

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
November 3, 1999**

Afternoon Session Model Answers

1. ANSWER: (A). MPEP § 2173.05(b). The term “substantially” has been held as definite, given sufficient guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). (B) is incorrect because the narrow range within the broad range using the term “preferably” will likely render the claim indefinite. MPEP § 2173.05(c). (C) - (E) are incorrect because each is narrower in scope than (A).

2. ANSWER: (D). 35 U.S.C. § 251; 37 CFR §§ 1.111; 1.173; 1.176; and MPEP §§ 706.03(o), 1411.02, and 1440. (A) is wrong because the statute pertains to a patent wherein the “patentee [is] claiming...less than he had a right to claim,” as opposed to a patentee being entitled to enlarge the scope of the content of the patent. (35 U.S.C. § 251). (B) and (C) are wrong because the amendment will be entered even if it contains new matter, inasmuch as the reissue application is examined in the same manner as the original application and the amendment, being a reply to a non-final first office action, is entitled to be entered. (37 CFR §§ 1.111 and 1.176, and MPEP 1440). (C) is also wrong because no petition and fee are needed. (E) is wrong because the 3.0 to 4.5 ohm range is outside the scope of the broadest range of resistance disclosed in the patent.

3. ANSWER: (D). It would not be proper to make final a first Office action in a continuing application where that application contains material that was presented in the earlier application after final rejection, and the material was denied entry because new issues were raised that required further consideration and/or search. MPEP § 706.07(b). Since the Amendment After Final Rejection was denied entry, a first Action final rejection in the CPA is improper. (A) is incorrect because it is based on the false premise. The determination that the amendment presented new issues requiring further consideration or search did not state that Claims 1-10 that the revisions failed to place Claims 1-10 in condition for allowance. In any event, proper PTO practice and procedure does not prevent the Examiner from reconsidering such a determination, even if it had been made, and allowing the claims. (B) is incorrect because proper PTO practice and procedure does not prevent the Examiner from determining in the CPA application that the revisions do not overcome the rejection of claims 11-20 made in the parent application. There is no requirement that the Examiner reject Claims 11-20 on grounds that differ from the grounds that these claims were rejected in the parent application due to the determination in the parent application that the Amendment After Final Rejection presented new issues. (C) is incorrect because the applicant may request that the amendment after final be entered in the CPA before issuance of an Office action. See 37 CFR § 1.53(d)(3)(ii); MPEP § 201.06(d), “FILING FEE.” (E) is incorrect because (B) is incorrect.

4. ANSWER: (A). MPEP § 714.13, and 1207.

5. ANSWER: (E). (A) and (B) are incorrect because a broadened claim can be presented within two years from the grant of the original patent in a reissue application. MPEP § 1412.03. (C) is incorrect because it would involve an attempt to recapture claimed subject matter deliberately canceled in a patent application. MPEP § 1412.02. (D) is incorrect because it improperly relies on new matter. The given facts state that “all leg members must be parallel.”

Although the specification of the nonprovisional application was later amended to state that the leg member could be substantially parallel, this is new matter, even in the absence of an objection to entry of new matter in the nonprovisional application. There was no support in the original disclosure for “substantially parallel,” where the specification requires the legs “must be parallel.” Therefore, amending the claim in the reissue application to replace “parallel” with “substantially parallel” is not likely to be allowed. MPEP § 1411.02.

6. ANSWER: (D). The claim (A) recites sufficient acts performed on subject matter, e.g. passing the signal through the filter. See MPEP § 2173.05(q) and *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) cited therein. Therefore, (A) appropriately claims a process. (B) recites the act of polymerizing an organic compound. Therefore, (B) appropriately claims a process. The claim in (C) is not a proper process claim because it does not recite an act specifying how a use or process is accomplished. Therefore, this claim would be rejected as indefinite under 35 U.S.C. § 112 or as an improper definition of a process under 35 U.S.C. § 101. See MPEP § 2173.05(q); *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (claim to “A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon” was held indefinite because it merely recited a use without any active, positive steps delimiting how this use is actually practiced); *Clinical Products Ltd. v. Brenner*, 255 F.Supp. 131, 149 USPQ475 (D.D.C. 1966) (claim to “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid” is not a proper process claim under 35 U.S.C. § 101). (E) is incorrect because (C) is incorrect.

