

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 17, 2001

Afternoon Model Answers

1. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph and MPEP § 2173.05(c)(III). The claim presented in (B) is improper as “an effective amount” has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture. The claims presented in (A) and (C) find support in the disclosure, which provides guidelines for determining “an effective amount” for each of the claims in (A) and (C). MPEP § 2173.05(c)(III). The claim presented in (D) is not indefinite, given that A, B, and C are known materials as set forth in the question and the composition can be determined by the claim language. (E) is incorrect because (B) is correct.

2. ANSWER: The most correct answer is (A). MPEP § 2137.01 (The Inventor Is Not Required To Reduce The Invention To Practice) citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982). (B) is not correct. MPEP § 2137.01 (An Inventor Must Contribute To The Conception Of The Invention) citing, *Fiers v. Revel*, 25 USPQ2d 1601, 1604 - 05 (Fed. Cir. 1993); and *In re Hardee*, 223 USPQ 1122, 1123 (Dep. Asst. Comm'r Pat. 1984). (C) is not correct. MPEP § 2137.01 (As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others) citing *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); and *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992). (D) and (E) are not correct. 35 U.S.C. § 116; MPEP § 2137.01 (Requirements For Joint Inventorship).

3. ANSWER: (D). Under 37 CFR 1.85(a), correcting the drawings to comply with 37 CFR 1.84(a)(1) and (k), and making them suitable for reproduction is a *bona fide* response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to hold the requirement in abeyance. As stated in 37 CFR 1.85(a) (effective November 29, 2000), “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, “Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule,” 65 F.R. 57024, 57032, “Section 1.85.” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

4. ANSWER: (B). Sydney is precluded from filing for a patent because of Charlie’s recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

5. ANSWER: (E) is the most correct answer. (A) is not the best answer inasmuch as all the items, such as the number of pages of specification and sheets of drawings, are not itemized on the card. (B) and (C) are wrong because they do not provide for a receipt from the USPTO. (B) is also wrong because § 1.8 cannot be used for obtaining an early filing date when filing a new application. (D) will not provide the earliest possible filing date. (A) and (E) will both provide an early information showing a filing date. But (E) is the best answer because it provides the best evidence of the documents received in the USPTO. See MPEP § 503, under the heading “RETURN POSTCARD.” (“A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO. *** The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested.... If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification...number-of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application), etc.”).

6. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 CFR 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 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 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).

7. ANSWER: (D) is the correct answer. MPEP § 608.04(c) (“Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.”); see, also, MPEP § 706.03(o) (“In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.”). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

8. ANSWER: (A) is the most correct answer, while (D) is not the most correct answer. See MPEP § 715.05, which, in pertinent part, states:

When the reference in question is a noncommonly owned U.S. patent claiming the same invention as applicant and its issue date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant’s remedy, if any, must be by way of 37 CFR 1.608 instead of 37

CFR 1.131.... The reference patent can then be overcome only by way of interference.

(B) and (C) are not the most correct answers. See MPEP § 715.05, which, in pertinent part, states:

If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

(E) is a wrong answer because an affidavit or declaration traversing a ground of rejection may be received only where the reference “substantially shows or describes but does not claim the same patentable invention.” 37 CFR 1.132.

9. ANSWER: The most correct response is (D). Bill’s thesis constitutes a printed publication as of January 29, 2001. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986). Since (B) and (C) are both correct statements, the most correct response is (D). The provisions of § 102(b) apply equally with regard to publications written in non-English languages.

10. ANSWER: (B) is correct and (A), (C) and (D) are wrong. 37 CFR 1.27(c)(4) (“The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.”). (E) is also wrong. 37 CFR 1.27(e)(1) (“Where an assignment of rights...to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.”)

11. ANSWER: (A) is the most correct answer. 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 (B) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 CFR 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (C) 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 (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 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 (E) 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.

