency of each of claims 16-27 reads “any of claims 5-15.” For purposes of fee calculation in accordance with the patent laws, rules and procedures as related in the MPEP, how many total claims are contained in the application after the amendment is entered?

- (A) One hundred thirty-six.
- (B) One hundred thirty-five.
- (C) Twenty-seven.
- (D) One hundred forty-seven.
- (E) Fifteen.

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**October 15, 2003**

**Morning Session Model Answers**

1. ANSWER: (C) is the most correct answer. MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections,” states “A rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.” Answer (C) is not accord with the USPTO rules and the procedures set forth in the MPEP. (A), (B) and (D) are incorrect. They are in accord with proper USPTO procedure. See MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections.” (E) is not correct because (C) is correct. MPEP § 2163.06.

2. CREDIT GIVEN FOR ALL ANSWERS.

3. ANSWER: (B) is the most correct answer. MPEP § 713.01, under the heading “Scheduling And Conducting An Interview,” states “[a]n interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application.” (A) is incorrect. 37 CFR § 1.133(a)(2); MPEP § 713.02. Section 713.02 states that although “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications[,] [a] request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).” (C) is incorrect. MPEP § 713.03. Larry is only sounding out the examiner and has no authority to commit Joe to any agreement reached with the examiner. (D) is incorrect. MPEP § 713.09. Jane has no right to an interview following the final rejection. Although such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration, interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. (E) is incorrect because (D) is incorrect.

4. ANSWER: (C) is the most correct answer. When the specification expressly provides a special definition for a term used in the claims, the term must be given that special meaning. See MPEP § 2111.01. (A) is incorrect because a term is given its plain meaning only when the specification does not provide a definition for the term. *Id.* (B) is incorrect because the specification defines the term as being inclusive of elemental copper. See MPEP § 2111.01. (D) is incorrect because it does not take into account the definition of copper found in the specification. See MPEP § 2111.01.

5. ANSWER: (B) is the most correct answer. MPEP § 2141.01. Quoting from *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987), MPEP 2141.01, under the heading “Prior Art Available Under 35 U.S.C. 102 Is Available Under 35 U.S.C. 103,” states “[b]efore answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102.” Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a

rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) (“it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.”). Because the printed publication in (B) was not published until *after* the filing date of the patent application, it does not constitute prior art. (A) is incorrect because the patent pre-dates the application, therefore qualifying as prior art, and comes from the same field as the application, therefore qualifying as analogous. (C) is incorrect because the printed publication pre-dates the application, therefore qualifying as prior art, and concerns the same particular problem sought to be solved in the patent application, therefore qualifying as analogous. (D) is incorrect because the printed publication pre-dates the application, therefore qualifying as prior art, and comes from the same field as the application, therefore qualifying as analogous. (E) is incorrect because the patent issued before the application, therefore qualifying as prior art, and concerns the same particular problem sought to be solved in the patent application, therefore qualifying as analogous. The USPTO classification in a different class does not render the patent non-analogous. See MPEP § 2141.01(a) (“While Patent Office classification of references . . . are some evidence of ‘nonanalogy’ or ‘analogy’ respectively, the court has found ‘the similarities and differences in structure and function of the inventions to carry far greater weight.’”).

6. ANSWER: (B) is the most correct answer. 37 CFR § 1.137; and MPEP § 2268. The patent owner will need to file a petition for entry of late papers in order to have their response entered, considered and acted upon. According to MPEP 2268, “[p]ursuant to 37 CFR 1.550(d), an *ex parte* reexamination proceeding is terminated if the patent owner fails to file a timely and appropriate response to any Office . . . An *ex parte* reexamination proceeding terminated under 37 CFR 1.550(d) can be revived if the delay in response by the patent . . . was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b).” (A) is not the most correct answer. In a reexamination proceeding, requests for extensions of time must be filed on or before the day on which action by the patent owner is due pursuant to 37 CFR § 1.550(c). See MPEP § 2265. (C) is incorrect. (C) is inconsistent with MPEP § 2266, which states that if the patent owner fails to file a timely response to any Office action, the reexamination proceeding will be terminated, and after the proceeding is terminated, the Commissioner will proceed to issue a reexamination certificate. There is no provision for issuing a notice of allowance in a reexamination proceeding. Further, (C) is incorrect inasmuch as the examiner should not mail a Notice of Allowance and grant a new patent. (D) is not the most correct answer. In a reexamination proceeding where patent owner fails to file a timely and appropriate response to any Office action, the reexamination proceeding will be terminated via issuance of the Notice of Intent to Issue Reexamination Certificate. See MPEP § 2266. (E) is not the most correct answer. In a reexamination proceeding, requests for extensions of time must be filed on or before the day on which action by the patent owner is due pursuant to 37 C.F.R. § 1.550(c).

7. ANSWER: (C) is the best answer. MPEP §§ 2107.01 and 2107.02. MPEP § 2107.01, under the heading “Therapeutic or Pharmacological Utility,” cites *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); and *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980) as taking the position that “[i]nventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of

technology.” MPEP § 2107.02, under the heading “The Claimed Invention Is The Focus Of The Utility Requirement,” states “. . . regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not "credible," do not render the claimed invention lacking in utility. See, e.g., . . . *In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964) ('Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes 'indicated' in the specification as possibly useful.').” The issue is whether Mr. Bloc has disclosed a specific utility for the claimed compound Y sufficient to satisfy the practical utility requirement of 35 U.S.C. § 101. According to the set of facts, we know that compound Y is an intermediate in the chemical manufacture of synthetic Z. We are given two utilities for synthetic Z: 1) alleviating pain, a utility it shares with the natural form of Z; and, 2) curing cancer. The examiner focuses on the disclosure that synthetic Z is a cure for cancer. Even if one were to agree that synthetic Z’s ability to cure cancer amounts to an incredible utility, a claim to the intermediate compound Y would not run afoul of the utility requirement of 35 U.S.C. § 101 where another substantial, credible and specific utility is alternatively demonstrated. Here, the specification discloses that synthetic Z, like the natural form of Z, alleviates pain. The alleviation of pain is another substantial, credible and specific utility and serves to give compound Y an alternative utility to that of being used to make a cancer-curing substance. An applicant need not show that all disclosed utilities are credible. An applicant need only show that one of the disclosed utilities is in fact credible. *In re Gottlieb, supra*. The establishment of a credible, substantial and specific utility renders the disclosure of an additional incredible utility superfluous, and therefore ultimately irrelevant. Accordingly, Mr. Bloc’s best course of action is to make the argument that he has disclosed another substantial, credible, and specific utility, notwithstanding the disclosure of curing cancer. (A) is not the most correct answer. The advice could prevent him from getting a patent to which he may be entitled. (B) is not the most correct answer. A cure for cancer is ostensibly incredible. It is hardly a response to the examiner’s rejection to ask for the chance to prove one can cure cancer. (D) is not the most correct answer. While it is true that the utility requirement is addressed to the claimed invention, which here is compound Y not synthetic Z, it is not enough to respond by repeating what the invention is but, rather, to show that the invention has indeed a substantial, credible, and specific utility. Whatever is claimed as the invention, it must comply with the utility requirement of 35 U.S.C. § 101. Here the examiner states that the claim does not comply, as evidenced by the incredible utility of the final product. It is Mr. Bloc’s responsibility to then show that compound Y does comply with 35 U.S.C. § 101 by showing that its end product has a substantial, credible, and specific utility. (E) is not the most correct answer. Noting that synthetic Z is modeled on natural Z does not go far enough in establishing a substantial, credible and specific utility for compound Y. It is synthetic Z’s therapeutic ability to alleviate pain which establishes the necessary alternative utility.

8. ANSWER: (D) is the most correct answer. As set forth in MPEP § 2135, under the heading “General Requirements of 35 U.S.C. 102(d),” states “(C) The foreign patent or inventor’s certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published.” Answer (A) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading “General Requirements of 35 U.S.C. 102(d),” states “(A) The foreign application must be filed

more than 12 months before the effective U.S. filing date....” Answer (B) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading “General Requirements of 35 U.S.C. 102(d),” states “(B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.” Answer (C) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading “General Requirements of 35 U.S.C. 102(d),” states “(C) The foreign patent or inventor’s certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published.” Answer (E) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading “General Requirement of 35 U.S.C. 102(d)” states “(D) The same invention must be involved.” See also MPEP § 2135.01(IV).

9. ANSWER: The most correct answer is (E). See MPEP § 201.11, under the heading “VI. When Not Entitled To Benefit Earlier Of Filing Date, ” states “[a]ny claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).” Accordingly, claims 1-10 are entitled to the benefit of the filing date of the first application, but claims 11-20 are not entitled to the benefit of the filing date of the first application because claims 11-20 recite an improved capacitor, which was not disclosed in the first application. Claims 1-10 have an effective filing date earlier than the publication date of the article. Claims 11-20 have a filing date later than the publication date of the article. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application. See MPEP 706.02(a), paragraph “III. 35 U.S.C. 102(a).” Thus, answers (A)-(D) are incorrect.

10. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2173.02, “[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” Answers (A), (B) and (C) each identify criteria to be analyzed in considering whether claim language is definite, therefore answer (E) which includes each of these answers is the most correct answer. Answer (D) is incorrect since it does not include criteria (C).

11. ANSWER: The correct answer is (C). See MPEP § 706.02(l) *et seq.* In accordance with proper USPTO policy and procedure, the prior art exclusion of 35 U.S.C. § 103(c) can only be invoked when the reference only qualifies as prior art under 35 U.S.C. § 102(f), 35 U.S.C. § 102(g), or 35 USC 102(e) for applications filed on or after November 29, 1999, the application and the reference were commonly owned, or subject to an assignment to the same person, at the time the invention was made, and the reference was used in an obviousness rejection under 35

U.S.C. § 103(a). Answer (A) is incorrect. The prior art exclusion in 35 U.S.C. § 103(c) cannot obviate rejections made under 35 U.S.C. § 102(e). See MPEP 706.02(I)(1). Answer (B) is incorrect. The prior art exclusion in 35 U.S.C. § 103(c) cannot obviate double patenting rejections. See MPEP §§ 706.02(I)(1) and (I)(3).

12. ANSWER: (C) is the most correct answer. MPEP § 106 states “[t]he assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See 37 CFR § 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.” (A), (B), (D), and (E) are incorrect. MPEP § 409.03(i) is directly contrary to answer (A), and provides that a non-signing inventor cannot revoke or give a power of attorney without agreement of all named inventors or the 37 CFR § 1.47(b) applicant. (B) is incorrect. MPEP § 106 does not empower an inventor who has assigned his or her rights to exclude a non-signing joint inventor from accessing an application in which the latter party is named as a joint inventor. (E) is incorrect. MPEP § 106. Corporation D, as an assignee of a part interest, cannot exclude the non-signing joint inventor from access to the application. See also, MPEP § 106.01, which states “While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.” (D) is incorrect because MPEP § 409.03(i) states that a nonsigning inventor is entitled to inspect any papers in the application, and order copies at the price set forth in 37 C FR § 1.19.

13. ANSWER: (D) is the most correct answer. 35 U.S.C. § 41(h); MPEP §§ 302.06; 509.02. 35 U.S.C. § 41(h) specifies that the fees “charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.” Since the fee for a document affecting title is charged pursuant to 35 U.S.C. § 41(d)(1), it is not subsection (a) or (b), and it is not entitled to a small entity discount. See also MPEP 509.02, which states, “[o]ther fees, established under section 41 (c) or (d) of Title 35, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247. Fees which are not reduced include . . . miscellaneous fees and charges, 37 CFR 1.21.” Fees for recording documents affecting title are set under 37 CFR § 1.21(h). See MPEP § 302.06. (A) is entitled to a small entity discount because it is a fee charged pursuant to 35 U.S.C. 41(a)(3)(A). (B) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(a)(5). (C) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(a)(8). (E) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(b)(1).

14. ANSWER: (A) is the most correct answer. 35 U.S.C. § 112, first paragraph; MPEP §§ 2164.01 and 2164.06(b). MPEP § 2164.01 states “[t]he standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term ‘undue experimentation,’ it has been

interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” See also the discussion of *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999) in MPEP § 2164.06(b). (B) is incorrect. MPEP § 2107.01, under the heading “III. Therapeutic Or Pharmacological Utility,” states “[t]he Federal Circuit has reiterated that therapeutic utility sufficient under the patent laws is not to be confused with the requirements of the FDA with regard to safety and efficacy of drugs to marketed in the United States. . . . *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). Accordingly, Office personnel should not construe 35 U.S.C. 101, under the logic of ‘practical’ utility or otherwise, to require that an applicant demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans.” (C) is incorrect. 35 U.S.C. § 112, first paragraph; MPEP § 2107.02. MPEP § 2107.02, under the heading “When Is An Asserted Utility Not Credible,” states “Rejections under 35 U.S.C. 101 have been rarely sustained by federal courts. Generally speaking, in these rare cases, the 35 U.S.C. 101 rejection was sustained . . . because . . . [applicant] asserted a utility that . . . was wholly inconsistent with contemporary knowledge in the art. *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967).” The disclosure in (C) is inconsistent with published information. (D) is incorrect. MPEP § 2107.01 under the heading “Relationship Between 35 U.S.C. 112, First Paragraph, and 35 U.S.C. 101,” quotes *In re Ziegler*, 992 F.2d 1197, 1200-1201, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) as stating “The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention. . . . If the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112.” Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. MPEP 2107.01 states that the examiner “must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement.” Inasmuch as countervailing evidence has been produced, the lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph to provide an enabling disclosure that is commensurate in scope with the claims.

15. ANSWER: (A) is the most correct answer. The filing of an amendment complying with 37 CFR § 1.116 is a proper reply under 37 CFR § 1.113 to a final rejection. See MPEP § 714.13, under the heading “Entry Not A Matter of Right,” which states, in pertinent part, “A reply under 37 CFR 1.113 is limited to: (A) an amendment complying with 37 CFR 1.116.” (B) is not the most correct answer because the Notice of Appeal must be accompanied by the appeal fee required by 37 CFR § 1.17(b). (C) is not the most correct answer because the RCE must be accompanied by a submission (*i.e.*, an amendment that meets the reply requirement of 37 CFR § 1.111). (D) is not the correct answer because CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000. See MPEP § 706.07(h), paragraphs I and IV. (E) is not the correct answer since (A) is a proper reply.

16. ANSWER: (A) is the most correct answer. 35 U.S.C. § 251, MPEP § 1402 (fifth paragraph). MPEP § 1402 states that one of the “most common bases for filing a reissue

application [is] (A) the claims are too narrow or too broad.” The claims may be broadened in a reissue application filed by the inventor within two years from the patent issue date. (B) is incorrect since the 4<sup>th</sup> paragraph of 35 U.S.C. § 251 states that no reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent. (C) and (E) are incorrect. MPEP § 1402, sixteenth paragraph. An applicant’s failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue. See *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (D) is incorrect. MPEP § 201.06. In order to claim benefit under 35 U.S.C. § 120 to a parent application, a divisional application must be filed while the parent patent application is still pending.

17. ANSWER: (A) is the most correct answer. MPEP § 2144.03 provides that when an applicant seasonably traverses an officially noticed fact, the examiner may cite a reference teaching the noticed fact and make the next action final. Here, applicant did seasonably traverse the noticed fact by demanding proof in response to the rejection. It is therefore an appropriate action by the examiner. It is also an appropriate action because the examiner should vacate a rejection based on official notice if no support for the noticed fact can be found in response to a challenge by the applicant. See *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (“[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work” and “[a]llegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported”). (B) is incorrect because (A) is correct. (C), (D), and (E) are incorrect because action III is improper. An applicant is entitled to respond to a rejection by requesting reconsideration, with or without amending the application. 37 CFR § 1.111(a)(1). Applicant is also required to timely challenge a noticed fact in order to preserve the issue for appeal. MPEP § 2144.03.

18. ANSWER: (A) is the most correct answer. MPEP § 2121, under the heading “What Constitutes An ‘Enabling Disclosure’ Does Not Depend On The Type Of Prior Art The Disclosure Is Contained In,” states, in reliance upon *In re Moreton*, 288 F.2d 708, 711, 129 USPQ 227, 230 (CCPA 1961): “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.... There is no basis in the statute (35 U.S.C. 102 or 103) for discriminating either in favor of or against prior art references on the basis of nationality.” Answer (B) is incorrect. MPEP § 2121, under the heading “Prior Art Is Presumed To Be Operable/Enabling,” states that “[w]hen the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable.” Answer (C) is incorrect. MPEP § 2121.01, under the heading “35 U.S.C. 103 Rejections And Use Of Inoperative Prior Art,” quotes *Symbol Technologies Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) as stating that “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.” Answer (D) is incorrect. MPEP § 2121.01 states that “[a] reference contains an ‘enabling disclosure’ if the public was in possession of the claimed invention before the date of invention.” Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

19. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2131.05, “‘Arguments that the alleged anticipatory prior art is ‘nonanalogous art’ or ‘teaches away from

the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102.' *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl.Ct.1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed.Cir.1999)." Therefore, answers (A) through (D) are incorrect. See also MPEP § 706.02(b) as to ways to overcome a rejection under 35 U.S.C. § 102.