7. ANSWER: (D). 37 CFR §§ 1.97; 1.98; 1.607(c); and 10.23(c)(7). (A), (B) and (C) are not correct because they do not identify the number of the patent claim that has been copied. (E) is not the most proper course of action to take. The IDS does not identify the QED patent from which the claim was copied. Arguing that Claim 6 of the QED patent is an obvious improvement to the instant invention would not be considered relevant. 37 CFR § 1.98(a)(3).

8. ANSWER: (A) is the most correct answer. 37 CFR § 1.131; and MPEP § 715.03. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974). (B) and (C) are incorrect. To overcome a reference indirectly, as in (B) and (C), a showing of prior completion of a different species should be coupled with a showing that the claimed species would have been an obvious modification of the species completed by applicant. *In re Spiller, supra*; *In re Clark*, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966), MPEP § 715.03. (D) is incorrect because the declaration cannot be used to antedate a statutory bar, and the reference is a statutory bar under 35 U.S.C. § 102(b) inasmuch as it issued more than one year before the Jones application was filed. 37 CFR § 1.131. (E) is incorrect because the declaration is ineffective to overcome a U.S. patent where there is no patentable distinction between the claims of the application and of the patent. *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); MPEP §§ 715.05 and 2308.01.

9. ANSWER: (D). MPEP § 713.05.

10. ANSWER: (B). *Ex parte Markush*, 1925 CD 126 (Comm’r Pat. 1925) sanctions claiming a genus as a group “consisting of” elements connected by “and.” MPEP § 2173.05(h), item I., Markush Groups. (A) is not the most correct answer inasmuch as the elements are improperly

connected by “or.” (C) and (D) are not the most correct answers. It is improper to use the word “comprising” instead of “consisting of.” *Ex parte Dotter*, 12 USPQ 283 (Bd. App. 1931); MPEP § 2173.05(h).

11. ANSWER: (E). 37 CFR § 1.8(a); and MPEP § 512. (A) is incorrect because the response would not be timely, even if the August 6th date is given to the response. The six month statutory period for response is measured from the date of the Office action, not the date the action was received. The response was mailed beyond the six month statutory period for response. (B) is incorrect because the U.S. Postal Service certificate of mailing does not comply with 37 CFR § 1.8(a). (C) is incorrect. The date of the certificate of mailing is after the statutory six month period for response. Therefore the response is not shown by the certificate to be timely mailed. (D) is incorrect because (A) and (C) are incorrect. (E) is correct because (A), (B), (C) and (C) are not correct.

12. ANSWER: (B). MPEP § 2173.05(b). (A) is incorrect because the claim interpretation of one possessing ordinary skill level is relevant. MPEP § 2173.02. (C) is incorrect because the guidelines in the specification may be sufficient. MPEP § 2173.05(b). (D) is incorrect since it relies on the improper addition of new matter. (E) is incorrect since (B) is correct.

13. ANSWER: (B). MPEP §§ 710.04, and 710.04(a).

14. ANSWER: (D). Claim 1 provides antecedent basis for Claim 2 of answer (D). 35 U.S.C. § 112, second paragraph. (A) is incorrect. Claim 1, which is drawn to a “modular telephone plug crimping tool,” provides no antecedent basis for “[t]he modular telephone” required by Claim 2. MPEP § 2173.05(e). (B) is incorrect because it fails to incorporate all the limitations of the claim to which it refers. Claim 1, requiring the secondary body part have a fixed length, provides not antecedent basis for the limitation of claim 2, that the second party part have an adjustable length. 35 U.S.C. § 112, fourth paragraph. (C) is incorrect because it improperly recites a process without setting forth any steps in the process. MPEP § 2173.05(q). (E) is incorrect because (D) is correct.

15. ANSWER: (E). 37 CFR §§ 1.131, and 1.132; and MPEP §§ 706.02(b), 715, and 716.

16. ANSWER: (E). Both (B) and (C) are proper dependent claims and are supported by the specification. 37 CFR § 1.75. (A) is incorrect. The use of the phrase “at least” has no upper limit and could include temperatures greater than that set forth in the specification, i.e. “when exposed to a temperature of from about 10°C. to 15°C.” MPEP § 2163.05. (D) is incorrect. MPEP § 2111.03 provides that “A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” As such, (D) seeks to add primary and secondary amines in violation of this caveat.