12. ANSWER: (D). 35 U.S.C. § 251. As to (A) and (D), 37 CFR 3.73(b)(2) requires the consent of all assignees or remaining inventors before any national (which includes reissue) application can be filed. Mike cannot alone file a reissue application. As to (E), under 35 U.S.C. § 253 the owner of a sectional interest in the patent may file a disclaimer, but disclaiming the claims of Mary would not void the assignment to Bird's Beak. As to (B) and (C), 35 U.S.C. § 262 provides that for joint ownership, each inventor owns an undivided interest in the whole and 35 U.S.C. § 261 provides for assignment of the inventor's interest.

13. ANSWER: The most correct answer is (D). MPEP § 2107(I), "Real World Value Requirement." The USPTO regards assertions falling within this category as sufficient to identify a specific utility for the invention. (A) is not correct. An invention that is not a machine, an article of manufacture, a composition, or a process cannot be patented. 35 U.S.C. § 101; MPEP § 2107; see *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); and *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). (B) and (C) are incorrect. The USPTO regards assertions in choices (B) and (C) as insufficient to define a specific utility for the invention, especially if the assertion takes the form of a general statement that makes it clear that a "useful" invention may arise from what has been disclosed by the applicant. *Knapp v. Anderson*, 477 F.2d 588, 177 USPQ 688 (CCPA 1973). (E) is incorrect. 35 U.S.C. §§ 101, and 112; and see *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

14. ANSWER: The most correct answer is (E). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Thomas' application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term adjustment, but is not a complete forfeiture of any adjustment. 37 CFR 1.704(b). Answer (C) is incorrect because the three year period set forth in 37 CFR 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences that was not favorable to applicant. 35 U.S.C. § 154(b)(1)(c). Answer (D) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. Thus, the reduction in any patent term adjustment due to the missing parts notice would be approximately two (2) months. See, 37 CFR 1.704(a) and "37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule," Federal Register Vol. 65, No. 181 at 56366 and 56370-71; MPEP § 2730 (pg. 2700-8 through 2700-9) (8th Ed.). Answer (E) is correct because each of the preceding statements is incorrect.

15. ANSWER: The most correct answer is (C). In this case, an appeal brief was due two months after the filing of the Notice of Appeal. 37 CFR 1.192. Thomas' Notice of Appeal was filed October 21, 2002 and the Appeal Brief was initially due December 21, 2002 (effectively Monday, December 23). This non-statutory time period could be extended under 37 CFR 1.136(a). Since Thomas filed the Appeal Brief on April 18, 2003, a four-month extension of time was required. Answers (A) and (B) are incorrect because they would insufficiently extend the time to February 18th and March 18th, respectively. Answer (D) is incorrect because the two-month period for filing the appeal brief is measured from the time that Thomas filed the Notice

of Appeal and the six-month statutory time period does not apply. Answer (E) is incorrect at least because the premise that the Appeal Brief was filed more than six months after the Notice of Appeal was filed is factually incorrect.

16. ANSWER: The most correct answer is (D). Nonpublication of the application does not affect the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Thus, statement (C) is true. The patent term adjustment provisions of 37 CFR 1.702 *et seq.* are separate and independent of the eighteen-month publication provisions. There is no support for statement (B). An applicant may rescind a nonpublication request at any time. 37 CFR 1.213(b), and see “37 CFR Parts 1 and 5 – Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule,” Federal Register Vol. 65, No. 183 (9/20/2000) at 57024. Thus, statement (A) is also true. Accordingly, the best answer is (D).

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

18. ANSWER: (C) is the most correct answer. MPEP § 608.01(n). (A) is incorrect because a dependent claim must further limit the subject matter of a previous claim. 37 CFR 1.75(c). The claim in (B) is actually inconsistent with claim 1. (B) 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 (C) is correct.

19. ANSWER: (A) is true, and thus the most correct answer. As stated in MPEP § 2129, and see *In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532,535-36 (CCPA 1982). (B) is not true, and thus not correct. MPEP § 2129, and see *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). (C) is not true, and thus not correct because the admitted foundational discovery is a statutory bar. See the reasons discussed for answer (B). (D) is not true, and is thus incorrect. MPEP § 2129, and see *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975) (figures in the application labeled “prior art” held to be an admission that what was pictured was prior art relative to applicant’s invention.). (E) is not true. MPEP § 2129; and see *In re Ehrreich*, 590 F.2d 902, 909 – 910, 200 USPQ 504, 510 (CCPA 1979); *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984).

