

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
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Morning Session Model Answers

1. ANSWER: Choice (C) is the correct answer. MPEP § 409.03(a), and 37 C.F.R. § 1.47(a). 37 C.F.R. § 1.47(a) provides, “If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.” Choices (A), (B), and (D) are each incorrect because they are not provided for by 37 C.F.R. § 1.47(a). MPEP § 409.03 (b), in pertinent part provides, “Where 37 C.F.R. § 1.47(a) is available, application cannot be made under 37 C.F.R. § 1.47(b).” Choice (E) is incorrect because choices (A), (B), and (D) are each incorrect.

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

3. ANSWER: (E). There is no such requirement. As to (C), see 37 C.F.R. § 1.52(b). As to (A) through (D) see MPEP § 608.01(m). 37 C.F.R. § 1.75(i).

4. ANSWER: The most correct answer is (E). A dependent claim must further limit the claim from which it depends. 35 U.S.C. § 112, ¶4; 37 C.F.R. § 1.75(c). Dependent claim 6 (Answer E) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.

5. ANSWER: (C) is most correct. 37 C.F.R. § 1.181; MPEP § 706.07(c). (A) and (B) are wrong. 37 C.F.R. § 1.181(a)(1); MPEP § 706.07(c). Prematureness of a final rejection is not appealable. 37 C.F.R. § 1.191(a). (D) and (E) are wrong because MPEP § 706.07(c) states,

“Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.” MPEP § 1210 indicates that jurisdiction is before the Board at the times set forth in (D) and (E).

6. ANSWER: (E) is the correct answer. MPEP § 715. (A) is incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where the reference is a prior U.S. patent to the same entity, claiming the same invention. MPEP § 715. (B) and (D) are each incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where the reference is a statutory bar under 35 U.S.C. § 102(d) as in (B) or a statutory bar under 35 U.S.C. § 102(b) as in (D). MPEP § 715. (C) is incorrect because an affidavit under 37 C.F.R. § 1.131 is not appropriate where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. MPEP § 715.

7. ANSWER: (B) is best choice because it is a false statement. MPEP § 2112.01 cites *Titanium Metals Corp. v. Banner*, 778 F.2d 660, 227 USPQ 773 (Fed. Cir. 1985), as stating, “it was immaterial what properties the alloys had...because the composition is the same and thus must necessarily exhibit the properties.” (A) is not correct because it is a true statement. (C), (D) and (E) are incorrect because the stated reliance is permitted. 37 C.F.R. § 1.104(c)(3); MPEP § 706.

8. ANSWER: Choice (B) is the correct answer. MPEP § 804.02, subpart (II) reads, “A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made.” Choices (A) and (C) are each incorrect. MPEP § 804.02, reads, “The use of a 37 C.F.R. § 1.131 affidavit in overcoming a double patenting rejection is inappropriate...37 C.F.R. § 1.131 is inapplicable if the claims of the application and the patent are ‘directed to substantially the same invention.’ It is also inapplicable if there is a lack of ‘patentable distinctness’ between the claimed subject matter.” Choice (C) is further incorrect since a nonstatutory double patenting rejection can be based on the claims not being patentably distinct. MPEP § 804, subpart (II)(B)(1). Choice (D) is incorrect because MPEP § 804, subpart (I)(A) reads, “Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent.” Choice (E) is incorrect because choices (A), (C), and (D) are each incorrect.

9. ANSWER: (B) is the most correct answer inasmuch as the title needs to be technically accurate and the limitation is 500 characters, not 10 words. See MPEP § 606. As to (A), (C) and (D), see MPEP §§ 606 and 606.01 on p. 600-50. As to (E), the title can be amended by the examiner.

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

11. ANSWER: (E) is correct. The statement finds support in MPEP § 1503.02, V. “Photographs and Color Drawings.” (A) and (C) are wrong because 37 C.F.R. § 1.152 states, “Photographs and ink drawings are not permitted to be combined as formal drawings in one

application.” Reproduced in MPEP § 1503.02. (B) and (D) are wrong because 37 C.F.R. § 1.152 states, “Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.” Reproduced in MPEP § 1503.02.