20. ANSWER: (D) is the most correct answer. MPEP § 201.06(c), under the heading "INCORPORATION BY REFERENCE", subheading "B. Application Entitled to a Filing Date," states that "[i]f the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application." (A) and (B) are incorrect because the application filing date will be the date of the filing of the missing drawing figure. See MPEP § 601.01(g). Furthermore, a priority claim under 35 U.S.C. § 120 in a continuation or divisional application does not amount to an incorporation by reference of the application to which priority is claimed. See MPEP § 201.06(c). (C) is incorrect. The continuation application will not be accorded with a filing date of January 3, 2003 with the missing drawing figure. (E) is incorrect because a petition under 37 CFR § 1.53(e) will not be granted if the missing drawing figure is inadvertently omitted by the applicant and not in fact deposited with the USPTO with the application papers.

21. ANSWER: (D) is most correct. MPEP § 706.02(b) (8th ed., Rev. 1) states that "[a] rejection based on 35 U.S.C. § 102(b) may be overcome by...(C) perfecting priority under...35 U.S.C. § 120 by amending the specification of the application to contain a specific reference to a prior application..." Answer (A) is incorrect because a declaration and evidence filed under 37 CFR § 1.131 cannot antedate a reference that qualifies as prior art under 35 U.S.C. § 102(b), a statutory bar. See 37 CFR § 1.131(a); MPEP § 715, "SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE." Answers (B) and (C) are incorrect because, as noted in MPEP § 2131.04, evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Answer (E) is incorrect because to serve as an anticipation when the reference is silent about an asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). See also MPEP § 2131.01, "Multiple Reference 35 U.S.C. 102 Rejections."

22. ANSWER: (E) is the most correct answer. MPEP § 103, under the heading "Published U.S. Patent Applications" states that "If a patent application has been published pursuant to 35 U.S.C. 122(b), then a copy of the specification, drawings, and all papers relating to the file of

that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee.” (A), and (B) are not correct. 37 CFR § 1.14(c)(2). Once an application has been published, a copy is available to the public upon written request and payment of a fee. (C) and (D) are not correct. As stated in MPEP § 103, under the heading “Published U.S. Patent Applications,” if the published patent application is pending, the application file itself will not be available to the public for inspection.”

23. ANSWER: (C) is the most correct answer. Pursuant to 35 U.S.C. § 112, paragraph 6, *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc), and MPEP § 2181, under the heading “Written Description Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph,” “step” plus function limitations shall be construed to cover the corresponding acts disclosed in the specification and their equivalents. Accordingly, the step plus function imitation correspondingly includes acts (1)-(5) and their equivalents. Thus, in order to anticipate, a prior art reference must disclose each and every act, or its equivalent, for the step plus function. If the reference is shown to not disclose one of the acts, or its equivalents, then the reference fails to anticipate, which is the answer set forth in (C). Thus, (C) is the most complete answer. (A) is not the most complete answer because acts (1)-(4) are disclosed in the reference and the equivalent of act (5) has to be dealt with, i.e., the equivalent of continuing to walk may still be met by the reference unless the applicant shows through argument that the reference also fails to contain any equivalent for act (5). Thus, the most complete answer is (C) as compared to (A). (B) is not the most correct answer because once act (5) is removed from the specification, the prior art reference clearly anticipates (since it otherwise expressly has acts (1)-(4) and the other claim limitations) under the above recited facts absent act (5) in the specification. See Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1849; MPEP § 2181. (D) is not the most complete answer the prior art still anticipates the claim. (E) is not the most correct answer because it includes two incorrect answer choices, (B) and (D).

24. ANSWER: (D) is the most correct answer. MPEP § 2181 under the heading “Procedures For Determining Whether The Written Description Adequately Describes The Corresponding Structure, Material, Or Acts Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph.” 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means plus function language “shall be construed to cover the corresponding structure, materials, or acts described in the specification and ‘equivalents thereof.’” See also *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).” The examiner has made a prima facie case of equivalent in the Office action to support the rejection based on 35 U.S.C. § 102. By amending the claim to no longer include the means limitation in question, the claim becomes narrower inasmuch as it no longer includes equivalents under 35 U.S.C. § 112, paragraph 6 for examination purposes. Thus, (D) overcomes the lack of novelty rejection under these circumstances. (A) is not the most correct answer because such an amended claim would continue to lack novelty, since both it and the prior art would have the attached bar expressly. Furthermore, such an amendment would introduce new matter lacking support in the application as originally filed. 35 U.S.C. § 112, first paragraph. (B) is not the most correct answer because the “not found in the prior art” argument does not rebut the prima facie case of equivalents raised by the examiner. (C) is not the most correct answer because it does not address the rejection. (E) is not the most correct answer because the amendment would raise a new matter issue.

25. ANSWER: The most correct answer is (D). See 35 U.S.C. § 154(b); 37 CFR § 1.702(f); MPEP § 2730 (quoting section 1.702(f)). The application was filed prior to May 29, 2000 and is ineligible for the provisions of Patent Term Adjustment (PTA). Moreover, the filing of a Request for Continued Examination (RCE) under 35 U.S.C. § 132(b) and 37 CFR § 1.114 does not cause an application filed before May 29, 2000 to be entitled to the benefits PTA under the provisions of 35 U.S.C. § 154(b) and 37 CFR §§ 1.702-1.705. See MPEP § 2730. (A) and (B) are not correct answers because the application was filed prior to May 29, 2000, the eligibility date for applications to receive the benefit of PTA provisions of 35 U.S.C. § 154(b) and 37 CFR §§ 1.702 through 705. Answer choice (C) is not correct because utility applications, not design applications are subject to the PTA provisions and the answer suggests that design applications are eligible for PTA. Answer choice (E) is not a correct answer because the application is not eligible for PTA and filing an RCE does not make an ineligible application eligible for PTA. Design patents are granted for fourteen year terms from the grant of the patent. 35 U.S.C. § 171. Utility patents are subject to patent term adjustment. 35 U.S.C. § 154(b)

26. ANSWER: (D) is the most correct answer. MPEP § 714.16, third paragraph, states “a supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s).” Answer (A) is incorrect because a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312 except when submitted in a reissue. See MPEP § 603.01. Answer (B) is incorrect because a supplemental oath or declaration in a reissue will be treated as an amendment under 37 CFR § 1.312 only if filed after allowance. Answer (C) is incorrect because amendments filed after the date the issue fee has been paid are no longer permitted under 37 CFR § 1.312. (E) is wrong because (A) is correct.

27. ANSWER: (C) is the most correct answer. 35 U.S.C. § 101; MPEP 2106, under the heading “A. Identify and Understand Any Practical Application Asserted for the Invention.” With regard to computer-related inventions, MPEP § 2106 states that “[a]lthough the courts have yet to define the terms useful, concrete, and tangible in the context of the practical application requirement for such inventions, the following example illustrates claimed inventions that have a practical application because they produce useful, concrete, and tangible results: ‘Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held to be directed to patentable subject matter because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle.’ *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999).” See also, *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Answers (A), (B) and (D) are incorrect. MPEP § 2105 states that abstract ideas, laws of nature and physical phenomena have been held by the Supreme Court to be unpatentable subject matter under 35 U.S.C. § 101. Answer (E) is incorrect because answers (A), (B) and (C) are incorrect.

28. ANSWER: (A) is the most correct answer. MPEP § 2144, under the heading “Rationale Different From Applicant’s Is Permissible.” Patent A suggests an insert with receptacles that are circular and which can be shaped to complement the shape of the object to be received. The

purpose for this in Patent A is to keep the cart organized, not as in the claim to prevent the object from falling and breaking. The difference in objectives does not defeat the case for obviousness because, as MPEP § 2144 states, the “reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) ...; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) ... .” In other words, it does not matter that Patent A does not appreciate the claimed purpose of preventing breakage. It suggests an insert with receptacles to hold bottles. That is enough to render the claimed subject matter *prima facie* obvious. The *prima facie* case is not rebutted by arguing that the purpose for the claimed insert is different from that specified for the insert described in Patent A. That is why answer (C) is wrong. To rebut the *prima facie* case, the practitioner must show a difference in structure instead. Answer (B) is wrong because the *prima facie* case is not rebutted by showing that Patent A does not teach wine bottles. This is not an anticipation rejection where identity of subject matter might be an issue. This is a question of obviousness. Therefore, it is sufficient to point out that Patent A is a generic teaching of shopping cart inserts that hold objects of any size and shape. (D) is not the most correct answer because what Patent A is interested in doing is irrelevant to the question of obviousness. (E) is not the most correct answer inasmuch as it was not the practitioner’s argument. However, the question inquires about the merits of the argument that the practitioner made as set forth in the penultimate sentence of the question, not the merits of some hypothetical reply the examiner may communicate.

29. ANSWER: (B) is the most proper answer. MPEP § 2128.02, under the heading “Date of Accessibility Can Be Shown Through Evidence of Routine Business Practices,” states, in reliance upon *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), cert. denied, 988 U.S. 892 (1988), and *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986), “Evidence showing routine business practices can be used to establish the date on which publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary.” Answer (A) is incorrect. MPEP § 2128.01, under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public,” states “[a] doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior art as a ‘printed publication.’ *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). Even if access to the library is restricted, a reference will constitute a ‘printed publication’ as long as a presumption is raised that the portion of the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978).” Answer (C) is incorrect. MPEP § 2128.01, under the heading “Orally Presented Paper Can Constitute A ‘Printed Publication’ If Written Copies Are Available Without Restriction,” states, in reliance upon *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985): “[a] paper which is orally presented in a forum open to all interested persons constitutes a ‘printed publication’ if written copies are disseminated without restriction.” Answer (D) is incorrect. MPEP § 2128.01, under the heading “Internal Documents Intended To Be Confidential Are Not Printed Publications,” states, in reliance upon *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Int. 1987), *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970), and *Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). “[d]ocuments and

items only distributed internally within an organization which are intended to remain confidential are not ‘printed publications’ no matter how many copies are distributed.” Answer (E) is incorrect. MPEP § 2128.02, under the heading “A Journal Article or Other Publication Becomes Available As Prior Art on Date of It Is Received by a Member of the Public,” states, in reliance upon *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956): “[a] publication disseminated by mail is not prior art until it is received by at least one member of the public.”

30. ANSWER: (B) or (D) is accepted as the correct answer. As to (B) and (D), see MPEP § 706.02(I)(2), under the heading “II. Evidence Required To Establish Common Ownership.” (B) is accepted because applicants, *e.g.*, inventors, have the best knowledge of the ownership of their applications, and because their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. (D) reproduces the example set forth under the foregoing heading. (A) is incorrect because applicants or the representatives of record have the best knowledge of the ownership of their applications, and because their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. (C) is incorrect because the statement does not establish common ownership at the time the later invention was made. 35 U.S.C. § 103(c). (E) is incorrect because it does not establish that the prior art invention and the claimed invention are entirely or wholly owned by the same person. MPEP § 706.02(I)(2).

31. ANSWER: (C). 35 U.S.C. § 305; MPEP §§ 2258 and 1412.03. MPEP § 2258, under the heading “Claims In Proceeding Must Not Enlarge Scope Of The Claims Of The Patent,” states “[w]here new or amended claims are presented . . . the claims of the reexamination proceeding should be examined under 35 U.S.C. 305, to determine whether they enlarge the scope of the original claims. 35 U.S.C. 305 states that ‘no proposed amended or new claim enlarging the scope of the claims of the patent will be permitted in a reexamination proceeding...’” Under the further subheading “Criteria for Enlargement of the Scope of the Claims,” MPEP § 2258 states “A claim presented in a reexamination proceeding ‘enlarges the scope’ of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, *i.e.*, what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination.” MPEP § 1412.03, under the heading “New Category of Invention Added In Reissue – Broadening,” states “[t]he addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Inter. 1989).” MPEP 2258, under the further subheading “Rejection of Claims Where There Is Enlargement,” states “[a]ny claim in a reexamination proceeding which enlarges the scope of the claims of the patent should be rejected under 35 U.S.C. 305.” Since no claims drawn to a method were ever presented during prosecution of Patent X (claims 1 through 4 “are the only claims that were ever presented during prosecution of the application that matured into Patent X”), the claim recited in (C) is not directed to “the invention as claimed.” (A), (B), and (D) are all incorrect because each of their claims are directed to a hydrocyclone separator apparatus, *i.e.*, “the invention as claimed,” and they do not enlarge the scope of the claims in Patent X. (E) is an incorrect answer because (C) is the correct answer.

32. ANSWER: (B) is the most correct, as only statement (2) is true. The examiner has the initial burden to establish a reasonable basis to question the enablement provided. MPEP § 2164.04 states “[i]n order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).” Answer (A) is incorrect, because statement (1) is not true. The examiner may not analyze enablement before construing the claims. MPEP § 2164.04. Answer (C) is incorrect, because statement (3) is not true. The examiner must give reasons for the uncertainty of the enablement, even when there is no evidence of operability without undue experimentation other than the disclosed embodiments. *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). MPEP § 2164.04 states “[a]ccording to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement.” Answer (D) is incorrect because it includes false statement (1). Answer (E) is incorrect because it includes false statements (1) and (3).

33. ANSWER: (D) is correct. “Inherent components of elements recited have antecedent basis in the recitation of the components themselves.” MPEP § 2173.05(e). The MPEP provides an analogous example: “the limitation ‘the outer surface of said sphere’ would not require an antecedent recitation that the sphere have an outer surface.” *Id.* (A), (B), (C), and (E) are all examples of things which inherently have the claimed characteristic and do not have an antecedent basis problem; that is, all circles have a center, all ellipses have a major diameter, all spheres have an outer surface, and all rectangles have an area, and these characteristics need not be provided with express antecedent basis. The ellipse example is from *Bose Corp. v. JBL Inc.*, 61 USPQ2d 1216, 1219 (Fed. Cir. 2001) (“There can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter.”). The lever recited in (D) is not an inherent component of a machine and therefore requires express antecedent basis.

34. ANSWER: (A), describing a procedure that is not in accordance with the USPTO rules and the procedures set forth in the MPEP, is the most correct answer. MPEP § 609, under the heading “Minimum Requirements for an Information Disclosure Statement,” under the subheading “B(3). Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97 (d)”, and subheading “B(5) Statement Under 37 CFR 1.97(e).” (A) The statement specified in 37 CFR § 1.97(e) requires that the practitioner certify, after reasonable inquiry, that no item of information contained in the IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of the information disclosure statement. The practitioner cannot certify this because the reference was known to the client before February 11, 2002, the time of filing of the utility application, which was more than three months prior to the filing of the information disclosure statement. See (B), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(a), a petition to withdraw the application from issue is not required if a proper RCE is filed before payment of the issue fee. (C), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. A practitioner can file a continuing application on or before the date that the issue fee is

due and permit the parent application to become abandoned for failure to pay the issue fee. (D), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(3), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit the express abandonment of the application in favor of a continuing application. (E), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(2), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit consideration of a Request for Continued Examination (RCE) under 37 CFR § 1.114. See also MPEP § 1308.

35. ANSWER: (E) is the most correct answer because (B) and (C) together are correct. Regarding (B), see MPEP § 2163.02, which states, “Whenever the [written description] issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).” Regarding (C), see MPEP § 2163.02, which states, “The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’ *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.” (B) alone and (C) alone are incorrect inasmuch as they do not address each of the examiner’s rationales for the rejection. (A) is incorrect. MPEP § 2161. The written description requirement is separate and distinct from the enablement requirement of 35 U.S.C. § 112, first paragraph. The argument does not address and otherwise traverse the rejection that was made. (D) is incorrect. MPEP § 2163.03, under the headings “RELIANCE ON FILING DATE OF PARENT APPLICATION UNDER 35 U.S.C. 120,” and “RELIANCE ON PRIORITY UNDER 35 U.S.C. 119.” The related case must be an application having a filing date to which the instant application is entitled, e.g., a parent or provisional application. The argument does not show the instant application is related to the “related application” under 35 U.S.C. §§ 119 or 120. (B) alone is not correct because (C) is also correct. (C) alone is not correct because (B) is also correct.

36. ANSWER: (D) is the correct answer. See MPEP §§ 706.07(h), under the heading “X. After Appeal But Before Decision By Board,” and 1215.01. As explained in MPEP § 1215.01, “The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission.” Thus, the filing of the RCE without the fee results in the withdrawal of the appeal in this application and passage of the application to issue with the allowed claims 6-10 after the cancellation of both rejected claims 1-

3 and claims 4 and 5 which are allowable except for their dependency from rejected claim 1 (A) is incorrect. As also explained in MPEP § 1215.01, although an application under appeal having no allowed claims will be considered abandoned by the filing of an improper RCE, an application having allowed claims will be passed to issue with the allowed claims. Upon withdrawal of appeal, claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. See MPEP § 1215.01. All rejected claims, such as claims 1-3, and claims which are allowable except for their dependency from rejected claims, such as claims 4 and 5, will be canceled. (B) is incorrect. As explained in MPEP § 706.07(h), under the heading “After Appeal But Before Decision By The Board,” proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that the filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission. (C) is incorrect for the reasons explained for (A), and because claims 4 and 5 will be canceled. (E) is incorrect. The RCE, which was filed without the fee, is improper. Thus, as explained in MPEP § 706.07(h), under the heading, “After Appeal But Before Decision By The Board,” proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that the filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission.