20. ANSWER: The best answer is (E). (A) is incorrect since facts within the knowledge of the examiner may be used whether or not the examiner qualifies as an expert. 37 CFR 1.104(c)(3). (B) is incorrect since the waiver is only effective against those named in the statutory registration. (C) is incorrect since on sale activities is not proper subject matter for reexamination, and inequitable conduct cannot be resolved or absolved by reexamination. (D) is not correct since a statutory bar cannot be overcome by acquiring the patent.

21. ANSWER: (E) is the correct answer. (A) is supported by 37 CFR 1.102. MPEP § 708.02(V). (B) is supported by 37 CFR 1.102. MPEP § 708.02(VIII). (C) is supported by 37 CFR 1.102. MPEP § 708.02(III). (D) is supported by 37 CFR 1.102. MPEP § 708.02(IV).

22. ANSWER: (A) 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”; MPEP § 2163, paragraph I. A. (pg. 2100-156) (8th Ed.). (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; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (C) 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; MPEP § 2163, paragraph I. (pg. 2100-155) (8th Ed.). (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”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.). (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”; MPEP § 2163, paragraph I. B. (pg. 2100-157) (8th Ed.).

23. ANSWER: The most correct answer is (B). MPEP § 713.05. Statements (A) and (C) are incorrect because Greene may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (D) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. *Id.* (E) is therefore also incorrect.

24. ANSWER: (E). 37 CFR 1.291(c). In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. (A) contains portions of the elements of 37 CFR 1.291(a) & (b). (B) contains portions of the elements of 37 CFR 1.291(a). (C) contains portions of the elements of 37 CFR 1.291(a) & (b). (D) contains portions of the elements of 37 CFR 1.291(a) & (b).

25. ANSWER: (E) is the correct answer. 37 CFR 1.114, effective date August 16, 2000, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097; MPEP § 706.07(h) (8th Ed.). (A) and (B) are each incorrect because if prosecution in an application is closed, an applicant may request continued examination “prior to the earliest of: (1) Payment of the issue fee, unless a petition under 37 CFR 1.313 is granted; (2) Abandonment of the application; or ...” 37 CFR 1.114(a). (C) is incorrect because prosecution is not closed. 37 CFR 1.114(b). (D) is incorrect because the application is abandoned for failure to pay the issue fee. 37 CFR 1.316.

26. ANSWER: (B) is the correct answer. 37 CFR 1.8, and 1.114, effective date August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 FR 50092, 50096; MPEP § 706.07(h), paragraph I. (pg. 700-69) (8th Ed.). Prosecution in the application is closed because the last Office action is a final action. 37 CFR 1.114(b). In (B), the facts given indicate that the submission meets the reply requirements of 37 CFR 1.111. Thus, according to 37 CFR 1.114(d), the Office will withdraw the finality of the Office action and the submission in (B) will be entered and considered. 65 FR 50096, columns 2-3, state, "There are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA procedure set forth in §1.53(d) resulting from the fact that a CPA is the filing of a new application, whereas continued examination under §1.114 merely continues the examination of the same application...(4) a request for continued examination under §1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A))...."; see also the comparison chart on pg. 700-78 to 700-81 of MPEP § 707.07(h) (8th Ed.). (A) is incorrect inasmuch as a continued prosecution application is not entitled to the benefit of a certificate of mailing under 37 CFR 1.8. 37 CFR 1.8(a)(2)(i)(A). Contrary to the desire to avoid abandonment of the application, filing an application filed under 37 CFR 1.53(d) would result in abandonment of the application inasmuch as the filing is a request to expressly abandon the prior application. 37 CFR 1.53(d)(2)(v). (C) is incorrect because the telephone call does not meet the reply requirements of 37 CFR 1.111. No reply under 37 CFR 1.114(d) to the Office action has been filed. All business must be conducted in writing. 37 CFR 1.2. (D) is incorrect because the reply does not reply to the rejection of claim 1 and therefore does not meet the reply requirements of 37 CFR 1.111 and is not a proper submission pursuant to 37 CFR 1.114(d). In (A), (C), and (D), the date of abandonment is August 15, 2001, i.e., after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. MPEP §711.04(a). (E) is incorrect because (A), (C), and (D) are incorrect.

