

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

Morning Model Answers
Examination for Registration to Practice in Patent Cases
Before the United States Patent and Trademark Office
October 17, 2001

1. 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).

2. ANSWER: (B) is the most correct answer. The application number of each U.S. patent is not required to be listed by 37 CFR 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” The elements of (A) are found in 37 CFR 1.98 (a)(3)(ii). The elements of (C) are found in 37 CFR 1.98 (b)(5). The elements of (D) are found in 37 CFR 1.98(c). The elements of (E) are found in 37 CFR 1.98(d).

3. ANSWER: (D) is the most correct answer. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. § 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR 1.55 (Claim for foreign priority), subparagraph (a)(2), which states “(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted...” As to (B), (B) contains the elements of 37 CFR 1.55 (a)(2), which states “...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.” As to (C), (C) contains the elements of 37 CFR 1.55 (a)(1)(ii), which provides “(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.” As to (A), (A) contains the elements of 37 CFR 1.14(c)(1)(i), which states “[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1).” As to (E), (E) contains all of the elements of 37 CFR 1.14(c)(1)(ii), which states “If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).”

4. All answers accepted.

5. ANSWER: The most correct answer is (B). 37 CFR 1.84(a)(2), MPEP § 608.02; Notice (Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs) in Official Gazette May 22, 2001, 1246 OG 106 (“In summary, the USPTO has *sua sponte* waived 37 CFR 1.84(a)(2)(iii) and 1.165(b) and is no longer requiring a black and white photocopy of any color drawing or photograph”). (A) is wrong because a petition under 37 CFR 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity status until any issue fee is due. 37 CFR 1.27(g)(1). (C) – (E) are also wrong because they do not provide for the required petition under 37 CFR 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

6. ANSWER: The most correct answer is (A). As stated in MPEP § 2107.01 (IV). A deficiency under 35 U.S.C. § 101 also creates a deficiency under 35 U.S.C. § 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (“If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.”). (B) is not correct. MPEP § 2107 (II), and see *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); and *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980). (C), (D) and (E) are not correct. MPEP § 2107 (II), and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

7. ANSWER: (B). The opposite is true in that 37 CFR 1.165 (Plant Drawings) expressly provides that “[v]iew numbers and reference characters need not be employed unless required by the examiner.” The elements of (A) are all present in 37 CFR 1.163. The elements of (C) are all present in 37 CFR 1.163(b). The elements of (D) are all present in 37 CFR 1.163(c). The elements of (E) are all present in 37 CFR 1.163(d).

8. ANSWER: Statement (E) is false and is not a correct statement. Since a redacted copy of the application was used for publication purposes, 37 CFR 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” For (A) and (B), see 37 CFR 1.14(b)(2). For (C) see 37 CFR 1.14(b)(2) and (c)(1)(i). As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 CFR 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

9. ANSWER: (B) is the most correct answer, and (A) and (C) are wrong. MPEP § 715.05 (“If the patent is claiming the same invention as the application and its issue date is one 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) (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.”). (D) is wrong. See MPEP § 2307 (“The fact that the application claim may be broad enough to cover the patent claim is not sufficient. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950)”). (E) is also wrong. See MPEP § 2307 (“If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent...then under the provisions of 35 U.S.C. § 135(b), an interference will not be declared unless at least one of the claims which were in the application...prior to expiration of the one-year period was for ‘substantially the same subject matter’ as at least one of the claims of the patent.”).

10. ANSWER: (B) is the most correct answer. 37 CFR 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (A) is incorrect. 37 CFR 1.192(a); MPEP § 1206, “Time For Filing Appeal Brief.” (C) is incorrect. MPEP §§ 1206 and 1215.04. Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. (D) is incorrect. 37 CFR 1.137(a) or (b), MPEP § 1206, “Time For Filing Appeal Brief.” A proper brief must be filed before the petition to revive the application and reinstate the appeal will be considered on its merits. Alternatively, a continuing application or an RCE may be filed. 37 CFR 1.137(c). (E) is incorrect. MPEP § 1206, “Time For Filing Appeal Brief.” The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

11. ANSWER: (C) is the correct answer. MPEP § 706.07(b). (A) is incorrect because a final rejection is not proper on a second action if it includes a rejection on newly cited art other than information submitted in an information disclosure statement under 37 CFR 1.97(c). MPEP § 706.07(a). (B) is incorrect because it is improper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the parent application. MPEP § 706.07(b). (D) is incorrect because it is improper to make final a first Office action in a substitute application where that application contains material, which was presented in the earlier application after final rejection, or closing of prosecution but was denied entry because the issue of new matter was raised. MPEP § 706.07(b). (E) is incorrect because (C) is correct.