37. ANSWER: (E) is the correct answer. 35 U.S.C. § 102(b); 37 CFR § 1.111(b); MPEP §§ 706.02(b), 2131 and 2131.03. As stated in MPEP 2131, under the heading “To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim,” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.03, under the heading, “Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With ‘Sufficient Specificity.’” states “When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with ‘sufficient specificity to constitute an anticipation under the statute.’” A claim containing a limitation that the grit particle size is 5-7 microns would not be anticipated by the applied reference, because the applied reference discloses a different grit particle size well outside that range. (A) is incorrect. MPEP § 2123(8<sup>th</sup> Ed.). Patents are relevant as prior art for all they contain and are not limited to their preferred embodiments. See *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) and *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 975 (1989). (B) is incorrect. See MPEP § 2131.04. Evidence of secondary considerations such as unexpected results is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based. See *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). (C) is incorrect. See MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Are Inappropriate.” An affidavit or declaration under 37 CFR § 1.131 is inappropriate where the reference publication date is more than 1 year prior to applicant’s effective filing date. Such a reference is a “statutory bar” under 35 U.S.C. § 102(b) as referenced in 37 CFR § 1.131(a)(2). (D) is also incorrect. See MPEP § 2131.05. Arguments

that the alleged anticipatory prior art is “nonanalogous art” are not “germane” to a rejection under 35 U.S.C. § 102. *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982).

38. ANSWER: (D) is the most correct answer. 37 CFR § 1.197(c); MPEP § 1214.06. This case is specifically set forth in MPEP § 1214.06 under the heading “Claims Stand Allowed.” Answers (A), (B) and (C) apply only if no claims stand allowed in the application. They are incorrect because the facts state that claim 3 was allowed. See MPEP § 1214.06, under the heading “No Claims Stand Allowed.” (B) is incorrect. See MPEP § 1214.06 under the heading “Claims Stand Allowed.” Where one or more other claims stand allowed, the examiner is not authorized to convert to independent form a dependent claim that has been objected to (but not allowed or rejected) based on its dependency to a rejected claim. (C) is incorrect. See MPEP § 1214.06 under the heading “Claims Stand Allowed.” Where one or more other claims stand allowed, the examiner is not authorized to provide appellant with time to rewrite a dependent claim into independent form where the dependent claim was objected to (but not allowed or rejected) based on its dependency to a rejected claim.

39. CREDIT GIVEN FOR ALL ANSWERS.

40. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2111.03 states “[t]he transitional term ‘comprising’ [Answer (A)], which is synonymous with ‘including’ [Answer (D)], ‘containing’ [Answer (B)], or ‘characterized by’ [Answer (C)], is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. Since Answers (A), (B), (C) and (D) are all open-ended transitional phrases they are incorrect answers.

41. ANSWER: The correct answer is (E). MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording.” Multiple dependent claims in proper form depend on preceding claims and refer to the claims from which they depend in the alternative only. Answer (A) is incorrect. See MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording,” and subheading “1. Claim Does Not Refer Back In the Alternative Only,” second example. A proper multiple dependent claim must refer back in the alternative only. Answer (B) is incorrect. See MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording,” and subheading “1. Claim Does Not Refer Back In the Alternative Only,” fifth example. A proper multiple dependent claim refers back in the alternative only. Answer (C) is incorrect. Answer (C) reproduces the example in MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording,” and subheading “3. References to Two Sets of Claims to Different Features.” A proper multiple dependent claim refers in the alternative to only one set of claims. Answer (D) is incorrect. See MPEP § 608.01(n), under the heading “B. Unacceptable Multiple Dependent Claim Wording,” and subheading “2. Claim Does Not Refer to a Preceding Claim,” second example. A proper multiple dependent claim depends only from preceding claims.

42. ANSWER: (E) is the most correct answer. MPEP § 1002.02(c) identifies among the matters petitionable to and decided by the Technology Center Directors “Petitions from a final decision of examiner requiring restriction in patent applications, 37 CFR 1.144, MPEP § 818.03(c).” Hence (A), and (C), which provide for review before the Board of Patent Appeals

and Interferences are clearly erroneous. Since the restriction requirement is not yet “final” no review is possible at this juncture. Answers (A), (B), (C), and (D) are also incorrect because no claim is under rejection hence no appeal is possible. See MPEP § 1205, which provides that under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner’s decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner’s rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of “twice or finally...rejected” does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

43. ANSWER: The answer is (C). See 37 CFR § 1.75(c); MPEP 608.01(n). Rule 1.75(c) provides that “[o]ne or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” See also MPEP § 608.01(n), under the heading “III Infringement Test,” second paragraph, wherein it states, “[t]he test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends.” For answer (A), see MPEP § 608.01(n), under the heading “III Infringement Test,” second paragraph, wherein it states, “[t]he test is not one of whether the claims differ in scope.” For answer (B), see MPEP § 608.01(n), under the heading “III Infringement Test,” second paragraph, wherein it states, “[a] dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim.” For answers (D) and (E), see MPEP § 608.01 (n), under the heading “III Infringement Test,” fifth paragraph, wherein it states, “[t]he fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.”

44. ANSWER: (A) is the most correct answer. See 35 U.S.C. 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (B) is incorrect. The notice of foreign filing can be filed as late as 45 days after the foreign filing before the U.S. application becomes abandoned. (C) is incorrect. See MPEP § 608.04(a). The improvements would constitute new matter and new matter cannot be added to the disclosure of an application after the filing date of the application. (D) is not correct. The applicant is required to provide notice of foreign filing, not merely rescind the nonpublication request within the appropriate time. (E) is not correct. The applicant was required to provide notice of foreign filing within 45 days of filing in Japan, and two months have passed. As a result, a petition to revive under 37 CFR § 1.137(b) is required for examination to continue. Also see 37 CFR § 1.137(f).

45. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2127, under the heading “Abandoned Applications, Including Provisional Applications,” and subheading,

“Abandoned Applications Disclosed to the Public Can Be Used as Prior Art,” states “the subject matter of an abandoned application, including both provisional and nonprovisional applications, referred to in a prior art U.S. patent may be relied on in a 35 U.S.C. 102(e) rejection based on that patent if the disclosure of the abandoned application is actually included or incorporated by reference in the patent. Compare *In re Lund*, 376 F.2d 982, 991, 153 USPQ 625, 633 (CCPA 1967) (The court reversed a rejection over a patent which was a continuation-in-part of an abandoned application. Applicant’s filing date preceded the issue date of the patent reference. The abandoned application contained subject matter which was essential to the rejection but which was not carried over into the continuation-in-part. The court held that the subject matter of the abandoned application was not available to the public as of either the parent’s or the child’s filing dates and thus could not be relied on in the 102(e) rejection.)” (A) is incorrect since an abandoned patent application may become evidence of prior art. Answers (B), (C) and (D) are incorrect due to the use of the word “only”. Answer (E) does not include the term “only”. In addition, Answer (C) and (D) are also incorrect due to the inclusion of the phrase “as of its filing date”. As set forth above, “An abandoned patent application becomes available as prior art only as of the date the public gains access to it. See 37 CFR 1.14(e)(2).”

46. ANSWER: The correct answer is (C). The internal report was intended to be confidential and therefore is not a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01, under the heading “Internal Documents Intended To Be Confidential Are Not ‘Printed Publications,’” citing *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Int. 1987) states “Research reports disseminated in-house to only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing.” Answer (A) is incorrect. An orally presented paper can be a “printed publication” if copies are available without restriction. The paper is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (B) is incorrect. The thesis is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (D) is incorrect. An electronic publication disclosed on the Internet is considered to be publicly available as of the date the item was posted. The reference is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128. Answer (E) is incorrect. There is no need to prove that anyone actually looked at a document. The manual is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.

47. ANSWER: (B) is the most proper answer. MPEP § 2111, under the heading “Claims Must Be Given Their Broadest Reasonable Interpretation,” states, in reference to *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969): “The court explained that ‘reading a claim in light of the specification,[’] to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed [sic, *disclosed*] limitations which have no express basis in the claim.” Answer (A) is an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. As pointed out in MPEP § 2111.01, the court in *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)), states: “It is well settled that ‘claims are not to be read in a vacuum and limitations therein are to be interpreted in light of the specification in giving them their “broadest reasonable interpretation.”’” Answer (C) is an improper response to the question because it is a

correct statement of claim interpretation during patent prosecution. MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states that “[w]hen not defined by applicant in the specification, the words of a claim must be given their plain meaning.” Answer (D) is an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. MPEP § 2111.01 states that it is only when the specification provides a definition for terms appearing in the claims can the specification be used to interpret the claim language. Answer (E) is an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. See MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states, in reliance upon *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), that there is “one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6<sup>th</sup> paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim.”

48. ANSWER: (C) is the most correct answer. 35 U.S.C. § 102(b); MPEP § 2133.03(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of “Sale,” and subheading “D. A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent,” states “[a]n assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b).” The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).” (A) is incorrect. Although reexaminations are limited to prior art patents and printed publications, that limitation is not present in original prosecution. MPEP § 2133.03(b) states “An impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed. Cir. 1995).” (B) and (D) are incorrect. There is no requirement that on-sale activity be public. See MPEP § 2133.03(b), under the heading “III. Sale By Inventor, Assignee Or Others Associated With The Inventor In The Course Of Business,” and subheading “A. Sale Activity Need Not Be Public.” (E) is wrong at least because an on-sale bar does not require an actual sale. A bar can also be based on an offer to sell. MPEP § 2133.03(b), under the heading “II. Offers For Sale.”

49. ANSWER: (D) is the correct answer. See MPEP § 2173.05(c), under the heading “Open-Ended Numerical Ranges.” Paraphrasing the explanation therein, when an independent claim recites a composition comprising “at least 20% iron” and a dependent claim sets forth specific amounts of non-iron ingredients which add up to 100%, apparently to the exclusion of iron, an ambiguity is created with regard to the “at least” limitation unless the percentages of the non-iron ingredients are based on the weight of the non-iron ingredients. On the other hand, a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of iron, 20-80% of gallium, and 1-25% of copper) is not necessarily indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. Here, because the invention is a non-theoretical alloy, the sum of the claimed constituents cannot exceed 100% unless the percentage is based on weight. In (D), the sum of elements (B) and (C)

is 81% by volume, leaving only 19% for iron. Claim 1, however, requires “at least 20% iron,” rendering Claim 2 ambiguous as to the percentage of element A. (A) is incorrect. The sum of gallium and copper components is 80%, leaving a possible 20% of the composition for element iron. Claim 1 requires “at least 20% iron,” which includes 20% iron. Therefore, the sum of iron, gallium and copper components in Claim 2 is 100%. (B) is incorrect. “At least 20% iron” includes 21% iron, “at least 10% gallium” includes 11% gallium, and “at least 10% copper” includes 10.01% copper. (C) is incorrect. “At least 20% iron” includes 20% iron, “at least 10% gallium” includes 10% gallium, and “at least 10% copper” includes 10% copper. (E) is incorrect because Claim 1 uses the open transition phrase “comprising,” which permits additional elements to be added to the composition. Nothing in the problem indicates that an additional component, silver, cannot be added to the composition.

50. ANSWER: (D) is the most correct answer. 37 CFR § 1.75; MPEP § 608.01(n). As explained in MPEP § 608.01(n), under the heading “Multiple Dependent Claims,” subheading “Acceptable Multiple Dependent Claim Wording” the multiple dependent claim wording of new claims 16-27 is proper. See, for example, “any one of the preceding claims,” and “in any of claims 1-3 or 7-9.” 37 CFR § 1.75(c) states “For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.” Therefore, claims 16-27 would each have a claim value of eleven and the total number of claims for fee calculation is one hundred forty-seven ( $12 \times 11 = 132 + 15 = 147$ ). Answers (A) and (B) are incorrect because they are not the correct total. Answer (C) is incorrect because the multiple dependent claims have not been calculated in accordance with 37 CFR § 1.75. Answer (E) is incorrect because the question asks for the total after the amendment adding claims 16-27 has been entered.

**UNITED STATES PATENT AND TRADEMARK OFFICE  
REGISTRATION EXAMINATION  
FOR PATENT ATTORNEYS AND AGENTS**

**OCTOBER 15, 2003**

**Afternoon Session (50 Points)**

**Time: 3 Hours**

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**DIRECTIONS**

This session of the examination is an open book examination. You may use books, notes, or other written materials that you believe will be of help to you *except* you may not use prior registration examination questions and/or answers. Books, notes or other written materials containing prior registration examination questions and/or answers *cannot* be brought into or used in the room where this examination is being administered. If you have such materials, you must give them to the test administrator before this session of the examination begins.

All questions must be answered in SECTION 1 of the Answer Sheet which is provided to you by the test administrator. You must use a No. 2 pencil (or softer) lead pencil to record your answers on the Answer Sheet. Darken *completely* the circle corresponding to your answer. You must keep your mark within the circle. Erase *completely* all marks except your answer. Stray marks may be counted as answers. No points will be awarded for incorrect answers or unanswered questions. Questions answered by darkening more than one circle will be considered as being incorrectly answered.

This session of the examination consists of fifty (50) multiple choice questions, each worth one (1) point. Do not assume any additional facts not presented in the questions. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the patent laws, rules and procedures as related in the Manual of Patent Examining Procedure (MPEP). Each question has only one most correct answer. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer that will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement that would make the statement *true*. If it is determined by the USPTO that there is more than one most correct answer to a question, each most correct answer will be accepted, but only one point will be given for the question. The presence of multiple most correct answers does not, in itself, render the question ambiguous. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

You may write anywhere on the examination booklet. However, do not remove any pages from the booklet. Only answers recorded in SECTION 1 of your Answer Sheet will be graded. **YOUR COMBINED SCORE OF BOTH THE MORNING AND AFTERNOON SESSIONS MUST BE AT LEAST 70 POINTS TO PASS THE REGISTRATION EXAMINATION.**

**DO NOT TURN THIS PAGE UNTIL YOU ARE INSTRUCTED TO**

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1. In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) The basic filing fee required by 37 CFR 1.16(a).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) Any drawing required by 37 CFR 1.81(a).

2. A U.S. patent was granted on May 8, 2001. The sole independent claim in the patent is directed to a combination of elements ABCD. A registered practitioner filed a reissue application on April 11, 2003 to narrow sole independent claim. In the reissue application, the independent claim is amended to a combination to elements ABCDE. The reissue application is accompanied by a transmittal letter stating that the application was filed to narrow a claim, that all inventors could not be located to sign the reissue oath or declaration at that time, and that a declaration would be submitted in due course. No other amendments to the claims were filed on April 11, 2003. On May 8, 2003, a declaration signed by all inventors is filed declaring that they had claimed less than they had a right to claim, and that the error arose without deceptive intent. The inventors also filed on May 8, 2003 a preliminary amendment deleting element A from the sole independent claim leaving elements BCDE. The amendment and declaration are filed using the provisions of 37 CFR 1.10. The practitioner included an authorization to charge the practitioner's deposit account for any necessary fees. Which of the following actions by the primary the examiner in the first Office action is in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a broadened reissue claim at the time of filing.
- (B) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant did not file a claim to a broadened reissue claim within the two year period set by 35 USC 251.
- (C) Reject all the claims based upon a broadening reissue outside the two year statutory period authorized by 35 USC 251 since applicant's indication in the transmittal letter indicated that the filing of the reissue application was a narrowing reissue and that the broadening amendment was not permissible even if filed within the two-years from the grant of the original patent.
- (D) Determine that the application is a proper broadening reissue and perform an examination and issue an Office action in due course.
- (E) Determine that the application is a proper broadening reissue and reject the claims under the recapture doctrine since the claims are broader than the issued claims.

3. An applicant submits a product-by-process claim to a shoe made by a series of specific process steps. The claim is rejected over a publication under 35 USC 102(b) and 103. Assume for this question that the publication reasonably appears to show the identical shoe, but describes a different method of making the shoe. What is the proper procedure to try to overcome the rejection in accordance with the patent laws, rules and the procedures as related in the MPEP?

- (A) Argue that all limitations in the claim must be given weight and that rejection must be withdrawn because the reference does not disclose the claimed method of making steps.
- (B) Argue that the examiner has not carried the burden of proving that the shoes are identical.
- (C) Present evidence why the steps of the claimed process produce a patentably different structure.
- (D) Submit a declaration under 37 CFR 1.132 by the author of the publication describing in more detail how the shoe in the publication was made by a different method.
- (E) Argue that the inventor was not aware of the publication when the invention was made.

4. A registered practitioner files an international application submission that includes a description, claims and drawings in the United States Receiving Office (RO/US) on Wednesday, January 8, 2003. The submission did not include the required request, international and search fees, or the designation of a PCT contracting State. The RO/US mails an "Invitation to Correct the Purported International Application," dated January 10, 2003, to the practitioner indicating that the designation of at least one Contracting State, as required by PCT Article 11(1)(iii)(b), was not included. A one-month period for response is set in the Invitation. On Monday, February 10, 2003, the practitioner submits by facsimile a designation sheet of the Request Form designating every available Contracting State, and authorization to charge all required fees. In accordance with the patent laws, rules and procedures as related in the MPEP, will the application be accorded an international filing date?

- (A) Yes. The application will be accorded a filing date of January 8, 2003.
- (B) Yes. The application will be accorded an international filing date of February 10, 2003.
- (C) No. The application will not be accorded an international filing date because the failure to designate at least one contracting State cannot be cured by a facsimile transmission.
- (D) No. The application was given a one-month period for response. The practitioner would have had to have filed the response on Friday, February 7, 2003 in order to have been timely.
- (E) None of the above.

