

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

**Afternoon Session Model Answers**

1. ANSWER: (D). 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (A), (B), (C), and (E) are required by 35 U.S.C. § 102(d).
2. ANSWER: (D) is the correct answer. MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.
3. ANSWER: (B). Hand entry of amendments to a claim in a reissue application is no longer permitted. 37 C.F.R. § 1.121(b)(2). Answers (A), (C) and (D) are all changes that were made pursuant to the December 1, 1997, change. 37 C.F.R. §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 C.F.R. § 1.121(b)(2)(i)(A) and MPEP § 1453.
4. ANSWER: (E). Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstop occurred prior to the filing date. Moreover, the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-4. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.
5. ANSWER: (E). 35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. § 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. MPEP § 2217. An admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure. The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an

appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

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

7. ANSWER: (B) is correct. See 35 U.S.C. § 151; MPEP § 1306. As to (A) see MPEP § 1306.01. As to (C) see MPEP § 2212. As to (D), the claim for priority is not required as a person may not wish to do so in order to increase the term of his or her patent. Since (A) and (C) are incorrect, (E) is incorrect.

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

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

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

11. ANSWER: The best answer is (C). See, e.g., 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

12. ANSWER: (A). MPEP § 706.03(u). (B) is incorrect. MPEP § 706.03(w) Res Judicata should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the

earlier decision. (C) is incorrect. MPEP § 608.01(l) and 706.03(o). If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim should not be rejected, but on that basis applicant is required to add it to the drawing. (D) is incorrect. As stated in MPEP § 706.03(a), “A thing occurring in nature, which is substantially unaltered, is not a ‘manufacture.’ A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).” (E) is incorrect. MPEP § 706.03(a) indicates that a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O’Reilly v. Morse*, 56 U.S. (15 Howard) 62 (1854).

13. ANSWER: (E) is the correct answer. MPEP § 706.02(b). (A) is incorrect because the Dan reference includes all the elements of claim 1. (B) is incorrect because the Federal holiday is merely to move the statutory bar date to the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). (C) is incorrect because a 37 C.F.R. § 1.131 affidavit can not be used to overcome a rejection under 35 U.S.C. § 102(b). (D) is incorrect because the rejection was not made under 35 U.S.C. § 103.

14. ANSWER: (E). MPEP § 201.13 “The Priority Claim.” (A) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. A right of priority does not exist in the case of an application of inventor B in the foreign country and inventor A in the United States, even though the two applications may be owned by the same party. The name of the treaty is appropriate if it is a bilateral treaty, as opposed to the Paris Convention, whereas naming the treaty is not appropriate if it is the Paris Convention. (B) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, must have been filed within twelve months of the earliest foreign filing. (C) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The twelve months is from earliest foreign filing except as provided in 35 U.S.C. § 119(c), which exception does not obtain in the given facts. (D) is incorrect. 35 U.S.C. § 119(a); MPEP § 201.13. The foreign application must be for the same invention as the application in the United States.

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

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

be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

17. ANSWER: (E). A claim may be amended by specifying the exact matter to be deleted or added, and the precise point where the deletion or addition is to be made. 37 C.F.R. § 1.121(a)(2)(i). The amendments are limited to deletions and/or additions of no more than 5 words per claim or deletions. 37 C.F.R. §§ 1.121(a)(2)(i)(A) and 1.121(a)(2)(i)(B). Here, Answer (A) is improper because the amendment does not specify the precise point where the addition is to be made. Answer (B) is improper because the amendment adds more than 5 words to the claim, and amendments by deletion and/or addition are limited to no more than 5 words per claim. Answer (C) is improper because line 3 contains the word “layer” twice and the amendment does not specify whether the word “thin” is to be added before the first occurrence, second occurrence, or all occurrences of the word “layer.” Answer (D) is improper because the amendment does not specify the exact matter to be deleted and the exact matter to be inserted.

18. ANSWER: (E) is the correct answer because Sally’s patent is prior art under 35 U.S.C. § 102(a) and cannot be disqualified by a showing of common ownership, which can be used to disqualify prior art under 35 U.S.C. 102(f) and (g). 37 C.F.R. § 1.104(a)(5); MPEP §§ 706.02(1) (“If the subject method qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a) . . .) it will not be disqualified as prior art under 35 U.S.C. 103.”), and 706.02(1)(2).