12. ANSWER: (C). This is not true since 37 CFR 1.76(d)(4) provides, in part, “(4)...Captured bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefore and the submission of a supplemental application data sheet, an oath or declaration under 37 CFR 1.63 or § 1.67, or a letter pursuant to 37 CFR 1.33(b).” (A) is in accordance with 37 CFR 1.76(a). (B) is in accordance with 37 CFR 1.76(b). (D) is in accordance with 37 CFR 1.76(c). (E) is in accordance with 37 CFR 1.76 (d)(4).

13. ANSWER: (D) is the most correct answer. 37 CFR 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 CFR 1.114(c).

14. ANSWER: (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, “A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description”; MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “A description as filed is presumed to be adequate...” MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.⁶⁵ ...The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.⁶⁶” (footnotes not reproduced); MPEP § 2163, paragraph III. A. (pg. 2100-166) (8th Ed.). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, “[W]hen filing an amendment, applicant should show support in the original disclosure for new or amended claims.⁵⁹” Footnote 59 states, “See MPEP §§ 714.02 and 2163.06 (‘Applicant should...specifically point out the support for any amendments made to the disclosure.’)”; MPEP § 2163, paragraph III. A. 3. (b) (pg. 2100-165) (8th Ed.). (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in “Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, ‘Written Description’ Requirement,” 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, “[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus”; MPEP § 2163, paragraph III. A. 3. (a)(ii) (pg. 2100-164) (8th Ed.).

15. ANSWER: (C). Not all fees are subject to the small entity reduction. See, for example, 37 CFR 1.17(p). As to (A), a small business concern for the purposes of claiming small entity status for fee reduction purposes is any business concern that: (i) has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization. and (ii) meets the standards set forth in the appropriate section of the code of federal regulations to be eligible for reduced patent fees. *Sam’s Labs* meets all of the elements required by 37 CFR 1.27 (a)(2). Statement (B) contains all of the elements required by 37 CFR 1.27 (a)(4). Statement (D) contains all of the elements required by 37 CFR 1.27 (c)(1). Statement (E) contains all of the elements required by 37 CFR 1.27 (c)(1)(iii).

16. 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).

17. 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.

18. ANSWER: The most correct answer is (B). MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

19. ANSWER: The correct response is (E). Adams is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). It does not matter that Mexico is a NAFTA country. Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Adams' filing date, it was not "in this country" as required by 35 U.S.C. § 102(b). Again, it does not matter that Mexico is a NAFTA country.

20. ANSWER: (C) is the most correct answer. See 37 CFR 1.196(b); MPEP § 1214.01. As to (A) see MPEP § 1206, p.1200-8, "(6) Issues." As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (D) see 37 CFR 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal 37 CFR 1.310 and 1.303(a). *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination under 35 U.S.C. § 302 is conducted ex parte after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate in ex parte reexamination before the USPTO).

21. ANSWER: The most correct answer is (C). MPEP § 2144.04(VII), citing *In re Bergstrom*, 427 F.2d 1394, 166 USPQ 256 (CCPA 1970). (A) is not correct. MPEP § 2144.04(IV)(A),

citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (B) is not correct. MPEP § 2144.04(IV)(B) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (D) is not correct. MPEP § 2144.04(VI)(A), citing *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). (E) is not correct. MPEP § 2144.04(II)(A), citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

22. ANSWER: (D). 37 CFR 1.97 (g) specifically states that “[a]n information disclosure statement filed in accordance with section shall not be construed as a representation that a search has been made.” The elements of (A) are supported by 37 CFR 1.97 (c). The elements of (B) are supported by 37 CFR 1.97(d). The elements of (C) are supported by 37 CFR 1.97(f). The elements of (E) are supported by 37 CFR 1.97(h).

23. ANSWER: (A) is the correct answer. 35 U.S.C. § 102 (d), and MPEP § 706.02(c). (A) is correct because the foreign patent establishes a bar under 35 U.S.C. §102 (d). MPEP § 706.02 (e). (B) is incorrect because the invention is not described in a printed publication more than one year prior to the date of the U.S. application. 35 U.S.C. § 102(b). (C) is incorrect because the invention is not in public use more than one year prior to the date of the U.S. application. MPEP § 2133. (D) is incorrect because the sale is not in the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (E) is incorrect because (A) is correct.

24. ANSWER: The most correct answer is (D). 35 U.S.C. § 116, first paragraph; MPEP § 2137.01, “Inventorship,” and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (A) is not correct. MPEP § 2137.01 (Requirements for Joint Inventorship) and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (B) is not correct. 35 U.S.C. §§ 101, 115; MPEP § 2137.01. (C) is not correct. MPEP § 2137.01. The inventor of an element, per se, and the inventor of a combination using that element may differ. See *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982); and *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). (E) is not correct. There is no provision in the Patent Statute requiring the invention to be reduced to practice in order to file a patent application claiming the invention. Further, see MPEP § 2137.01; and see *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

25. ANSWER: (C). Ada may file an affidavit or declaration pursuant to 37 CFR 1.131. As to (A), *In Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997), the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). However, the sale occurs in China and not in the United States as is required by 35 U.S.C. § 102(b). As to (B), the sale in China is not a bar. 35 U.S.C. § 102(b) requires the sales to be in the United States. As to (D), reexaminations are based solely upon patents and printed publications. (E) is incorrect since disclosure of another’s idea does not render a patent invalid and breach of the confidentiality agreement does not render the patent invalid.