5. In accordance with the patent laws, rules and procedures as related in the MPEP, satisfaction of the written description requirement may not be demonstrated by:

- (A) including in the specification a description of an actual reduction to practice.
- (B) describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.
- (C) describing during prosecution of a new or amended claim an element or limitation (omitted from the original disclosure in the specification) as an essential or critical feature of the invention.
- (D) including in the specification a description of distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention at the time of filing.
- (E) including in the patent application disclosure of drawings or structural chemical formulas showing that the invention is complete.

6. Inventor Tip, a scientist in a pencil research laboratory, theorized that, based on the abrasive properties of moon dust, a highly efficient erasure can be made by adding a trace amount of moon dust to a normal pencil erasure formulation. Point, in the Sales department, determined that this would be perfect for a high end product. A U.S. patent application has been filed claiming a pencil erasure formulation with a trace amount of moon dust. An example of how to make the formulation with specified percentages of moon dust is presented therein. Thereafter, Tip learns about the duty to disclose information and he recalls signing a declaration under 37 CFR 1.63 stating that he had reviewed and understood the contents of the specification including the claims. Tip becomes concerned that the use of moon dust was only a theory and that to obtain patent would mislead the public to conclude that moon dust was actually used and found to be effective. The application has been allowed, but the issue fee has not yet been paid. Which of the following is most in accord with patent laws, rules and procedures as related in the MPEP?

- (A) Point is under a duty to disclose material information to the USPTO.
- (B) Tip is under a duty to disclose his concern regarding the moon rock information to the USPTO.
- (C) Both Point and Tip are under a duty to disclose material information to the UPSTO.
- (D) There is no duty to disclose information regarding how the moon rock formulation was developed to the USPTO.
- (E) Inasmuch as the application is allowed, an appropriate Request for Continued Prosecution pursuant to 37 CFR 1.114 needs to be filed accompanied by a information disclosure regarding the possibility of rejections under 35 USC 101, and 112, first paragraph.

7. The claimed invention in a patent application is directed to an explosive composition “comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree.” The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to “sensitize the composition.” A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is “sufficient aeration entrapped to enhance sensitivity to a substantial degree.” The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. In addition to the prior art reference, a printed publication contains test data demonstrating that “sufficient aeration” is necessarily an inherent element in the prior art blasting composition under the circumstances. In accordance with the patent laws, rules and the procedures as related in the MPEP, the prior art reference:

- (A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.
- (B) does not anticipate the claim because the prior art reference does not recognize an inherent property.
- (C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.
- (D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

8. With respect to establishing “reasonable diligence” for under 35 USC 102(g), which of the following statements is or are in accordance with the patent laws, rules and procedures as related in the MPEP?

- (1) The inventor and his attorney must drop all other work and concentrate on the particular invention involved.
  - (2) The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.
  - (3) Work relied upon to show reasonable diligence must be directly related to the reduction to practice.
- (A) Statement (1) only
  - (B) Statement (2) only
  - (C) Statement (3) only
  - (D) Statements (1) and (3)
  - (E) Statements (2) and (3)

9. Which one of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP regarding double patenting rejections?

- (A) A rejection of application claims for obviousness-type double patenting over the claims of a patent which names a different inventive entity (where one inventor is in common with the inventive entity in the application) and was not commonly owned at the time applicant made his or her invention can be overcome with an affidavit or declaration under 37 CFR 1.131 showing that the applicant made the invention in the United States prior to the effective filing date of the patent.
- (B) A rejection for obviousness-type double patenting of application claims over patent claims can properly rely on an embodiment which is disclosed in the patent and provides support for the patent claims on which the rejection is based.
- (C) The filing of a terminal disclaimer to overcome an obviousness-type double patenting rejection constitutes a binding admission that the rejection is proper.
- (D) Application claims are properly rejected for obviousness-type double patenting over claims of a patent having an effective filing date earlier than the effective filing date of the application only if both of the following two conditions are satisfied: (a) the rejected application claims recite an obvious variation of the subject matter recited in the patent claims on which the rejection is based; and (b) the patent claims on which the rejection is based recite an obvious variation of the subject matter recited in the rejected application claims.
- (E) None of statements (A) through (D) is correct.

10. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following can a third party submit in a pending published application within two months from the publication date where the submission identifies the application to which it is directed by application number and includes the appropriate fee?

- (A) A list referencing a videotape and copy of the tape showing that the process claimed in the application was in use more than one year before the filing date of the application.
- (B) A U.S. patent issued more than one year before the filing date of the application and a written explanation of the patent made by the third party on the patent.
- (C) A publication with a publication date more than one year before the filing date of the application and including underlining made by the third party on the publication.
- (D) A protest raising fraud and inequitable conduct issues.
- (E) A list of the sole Japanese language publication submitted for consideration, including the publication date of the publication, a copy of the Japanese language publication and a written English language translation of the pertinent parts of the publication.

11. A U.S. patent was granted on May 8, 2001 to five inventors. The five inventors assigned their entire patent rights to Q Company. Q Company needs to file a reissue application to broaden the claims of the patent. The registered practitioner preparing the application has been unable to locate any of the five inventors to sign the reissue oath or declaration. Today is May 8, 2003. Which of the following should the practitioner do to enable the applicant to broaden the patent claims in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Wait to file the reissue application until the first day the signatures of all five inventors can be obtained. At that time, pay the filing fee and file a petition seeking May 8, 2003 as the filing date. File with the petition a showing of the unavailability of all inventors until the filing of the application.
- (B) Wait to file the reissue application until the signatures of at least three inventors can be obtained. At that time, file a petition seeking May 7, 2003 as the filing date accompanied by a showing of the unavailability of all inventors on May 8<sup>th</sup>. Payment of the filing fees may be postponed until receipt of a decision on the petition.
- (C) File the reissue application on May 8, 2003, presenting only the claims in the patent, and include a listing of inventors, but not pay the filing fee at the time of filing.
- (D) Wait to file the reissue application until the signature of one of the inventors has been obtained since at least one inventor is needed to show a lack of deceptive intent on the part of the applicants.
- (E) File the complete reissue application complying with 37 CFR 1.173(a) and 1.53(b) with an unexecuted reissue declaration listing the names of all the inventors with at least one broadening claim on May 8, 2003.

12. Which of the following is patentable subject matter under 35 USC 101 in accordance with the patent laws, rules, and procedures as set forth in the MPEP?

- (A) A claim to a new mineral discovered in the earth or a new plant found in the wild.
- (B) A claim to a method of using a computer to select a set of arbitrary measurement point values. (The selected values are not to be transformed outside of the computer into computer data).
- (C) A claim to a method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot.
- (D) A claim to a method of updating alarm limits by changing the number value of a variable to represent the result of the calculation.
- (E) A claim to a data structure *per se*. (The claim does not specify any location where the data structure is stored).

13. On January 2, 2001, a registered practitioner filed a patent application with the USPTO for inventor Beck. The application includes a specification and a single claim to the invention which reads as follows:

1. Mixture Y made by the process Q1.

In the specification, Mr. Beck discloses that mixture Y has a melting point of 150° F. On June 2, 2001, the practitioner received an Office action from the primary examiner rejecting the claim. The claim is rejected under 35 USC 102/103 as being clearly anticipated by or obvious over Patent A. The examiner states “Patent A teaches mixture Y but made by a different process Q2.” Beck believes he is entitled to a patent to mixture Y. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following would be the best reply to the rejection of his claim?

- (A) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (B) An argument that the processes used by applicant and patent A are different, supported by a third-party declaration stating only that the processes are different.
- (C) An argument that the claimed product has an unexpectedly low melting point of 150° F, supported by a third-party declaration stating only that the products are different.
- (D) An argument that the processes used by applicant and patent A are different, supported by an affidavit showing that the mixture Y made by process Q2 exhibits a melting point of 300° F.
- (E) An argument that the claimed product has an unexpectedly low melting point of 150° F because the claimed mixture Y has a melting point of 150° F and the mixture Y of patent A has a melting point of 300° F.

14. Inventor Jones files an application under 35 USC 111(a) on March 27, 2002. The application is a continuation of an international application, which was filed on December 1, 2000. The international application claims priority to a U.S. provisional application filed December 2, 1999. The international application designated the United States, and was published in English under PCT Article 21(2). All applications contained the exact same disclosure. In accordance with the patent laws, rules and procedures as related in the MPEP, what, if any, is the earliest prior art date under 35 USC 102(e) for the publication of the 35 U.S.C. 111(a) application under 35 USC 122(b)?

- (A) None, the publication has no prior art date under 35 U.S.C. 102(e)
- (B) March 27, 2002
- (C) December 11, 2001
- (D) December 1, 2000
- (E) December 2, 1999

15. Applicant filed an international patent application under the Patent Cooperation Treaty (PCT) designating the United States. A copy of the international application has not been submitted to the USPTO by the International Bureau. The deadline for entering the national stage under 35 USC 371(c) was August 15, 2002. Applicant submitted all of the national stage items required by 35 USC 371(c) by facsimile transmission on August 15, 2002. The facsimile transmission was successfully received by the USPTO on August 15, 2002. The submission included an authorization to charge any required fees to the valid deposit account of the registered practitioner representing applicant. The account contained sufficient funds. Assuming that applicant has made no other national stage submissions under 35 USC 371(c), which of the following statements is most correctly describes why the national stage submission in accordance with the patent laws, rules and the procedures as related in the MPEP is proper or improper?

- (A) The national stage submission was proper because facsimile transmission is a valid method of correspondence in the USPTO.
- (B) The national stage submission was proper because a copy of an originally executed oath or declaration is acceptable, but the original oath or declaration should be retained as evidence of authenticity.
- (C) The national stage submission was improper because a copy of the international application and the basic national fee necessary to enter the national stage as required by 35 USC 371(c) may not be submitted by facsimile transmission.
- (D) The national stage submission was improper because the USPTO does not accept fee payments via facsimile transmission.
- (E) The national stage submission was improper because facsimile transmission may never be used for PCT applications.

16. Which of the following statements is or are in accord with the patent laws, rules and procedures as related in the MPEP?

- (1) In a 35 USC 103 obviousness analysis, the proper question is whether the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.
  - (2) In a 35 USC 103 obviousness analysis, an inventor's assertion the he has discovered the source or cause of an identified problem should never be considered.
  - (3) A 35 USC 103 obviousness analysis requires consideration not just of what is literally recited in the claims, but also of any properties inherent in the claimed subject matter that are disclosed in the specification.
- (A) Statement 1
  - (B) Statement 2
  - (C) Statement 3
  - (D) Statements 1 & 2
  - (E) Statements 1 & 3

17. A patent application was filed on November 1, 2000 for the invention of J.J. Smithy. The application has no priority or benefit claims to any other application. Claims in the application are separately rejected under 35 USC 102 as being anticipated by each of the following references. Which reference can be properly applied under 35 U.S.C. 102(e) in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A WIPO publication of an international application under PCT Article 21(2), which has an international filing date of October 3, 2000, was published in English and designated the United States.
- (B) A U.S. patent by J.J. Smithy that has a filing date of September 5, 2000.
- (C) A U.S. application publication under 35 U.S.C. 122(b) by inventor Jones that was filed on August 8, 2000.
- (D) A journal article by Marks published on October 11, 2000.
- (E) All of the above.

18. A registered practitioner filed a design patent application on December 30, 2003. The application was filed with an inventor-executed declaration naming Jon Jones as the sole inventor, who has not assigned the invention and is not under an obligation to assign his invention. The filing receipt was recently received, indicating that the application will be published on Thursday, July 1, 2004. In reviewing the filing receipt the practitioner realizes that the typed name of the inventor contained a typographical error (an “h” was missing) and that the correct spelling was John Jones. Which of the following would be the course of action at the least expense to correct the error in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The practitioner should file a request under 37 CFR 1.48 to correct the inventorship of the application with a new declaration under 37 CFR 1.63 signed by John Jones (with the correct spelling of this name), a statement by Mr. Jones as to how the error occurred and that the error was without deceptive intention, and the processing fee set forth in 37 CFR 1.17(q).
- (B) The practitioner should file a petition under 37 CFR 1.182 and the petition fee set forth in 37 CFR 1.17(h), requesting correction of the spelling of the inventor’s name.
- (C) The practitioner should file a request for a corrected filing receipt and a separate letter to the Office explaining that the declaration contains a typographical error, that the correct spelling of the inventor’s name is John Jones, and requesting correction of the Office records.
- (D) The practitioner should expressly abandon the application, and file a continuation with a new declaration with the correct spelling.
- (E) The practitioner should call the examiner and tell the examiner that the inventor’s name is wrong, and ask for the examiner to change the name on the declaration.

19. The claims in an application are rejected under 35 USC 103 as obvious over prior art reference A in view of prior art reference B. All of the following statements are in accord with the patent laws, rules and procedures as related in the MPEP except:

- (A) Where the combination of prior art references provides motivation to make the claimed invention to achieve the same advantage or result discovered by the applicant, the references do not have to expressly suggest the combination of references.
- (B) The rationale to modify or combine the prior art references may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.
- (C) In considering the disclosure of the prior art references, it is proper to take into account the specific teachings of the references, as well as the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) An examiner may take official notice of facts outside the record that are capable of instant and unquestionable demonstration as being “well known” prior art or common knowledge in the art.
- (E) To rely on equivalence as a rationale supporting an obviousness rejection under 35 USC 103 an examiner may base the rejection on the mere fact that the components at issue are functional or mechanical equivalents.

20. Recommend which of the following rejections under 35 USC 102 in a reexamination proceeding is in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A rejection under 35 USC 102(a) based on an affidavit that the invention was known or used by others before the invention thereof by the applicant for patent.
- (B) A rejection under 35 USC 102(b) based on an affidavit that the invention was in the public use in this country more than one year prior to the date of the application for a patent in the United States.
- (C) A rejection under 35 USC 102(e) that the invention was described in a patent by another filed in the United States before the invention thereof by the patent applicant.
- (D) A rejection under 35 USC 102(f) based on an affidavit that the applicant did not himself invent the subject matter sought to be patented.
- (E) A rejection under 35 USC 102(b) that the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

21. Which of the following would comply with the patent laws, rules and procedures as related in the MPEP and would be a fully responsive reply to a non-final Office action on the merits rejecting all the claims in the application as being unpatentable under 35 USC 102 and/or 103 over prior art references?

- (A) A timely filed and properly signed written reply which does not include an amendment to the claims, but includes a request for the examiner's rejections to be reconsidered supported by arguments replying to every ground of rejection and distinctly and specifically points out the supposed errors in every rejection. and pointing out the specific distinctions believed to render the claims patentable over any applied references.
- (B) A timely filed and properly signed written reply which includes an amendment canceling all the claims in the application and adding new claims, and a request for the examiner's rejections to be reconsidered in view of the newly presented claims.
- (C) A timely filed and properly signed written reply which does not include an amendment to the claims, but does generally alleges that the claims define a patentable invention.
- (D) A timely filed and properly signed written request for continued examination (RCE).
- (E) All of the above.

22. Which, if any, of the following statements is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) Where an inventor's residence is stated correctly in the 37 CFR 1.76 application data sheet and incorrectly in the inventor's 37 CFR 1.63 oath or declaration, the discrepancy must be corrected by filing a supplemental 37 CFR 1.67 oath or declaration giving the correct residence.
- (B) Where two inventors file separate 37 CFR 1.63 oaths or declarations which do not identify both inventors, the USPTO will presume they are joint inventors and will not require new oaths or declarations.
- (C) A dependent claim which merely repeats a limitation that appears in the claim on which it depends is properly rejected under the fourth paragraph of 35 USC 112.
- (D) In a statement under 37 CFR 1.97(e)(1) specifying that "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement," the three-month period begins on the date the communication was first received by either a foreign associate or a U.S. registered practitioner.
- (E) None of statements (A) to (D) is correct.

23. A patent application is filed having one claim (claim 1). The most relevant prior art uncovered by the primary examiner, after searching the claimed subject matter, is a published abstract summarizing the disclosure of a foreign patent document. The abstract is in English, the foreign document is in German. Both the published abstract and the foreign document are prior art under 35 USC 102(b). The published abstract provides an adequate basis for concluding that claim 1 is *prima facie* obvious under 35 USC 103. Which of the following actions is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) Reject claim 1 under 35 USC 103, based on the abstract, because it is a publication in its own right and provides sufficient basis for a *prima facie* case of obviousness.
- (B) Reject claim 1 under 35 USC 103, based on the abstract, because disclosures that are not in English cannot form the basis of a prior art rejection.
- (C) Reject claim 1 under 35 USC 103, based on the German-language patent document, as evidenced by the abstract.
- (D) Do not reject claim 1 based on the abstract; instead, obtain a translation of the German-language document and determine whether its full disclosure supports a rejection under 35 USC 102(b) or 103.
- (E) Do not reject the claims based on the abstract because an abstract can never provide sufficient disclosure to be enabling.