17. ANSWER: (C). The amendment points out two words occurring in line 6 that are to be deleted, and two words that are to be inserted in place of the deleted words. 37 CFR § 1.121(a)(2)(i). (A) is incorrect because “dihydric” appears on line 4 and not line 3. (B) is incorrect because “alcohols” does not occur in line 4 of claim 1. (D) is incorrect because “cooling” appears on line 9 and not line 8. (E) is not correct because (B) is incorrect.

18. ANSWER: (C). The scope of Claim 1 is enlarged, or broadened by the deletion of “from the local pool subset” from the claim. As presented in (C), the reissue application is filed less than two years after the original patent was granted and the application seeks to enlarge the scope of Claim 1. As such, a reissue application may be properly granted containing the claim. 35 U.S.C. § 251. (A) and (B) are incorrect. The scope of Claim 1 is enlarged by the proposed amendment. Claims cannot be enlarged or broadened in a reexamination application regardless of when the application is filed. 35 U.S.C. § 305; 37 CFR § 1.552(b). (D) and (E) are also incorrect given that the scope of Claim 1 is broadened by the proposed amendment. As such, the reissue application cannot be filed more than two years from the grant of the original patent. 35 U.S.C. § 251.

19. ANSWER: (B). In *Racing Strollers Inc. v. TRI Industries Inc.*, 11 USPQ2d 1300 (Fed. Cir. 1989) the in banc Federal Circuit stated that for design patents “the ‘best mode’ requirement of the first paragraph of §112 is not applicable, as a design has only one ‘mode’ and it can be described only by illustrations showing what it looks like (though some added description in words may be useful to explain the illustrations).” 35 U.S.C. § 171 indicates that the provisions of the Patent Act relating to utility inventions apply to designs “except as otherwise provided.” MPEP § 1504.04. The Patent Act, the Rules of Practice in Patent Cases, and the pertinent case law do not exempt designs from the written description, definiteness and independent claim requirements of 35 U.S.C. § 112. Accordingly, inasmuch as (B) is correct, (E) is incorrect. (A), (C), and (D) are incorrect because the written description, definiteness and independent claim requirements of 35 U.S.C. § 112 apply to design applications.

20. ANSWER: (D). MPEP § 402.10.

21. ANSWER: (A). 37 CFR § 1.11; and MPEP §§ 103, and 201.09.

22. ANSWER: (E). The transitional phrase “consisting of” in Claim 1, excludes any element not specified in the claims. MPEP § 2111.03. When the phrase “consisting of” appears in a clause of the body of a claim, rather than immediately following the preamble, it limits the elements set forth only in that clause, but other elements are not excluded from other clauses in the claim as a whole. *Id.* Here, the phrase “consisting of” in the base claim limits the output device to a video monitor. Thus, in Claim 4 the recitation of “a printer” as an output device is improper. Moreover, the recitation of the same limitation found in Claim 1, *i.e.*, “a video monitor,” does not further limit the base claim. 35 U.S.C. § 112, paragraph 5, 37 CFR § 1.75(c). Claim 5, depends on improper Claim 4, and they are improper. A claim, which depends from an improper base claim, is itself improper. MPEP § 608.01(n). Answer (A) is incorrect because Claim 2 properly refers to a prior claim, Claim 1, it includes all the limitations of Claim 1, and it further limits claim 1. 35 U.S.C. § 112, paragraph 4, 37 CFR § 1.75(c). Answer (B) is incorrect because Claim 3 properly refers to, in the alternative, prior claims (claim 1 or claim 2), it includes all the limitations of Claim 1 or Claim 2, and it further limits Claim 1 or Claim 2. 35 U.S.C. § 112, paragraph 5, 37 CFR § 1.75(c). As discussed above, Claim 2 is a proper dependent claim. Answer (C) is incorrect because, as discussed above, Claim 3 is a proper dependent claim. Answer (D) is incorrect because, as discussed above, Claim 4 is also an improper dependent claim. Thus, the most correct answer is Answer (E).

23. ANSWER: (E) is the most correct answer. MPEP § 2173.05(b), “Reference To An Object That Is Variable May Render A Claim Indefinite,” items B, C, and F. Each expression has been found to require support in the specification disclosing a standard for ascertaining what the inventor meant.