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

20. ANSWER: (D) is the correct answer. Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

21. ANSWER: (C). (A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

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

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

24. ANSWER: (E). MPEP §§ 1502.01; 201.04(b).

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

26. ANSWER: (B). *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989); MPEP § 2136.05. (A) is incorrect. A prior abandoned application that was not copending with the application in issue cannot be used to antedate a reference. *In re Costello*, 219 USPQ 389 (Fed. Cir. 1983); MPEP § 2136.05. (C) is incorrect. 35 U.S.C. § 102(b). The one year time bar precludes antedating the publication. *In re DeBaun*, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 215 USPQ 14 (CCPA 1982)); MPEP § 2136.05. (D) is incorrect. The applicant must produce evidence showing who invented the subject matter. *In re Whittle*, 172 USPQ 535, 537 (CCPA 1972); MPEP § 2136.05. (E) is incorrect inasmuch as (A), (C) and (D) are incorrect.

27. ANSWER: (A) is the correct answer. MPEP § 2133.03(e)(1) and 35 U.S.C. § 102(b). II does not create a statutory bar because it is permitted experimental testing. MPEP § 2133.03(e)(3) and (6). Therefore (B) is incorrect. III does not create a statutory bar because the sale did not occur in the United States. MPEP § 2133.03(d). Therefore, (C) and (D) are incorrect. (E) is incorrect because (A) is correct.

28. ANSWER: (C) is the correct answer. MPEP § 609(B)(3) and 37 C.F.R. § 1.97. (A) is incorrect because each individual associated with the filing and prosecution of a patent application has a duty to disclose to the Office all information which they know to be material to the patentability of pending claims. 37 C.F.R. § 1.56. (B) is incorrect because 37 C.F.R. § 1.97(d) requires the filing of the items specified in III, including the § 1.97(e) statement, after the mailing date of a notice of allowance. (D) is incorrect because I is incorrect. (E) is incorrect because only III is correct, and I and II are incorrect.

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

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

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

practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, “There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

32. ANSWER: (B). There must be a previously expressed desire by the applicant to receive benefits under a claim of priority before a Certificate of Correction request will be granted. While a continuation application can rely on a previously expressed desire to receive benefits under a claim of priority in a parent case, a parent case has no prior application to look to. MPEP § 201.16. (A) is incorrect because it is a true statement. See *Brenner v. State of Israel*, 158 USPQ 584 (D.C. Cir. 1968). (C) and (D) are true statements. Hence, they are incorrect answers. *In re Van Esdonk*, 187 USPQ 671 (Comm’r Pat. 1975). MPEP § 201.16 and 2258, respectively. (E) is a true statement, and therefore, is a wrong answer. MPEP § 201.15 (last paragraph).

33. ANSWER: (D). Jake is the applicant, and Jim and Jill are registered practitioners. “An applicant for patent may file and prosecute his or her own application... .” MPEP § 401. The applicant, Jake, is not required to revoke Mike’s power of attorney because Jack is unregistered, and therefore his appointment is void *ab initio*. MPEP § 402, Form Paragraph 4.09 (first paragraph). Jim and Jill’s signature constitutes “a representation to the Patent and Trademark Office that...he or she is authorized to represent the particular party in whose behalf he or she acts.” 37 C.F.R. § 1.34. This privilege applies whether or not the registered attorney is of record. 37 C.F.R. § 1.31; MPEP § 402. (A), (B), and (C) are wrong because they do not represent the “most comprehensive” answer. (E) is wrong because it is inconsistent with (D), which is correct.

34. ANSWER: (A) is the correct answer. MPEP § 710.02(d), last paragraph, and 37 C.F.R. § 1.136(a). (B) is incorrect because a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. § 133. (C) and (D) are incorrect because the provisions of 37 C.F.R. § 1.136(a) are available. (E) is incorrect because (A) is correct.

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

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

37. ANSWER: (E). MPEP §§ 608.04(b) and 608.04(c). Answer (A) is incorrect because the preliminary amendment does not enjoy the status as part of the original disclosure in an application accompanied by a signed declaration unless the preliminary amendment is referred to in the declaration. (B) is incorrect because a petition under §1.181 would only be appropriate if the new matter is confined to the specification. If the new matter is introduced into or affects the claims, the question becomes an appealable one. (C) is incorrect because the Office action is a first, non-final action and the issue is therefore not yet ripe for appeal. 37 C.F.R. § 1.191. (D) is incorrect because the original disclosure cannot be altered merely by filing of a subsequent oath or declaration referring to different papers.