12. ANSWER: The best choice is (E). *See* MPEP § 1412.04. Reissue is a proper vehicle for correcting inventorship in a patent. Because correction of inventorship does not enlarge the scope of the patent claims, the reissue application may be filed more than two years after the patent issued. Answers (A) and (B) are therefore both correct, and (E) is the best response. Although a certificate of correction may be used to correct inventorship where all parties are in agreement, the facts of the question show that Inventor A is not in agreement. Choice (C) is thus not an available option for MegaCorp. Choice (D) is incorrect because the provisions of 37 C.F.R. § 1.48 are not available to correct inventorship in an issued patent.

13. ANSWER: (A) is the most 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 (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

14. ANSWER: The most correct answer is (E). (A), (B), (C) and (D) are not in accordance with proper USPTO practice and procedure. (A) alone is not correct. MPEP § 2131.04 and see *In re Wiggins*, 179 USPQ 421, 425 (CCPA 1973). (B), (C), and (D) are not correct. MPEP § 2131.05, and see *Twin Disc, Inc. v. U. S.*, 231 USPQ 417, 424 (Cl. Ct. 1986); *In re Self*, 213 USPQ 1, 7 (CCPA 1982).

15. ANSWER: Choice (D) is the correct answer. MPEP § 804.02, reads, “A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope.” Choices (A) and (C) are each incorrect because MPEP § 804.02, reads, “The use of a 37 C.F.R. § 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate.” Choice (C) is further incorrect since the statutory double patenting rejection is based on the conflicting claims being coextensive in scope. Choice (B) is incorrect because MPEP § 804.02, reads, “A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.” Choice (E) is incorrect because choices (A), (B), and (C) are each incorrect.

16. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.121(c) and (d), and MPEP § 714, page 700-169 through 172 (8th Ed.) (*Amendments, Applicant’s Action*). (A) is incorrect. MPEP § 714.22, page 700-196, 197 (8th Ed.) (*Entry of Amendments*). Applicant may resubmit the amendment within any remaining period of time (set in the final rejection). No further extension of time or new time periods which might serve to extend the six month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may resubmit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an extension beyond the six-month statutory deadline. (B) is incorrect. MPEP § 714.22(a), page 700-198, (*Amendments Consolidating All Claims*). Applicants have the opportunity to consolidate all previous versions of pending claims from a

series of separate amendment papers into a single clean version in a single amendment paper. This may be done at any time during prosecution of the application, though the entire clean claim set is subject to the provisions of 37 C.F.R. §§ 1.116(b) and 1.312. (C) is incorrect. MPEP § 714, page 700-169 through 172 (8th Ed.) (*Amendments, Applicant's Action*) While the first portion of the answer is correct because amendments to the drawings must be submitted on a separate paper showing the proposed changes in red for to the specification including the claims must be made by replacement paragraph/section/claim in clean form. This requirement is regardless of the mailing date of the Office action.

17. ANSWER: (C) is correct. MPEP § 707.05(f) states, "In the use of [declassified material] ... as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute." (A) is wrong. MPEP § 706.02(a) states, "A magazine is effective as a printed publication under 35 U.S.C. § 102(b) as of the date it reached the addressee and not the date it was placed in the mail." (B) is wrong. MPEP § 707.05(f) states, "For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. § 102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time." (D) and (E) are wrong. The AIPA amended 35 U.S.C. § 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 U.S.C. § 102(e) based on their earliest effective filing date against applications filed on or after November 29, 2000, and applications filed prior to November 29, 2000 which have been voluntarily published. MPEP § 706.02(a).

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

19. ANSWER: (A) is the best answer as there is no provision regarding one year from discovery in 37 C.F.R. § 1.26. As to (B) through (E) see MPEP § 607.02. The Office will refund amounts of twenty-five dollars or less if requested to do so by the applicant. See MPEP § 607.02 at p. 600-51. As to (A), (B), (D) and (E), see MPEP § 607.02 at p. 600-51.

20. ANSWER: The most correct answer is (E). MPEP § 2164.01(a).

21. ANSWER: (D) is correct. (A) is wrong. 37 C.F.R. § 1.14(e)(2); MPEP § 103, application files are available upon request because the divisional application refers to the abandoned parent application, and the division issued as a patent, causing the application to be open to inspection. (B), (C) and (E) are wrong and (D) is correct. MPEP § 301.01.

22. ANSWER: (E) is incorrect as a preliminary amendment may be filed with the original disclosure and will be treated as part of the original disclosure in accordance with MPEP § 608.04(b) (A) through (D) are all correct. See MPEP § 608 at p. 600-53.

23. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must

(1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

24. ANSWER: (C) is incorrect as the Office will refund amounts of twenty-five dollars or less if requested to do so by the applicant. See MPEP § 607.02 at p. 600-51. As to (A), (B), (D) and (E), see MPEP § 607.02.

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

26. ANSWER: (E). The abstract should not compare the invention with the prior art. MPEP § 608.01(b). As to (A) through (C), see MPEP § 608.01(b). As to (D), when the process for making is not obvious, the process should be set forth in the abstract. See MPEP § 608.01(b).

27. ANSWER: The most correct answer is (B). 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141. Resolving any issue of indefiniteness in favor of clarity is not among the factual inquiries enunciated in *Graham*. The four factual inquiries are set forth in answers (A), (C), (D), and (E).

28. ANSWER: (C) is the correct answer. Claim 3 in answer (C) employs improper multiple dependent claim wording. MPEP § 608.01(n)(I)(B). (A), (B), (D), and (E) are incorrect as each uses acceptable multiple dependent claim wording. MPEP § 608.01(n)(I)(A).

29. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted’s application. (D) is incorrect because the Japanese patent application issued after the date of Ted’s application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

30. All answers accepted.

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

32. ANSWER: (A) is the most correct answer. The patentability of a product-by-process claim is determined based on the product itself, not on the process of making it. *See In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), and MPEP § 2113. (B) and (D) are not proper choices because when evidence indicates that the applicant's product and that of the prior art are identical or substantially identical, the burden shifts to the applicant to overcome the rejection by providing evidence that the prior art product does not necessarily or inherently possess a relied-upon characteristic of the applicant's claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977), and MPEP § 2112. (C) is not the proper choice because evidence of unexpected results is not relevant to anticipation. *See In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974), and MPEP § 711.03(c). (E) is not the proper choice because a rejection under 35 U.S.C. § 102(b) is a statutory bar to patentability, and 37 C.F.R. § 1.131(a)(2) states that § 131 cannot be used to establish prior invention when the rejection is based upon a statutory bar.

33. ANSWER: (C) is correct and (B) is wrong because MPEP § 706.07(f), part (H), states, "Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action." (A), (D) and (E) are wrong because MPEP § 706.07(f), part (H), states, "Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law." In (A), when an examiner's amendment is mailed exactly 5 months after Xavier's reply, the examiner's amendment would be made more than 6 months after the Office action.

34. ANSWER: (A) is correct and (B), (C), (D) and (E) are wrong. MPEP § 601.01(d).

35. ANSWER: (C). According to MPEP § 608.01(I), “[t]he claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description.” As to (A), (B), (D), and (E), see MPEP § 608.01(I).

36. 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.

37. ANSWER: (C). As indicated in MPEP § 608.01(b), if an application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by examiner’s amendment rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions. As to (A), (B), (D), and (E), see MPEP § 608.01(b).

38. ANSWER: (D) is the most correct answer. A reference is a “printed publication” if one of ordinary skill in the art can locate it with reasonable diligence. Its availability as prior art under § 102(b) depends upon proof of when the reference was “published” or became publicly accessible. Here, (D) is the correct answer because the Japanese patent application was published, *i.e.*, “laid open,” more than 1 year before applicant’s filing date. (C) is incorrect because it was posted or published less than one year after applicant’s filing date. (B) is incorrect because (1) the database retrieval date is after applicant’s filing date, (2) the printout does not include the date on which the MEDLINE abstract was publicly posted and (3) reliance is on the printout per se not the actual article (reliance on the actual article would require getting the article and an English translation as well as determining the date when the journal was publicly available). (A) is incorrect because there is no evidence when the journal was publicly available. The examiner was unable to determine the actual date of publication.(E) is incorrect because (A), (B) and (C) are incorrect

39. ANSWER: (E). As to (E), it is not in accord with MPEP § 201.08 since the application need not be filed before a notice of allowance, but instead before patenting of the first application. (A) through (C) are found in MPEP § 201.08. As to (D), calling the patent application a continuation-in-part will result in the application having its patent term calculated from its filing date. An application filed under 35 U.S.C. §§ 120, 121, or 365(c) will have its patent term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s). 35 U.S.C. § 154(a)(2) and (a)(3).