24. ANSWER: (A). 37 CFR § 1.75, and MPEP § 2173.05(b). The limitation, “the outer surface of said case” does not lack antecedent basis since it is an inherent part of the case. (B) is incorrect because claim 1 recites two different memory chips and the recitation of “said memory chip” therefore renders the claim indefinite. MPEP § 2173.05(e). (C) is incorrect because claim 5 does not further limit claim 1. (D) and (E) are incorrect because (A) is correct.

25. ANSWER: (C). 37 CFR §§ 1.10(a), and 1.53(b). “The filing date of an application for patent filed under this section, is the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office.”

26. ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad “comprising” language permits the laminate to have additional layers, such as an intermediate adhesive layer. MPEP § 2111.03. (B) overcomes a § 102 rejection on the basis of the prior art by reciting that the transparent protective layer and the light-sensitive layer are in actual contact therewith, eliminating the possibility of an intermediate adhesive layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that X does not claim any laminate including an adhesive layer. MPEP § 2173.05(i).

27. ANSWER: (B). 37 CFR § 1.172.

28. ANSWER: (D). 37 CFR § 1.52(c), and MPEP § 605.04(a).

29. ANSWER: (A). 35 U.S.C. §112, paragraph 2; and MPEP §§ 2173.05(a), and 706.03(d). A patentee can be his own lexicographer and may use a term in a manner contrary to or inconsistent with one or more of the term’s ordinary meanings. However, a term may not be given a meaning repugnant to its usual meaning. MPEP § 2173.05 (third italicized subject). Here, the use of “fluid” to mean “solid” is repugnant to its ordinary meaning. Also, when there is more than one definition for a term, it is incumbent on the applicant to make clear which definition is relied upon. Until the meaning of the claim is clear, a rejection under the second paragraph of 35 U.S.C. § 112 is appropriate. Here, “fluid” is inconsistently defined. In the specification, it must be “above 2° C.” in the specification, whereas it is “0° to 10° C. in the claim. *See also* MPEP § 2106 (in context of computer related inventions). If an applicant asserts that a term has a meaning that conflicts with its art-accepted meaning, the applicant should be encouraged to amend the claim to better reflect what is intended to be claimed as the invention. MPEP § 2106. (B) is incorrect because the Greene research results were published after Billie’s filing date and the research occurred in Great Britain. Thus, this research does not constitute prior art under 35 U.S.C. § 102(a). (C) is incorrect because it confuses the concept of enablement with definiteness. (D) is incorrect because whether the composition that results from the claimed process occurs naturally is immaterial to whether a method for forming that

composition is statutory subject matter. (E) is incorrect because an applicant need not understand how an invention works or recite the theory in a claim.

30. ANSWER: (D). 35 U.S.C. § 4; and MPEP § 309.

31. ANSWER: (C). August 3, 1998, was the date on which the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) were completed. PCT Articles 11 and 20; PCT Rule 47.1(c); and 35 U.S.C. § 102(e) which states that a person shall be entitled to a patent *unless* “the invention was described in a patent granted on...an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent.”

32. ANSWER: (B). 37 CFR §§ 1.291, and 1.501; MPEP §§ 2202, and 2203.

33. ANSWER: (D). 37 CFR § 1.321(c); and MPEP § 804.02. (A) is incorrect because provisional rejections between copending applications based on the judicially created doctrine of double patenting are provided for in MPEP § 804, item 1B. (B) is incorrect because the rejection is still applicable even though the continuation application gets the filing date of the first application. MPEP § 804.02. (C) is incorrect because the rejection is proper. Applicant voluntarily filed a second application without a restriction requirement by the Examiner. *In re Schneller*, 158 USPQ 210 (CCPA 1968) and MPEP § 804. (E) is incorrect because it omits the provision concerning common ownership. 37 CFR § 1.321(c).

34. ANSWER: (E). (A) is incorrect because the composition naturally occurring. MPEP 2106. (B) is incorrect because patentability of a product claimed by a product-by process claim is based on the product itself. MPEP § 2106. Since the product is naturally occurring, the claim provides the basis for a proper rejection under 35 U.S.C. § 101. (C) is incorrect because it drawn to more than one statutory class of invention, i.e., 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. The claim is properly rejectable under 35 U.S.C. § 112, second paragraph. MPEP § 2173.05(p). (D) is incorrect because mathematical equations alone are not patentable subject matter. MPEP § 2106. (E) is correct because (A) - (D) are incorrect.