24. Applicant filed a provisional patent application in the USPTO under 35 USC 111(b) on Tuesday, November 30, 1999. On Tuesday, November 28, 2000, applicant filed a nonprovisional application in the USPTO under 35 USC 111(a) that properly claimed priority under 35 USC 119(e) to the filing date of the provisional application. On Wednesday, November 29, 2000, applicant filed an international application for patent in the USPTO under the Patent Cooperation Treaty that designated the United States and properly claimed priority to both the provisional and the nonprovisional applications. On Friday, July 28, 2001, applicant filed a national stage application in the USPTO under 35 USC 371, providing all of the requirements under 35 USC 371 and properly claiming benefit to the filing date of the provisional application under 35 USC 119(e) and the nonprovisional application under 35 USC 120. The national stage application was published on Tuesday, January 30, 2002 and issued as a patent on Tuesday, February 4, 2003. Assuming no patent term extension or adjustment, the patent term ends on the date that is 20 years from which of the following dates in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) Tuesday, November 30, 1999
- (B) Tuesday, November 28, 2000
- (C) Wednesday, November 29, 2000
- (D) Friday, July 28, 2001
- (E) Tuesday, February 4, 2003

25. A registered practitioner files a nonprovisional utility application in 2000. In 2002, the practitioner files a continuation-in-part application and claims benefit of the filing date of the 2000 application for the 2002 application. Thereafter, the practitioner amends the 2002 application to include claims that were not present in either the originally filed 2000 application or the originally filed 2002 application. The primary examiner properly concludes that the added claims are not supported by the original disclosure in either application. Which of the following is in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) The added claims are rejected for lack of written description under 35 USC 112, first paragraph.
- (B) The added claims are rejected as new matter under 35 USC 132.
- (C) The added claims are denied benefit of the filing date of the 2000 application.
- (D) (A) and (B).
- (E) (A) and (C).

26. Which of the following best describes a situation for which a reply to the examiner's Office action including both an affidavit filed under 37 CFR 1.131 and an affidavit filed under 37 CFR 1.132 may be in accord with the patent laws, rules and procedures as related in the MPEP?

- (A) In a timely reply to a non-final Office action, where the examiner's sole rejection of appellant's claims is based on an alleged violation of the enablement requirement of 35 USC 112.
- (B) In a timely reply to non-final Office action, where the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-patent document that was published less than one year prior to the filing date of appellant's patent application.
- (C) In a timely reply to a non-final Office action, where the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-commonly owned U.S. patent as prior art under 35 USC 102 (e) that claims the same invention as applicant.
- (D) In a timely reply to an examiner's answer presenting the affidavits for the first time, where in the examiner's first Office action and final rejection, the examiner maintains the same rejection under 35 USC 103(a) of all of appellant's claims based in part on a non-patent document that was published less than one year prior to the filing date of appellant's patent application.
- (E) In a timely reply to a final Office action presenting the affidavits for the first time, where in the examiner's first Office action, the examiner's sole rejection of appellant's claims is a rejection under 35 USC 103(a) employing a non-patent document that was published less than one year prior to the filing date of appellant's patent application.

27. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following is not within the scope of the term “on sale” as it is used in 35 USC 102(b)?

- (A) A sale conditioned on buyer satisfaction.
- (B) A sale that did not result in a profit.
- (C) A single sale of the claimed subject matter.
- (D) A commercial offer to sale the claimed subject matter.
- (E) An offer to sale the patent rights in the claimed subject matter.

28. A patent application is filed disclosing and claiming a system for detecting expired parking meters. The specification fully supports the original, sole claim. The application discloses that the “electronics control unit” contains a comparator and an alarm. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled “electronics control unit.” The sole claim of the application is as follows:

The claim. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit, including a comparator and an alarm, coupled to the infrared sensor and the timer mechanism.

A final Office action, dated February 3, 2004, indicates that the sole claim contains allowable subject matter, but includes an objection to the specification, on the grounds that the subject matter of the electronics control unit, though described in a sufficiently specific and detailed manner in the original specification, was required to be shown in the drawings under 37 CFR 1.83. The Office action did not set a period for reply. Determine which of the following actions, if any, comports with the patent laws, rules and procedures as related in the MPEP for overcoming the objection.

- (A) On April 1, 2004, a Notice of Appeal is filed together with appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2004, a drawing is filed in the USPTO illustrating only the comparator and alarm of the electronics control unit that was described in the original specification.
- (C) On April 1, 2004, a Notice of Appeal of appeal is filed together with appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2004, a petition is filed urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

29. On Thursday, February 6, 2003, applicant files an application for a design patent in Country X, which issues the patent on the filing date. In accordance with the patent laws, rules and the procedures as related in the MPEP, what is the last date applicant can file a U.S. design application to avoid any loss of patent rights?

- (A) Friday, February 6, 2004 (assume not a Federal holiday).
- (B) Thursday, February 5, 2004 (assume not a Federal holiday).
- (C) Wednesday, August 6, 2003.
- (D) Wednesday, May 6, 2003.
- (E) None of the above are correct.

30. Co-inventors Smith and Jones filed an application for a patent on a cell phone, on May 15, 2002. They received a first Office action from a primary examiner rejecting the claims under 35 USC 102(a) over a publication by Bell and Watson, published on April 5, 2002, describing a cell phone having all the same features as is claimed in the patent application. In reply, the co-inventors each submitted a declaration under 37 CFR 1.131 stating that they had actually reduced the invention to practice no later than March 13, 2002. However, the declarations failed to include two claimed features. Neither the particular antenna needed to enable the cell phone could receive transmissions from the local cellular transmitting tower, nor a detachable carrying strap was included in the declarations. As evidence of their prior reduction to practice, Smith and Jones submitted their co-authored journal article. The journal article contained a figure of the cell phone as described in the declarations. That is, the cell phone shown in the figure of the article lacked an antenna and a detachable strap. The article was received by the journal on March 13, 2002, and was published on April 30, 2002. The cell phones shown in the figure in the Bell and Watson publication, and in the Smith and Jones patent application have the particular antenna and a detachable strap. Which of the following actions, if taken by the examiner, would be the most proper in accordance with the patent laws, rules and the procedures as related in the MPEP?

- (A) The examiner should maintain the rejection of the claims under 35 USC 102(a) and make the rejection final.
- (B) The examiner should withdraw the rejection and look for references which have a publication date prior to May 15, 2001.
- (C) The examiner should withdraw the rejection and notify Smith and Jones that their application is in condition for allowance.
- (D) The examiner should maintain the rejection, but indicate that the claims would be allowable if Smith and Jones provided an original copy of the figure published in their journal article as factual support for their declarations.
- (E) The examiner should maintain the rejection and inform Smith and Jones that the declarations are insufficient because they cannot “swear behind” a reference which is a statutory bar.

31. In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) An oath or declaration executed by applicant pursuant to 37 CFR 1.63.
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) A description pursuant to 37 CFR 1.71.
- (D) At least one claim pursuant to 37 CFR 1.75.
- (E) A drawing when required by 37 CFR 1.81(a).

32. Determine which of the following documents, if any, must also contain a separate verification statement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) A request to correct inventorship in a pending application.
- (B) A petition to make an application special.
- (C) A claim for foreign priority.
- (D) A substitute specification.
- (E) None of the above.

33. A registered practitioner files an application on the client's discovery that adding silica to a known plastic composition containing the flame retardant, X, results in increased flame retardance. The application claims a composition comprising the known plastic composition containing X and also silica. The primary examiner rejects the claim on the basis that applicant admits that X was a known flame retardant and that there is no evidence of improved flame retardance. In accordance with the patent laws, rules and procedures as related in the MPEP, a proper reply could include which of the following argument(s) to rebut and overcome the rejection?

- (A) The examiner cannot rely on admitted prior art.
- (B) The examiner has not shown that the prior art appreciated applicant's discovery of silica to be a flame retardant.
- (C) The examiner has not made out a prima facie case of obviousness due to lack of motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art for adding silica to the known plastic composition.
- (D) The applicant does not have to show an improved or unexpected result for the claimed invention.
- (E) (C) and (D).

34. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following paper is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.
- (B) An amendment, replying to an Office action setting a period for reply, transmitted by facsimile with a certificate of transmission to the USPTO from a foreign country.
- (C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.
- (D) A request for continued examination (RCE) under 37 CFR 1.114.
- (E) An appeal brief.

35. The sole claim in an application filed by A and having an effective filing date of June 5, 2002, recites an electrical signal amplifier comprising a plurality of germanium transistors connected together in a particular configuration. The claim is rejected under 35 USC 103(a) as being obviousness over a primary nonpatent reference publication (Reference P) in view of a secondary nonpatent reference publication (Reference S). Reference P has an effective date of April 3, 2002, and names A and B as the authors. Reference S has an effective date of December 10, 2001, and names C as the sole author. Reference P discloses an electrical signal amplifier including a plurality of silicon transistors connected together in the same configuration as that set forth in the claim. Reference S discloses a signal amplifier employing germanium transistors connected in a configuration different from the claimed configuration. The applicant does not deny that the references render the claimed subject matter *prima facie* obvious. Which, if any, of the declarations under 37 CFR 1.132 set forth below should be sufficient under the patent laws, rules and procedures as related in the MPEP to overcome the rejection?

- (A) An uncontradicted declaration by A asserting that the subject matter relied on by the examiner in reference P constitutes A's sole invention, with the result that Reference P is not available as prior art against the claim.
- (B) A declaration by A asserting that "the claimed amplifier has satisfied a long-felt need in the art."
- (C) A declaration by A and accompanying copies of competitors' advertisements which conclusively show that those competitors have exactly copied appellant's commercial embodiment of the claimed amplifier.
- (D) A declaration by A and supporting documentation establishing that ever since the filing date of A's application, sales of the commercial embodiment of A's claimed amplifier have consistently constituted ninety percent or more of the relevant signal amplifier market in the United States.
- (E) None of the above.

36. An application naming X and Y as joint inventors, filed on April 3, 2002, has a single pending claim, and does not claim the benefit of any earlier application. Which, if any, of the following items of prior art that have been relied on in various rejections of the claim may be overcome by a suitable affidavit under 37 CFR 1.131 in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A U.S. patent to G that issued on March 27, 2001, has an effective U.S. filing date of January 4, 2000, and does not claim the “same patentable invention” (as defined in 37 CFR 1.601(n)) as the rejected claim.
- (B) A U.S. patent to P that issued on June 5, 2001, has an effective U.S. filing date of February 1, 2000, and includes a claim that is identical to the rejected claim.
- (C) A journal article to H published on December 10, 2001, and characterized in the application as “describ[ing] the prior art.”
- (D) A foreign patent issued to X and Y on November 7, 2001, which claims the same subject matter as the rejected claim and is based on an application filed on January 3, 2001.
- (E) None of the above.

37. The specification of an application does not disclose the utility of the claimed composition. In fact, the claimed invention is useful for shrinking a specific class of tumors. In a first Office action, the primary examiner has properly determined that the claims lack utility, and has rejected all of the composition claims under the first paragraph of 35 USC 112 as lacking utility. Which of the following responses is in accord with the USPTO rules and the procedures of the MPEP for persuading the examiner that the rejection is improper?

- (A) Explain that the rejection is statutorily improper because the first paragraph of section 112 is concerned with enablement and written description issues and therefore does not support a rejection for lack of utility.
- (B) Point out that the rejection is based on an erroneous finding by the examiner because the specification, in fact, clearly discloses that the composition in question possesses “useful biological” properties.
- (C) Show that the rejection is improper by filing probative evidence that the claimed composition has unambiguously proven to be useful for shrinking a specific class of tumors.
- (D) File declarations by persons with ordinary skill in the art stating that they would immediately appreciate that the claimed composition is useful for shrinking a specific class of tumors due to the fact that similar compositions having the same characteristics as applicant’s claimed composition were known to be effective for this purpose.
- (E) Argue that the rejection is improper because the examiner has failed to present evidence in support of his position that the claimed composition has no utility.

38. A registered practitioner properly recorded an assignment document for application A identifying XYZ Company as the assignee. The document assigns to XYZ Company the “subject matter claimed in Application A.” A proper restriction requirement was made by a primary examiner in application A between two distinct inventions, and the practitioner elected to prosecute one of the inventions. Application A was prosecuted, and later became abandoned. Before the abandonment date of application A, the practitioner filed a complete application B as a proper divisional application of application A. Application B claimed the nonelected invention of Application A, and was published as a U.S. application publication. XYZ Company remains the assignee of application A. What must the practitioner do in accordance with the patent laws, rules and procedures as related in the MPEP to ensure that XYZ Company is listed as the assignee on the face of any patent issuing from application B?

- (A) File a proper assignment document in application B identifying XYZ Company as the assignee.
- (B) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that USPTO’s bibliographic data for application B identifies XYZ Company as the assignee by checking the filing receipt for application B, the U.S. application publication of application B, or the USPTO’s Patent Application Information Retrieval (PAIR) system data for application B, depending on when the practitioner filed the assignment document in application B.
- (C) Confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (D) File a proper assignment document in application B identifying XYZ Company as the assignee, and confirm that XYZ Company is identified as the assignee on the U.S. application publication of application B.
- (E) Upon allowance of application B, the practitioner must identify XYZ Company as the assignee in the appropriate space on the Issue Fee Transmittal form for specifying the assignee for application B.

39. An international application is filed in the United States Receiving Office on September 18, 2002. In accordance with the PCT and USPTO rules and the procedures set forth in the MPEP, which of the following will result in the application not being accorded an international filing date of September 18, 2002?

- (A) The description and claims are in German.
- (B) The Request is signed by a registered attorney rather than the applicant.
- (C) The sole applicant is a Canadian resident and national.
- (D) The application does not contain a claim.
- (E) The application is not accompanied by any fees.

40. Applicant files a patent application in Japan on January 5, 2000. Applicant files a PCT international application designating the United States on January 5, 2001, based on the Japanese application. The international application is published in English on July 5, 2001. The international application enters the national stage in the United States on September 5, 2001. The USPTO publishes the application on June 6, 2002. The application issues as a United States patent on December 3, 2002. What is its earliest possible 35 USC 102(e) prior art date for the application published by the United States, in view of the amendment to Title 35 by the American Inventors Protection Act of 1999 and the Intellectual Property and High Technology Technical Amendments Act of 2002?

- (A) January 5, 2000.
- (B) January 5, 2001.
- (C) July 5, 2001.
- (D) June 6, 2002.
- (E) December 3, 2002.

41. A non-final Office action contains, among other things, a restriction requirement between two groups of claims (Group 1 and Group 2). Determine which of the following, if included in a timely reply under 37 CFR 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (B) Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
- (C) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (D) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."
- (E) None of the above.

42. The primary examiner has rejected claims 1-10 under 35 USC 103(a) as being unpatentable over the Smith patent in view of the Jones reference. Appellant properly argues that there is no motivation to combine the teachings of Smith and Jones. The examiner repeats the rejection of claims 1-10 as being “unpatentable over Smith in view of Jones.” The examiner additionally cites a patent to Brown that was necessary to provide motivation for combining the teachings of Smith and Jones. The examiner does not list Brown in the statement of the rejection. Appellant timely appeals to the Board of Patent Appeals and Interferences, and files a proper appeal brief. The examiner files an examiner’s answer addressing the rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Smith in view of Jones, and cites Brown in the argument as providing motivation to combine Smith and Jones. In accordance with the patent laws, rules and procedures as related in the MPEP, what will be the most proper decision of the Board?

- (A) The Board will affirm the rejection based on Smith and Jones only.
- (B) The Board will affirm the rejection based on Smith, Jones and Brown.
- (C) The Board will reverse the rejection based on Smith and Jones only.
- (D) The Board will reverse the rejection based on Smith, Jones and Brown.
- (E) None of the above.

43. Which of the following statement(s) is in accordance with patent laws, rules and procedures as related in the MPEP regarding filing of an Application Data Sheet (ADS) in the USPTO?

- (A) All non-provisional applications must include an ADS when the application is originally filed.
- (B) If an ADS is filed at the same time as an oath or declaration under 37 CFR 1.63 or 1.67 and the information supplied in the two documents is inconsistent, the information provided in the ADS will always govern.
- (C) If an ADS is filed at the same time as an oath or declaration under 37 CFR 1.63 or 1.67 and the information supplied in the two documents is inconsistent, the oath or declaration will govern any inconsistency related the claiming of benefit under 35 USC 119(e), 120, 121 or 365(c).
- (D) If an ADS is filed after an oath or declaration under 37 CFR 1.63 or 1.67 is filed, and the information supplied in the two documents is inconsistent, the information provided in the ADS will always govern.
- (E) The oath or declaration under 37 CFR 1.63 or 1.67 governs inconsistencies with the ADS when the inconsistency concerns setting forth the citizenship of the inventor(s) under 35 USC 115.

44. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following statements regarding claim interpretation is the most correct?

- (A) A claim having the transition term “comprising” is limited to only the limitations, elements or steps recited in the claim, and is not inclusive or open-ended of other unrecited elements or steps.
- (B) The transition term “consisting essentially of” limits the claim to the limitations recited in the claim and additional elements or steps which do not materially affect the basic and novel characteristics of the claimed invention.
- (C) A claim having the transition term “consisting of” is not limited to the elements or steps recited in the claim, but can include elements or steps other than those recited in addition to any impurities ordinarily associated therewith.
- (D) A claim which depends from a claim which claims an invention “consisting of” the recited elements or steps can add an element or step to further limit the claimed invention.
- (E) All of the above.

45. A patent application has claims 1-10 pending. Claims 1 and 7 are independent claims. Claims 2-6 depend directly from claim 1 while claims 8-10 depend directly from claim 7. Claims 1-10 have been twice rejected by the primary examiner under 35 USC 103(a) as being unpatentable over Smith patent in view of Jones patent. The applicant has appealed the rejection to the Board of Patent Appeals and Interferences. In the brief under the “grouping of claims” section, appellant states that each of the claims is separately patentable. In the arguments section of the brief, appellant separately argues only claims 1, 4 and 6. In the examiner’s answer, the examiner disagrees with appellant’s claim grouping because all the claims present a similar issue of patentability. The examiner states that the claims all stand or fall together as a single group. In accordance with the patent laws, rules and procedures as related in the MPEP, which claim(s) must the Board consider separately on the merits?