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

39. ANSWER: (D). See 37 C.F.R. § 1.313(b); MPEP §§ 609, subpart (B)(4) and 1308. After payment of the issue fee it is impractical for the Office to consider any information disclosures. As to (A), a prior art statement is applicable only to patent, not application, files. 37 C.F.R. § 1.501. As to (B), duty of disclosure continues until the patent is issued. As to (C), the patent should not be allowed to issue since it may contain invalid claims. As to (E) no amendment is entitled to entry after payment of the issue fee. 37 C.F.R. § 1.312(b).

40. ANSWER: (C). Admissions by applicant constitute prior art. As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler's admission of the Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the



Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

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

41. ANSWER: (B) is not in accordance with proper USPTO practice and procedure, is the correct answer. A supplemental oath or declaration in a nonprovisional application other than a reissue application is not treated as an amendment of the specification or claims. MPEP § 603.01 and 714.16(d). (A), (C), (D), and (E), being in accordance with proper USPTO practice and procedure, are incorrect answers. 37 C.F.R. § 1.312; MPEP § 714.15 and 714.16.

42. ANSWER: (E) is the correct answer because there is compliance with 37 C.F.R. § 1.195. MPEP § 1211.02. (A) and (C) are wrong because jurisdiction has not passed to the Board. MPEP § 1210. (B) and (D) are wrong because a remand is an action by the Board when it has jurisdiction of the case. MPEP § 1211. Under the present facts, the Board has no jurisdiction. MPEP § 1210.

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

44. ANSWER: (B). As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the

best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).”

45. ANSWER: (A) is the correct answer because the application is properly deposited with the USPS as “Express Mail Post Office to Addressee” and the “date-in” is properly entered by the USPS. MPEP § 502, subpart styled “‘Express Mail’ Service” states, “The only type of service which can be used for ‘Express Mail’ directed to the Patent and Trademark Office is the ‘Post Office to Addressee’ service of the U.S. Postal Service. 37 C.F.R. 1.10.” MPEP § 513 under the heading “Date-In, Direct Deposit, ‘Express Mail’ Box Receptacles & Log Books” recites, “The ‘date-in’ on the ‘Express Mail’ mailing label must be completed by the USPS, not the applicant.” MPEP § 513 under the heading “‘Express Mail’ Mailing Label Number” recites, “Effective December 2, 1996, 37 C.F.R. 1.10(b) no longer requires...that the ‘Express Mail’ mailing label number be placed on the correspondence prior to mailing.” MPEP § 513, subpart styled “Effective Date, Weekends & Holidays” states, “Effective December 2, 1996, 37 C.F.R. 1.6(a)(2) provides that correspondence deposited as ‘Express Mail’ in accordance with 37 C.F.R. 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.” Therefore, (A) provides a filing date of June 24, 2000. (B) is wrong because the receipt date of June 26, 2000, is the filing date, since the “Express Mail Post Office to Post Office” procedure is ruled out by MPEP § 502. (C) is wrong because the receipt date of July 5, 2000, is the filing date, since the “date-in” was not entered by the USPS as required by MPEP § 513. (D) is wrong because the effective receipt date is July 3, 2000, since the “date-in” was not entered by the USPS as required by MPEP § 513. (E) is wrong because the receipt date is July 3, 2000, since the “Express Mail Post Office to Post Office” procedure is ruled out by MPEP § 502.

46. ANSWER: (B). The petition for extension of time filed February 14, 2000 provided applicant with a one-month extension of time from the original due date, February 12, 2000 (not from the date the petition was filed). See MPEP § 710.01(a). Thus, the extended due date was Sunday, March 12, which means a reply was due by Monday, March 13. Since an additional extension of time is needed, (A) is incorrect. Under the provisions of 37 C.F.R. § 1.136(a)(3), applicant’s statement is treated as a constructive petition for extension of time. MPEP § 710.02(e). (C) is incorrect because applicant’s statement in the Remarks portion of the amendment acted as a constructive petition for extension of time and, therefore, the amendment is timely. There is no need for the petition to appear in a separate paper, so (D) is not correct. (E) is incorrect because (C) and (D) are both incorrect.

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

claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

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

49. ANSWER: (B). 37 C.F.R. §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), subsection styled “Specification and Drawings,” 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 C.F.R. § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

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