35. ANSWER: (D). MPEP § 608.01(l). (A) is incorrect because the original numbering of the claims must be preserved throughout the prosecution. 37 CFR § 1.126. (B) is incorrect and nonsensical. (C) is incorrect because a multiple dependent claim will always be considered to be the total number of claims (dependant and independent) to which direct reference is made therein. 37 CFR § 1.75(c). (E) is incorrect because (D) is correct.

36. ANSWER: (D). Claim 1 is a “single means claim” which is not subject to the interpretive rules of §112, paragraph 6 (which applies only to claims for combinations). Answers (A), (B) and (E) are incorrect for at least that reason. According to *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983), the proper basis for rejecting a single means claim is the first paragraph of §112 (enablement) rather than the second paragraph (definiteness). *See also* MPEP § 2181. Therefore, answer (C) is not the correct answer

37. ANSWER (D). Claim 3 is improper because does not further limit the claim from which it depends, in violation of 35 U.S.C. § 112, paragraph 4 and 37 CFR §1.75(c). (A) is wrong because the Barry patent anticipates only claims 1, 3 and 4. (B) is wrong at least because Claim 1 is an original claim and an original claim provides its own written description. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). (C) is wrong because claim 2 is a proper dependent claim that further restricts the scope of claim 1 by narrowing the resistance value range. Similarly, (E) is incorrect because claim 4 specifies that the DC current source produces variable current, a limitation not in claim 1, and therefore properly narrows the scope of that claim.

38. ANSWER: (B). 35 U.S.C. §§ 101 and 112, second paragraph; and MPEP § 2173.05(q). The claim in (B) recites two positive steps of using paint. The first step is applying the paint to a surface. The second step is removing the excess paint. (A), (C) and (D) are not proper process claims because they do not recite a positive step specifying how the use is accomplished. For example, (A) does not set forth the step(s) by which the antibodies isolate interferon.

39. ANSWER: All answers accepted.

40. ANSWER: (C). 35 U.S.C. § 102; and MPEP §§ 2133.03(e)(4), and 2133.03(e)(6).

41. ANSWER: (C). (C) is correct because it fails to comply with 37 CFR § 1.75(c), which states: “One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” In the present case, Claim 2 refers back to Claim 1, but fails to properly limit the capacitance recited in Claim 1 because it recites the term “about” immediately before the capacitance range. The term “about” allows for a range slightly above 0.011 μf or below 0.003 μf . A range below 0.003 is outside the scope of Claim 1. See MPEP 2144.05. Therefore, the claim in (C) does not properly limit Claim 1. (A), (B), and (D) are wrong because they are proper dependent claims. They further limit Claim 1 by limiting the capacitance to values within the scope of Claim 1, and therefore, comply with 37 CFR § 1.75(c). In (D), the applicant may rely upon the original claim for the description of the range of capacitance. MPEP § 608.01(l). (E) is wrong because (D) is a proper dependent claim.

42. ANSWER: (C). 37 CFR § 1.75(c); and MPEP 608.01(n).

43. ANSWER: (C). 35 U.S.C. § 102(b); and MPEP § 2133.03(b), item D, states “An assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b). The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).” (A) is incorrect. MPEP § 2133.03(b), item I (A), states, “An invention may be deemed to be ‘on sale’ even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).” (B) is incorrect. MPEP § 2133.03(b), item I (B), states, “A ‘sale’ need not be for profit to bar a patent. If the sale was for the commercial exploitation of the invention, it is ‘on sale’ within the meaning of 35 U.S.C. 102(b). *In re Dybel*, 187 USPQ 593, 599 (CCPA 1975)

(‘Although selling the devices for a profit would have demonstrated the purpose of commercial exploitation, the fact that appellant realized no profit from the sales does not demonstrate the contrary.’)” (D) is incorrect. MPEP § 2133.03, item IIB, states, “It is not necessary that a sale be consummated for the bar to operate. *Buildex v. Kason Indus.*, 849 F.2d 1461, 1463-64, 7 USPQ2d 1325, 1327-28 (Fed. Cir. 1988) (citations omitted).” (E) is incorrect. MPEP § 2133.03, item II (A), states, “Since the statute creates a bar when an invention is placed ‘on sale,’ a mere offer to sell is sufficient commercial activity to bar a patent. *In re Theis*, 610 F.2d 786, 791, 204 USPQ 188, 192 (CCPA 1979)... In fact, the offer need not even be actually received by a prospective purchaser. *Wende v. Horine*, 225 F. 501 (7th Cir. 1915).”