- (A) The Board must consider each of claims 1-10 separately on the merits.
- (B) The Board must only consider claims 1, 4 and 6 separately on the merits.
- (C) The Board must only consider claim 1 separately on the merits.
- (D) The Board must consider claim 1 and claim 7 separately on the merits as representative of all the claims on appeal.
- (E) The Board must determine which claim is representative of all the claims on appeal and consider only that claim separately on the merits.

46. A primary examiner is examining a patent application. The application includes a specification and a single claim to the invention that reads as follows:

1. A building material to be used as an alternative to brick in the construction of a house, said building material comprising compressed refuse, the majority of which is wood.

In the specification, the inventor explains that the wood to be used in the inventive building material should be balsa wood. According to the specification, balsa-containing building material has the advantage of being lighter than brick. In a first Office action mailed to the registered practitioner representing the inventor the single claim was rejected as anticipated under 35 U.S.C. § 102 over Patent A. Patent A issued more than one year before the effective filing date of the application, and teaches a building material to be used as an alternative to brick in the construction of a house comprising compressed refuse, the majority of which is pine. The practitioner replies to the first Office action by arguing that the invention is different from that of Patent A. According to the practitioner, the inventor uses balsa wood, not pine. The claim has not been amended. Which of the following describes how the examiner should proceed in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) The examiner should allow the claim.
- (B) The examiner should allow the claim only after including a Reasons for Allowance pointing out that the inventor argues that her invention is directed to using balsa wood, not pine.
- (C) The examiner should issue a Final Rejection again rejecting the claim as anticipated under 35 USC102 over Patent A.
- (D) The examiner should reopen prosecution and begin anew, this time searching for a reference that shows a building material containing balsa wood.
- (E) The examiner should withdraw the rejection but issue a new Office action this time rejecting the claim under 35 USC 112, second paragraph, because the claim is broad enough to encompass using pine.

47. To rely in a rejection under 35 USC 102(a) on an invention that is known or publicly used in accordance with patent laws, rules and procedures as related in the MPEP, the invention:

- (A) must be known or used in NAFTA or WTO member countries.
- (B) must be known or used in a NAFTA member country, but only if the filing date of the application is after the effective date of the North American Free Trade Agreement Implementation Act.
- (C) must be known or used in this country.
- (D) can be known or used in any country.
- (E) must be known or used in a WTO member country, but only if the filing date of the application is after the effective date of the implementation of the Uruguay Round (WTO) Agreements Act.

48. A registered practitioner timely files a petition under 37 CFR 1.181 while the application is pending before the primary examiner to challenge the prematureness of the final rejection that set a shortened statutory period for reply. Assume the petition is filed within two months of the date on the final rejection. What is the next response that should be docketed by the practitioner in accordance with the patent laws, rules and the procedures as related in the MPEP to avoid a penalty or payment of fees?

- (A) A reply to the final rejection within 6 months.
- (B) A status inquiry 6 months after filing the petition.
- (C) A reply to the final rejection within the shortened statutory time period set for reply in the final rejection.
- (D) No reply is necessary until a decision is received on the petition.
- (E) All of the above.

49. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory that includes at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are in accord with the patent laws, rules and procedures as related in the MPEP regarding the respective claims under the fourth paragraph of 35 USC 112?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

50. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following facts are required for 35 USC 102(g) to form the basis for an *ex parte* rejection:

- (1) The subject matter at issue has been actually reduced to practice by another before the applicant's invention.
- (2) There has been no abandonment, suppression or concealment.
- (3) A U.S. patent application for the subject matter at issue has been filed by another prior to the filing of the applicant's application.
- (4) A U.S. patent has been granted for the subject matter at issue prior to the filing of the applicant's application.

- (A) Fact (1) only
- (B) Fact (2) only
- (C) Facts (1) and (2)
- (D) Facts (1), (2) and (3)
- (E) Facts (1), (2), (3) and (4)

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**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**October 15, 2003**

**Afternoon Session Model Answers**

1. ANSWER: (A) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the filing fee for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. (B), (C), (D) and (E) are incorrect. 37 CFR § 53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75, and any drawing required by 37 CFR § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

2. ANSWER: (D) is the most correct answer. MPEP §§ 1403 and 1412.03, under the heading “When A Broadened Claim Can Be Presented.” A broadening reissue claim must be filed within the two years from the grant of the original patent. (D) is the most correct and the examiner should examine the case as any other application and address appropriate issues concerning reissue examination. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences). Since applicant filed the amendment by Express Mail, the amendment is treated as being filed with the USPTO on the date of deposit with the US Postal Service. Therefore, (A), (B) and (C) are incorrect answers. A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. Choice (E) is not correct since the mere deletion of an element of a claim does not automatically raise a ground of rejection based on the recapture doctrine. See MPEP § 1412.02.

3. ANSWER: (C) is correct. MPEP § 2113, under the heading “Once A Product Appearing To Be Substantially Identical Is Found And A 35 U.S.C. 102/103 Rejection Made, The Burden Shifts To The Applicant To Show An Unobvious Difference,” states “[o]nce the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).” (A) is incorrect because the patentability of product-by-process claims is based on the product itself. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Where the end products are the same, the process of making limitations do not have to be given weight in ex parte examination. See *Atlantic Thermoplastics Co. v. Faytex Corp.*, 23 USPQ2d 1481, 1490-91 (Fed. Cir. 1992) (product-by-process claims are treated differently for patentability purposes during *ex parte* examination in the USPTO than for infringement and validity purposes during litigation). (B) is incorrect because “[o]nce the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.” MPEP § 2113. “To the extent that the process limitations distinguish the products over the prior art, they must be given the same consideration as traditional product characteristics.” *In re Hallman*, 210 USPQ 609, 611 (CCPA 1981). Thus, (C) is correct because applicant can show by factual arguments and/or declarations or affidavits under 37 CFR § 1.132 that the

method of making produces a different product and that the differences are unobvious. (D) is incorrect because it does not tend to show that the products are different. (E) is incorrect because the inventor's awareness of prior art is of no consequence to patentability.

4. ANSWER: (C) is the correct answer. 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d); MPEP § 502 (reproducing Rule 1.6(d)(3)); MPEP § 512 (reproducing Rule 1.8(a)(2)(i)(d)); and MPEP § 1817.01. As stated in MPEP § 1817.01, “[a]ll designations must be made in the international application on filing; none may be added later.” The application will not be accorded an international filing date since the practitioner has tried to cure the failure to designate at least one contracting State by filing a paper using facsimile which is not permitted according to 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d). (A) is wrong because applicant has failed to comply with Article 11(1)(iii)(b) on such date. See MPEP § 1810 (reproducing PCT Article 11(1)(iii)(b)). (B) is wrong because according to 37 CFR 1.6(d)(3) and 37 CFR 1.8(a)(2)(i)(d), applicant cannot file an international application by facsimile. See MPEP § 502 (reproducing 37 CFR § 1.6(d)(3)); MPEP § 512 (reproducing 37 CFR § 1.8(a)(2)(i)(d)). Since no designations were included on filing, the application papers cannot be accorded an international filing date. See PCT Article 11(1)(iii)(b). Applicant cannot correct this by filing the designation sheet by facsimile. See MPEP § 502 (reproducing Rule 1.6(d)(3)); MPEP § 512 (reproducing Rule 1.8(a)(2)(i)(d)). (D) is wrong because according to PCT Rule 80.5, when a response is due on a day where the receiving Office is not open for business, applicant has until the next business day. See Appendix T of the MPEP. (E) is incorrect because (C) is correct.

5. ANSWER: (C) is the most correct answer. MPEP § 2163, under the heading “GENERAL PRINCIPLES GOVERNING COMPLIANCE WITH THE “WRITTEN DESCRIPTION” REQUIREMENT FOR APPLICATIONS,” and subheading “New or Amended Claims,” states “A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) (‘[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any ‘aryl or substituted aryl radical’ would be suitable for the purposes of the invention but rather that only certain aryl radicals and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.’).” (A), (B), (D) and (E) are incorrect. Each lists a proper way to demonstrate satisfaction of the written description requirement. MPEP § 2163.02, under the heading “STANDARD FOR DETERMINING COMPLIANCE WITH THE WRITTEN DESCRIPTION REQUIREMENT,” provides that the written description requirement is met “when the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).” Possession may be shown in a variety of ways “including description of an actual reduction to practice, or by showing that the invention was ‘ready for patenting’ such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119

F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991)."

6. ANSWER: (D) is the most correct answer. 37 CFR § 1.56; MPEP § 2001.05. 37 CFR § 1.56(a) sets forth a duty to disclose information that is material to patentability. MPEP § 2001.05 states that "information is not material unless it comes within the definition of 37 CFR 1.56(b)(1) or (b)(2). If information is not material, there is no duty to disclose the information to the Office." The information that moon dust was never actually used is not material as defined under 37 CFR § 1.56(b)(1) or (2) which state that information is material if "(b)(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office or, (ii) Asserting an argument of patentability." That the use of the moon dust as part of an erasure formulation was only theorized and not actually used is acceptable as is an example for making it. MPEP § 608.01(p), II, under the heading "Simulated or Predicted Test Results Or Prophetic Examples," states that "[s]imulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. ... Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted." Care, however, must be taken not to state that an experiment was actually run or conducted when it was not and that "[n]o results should be presented as actual results unless they have actually been achieved." MPEP § 2004, item 8. (A) is incorrect. 37 CFR § 1.56(a) requires that individuals associated with the filing and prosecution of a patent application have a duty to disclose information to the Office. 37 CFR § 1.56(c) defines which individuals are associated with the filing and prosecution of a patent application and that "(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are: (1) Each inventor named in the application; (2) Each attorney or agent who prepares or prosecutes the application; and (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." Point is part of the Sales department and no facts were presented that substantively involved him in the preparation or prosecution of the application. Additionally, as noted in the explanation relating answer to (D), the information given to Point by Tip was not material information. (B) is incorrect. While Tip would be an individual identified under 37 CFR § 1.56(c), there is no material information to be disclosed as noted in the explanation to (D). (C) is incorrect. As noted in the explanation relating to (D), the information is not material. Additionally, as noted in the explanation to answer (A), Point is not an individual defined by 37 CFR 1.56(c) as owing a duty. (E) is incorrect. As there is no requirement that it be explicitly stated that an invention has or has not been actually conducted, as noted in the explanation of (D), the prosecution need not be continued for the purpose of supplying an information disclosure statement regarding the development of the moon rock erasure formulation.

7. ANSWER: (A) is the best answer. 35 U.S.C. § 102; MPEP § 2131.01, under the heading "Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference," states "that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of

anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). (B) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent property. See MPEP § 2131.01. (C) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent function of oxygen. See MPEP § 2131.01. (D) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent ingredient, oxygen. See MPEP § 2131.01. (E) is incorrect because (B), (C), and (D) are incorrect, as explained above.

8. ANSWER: (E) is the most correct, because statements (2) and (3) are true. The entire period for which diligence is required must be accounted for. MPEP § 2138.06, under the heading "The Entire Period During Which Diligence Is Required Must Be Accounted For By Either Affirmative Acts Or Acceptable Excuses," states "[a]n applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.)." MPEP § 2138.06, under the heading "Work Relied Upon To Show Reasonable Diligence Must Be Directly Related To The Reduction To Practice," states "[t]he work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). 'U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue.'" (A) is incorrect because statement (1) is not true – an inventor or his attorney need not drop all other work to establish reasonable diligence. *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974); MPEP § 2138.06. (B) is incorrect because it does not include true statement (3). (C) is incorrect because it does not include true statement (2). (D) is incorrect because it includes false statement (1).

9. CREDIT GIVEN FOR ALL ANSWERS.

10. ANSWER: (E) is the most correct answer. 37 CFR § 1.99; MPEP § 610. Rule 1.99 provides that a third party may submit in a published application a foreign-language publication and an English language translation of pertinent portions of the publication. The submission must "identify the application to which it is directed by application number," . . . "include the fee set forth in § 1.17(p)," include "a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;" . . . a "copy of each listed patent or publication in written form or at least the pertinent portions;" and an "English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon." (A) is incorrect. 37 CFR § 1.99 does not authorize a third-party submission of materials or things other than patents or publications. See 37 CFR § 1.99; MPEP § 610. Thus, submission of a videotape under §1.99 is

not authorized. (B) is incorrect. A third-party submission under 37 CFR 1.99 may not include explanations. See 37 CFR § 1.99(d); MPEP § 610. (C) is incorrect. A third-party submission under 37 CFR 1.99 may not include markings or highlights on the publications. See 37 CFR § 1.99(d); MPEP § 610. (D) is incorrect because a protest cannot be filed in a published application. See 37 CFR § 1.291(a)(1); MPEP 1901.06.

11. ANSWER: (E) is the most correct answer. 35 U.S.C. § 251; 37 CFR § 1.53(f); MPEP § 1403. Filing a broadened reissue application with at least one broadening claim prior to the expiration of the two-year time period set in the statute satisfies the diligence provisions of 35 U.S.C. § 251. The executed reissue oath/declaration and the filing fee may be filed at a later time. According to MPEP § 1403, a reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). The reissue applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. (A), (B) and (D) are clearly incorrect since the inventors and assignee would be barred from a broadening reissue if filed after the two year period set in the statute. (C) is incorrect since the reissue application was filed without at least one broadening claim prior to the expiration of the two-year time period set in 35 U.S.C. § 251.

12. ANSWER: (C) is the most correct answer. MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of this type of statutory process include ...[a] method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot, using a computer processor to calculate positioning of the robot in relation to given tasks to be performed by the robot, and controlling the robot’s movement and position based on the calculated position.” (A) is a true statement, and is therefore an incorrect answer. As set forth in MPEP § 2105 a “new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter.” (B) is an incorrect answer. As set forth in MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity),” states that “[e]xamples of claimed processes that do not limit the claimed invention to pre-computing safe harbor include: . . . - selecting a set of arbitrary measurement point values ([*In re*] *Sarkar*, 588 F.2d [1330] at 1331, 200 USPQ [132] at 135).” (D) is an incorrect answer. MPEP § 2106(IV)(B)(2)(b)(i) under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of claimed process that do not achieve a practical application include:-step of ‘updating alarm limits’ found to constitute changing the number value of a variable to represent the result of the calculation (*Parker v. Flook*, 437 U.S.584, 585, 198 USPQ 193, 195 (1978).” (E) is a true statement, and therefore is an incorrect answer. MPEP § 2106(IV)(B)(1), under the heading “Nonstatutory Subject Matter” states “[*In re*] *Warmerdam*, 33 F.3d [1354,] at 1361, 31 USPQ2d [1754,] at 1760 (claim to a data structure per se held nonstatutory).”

13. ANSWER: (A) is the most correct answer. MPEP § 2113, under the heading “Product-By-Process Claims Are Not Limited To The Manipulations Of The Recited Steps, Only The Structure Implied By The Steps,” states “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.’ *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).” The issue is whether the claimed mixture Y is the same as or obvious over the patented mixture Y. MPEP § 2113, under the heading “Once A Product Appearing To Be Substantially Identical Is Found And A 35 U.S.C. 102/103 Rejection Made, The Burden Shifts To The Applicant To Show An Unobvious Difference,” states “[o]nce the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).” Evidence that the two processes produce different properties is germane to the issue of patentability of the product-by-process claim. Accordingly, a comparison of the results obtained by conducting the process recited in the claim versus the process used by patent A and which shows that the claimed product exhibits an unexpectedly lower melting point would be a persuasive demonstration that, although the products would appear to be substantially identical, in fact, they are patentably different. *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). Therefore, the best reply to the outstanding rejection would be to argue that the claimed product has an unexpectedly lower melting point and to support that argument with evidence showing that the result of the patent A process is a mixture with higher melting point as compared to the claimed product. (B) is incorrect. The patentability of a product-by-process claim is determined on the basis of product characteristics, not process steps. (C) is incorrect. The declaration is conclusory, as opposed to being factual. Thus, the argument is not supported by facts. As stated in MPEP § 716.02(c), under the heading “Opinion Evidence,” “Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).” Thus, the reply in (A) is the most correct answer vis-à-vis (C). (D) like (B), is incorrect for the same reason discussed for (B). (E) is incorrect. Like (C), this reply rightly focuses on product properties. But without the comparative factual evidence to support it, this reply is weaker than one described in (A).

14. ANSWER: The correct answer is answer (E). See MPEP § 706.02(f)(1) in general and Example 7 in particular. (A) is not correct as the publication under 35 U.S.C. § 122(b) does have a prior art date under 35 U.S.C. 102(e). (B) and (D) are not correct because March 27, 2002 and December 1, 2000 are not the earliest prior art date under 35 U.S.C. § 102(e). The publication has an earlier prior art date than March 27, 2002 and December 1, 2000 because of its benefit/priority claims to the international application and the provisional application. See MPEP § 706.02(f)(1). (C) is not correct as it is not a filing date for any application in this question.