27. ANSWER: (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

28. ANSWER: The most correct answer is (B). 35 U.S.C. §102(d); MPEP §2135.01, (A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents). If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP

application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re van Langenhoven*, 173 USPQ 426, 429 (CCPA 1972); *Ex parte Appeal No. 242 - 47*, 196 USPQ 828 (Bd. App. 1976). (A) is incorrect. 35 U.S.C. § 102(d). (C) is not correct. 35 U.S.C. § 102(d); MPEP § 2135.01, (An Allowed Application Can Be A 'Patent' For Purposes Of 35 U.S.C. 102(d) As Of The Date Published For Opposition Even Though It Has Not Yet Been Granted As A Patent), citing *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968). An application must issue into a patent before it can be applied in a 35 U.S.C. 102(d) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977). (D) is not correct. 35 U.S.C. § 102(d); MPEP § 2136 (Defensive Publications Are Not Prior Art As Of Their Filing Date) citing *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973). (E) is not correct inasmuch as (A), (C) and (D) are not correct.

29. ANSWER: (B) is the most correct answer. 37 CFR 1.16(a) and 1.17(e). The fee to request continued examination of an application is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. The fee for filing each application for an original patent, except provisional, design, or plant applications is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. See "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000); MPEP § 706.07(h) (8th Ed.). (A) is not the most correct answer. 37 CFR 1.8(a)(2) provides, in pertinent part, "The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following: (i) Relative to Patents and Patent Applications – (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d)." (C) is not the most correct answer. 37 CFR 1.21(m). (D) is not the most correct answer. 37 CFR 1.53(c)(3) requires the petition to convert be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. (E) is not the most correct answer. Under 37 CFR 1.53, a nonprovisional application based on conversion of a provisional application must include the filing fee for a nonprovisional application. The conversion request must be accompanied by the fee set forth in 37 CFR 1.17(i). In addition, the surcharge required by 37 CFR 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 CFR 1.53(c)(3), second sentence.

30. ANSWER: (A) is correct and (B), (C), (D), and (E) are wrong. 37 CFR 1.28(c)(2)(i) ("The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment...Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error.") The current basic fee of \$710 for other than a small entity less than the previously paid small entity basic fee of \$345 results in a deficiency of \$365. There was no error in the previously paid IDS fee since \$240 was the proper amount at the time of payment for

either a small entity or other than a small entity. Therefore, the IDS fee did not enter into the deficiency calculation.

31. ANSWER: (E) is correct because the statement is supported by 37 CFR 1.304(a)(1). (A), (B), (C), and (D) are wrong because 37 CFR 1.304(a)(1) and MPEP § 1216 indicate that the time period for appeal is 2 months from the BPAI decision or from action on the request, and 37 CFR 1.304(a)(2) provides that the 2 month time period is not subject to the provisions of 37 CFR 1.136.

32. ANSWER: (E). As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 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. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

34. ANSWER: (D) is the correct answer because it is a dependent claim which fails to further limit the subject matter of claim 1, as it seeks to remove the limitation that the parabolic reflector is metallic. MPEP § 608.01(n)(II) and 37 CFR 1.75(c). (A), (B), (C), and (E) are incorrect because each of these claims further limits claim 1 and therefore do not support on objection under § 1.75(c).