40. ANSWER: (C) is the most correct answer. The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (A) is a USPTO recommendation. See MPEP § 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (B) is a USPTO recommendation. See MPEP § 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least

restrictive.”). (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.”).

41. ANSWER: (A) is the most correct answer. 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.

42. ANSWER: (A) is correct. MPEP § 706.07(f), paragraph (I). (B) is wrong. MPEP § 706.07(f), paragraph (M). (C) is wrong. MPEP § 706.07(f), paragraph (N). (D) is wrong. MPEP § 706.07(f), paragraph (H). (F) is wrong. MPEP § 706.07(f), paragraph (O).

43. ANSWER: The most correct answer is (A). MPEP § 2143.03 (Indefinite Limitations Must Be Considered). (B) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). (C) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Indefinite Limitations Must Be Considered), and see *In re Wilson*, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). (D) is not correct because it is proper procedure to be followed by an examiner. MPEP § 2143.03, (Limitations Which Do Not Find Support In The Original Specification Must Be Considered), and see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). (E) is incorrect because the examiner may properly take the actions set forth in (B), (C), and (D).

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

45. ANSWER: (C) is a false statement and therefore the correct answer. Under 35 U.S.C. § 261, “An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.” (C) is correct because ABC Corporation acquired all of John’s ownership rights in the original patent application, including the subcombination claimed in the original nonprovisional and divisional patent applications. The assignment of the rights to ABC Corporation was recorded in the USPTO prior to the subsequent acquisition of the subcombination by XYZ Corporation. U.S.C. § 261. ABC Corporation’s recordation of its assignment gave constructive notice to XYZ Corporation. MPEP § 306 recites that in the case of a division...application, a prior assignment recorded against the original application is applied to the division...application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. (A) and (B) are true statements and therefore wrong answers. John gave up his ownership rights when he executed the assignment to ABC Corporation. The assignment to ABC Corporation carries with it the transfer of the bundle of rights associated with subject matter common to the original patent

application, e.g., the divisional patent application. (D) and (E) are true statements and therefore wrong answers because XYZ Corporation acquired no rights in the original or divisional patent applications. MPEP § 306.

46. ANSWER: (D) is correct. 37 C.F.R. §1.99(e). (D) is correct because 37 C.F.R. § 1.99(e) provides, “A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier.” Therefore, answer (D) is correct and answers (A), (B), and (C) are incorrect. (E) is wrong because 37 C.F.R. § 1.99(e) recites, “A submission by a member of the public to a pending published application that does not comply with the requirements of this section will be returned or discarded.”

47. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 C.F.R. § 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

48. ANSWER: Choice (E) is the correct answer. MPEP § 804, subpart (II)(B)(1), reads, “Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 138 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis.” Each of choices (A), (B), (C), and (D) is incorrect because it is a factual inquiry set forth in *Graham v. John Deere Co.*

49. ANSWER: Choice (E) is the correct answer. MPEP § 502.01, and 37 C.F.R. § 1.6(d)(3). MPEP § 502.01 reads, “The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d), is the date the complete transmission is received by an Office facsimile unit...An applicant filing a CPA by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card.” Choice (A) is incorrect because 37 C.F.R. § 1.6(d) states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(5) A request for reexamination under §1.510 or § 1.913.” Choice (B) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ...(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72.” Choice (C) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be

accorded a date of receipt in the following situations: ... (3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in 1.8(a)(2)(i)(A)...” 37 C.F.R. § 1.8(a)(2)(i)(A) reads, “The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date...” Choice (D) is incorrect because 37 C.F.R. § 1.6(d) also states, “Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations: ... (6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application.”

50. ANSWER: (A) is correct. MPEP § 1412.03. *In re Doll*, 164 USPQ 218, 220 (CCPA 1970). (B) is wrong because 35 U.S.C. § 251 prescribes a 2-year limit for filing applications for broadening reissues. (C) is wrong because although *Switzer v. Sockman*, 142 USPQ 226 (CCPA 1964), holds that while a reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant, it is necessary that an intent to broaden be indicated in the reissue application within the two years from the patent grant. MPEP § 1412.03. (D) is wrong because a proposal for broadened claims must be made in the parent reissue application within two years from the grant of the original patent MPEP § 1412.03. *In re Graff*, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). (E) is wrong because there was no intent to broaden indicated within the two years. MPEP § 1412.03. *In re Fotland*, 228 USPQ 193 (Fed. Cir. 1985).