44. ANSWER: (D). “Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the application or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.” 35 U.S.C. § 122. However, when the applications share a common assignee, an examiner may provisionally reject claims, under 35 U.S.C. § 102(e)/103, in the later filed application, when appropriate. MPEP § 706.02(k). Here, G’s application and H’s application share a common assignee. Answers (A) and (E) are incorrect because a provisional rejection, under 35 U.S.C. § 102(e)/103, in any of these circumstances would not maintain the confidence of G’s application or H’s application. 35 U.S.C. § 122. Thus, in neither of the circumstances presented in these answers will you most likely need to overcome the rejection. Answer (B) is incorrect. Inasmuch as there is no common assignee, the confidential status of applications under 35 U.S.C. § 122 must be maintained, and no rejection can be made using or relying on the earlier filed application as prior art. MPEP 706.02(g), item II. Answer (C) is incorrect because a provisional rejection under 35 U.S.C. § 102(e)/103, cannot be properly made when the applications have the same filing date. A provisional double patenting rejection may be proper. Answer (E) is incorrect because the examiner may not properly reject claims in an earlier filed application over the claim of a later filed application. 35 U.S.C. § 102(e)/103; MPEP § 706.02.

45. ANSWER: (E). 35 U.S.C. § 112, first and second paragraphs. Interconnection of the elements as described in the written description provided by the inventor and as disclosed in the drawings is no longer required.

46. ANSWER: (A). An applicant in a patent application filed on or before June 8, 1995, and which has an effective filing date of June 8, 1993 or earlier, is entitled to have new evidence in support of patentability entered and considered (and the finality of the final rejection withdrawn), provided the submission (along with the appropriate fee) is filed prior to the filing of an appeal brief to the Board of Patent Appeals and Interferences or abandonment of the application. 37 CFR § 1.129(a); MPEP § 706.07(g). Here, the application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and the submission (along with the appropriate fee) is filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences or the abandonment of the application. Answers (B) and (D) are incorrect because the submission was not filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences. 37 CFR § 1.129(a); MPEP § 706.07(g). Answer (C) is incorrect because the submission was not filed prior to the abandonment of the application on December 18, 1999. 37 CFR § 1.129(a); and MPEP § 706.07(g). Answer (E) is incorrect because Answer (C) is incorrect.

47. ANSWER: (C). 35 U.S.C. 102(b); and MPEP §§ 715.03, 2111.03, and 2173.05(h). Deletion of the anticipated element from the claim leaves an invention, which is no longer anticipated by the reference. (A), (D), and (E) are incorrect because despite the amendments, 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.

48. ANSWER: (D). MPEP § 2136.05. (A) is incorrect. MPEP § 2137. “The mere fact that a claim recites the use of various components, each of which can be argumentatively assumed to be old, does not provide a proper basis for a rejection under 35 U.S.C. 102(f).” *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976). Derivation requires complete conception and communication by another to the applicant. *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter. 1978). (B) is incorrect. MPEP § 2137, third paragraph. The designation of inventorship in a patent does not raise a presumption of inventorship with respect to subject matter disclosed, but unclaimed in the patent. (C) is incorrect. MPEP § 2136.05. A terminal disclaimer does not overcome a 35 U.S.C. § 102(e) rejection. *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). (E) is incorrect because (A), (B) and (C) are incorrect.

49. ANSWER: (B). 37 CFR § 1.53; and MPEP §§ 601.01, and 601.01(g). The only way to retain the original filing date of the application is to delete all reference to the omitted figure and comply with the requirements set forth in MPEP § 608.02.

50. ANSWER: (C) is the most correct answer. 35 U.S.C. § 103; *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983); and MPEP § 2112. (A) and (B) are incorrect because a suggestion to modify the art to render obvious the claimed invention need not be expressly stated in one or all of the references. *In re Napier, supra*. (D) is incorrect. The burden is on the examiner to show that the prior art suggests modifying the art to render obvious the claimed invention. If the examiner sustains his burden of proof only then does the burden shift to the applicant to present rebuttal evidence. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986), and MPEP §§ 2141, and 2143.01. (E) is incorrect because only analogous art can be used in a 35 U.S.C. § 103 rejection.