35. ANSWER: (C). 37 CFR 1.99(c) requires service on the applicant and provides “[t]he submission under this section must be served upon the applicant in accordance with § 1.248.” (A) contains all of the elements of 37 CFR 1.99(a). (B) contains all of the elements of 37 CFR 1.99(b). (D) contains all of the elements of 37 CFR 1.99(d). (E) contains all of the elements of 37 CFR 1.99(e).

36. 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).

37. ANSWER: (C) is the most correct answer. 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). (B) 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).” (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 § 2165.02, “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).

38. ANSWER: The most correct answer is (B). 35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client’s application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is “by others,” Able, Baker, and McGeiver. The reference is prior art “by others.” See MPEP § 2132 (‘Others’ Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A “secret” use by another inventor of a machine to make a product is “public” if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

39. ANSWER: (D) is the correct answer. 35 U.S.C. § 41(h)(1); 37 CFR 1.17(e) and § 1.114, and MPEP § 509.02. (A) is incorrect because there is no support for (A) in 37 CFR 1.102. (B) is incorrect because there is no support for (B) in 37 CFR 1.8. (C) is incorrect because it is inconsistent with 35 U.S.C. § 42(d); 37 CFR 1.26. *Miessner v. United States*, 228 F.2d 643, 644 (D.C. Cir. 1955). (E) is incorrect because (D) is correct.

40. ANSWER: (B) is the most correct answer. As stated in “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000), “Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. § 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999); MPEP § 201.04(b) (pg. 200-16) (8th Ed.). However, the pendency is counted against the patent term. 37 CFR 1.53(c)(3), fourth sentence. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 1.53(c)(3), third sentence. See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000); MPEP § 201.04(b) (pg. 200-16) (8th Ed.). (C) is not the most correct answer. 37 CFR 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 CFR 1.53(c)(3). (E) is a correct statement, and therefore is not a correct answer. 35 U.S.C. § 119(e)(3).

41. ANSWER: (C) is the correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

42. ANSWER: (C) is the correct answer. 37 CFR 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000); MPEP § 2515 (pg. 2500-5) (8th Ed.). Under 37 CFR 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 CFR 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect. (D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (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”). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific

examples falling within the claimed, a case by case determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

44. ANSWER: The most correct answer is (A). 35 U.S.C. § 102(c); MPEP § 2134, and see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 149 USPQ 420, 435 - 436 (E.D. N.C. 1966). (B) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991). (C) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977). (D) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Petersen v. Fee Int'l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974). (E) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

45. ANSWER: The most correct answer is (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. 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).

46. ANSWER: (E) is the correct answer. MPEP § 715. (A) is incorrect because an affidavit under 37 CFR 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 CFR 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 CFR 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.

47. 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).

48. ANSWER: (C). Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. *See, e.g.,* 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

49. ANSWER: (E) is correct because 37 CFR 1.362(h) states that the periods specified for payment of the maintenance fees “are counted from the date of grant of the original non-reissue application on which the reissued patent is based.” The facts are that the original non-reissue application was granted and the reissue patent was granted exactly two years later. A year from the date of grant of the reissue would calculate to be 3 years from the date of the grant of a patent on the original non-reissue application. 37 CFR 1.362(d)(1) indicates that a maintenance fee may be paid in patents without surcharge if paid during the period “3 years through 3 years and 6 months after grant for the first maintenance fee.” (A), (B), and (C) are wrong because 37 CFR 1.362(b) states, in pertinent part, “Maintenance fees are not required for any plant patents or for any design patents.” (D) is wrong because payment of the maintenance fee without surcharge for the 2nd maintenance fee must be made during the period “7 years through 7 years and 6 months after grant of the nonprovisional utility patent.”

50. ANSWER: The most correct response is (A). 35 U.S.C. § 102(g); *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (D) were correct, there would be no need for interference proceedings. Statement (B) is incorrect because Debbie need not establish diligence for the period from February 2000 until just before Billie’s conception on May 15, 2000. Statement (C) is incorrect because, so long as there has not been an abandonment, suppression or concealment of the invention, Debbie need not show diligence between the actual reduction to practice and the patent filing. Statement (E) is inconsistent with 35 U.S.C. § 102(g).