15. ANSWER: (C) is the most correct answer. 37 §§ CFR 1.6(d)(3); 1.8(a)(2)(i)(F); 1.495(b); MPEP § 1893.01(a)(1), 2nd paragraph. The filing of the copy of the international application and the basic national fee in order to avoid abandonment under 37 CFR § 1.495(b), as appropriate, may not be transmitted by facsimile. See 37 CFR § 1.6(d)(3) and 37 CFR § 1.8(a)(2)(i)(F). (A) is not the most correct answer because facsimile transmission is not permitted in the situations set forth in 37 CFR § 1.6(d). (B) is not the most correct answer

because even though an oath or declaration may be submitted by facsimile transmission as set forth in MPEP § 602, the national stage submission was improper for the reasons discussed in (C). (D) is not the most correct answer because (C) is the most complete answer. Facsimile transmissions may not be used to file a copy of the international application necessary to enter the national stage. (E) is not the most correct answer because facsimile transmission may be used to file certain correspondence in PCT applications. See MPEP § 1805.

16. ANSWER: (C) is the most correct answer. The principle in Statement 3, that consideration of inherent properties is part of proper consideration of the invention as a whole, is recited in MPEP § 2141.02, under the heading “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry,” and in *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977). (A) is incorrect, because the proper question is whether the invention as a whole, not just the differences, would have been obvious. See MPEP § 2141.02, under the heading “The Claimed Invention As A Whole Must Be Considered,” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). (B) is incorrect because an examiner should consider such assertions by an inventor as part of the “subject matter as a whole.” See MPEP § 2141.02 (citing *In re Spohnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969)). (D) and (E) are incorrect because they include incorrect Statements 1 and/or 2.

17. ANSWER: The correct answer is answer (C). 35 U.S.C. § 102(e); MPEP § 706.02(f). The application publication is a proper reference under 35 U.S.C. 102(e) because it was filed by another prior to the filing date of the invention. See MPEP § 706.02(f) et seq. Answer (A) is incorrect. The reference in answer (A) is not a proper reference under 35 U.S.C. § 102(e) because its international filing date was prior to November 29, 2000 thereby failing one of the three conditions for a WIPO publication of an international application to be applied under 35 U.S.C. § 102(e). See MPEP § 706(f)(1), under the heading “I. Determine The Appropriate 35 U.S.C. 102(e) For Each Potential Reference By Following The Guidelines, Examples And Flow Charts Set Forth Below,” subpart (C), which states “[I]f the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined: (1) If the international application meets the following three conditions: (a) an international filing date on or after November 29, 2000 . . . then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).” The reference in (B) is not a proper reference under 35 U.S.C. § 102(e) because the reference is not by another. See MPEP § 706.02(f). The reference in (D) is not a proper reference under 35 U.S.C. § 102(e) because 35 U.S.C. § 102(e) refers to patents and patent applications, not journal articles. See MPEP § 706.02(f)(1). (E) is not correct because (C) is correct and (A), (B) and (D) are incorrect.

18. ANSWER: (C) is the most correct answer. See MPEP § 605.04(b), which states “Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained...When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The U.S.[PTO] should simply be notified of the error and reference to the notification paper will be made on the previously filed oath or declaration by the Office.” (A), (B) and (D) could result in the spelling of Jon's name being corrected in USPTO records, but would do so at a higher cost to applicant,

and therefore neither one is the most correct answer. Furthermore, (A) is also not correct in that if a request to add John Jones as an inventor was to be filed, another request (and fee) to delete Jon Jones would be required. (B) is wrong because a petition under 37 CFR § 1.182 is not required if the error in the name is a typographical error, and the facts specify that the error in the spelling of “John” as “Jon” is a typographical error. (D) is not correct because not only would filing a continuation create an additional expensive, but filing a new application could also delay examination. (E) is not correct because pursuant to 37 CFR § 1.2, business with the Office is to be conducted in writing, and, even more importantly, because “it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant.” MPEP § 605.04(a).

19. ANSWER: (E) is the most correct answer. MPEP § 2144.06, under the heading “Substituting Equivalents Known For The Same Purpose,” states “[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).” (A) is incorrect. MPEP § 2144, under the heading “Rationale Different From Applicant's Is Permissible,” states “[t]he reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . . ; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). . . .” (B) is incorrect. MPEP § 2144, under the heading “Rationale May Be In A Reference, Or Reasoned From Common Knowledge In The Art, Scientific Principles, Art-Recognized Equivalents, Or Legal Precedent,” states “[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also . . . *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings).” (C) is incorrect. MPEP § 2144.01, quotes *In re Preda*, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) as stating “[i]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” (D) is incorrect. MPEP § 2144.03 under the heading “A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion,” states “[o]fficial notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. . . . Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).’”

20. ANSWER: (C) is the most correct answer. 35 U.S.C. § 302; 37 CFR § 1.552; and MPEP § 2258. MPEP § 2258, under the heading “Prior Patents Or Printed Publications,” states “[r]ejections on prior art in reexamination proceedings may only be made on the basis of prior patents or printed publications. Prior art rejections may be based upon the following portions of 35 U.S.C. 102: . . . (e).” (A), (B), (D) and (E) are incorrect. MPEP § 2258, under the heading “Matters Other Than Patents or Printed Publications,” states “[r]ejections will not be based on matters other than patents or printed publications, such as public use or sale, inventorship, 35 U.S.C. 101, fraud, etc. In this regard, see *In re Lanham*, 1 USPQ2d 1877 (Comm’r Pat. 1986), and *Stewart Systems v. Comm’r of Patents and Trademarks*, 1 USPQ2d 1879 (E.D. Va. 1986). A rejection on prior public use or sale, insufficiency of disclosure, etc., cannot be made even if it relies on a prior patent or printed publication. Prior patents or printed publications must be applied under an appropriate portion of 35 U.S.C. 102 and/or 103 when making a rejection.” Reexamination is limited to substantially new questions of patentability based on patents and publications.

21. ANSWER: (A) is the most correct answer. 37 CFR § 1.111; MPEP § 714.02. Section 1.111 states in pertinent part: “(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, . . . must reply and request reconsideration or further examination, with or without amendment. . . . (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner 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. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. . . . The applicant’s or patent owner’s reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. 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.” MPEP § 714.02 states “In all cases where reply to a requirement is indicated as necessary to further consideration of the claims . . . a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.” (B) and (C) are not the most correct answers. 37 CFR § 1.111; MPEP §§ 714.02 and 714.04. Neither reply specifically points out the supposed errors in the examiner’s action and neither reply present arguments pointing out how the newly presented claims overcome the rejections. (D) is not the most correct answer. See 37 CFR § 1.114. A request for continued examination can only be made if prosecution of an application is closed. In this question the Office action is a non-final office action. (E) is not the most correct answer since (A) is correct and (B), (D) and (D) are incorrect.

22. ANSWER: (E) is the correct answer. (A) is not in accord the patent laws, rules and procedures as related in the MPEP. Regarding (A), MPEP § 601.05, states (“[i]f an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed 37 CFR 1.63 declaration setting forth a different incorrect citizenship of inventor B, the Office will capture the citizenship of inventor B found in the application data sheet. Applicant, however, must submit a supplemental oath or declaration under 37 CFR 1.67 by inventor B setting forth the correct citizenship even though it appears correctly in the application data sheet.

... If, however, the error is one of residence, no change would be required (37 CFR 1.76(d)(2)).” (B) is not in accord the patent laws, rules and procedures as related in the MPEP. As for (B), MPEP § 602, under the heading “Sole Or Joint Designation,” states “[w]hen joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name.” The examiner should notify the inventors that their oaths or declarations are defective and that new oaths or declarations are required. (C) is incorrect. MPEP § 608.01(n), under the heading “II. Treatment Of Improper Dependent Claims,” states “[c]laims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36.” The claim should not be rejected. Further as for (C), MPEP § 608.01(n), under heading “III. Infringement Test,” states “[a] dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.” (D) is not in accord the patent laws, rules and procedures as related in the MPEP. As for (D), MPEP § 609, under heading “(B)(5) Statement Under 37 CFR 1.97(e),” states “[t]he date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply . . . . The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner.”

23. ANSWER: (A) or (D) is accepted as correct. As to (A), MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[i]n limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document.” In the facts, the “published abstract provides an adequate basis for concluding that claim 1 is *prima facie* obvious under 35 USC 103.” As to (D) MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[c]itation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Int. 2001) (unpublished).” (B) is incorrect. MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” indicates that documents that are not in English can form the basis of a prior art rejection, although they must be translated first in order to make clear the facts that the examiner is relying on. (C) is incorrect. MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[w]hen an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full-text document.” (E) is incorrect. See, e.g., MPEP § 2121.01. Whether a disclosure is enabling is a fact-dependent determination that must be made on a case-by-case basis. Even pictures may constitute an enabling disclosure in some cases (MPEP § 2121.04).

24. ANSWER: The filing date of the nonprovisional application, (B), is the correct answer. See MPEP § 201.04(b), which states “[t]he [Uruguay Agreement Round Act] provides a mechanism to enable domestic applicants to quickly and inexpensively file provisional applications. Under the provisions of 35 U.S.C. § 119(e) applicants are entitled to claim the benefit of priority in a given application in the United States. The domestic priority period will not count in the measurement of the 20-year patent term. See 35 U.S.C. 154(a)(3). Thus, domestic applicants are placed on the same footing with foreign applicants with respect to the patent term.” A provisional application is filed under 35 U.S.C. § 119(e) and according to 35 U.S.C. § 154(a)(3), such a filing date is not taken into account in determining patent term. Therefore, (A) is incorrect. The fact pattern states that benefit was properly claimed in the international application to both the provisional application and the national application and that the national stage application filed under 35 U.S.C. § 371 claimed benefit to the filing date of the nonprovisional application under 35 U.S.C. § 120. According to 35 U.S.C. § 154(a)(2), where an application contains a reference to an earlier filed application or applications under 35 U.S.C. § 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed; in this fact pattern that date would be (B), the filing date of the nonprovisional application. The filing date of the international application, (C), is not correct in view of 35 U.S.C. § 154(a)(2) since the international application claimed the benefit under 35 U.S.C. § 120 to the filing date of the nonprovisional application. The date of commencement of the national stage in the United States, (D), is not correct, since the date of commencement of the national stage in the U.S. is not relevant in the determination of the patent term of a patent issuing from the national stage of the international application. Furthermore, as noted in (B) above, since the international application claims the benefit under 35 U.S.C. § 120 to the nonprovisional application, the patent term of the patent issuing from the national stage is measured from the filing date of the nonprovisional application. Finally, the issue date, (E), is not correct, because in 1994, 35 U.S.C. § 154 was amended to provide that for applications filed on or after June 8, 1995, the term of a patent begins on the date the patent issues and ends on the date that is twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. § 120, 121, or 365(c), twenty years from the filing date of the earliest of such application(s).

25. ANSWER: (E) is the most correct answer. Both (A) and (C) are correct. MPEP § 2163.01, under the heading “Support For The Claimed Subject Matter In The Disclosure,” states that “[I]f the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph, or denial of the benefit of filing date of a previously filed application.” (B) is incorrect. MPEP § 2163.01 states that unsupported claims “should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented.” (D) is incorrect because (B) is incorrect.

26. ANSWER: (B) is the most correct answer. MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Can Be Used,” provides that an affidavit under

37 CFR § 1.131 may be used to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(a) but not 35 U.S.C. § 102(b). Also, MPEP § 716 provides that objective evidence traversing a rejection may be presented in a timely submitted affidavit under 37 CFR § 1.132. As for (A), an affidavit under 37 CFR § 1.131 would not serve any useful purpose in those situations. See MPEP § 715. Regarding (C), an affidavit under 37 CFR § 1.131 would be inappropriate. See MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Are Inappropriate.” As for (D) and (E), a reply including affidavits under 37 CFR § 1.131 and 37 CFR § 1.132 normally would be considered untimely under the circumstances set forth in those answers. See 37 CFR §§ 1.116, 1.192(a) and 1.195. Also, see MPEP §§ 715.09 and 716.01. Consequently, (B) is the most correct answer.

27. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2133.03(b), under the heading “I The Meaning Of ‘Sale’,” subheading “A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent,” “[a]n assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b). The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).” (A) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “A. Conditional Sale May Bar a Patent,” states “[a]n invention may be deemed to be ‘on sale’ even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).” (B) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “Nonprofit Sale May Bar a Patent,” states “[a] ‘sale’ need not be for profit to bar a patent. If the sale was for the commercial exploitation of the invention, it is ‘on sale’ within the meaning of 35 U.S.C. 102(b). *In re Dybel*, 524 F.2d 1393, 1401, 187 USPQ 593, 599 (CCPA 1975) (‘Although selling the devices for a profit would have demonstrated the purpose of commercial exploitation, the fact that appellant realized no profit from the sales does not demonstrate the contrary.’). (C) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “A Single Sale or Offer To Sell May Bar a Patent,” states “[e]ven a single sale or offer to sell the invention may bar patentability under 35 U.S.C. 102(b). *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92, 94 (1876); *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 836-37, 23 USPQ2d 1481, 1483 (Fed. Cir. 1992).” (D) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b) quotes *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.2d 1041, 1047, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001) as stating “As a general proposition, we look to the Uniform Commercial Code (‘UCC’) to define whether ... a communication or series of communications rises to the level of a commercial offer for sale.”

28. ANSWER: (B). 37 CFR § 1.83(a); MPEP §§ 608.01(l) and 706.03(o). MPEP § 608.01(l) states “[w]here subject matter not shown in a drawing...is claimed in the specification as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter...It is the drawing...that [is] defective, not

the claim. It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing...” MPEP § 608.02(d) and 706.03(o). MPEP § 706.03(o), state “[i]f subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(l).” (A), (C), and (D) are incorrect. See the foregoing quotation from MPEP § 706.03(o). (A) and (C) also are incorrect because objections to drawings are petitionable, not appealable. MPEP §§ 608.02, under the heading “Receipt of Drawing After Filing Date,” and 1002. (D) is incorrect because the petition, filed more than six months after the final rejection, is not timely. A timely petition would be filed within two months from the mailing date of the action or notice from which relief is requested. See 35 U.S.C. § 133; 37 CFR §§ 1.181(f), 1.134 and 1.135(a); and MPEP § 710.01. (E) is incorrect because (B) is correct.

29. ANSWER: The correct answer is (C). See 35 U.S.C. § 172; MPEP § 1504.02. 35 U.S.C. § 172 provides that the time specified in 35 U.S.C. 102(d) shall be six months in the case of designs. Thus, to avoid a statutory bar under 35 U.S.C. § 102(d), the U.S. design patent application must be made within six months of the foreign filing, *i.e.*, by August 6, 2003. MPEP § 1504.02 states “[r]egistration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster*, 151 USPQ 713 (Bd. App. 1965); *Ex parte Marinissen*, 155 USPQ 528 (Bd. App. 1966); *Appeal No. 239-48*, Decided April 30, 1965, 151 USPQ 711, (Bd. App. 1965); *Ex parte Appeal decided September 3, 1968*, 866 O.G. 16 (Bd. App. 1966). The basis of this practice is that if the foreign applicant has received the protection offered in the foreign country, no matter what the protection is called (‘patent,’ ‘Design Registration,’ etc.), if the United States application is timely filed, a claim for priority will vest. If, on the other hand, the U.S. application is not timely filed, a statutory bar arises under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172. In order for the filing to be timely for priority purposes and to avoid possible statutory bars, the U.S. design patent application must be made within 6 months of the foreign filing.” (A) and (B) are incorrect because they are after the six month period. (D) is not correct because it is not the latest date for filing as required by the question. (E) is not correct because answer (C) is correct.

30. ANSWER: (A) is the correct answer. MPEP (8th Ed.) § 715.07, under the heading “Facts and Documentary Evidence” states that “The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference. ... In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.” Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith’s and Jones’s declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of

the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final. (B) and (C) are incorrect choices since the evidence of record shows that Smith and Jones are unable to overcome the prior art. (D) is wrong because an original copy of the published figure which shows that Smith and Jones were not in possession of the claimed invention prior to Bell and Watson publication cannot help their case. (E) is incorrect because prior art under 102(a) is not a statutory bar.

31. ANSWER: (A) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01 As provided in 37 CFR § 1.53(f) and MPEP § 601.01(a), the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. (B), (C), (D) and (E) are incorrect. 37 CFR § 53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

32. ANSWER: (E) is the most correct answer. MPEP § 410 states that the certification requirement set forth in 37 CFR § 10.18(b) “has permitted the USPTO to eliminate the separate verification requirement previously contained in 37 CFR ...1.48 [correction of inventorship in a patent application], ...1.55 [claim for foreign priority], ...1.102 [petition to make an application special], [and] ... 1.125 [substitute specification].”

33. ANSWER: (E) is the most correct answer. MPEP §§ 2141, 2142, 2143 and 2143.01. Regarding (C) MPEP 2142 under the heading “ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS,” states “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 for decisions pertinent to each of these criteria.” MPEP § 2143 states the same criteria, and further “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” Regarding motivation, MPEP 2143.01 states “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” The examiner has not shown any suggestion or motivation, either in the prior art or in the knowledge generally available to one of ordinary skill in the art, to

modify the known plastic composition. Regarding (D) MPEP § 2142 states “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.” (E) is the most correct answer since it addresses both issues raised by the examiner, obviousness and evidence of improved results. (C) alone is incorrect inasmuch as it does not address the examiner’s comments regarding improved results. (D) alone incorrect because it does not address the examiner’s burden of presenting a *prima facie* case of obviousness. (A) is not correct. MPEP § 2129. Admissions by applicant can be used as prior art. (B) is not correct. MPEP § 2144. It is not necessary for a finding of obviousness that prior art be combined for the same advantage or result as applicant.

34. ANSWER: (A) is the most correct answer. See MPEP § 512, which states “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.” (B) is not correct. See MPEP § 512. Certificate of transmission procedure applies to correspondence transmitted to the Office from a foreign country and an amendment is not prohibited from being transmitted by facsimile and is not precluded from receiving the benefits under 37 CFR § 1.8. (C) is not correct. See MPEP § 609, subsection “Time for Filing.” An IDS will be considered to have been filed on the date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR § 1.8. (D) is not correct. See MPEP § 706.07(h) Comparison Chart. An RCE is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8. (E) is not correct. See MPEP § 1206. An appeal brief is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8 because it is required to be filed in the Office within a set time period which is 2 months from the date of appeal.

35. ANSWER: (A) is the correct answer. See MPEP § 716.10, which states "Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. . . . An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982)." (B) is insufficient in the absence of "objective evidence that an art recognized problem existed in the art for a long period of time without solution." MPEP § 716.04 under heading "THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS." Regarding (C), see MPEP § 716.06: "[M]ore than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985)." (D) is insufficient in the absence of evidence demonstrating that the sales are attributable to the technical merits of the invention rather than to other factors, such as "heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re*

*Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973)." MPEP § 716.03(b) under heading "COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION." (E) is incorrect because (A) is correct.

36. ANSWER: The correct answer is (E), "None of the above." (A) is incorrect because the G patent is a 35 U.S.C. § 102(b) statutory bar. See MPEP § 715 under heading "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," states "(A) Where the reference publication date is more than 1 year prior to applicant's or patent owner's effective filing date. Such a reference is a 'statutory bar' under 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2)." (B) is incorrect because 37 CFR § 1.131 expressly provides that prior invention may not be established under the rule "if the rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in 37 CFR 1.601(n)." 37 CFR § 1.131(a)(1). Regarding (C), see MPEP § 715, under heading "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," which states "(G) Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964)." Regarding (D), see MPEP § 715, under heading, "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," which states "(C) Where the reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than 12 months prior to the filing date of the domestic application. See 35 U.S.C. 102(d)."

37. ANSWER: (D) is most correct answer. As explained at MPEP § 2107.02, II, B, under the heading "No Statement of Utility for the Claimed Invention in the Specification Does Not Per Se Negate Utility," the fact that a specification does not contain a statement of utility for the claimed invention does not *per se* negate utility. This is because a claimed invention may have a well-established utility, and an invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention and (ii) the utility is specific, substantial, and credible. In this case, the declarations specify a specific substantial and credible utility and explain why the declarants (*i.e.*, persons of ordinary skill in the art) would immediately appreciate that the applicant's claimed composition would possess this utility. (A) is incorrect. A lack of utility deficiency under 35 U.S.C. § 101 also creates a lack of utility deficiency under the first paragraph of 35 U.S.C. § 112 as fully explained at MPEP § 2107.01, under the heading "IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101." (B) is not the most correct answer. 35 U.S.C. § 101 (and the first paragraph of 35 U.S.C. § 112) requires that the utility be specific. Therefore, the disclosure of a general utility such as "useful biological" properties does not satisfy this requirement as fully explained at MPEP § 2107.01, under the heading "I. Specific And Substantial Requirements." Response (C) also would not be persuasive since the rejection is based on the fact that the applicant's specification fails to identify any

specific and substantial utility for the claimed composition or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. This is explained at MPEP § 2107.01. The fact that the claimed composition has unambiguously proven to be useful for curing a form of cancer previously thought to be incurable does not negate these specification deficiencies. That is, notwithstanding this unambiguous proof, the fact remains that the applicant's specification fails to identify any specific and substantial utility for the composition. Moreover, it is clear that the specification would not make this specific usefulness immediately apparent to those familiar with the technological field of the composition since the cancer was previously thought to be incurable. Finally, response (E) also would not be persuasive. Under current USPTO policy and procedure, the examiner is not required to present evidence in support of a rejection based on lack of utility where, as here, the specification does not identify a specific, substantial and credible utility and does not appear to provide sufficient information such that a well-established utility would be apparent to a person with ordinary skill in the art. See MPEP § 2107, under the heading "II. Examination Guidelines For The Utility Requirement."

38. ANSWER: (E) is the most correct answer. MPEP §§ 306 and 307. MPEP § 306 states, "In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications." MPEP § 307 states, "Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied." A new assignment document need not be recorded for a divisional or continuation application where the assignment recorded in the parent application remains the same. Accordingly, (A), (B) and (D) are incorrect. In addition, (A), (B) and (D) are incorrect because unless an assignee's name and address are identified in item 3 of PTOL-85B, the patent will issued to the applicant and the assignee information, even if recorded, will not appear on the patent. (C) is incorrect for the same reason. (B) is also incorrect. Assignment data is reflected on the filing receipt, PAIR, or a patent application publication when applicant includes assignment information for purposes of publication of the application on the transmittal letter. Assignment data printed on the patent will be based solely on the information supplied on the Issue Fee Transmittal Form PTOL-85B. See MPEP §§ 1309 and 1481. Accordingly, (E) is correct and (C) is incorrect.

39. ANSWER: The correct answer is (D). PCT Article 11(1)(iii)(e); 35 U.S.C. § 363; 37 CFR § 1.431(a); MPEP § 1810. Under PCT Article 11(1)(iii)(e) to be accorded an international filing date an application must have "a part which on the face of it appears to be a claim or claims." (A) and (C) are incorrect. Under PCT Rule 19.4 if an application is not filed in the prescribed language or is filed by an applicant for which the Office to which the application is submitted is not competent, such application will be forwarded to the International Bureau which will act as receiving Office and accord a filing date as of the date of receipt in the USPTO. (B) is not correct. The Request may be signed by an attorney or agent who is registered to practice before the USPTO. In such a situation the application will be accorded an international filing date of September 18, 2002, and under PCT Article 14 an invitation to correct the defect will be

mailed. See MPEP § 1805, paragraph 7; MPEP 1810, under the heading “The ‘International Filing Date,’” second paragraph. (E) is also incorrect. Under PCT Rules 14.1(c), 15.4(a), 16.1(f), and 16bis.1 the fees may be paid at a date later than the original receipt date.

40. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a US published application of a national stage of an international application filed on or after November 29, 2000 has a prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, and was filed on or after November 29, 2000, the USPTO published application is entitled to its international filing date of January 5, 2001 for prior art purposes under 35 U.S.C. § 102(e)(1). See Example 4 of MPEP § 706.02(f)(1). (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119(a) only for priority and not prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than January 5, 2001. (D) is wrong because the prior art date under 35 U.S.C. § 102(e)(1) is earlier than the application publication date, June 6, 2002.

41. ANSWER: (D) is the most correct answer. 37 CFR § 1.111(b); MPEP §§ 818.03(a)-(c). MPEP § 818.03(a) states “[a]s shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) . . . Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error.” An election must be made even if the requirement is traversed. MPEP § 818.03(b). Answer (A) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action, and no election is made. 37 CFR § 1.143. MPEP § 818.03(a) states “[a] mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR 1.111.” Answer (A) is also incorrect because no election is made. MPEP § 818.03(b) states, “[a]s noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed. (B) is incorrect. MPEP § 818.03 since the traversal does not distinctly point out the supposed errors in the examiner’s action. (C) is incorrect since no election is made. See MPEP § 818.03(b) (E) is incorrect because (D) is correct.

42. ANSWER: (C) is the most correct answer. 37 CFR § 1.193(a)(2); MPEP § 1208.01. If the claimed invention is rendered obvious by Smith in view of Jones and Brown, the statement of rejection must include all three references. Reliance on Brown to support the rejection is a different rejection from a rejection relying only on Smith in view of Jones. In accordance with MPEP § 1208.01, the Board will not consider the teachings of Brown because Brown was used to support the rejection, but was not listed in the statement of the rejection. As stated in MPEP § 1208.01, “Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).” Therefore, (B) and (D) are clearly wrong. (A) is incorrect. The decision cannot affirm the rejection since there is no motivation for combining the teachings of Smith and Jones absent the teachings of Brown. Therefore, the rejection must be reversed, not affirmed.

43. ANSWER: (E) is the most correct answer. See 37 CFR § 1.76(d)(3); MPEP § 601.05. The oath or declaration filed under 37 CFR §§ 1.63 or 1.67 governs any inconsistency with the Application Data Sheet (ADS) when the inconsistency relates to the setting forth the citizenship of the inventor(s) even if the ADS was filed after the filing of the oath or declaration. (A) is incorrect because an ADS is a voluntary submission in either a provisional application or a nonprovisional application. See 37 CFR 1.76(a). (B) is an incorrect answer because the information related to the naming of inventors 37 CFR § 1.41(a)(1) and the information relating to setting forth citizenship 35 U.S.C. § 115 is governed by the oath or declaration filed under 37 CFR §§ 1.63 or 1.67 regardless if the two documents are filed simultaneously. (C) is an incorrect answer because the ADS will govern an inconsistency concerning the claiming of domestic priority information. See 37 CFR § 1.76(d)(2). (D) is an incorrect answer because the information related to the naming of inventors 37 CFR § 1.41(a)(1) and the information relating to setting forth citizenship 35 U.S.C. § 115 is governed by the oath or declaration filed under 37 CFR §§ 1.63 or 1.67 regardless of whether or not the ADS is filed after the oath or declaration under 37 CFR §§ 1.63 or 1.67.

44. ANSWER: (B) is the most correct answer. MPEP § 2111.03 (fourth paragraph) states, in reliance upon *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976), that “[t]he transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” (A) is incorrect. The statement is contradicted by MPEP § 2111.03 (second paragraph), which states, in reliance upon *Genentech, Inc. v. Chiron Corp.*, 112, F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) that “[t]he transition term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. (C) is incorrect. The statement is contradicted by MPEP § 2111.03 (third paragraph), which states, in reliance upon *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931) that “[t]he transitional phrase ‘consisting of’ excludes any element, step, or ingredient not specified in the claim.” (D) is incorrect. The statement is directly contradicted by MPEP § 2111.03 (third paragraph), which states “[a] claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (E) is incorrect because (A), (B) and (C) are incorrect.

45. ANSWER: (B) is the most correct answer. 37 CFR § 1.192(c)(7); MPEP § 1206, under the heading “Appeal Brief Content,” subheading “(7) Grouping of Claims.” 37 CFR § 1.192(c)(7) requires that an appellant perform two affirmative acts in the brief to receive separate consideration of the patentability of a plurality of claims that are subject to the same rejection. The appellant must (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable. Since the appellant here has only performed the two affirmative acts with respect to claims 1, 4 and 6, these are the claims that the Board must consider separately for patentability. The examiner has no input on the grouping of claims. (D) is incorrect inasmuch as § 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. See MPEP § 1206, subheading subheading “(7) Grouping of Claims.” Where the grouping of claims section is inconsistent with the arguments section as in the facts of this case, the examiner should have notified the appellant that the brief was in noncompliance as per 37 CFR § 1.192(d). See *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020

(Bd. Pat. App. & Int. 1991). However, failure of the examiner to note noncompliance does not require the Board to separately consider claims which have not been specifically argued in the brief. (A) is incorrect inasmuch as the two affirmative acts required by § 1.192(c)(7) to have the separate patentability of a plurality of claims subject to the same rejection considered, i.e., (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable, have not been presented for each of claims 1-10. (C) is incorrect because the provisions of § 1.192(c)(7) have been satisfied for claims 1, 4 and 6. (E) is wrong because the provisions of § 1.192(c)(7) have been satisfied. (A), (C) and (D) are incorrect answers.

46. ANSWER: (C) is the best answer. 35 U.S.C. § 102; MPEP §§ 2111 and 2131. MPEP § 2131, under the heading, "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim." "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Here, every element of the claim is found in Patent A. See MPEP 2111, under the heading "Claims Must Be Given Their Broadest Reasonable Interpretation," where it explained that "[d]uring patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification,'" and cites *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) to explain that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." (A) and (B) are incorrect. MPEP § 2111. The claim, as written, is not allowable over Patent A since Patent A disclosed every element recited in the claim. (D) is incorrect. There is no need to search again for a building material, this time looking for balsa wood. The claim has not been amended to be directed to balsa wood. Since it still broadly recites "wood," Patent A that discloses pine remains germane and anticipates the claim. (E) is incorrect for one or more reasons. It is incorrect because it wrongly agrees with the practitioner's argument that Patent A is poor reference. It also is incorrect because it seeks to reject the claim over 35 U.S.C. § 112, second paragraph, for indefiniteness. The claim is clear on its face and there is nothing indefinite about what the claim says. This answer makes the mistake of confusing breadth with indefiniteness. The claim is broad but it is definite.

47. ANSWER: (C) is the most correct answer. 35 U.S.C. § 102(a); MPEP § 2132. As set forth in MPEP § 2132, under the heading "II. 'In This Country,'" subheading "Only Knowledge or Use In The U.S. Can Be Used in a 35 U.S.C. 102(a) Rejection," states "[t]he knowledge or use relied on in a 35 U.S.C. 102(a) rejection must be knowledge or use 'in this country.' Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under 35 U.S.C. 102(a). *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). Note that the changes made to 35 U.S.C. 104 by NAFTA (Public Law 103-182) and Uruguay Round Agreements Act (Public Law 103-465) do not modify the meaning of 'in this country' as used in 35 U.S.C. 102(a) and thus 'in this country' still means in the United States for purposes of 35 U.S.C. 102(a) rejections.'" See also MPEP § 706.02(c), "[t]he language 'in this country' means in the United States only and does not include other

WTO or NAFTA member countries.” Since “in this country” means in the United States for purposes of 35 U.S.C. § 102(a) rejections, (A), (B), (D) and (E) are incorrect.

48. ANSWER: (C) is correct. 37 CFR § 1.181(f); MPEP §§ 714.13 and 1002: 37 CFR § 1.181(f) provides “The mere filing of a petition will not stay the period for reply to an Examiner’s action which may be running against an application, nor act as a stay of other proceedings.” MPEP § 714.13 states “[i]t should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner’s action which may be running against an application.” See also MPEP § 1002. Thus, if a petition to vacate a final rejection as premature is filed within 2 months from the date of the final rejection, the period for reply to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full reply to the rejection within the period for reply, the case is not abandoned. (C) is correct because the petition does not stay the time for responding to the final and a reply should be filed within the shortened statutory period to avoid fees. (A) is incorrect because any reply after the shortened statutory period set for reply in the final rejection will require at least payment of fees for an extension of time. MPEP § 1002 states “The mere filing of a petition will not stay the period for replying to an examiner’s action which may be running against an application, nor act as a stay of other proceedings (37 CFR 1.181(f)). For example, if a petition to vacate a final rejection as premature is filed within 2 months from the date of the final rejection, the period for reply to the final rejection is not extended even if the petition is not reached for decision within that period.” (B) is incorrect because the application will be abandoned 6 months after the date of the final rejection for lack of reply to the final rejection, 35 U.S.C. 133, and a status inquiry filed 6 months after filing the petition would be in an abandoned application. Moreover, a petition status inquiry filed at any time is not a proper reply to the final rejection. See 37 CFR §§ 1.113(c) and 1.116. (D) is incorrect because the filing of a petition does not stay the period for reply. 37 CFR § 1.181(f); MPEP §§ 714.13 and 1002. (E) is incorrect because (C) is correct, and (A), (B) and (D) are incorrect.

49. ANSWER: (E) is the most correct answer. 37 CFR § 1.75(c); MPEP § 608.01(n), under the heading “II. Treatment Of Improper Dependent Claims,” 37 CFR § 1.75(c) provides “One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. See MPEP §§ 608.01(l) and 2163. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 CFR § 1.75(c). Claim 11 is an improper dependent claim because it is inconsistent with and does not further limit the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 redefines the minimum memory by setting a lower minimum of ½ gigabyte.

50. ANSWER: (C) is the most correct, as a 35 U.S.C. § 102(g) rejection requires actual reduction to practice by another, and lack of abandonment, suppression, or concealment. MPEP § 2138 states “35 U.S.C. 102(g) may form the basis for an ex parte rejection if: (1) the subject matter at issue has been actually reduced to practice by another before the applicant’s invention; and (2) there has been no abandonment, suppression or concealment. See, e.g., *Amgen, Inc. v.*

*Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1205, 18 USPQ2d 1016, 1020 (Fed. Cir. 1991); *New Idea Farm Equipment Corp. v. Sperry Corp.*, 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990); *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434, 7 USPQ2d 1129, 1132 (Fed. Cir. 1988); *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1444-46, 223 USPQ 603, 606-08 (Fed. Cir. 1984).” (A) is incorrect, as actual reduction to practice is not sufficient to establish a 35 U.S.C. § 102(g) rejection where the subject matter has been abandoned, suppressed, or concealed. MPEP § 2138. (B) is incorrect, as abandonment, suppression, or concealment is not sufficient to establish a 35 U.S.C. § 102(g) rejection where the subject matter has been reduced to practice in that conception alone is not sufficient. See *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1445, 223 USPQ 603, 607 (Fed. Cir. 1984). MPEP § 2138. (D) is incorrect because no prior patent application is required for a § 102(g) rejection. MPEP § 2138. Similarly, (E) is incorrect, because no prior patent application nor issued patent is required for a rejection under 35 U.S.C. § 102(g).