26. All answers accepted.

27. ANSWER: (C) is the correct answer. 37 CFR 1.144; MPEP §§ 818.03(a)-(c). (A), (B), and (D) are each incorrect because no supposed errors in the restriction requirement are distinctly and specifically pointed out. (A) and (D) are further incorrect because no election is made. (E) is incorrect because (C) is correct.

28. ANSWER: (D). See 37 CFR 1.196(b); MPEP § 1214.01. As to (A) see MPEP § 1204 under Special Case. As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (C) see 37 CFR 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal. 35 U.S.C. § 306; MPEP § 2273; *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989)(a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate before the USPTO). See also MPEP § 2279.

29. ANSWER: The most correct answer is (C). Regardless of whether the customized PDA or the golf magazine article qualifies as prior art under 35 U.S.C. § 102(a) and/or § 102(b), and despite the belief that the claims are patentably distinct, Kat's derivation of the idea for the golfer's aid from those sources raises a possible obviousness rejection under 35 U.S.C. § 103/102(f). See 37 CFR 1.56. Moreover, the golf magazine article published more than a year before Kat's filing date and is therefore available as prior art under at least 35 U.S.C. § 102(b).

30. ANSWER: The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). (A) is not the best answer because 35 U.S.C. § 103 specifically states that patentability shall not be negated by the manner in which the invention was made. (B) is not the best answer because economic unfeasibility is not a basis for a determination of nonobviousness. See MPEP § 2145 VII. (D) is directed to the issue of enablement, not obviousness. (E) is wrong because the commercial success of the prior art distance finder is not relevant (although commercial success of Kat's invention would be relevant).

31. ANSWER: The best answer is (E). The effective prior art date of Nichols' U.S. patent under 35 U.S.C. §§ 102(a) and 102(b) is September 18, 2001. Therefore, answers (A), (B) and (C) are incorrect. The provisions of § 102(d) do not apply to Kat's application at least because Nichols' German application was not filed by Kat. (D) is therefore incorrect.

32. ANSWER: The best answer is (D). Answers (A), (B) and (C) do not provide antecedent basis for "said receiver" in part v of claim 8. Answer (E) does not provide antecedent basis for "said plurality of remote devices" in claims 9 and 10.

33. ANSWER: (E) is correct because 37 CFR 1.321(a) states, in pertinent part, that "any patentee may disclaim or dedicate to the public...any terminal part of the term, of the patent granted." 35 U.S.C. § 173 states, "Patents for designs shall be granted for the term of fourteen years from the date of grant." (A) is wrong because such action would not permit Igor to financially exploit any portion of the term of his patent, since 37 CFR 3.56 indicates that the

result is a conditional assignment, which is regarded as an absolute assignment for Office purposes. (B) is wrong because 37 CFR 1.321(a) provides for dedication to the public of “the entire term, or any terminal part of the term” only. “[T]he first five years of the patent term” does not qualify as a terminal part of the term. (C) is wrong because Igor would not achieve his objective of dedicating at least a portion of his patent term to the public, since the term of the design patent would expire on January 23, 2015. 35 U.S.C. § 173. (D) is wrong because 37 CFR 1.321(a) restricts a disclaimer to “any complete claim or claims” or “the entire term, or any terminal part of the term” of a patent. “Royalties received from licensing” are not addressed by 37 CFR 1.321(a).

34. ANSWER: (D) 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 (A) is incorrect because the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited steps. MPEP § 2111.03. Answers (B) and (C) are incorrect because the terms “including” and “characterized by” are synonymous with the term “comprising.” MPEP § 2111.03. Answer (E) is incorrect because Answer (B) and Answer (C) are incorrect.

35. ANSWER: (D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with 37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy’s application has not issued as a patent, and reissue relates only to applications that have issued as patents.

36. ANSWER: The most correct answer is (C). The one-month extension of time filed February 23, 2001 properly extended the deadline for reply to Friday, March 23, 2001. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, *i.e.*, the application was abandoned at 12:01 AM on Saturday, March 24, 2001. The fact that March 24 was a Saturday does not change the abandonment day because the reply was due on March 23, a business day. MPEP § 710.01(a).

37. ANSWER: The most correct answer is (B). MPEP § 2163.01. (A) is incorrect because the claims as filed in the original application are part of the disclosure, MPEP §§ 2163.03 and 2163.06(III), and claim 2 is enabled by the original disclosure. (C) is incorrect. The original disclosure enables claim 2. (D) is incorrect because although the specification should be objected to, the original disclosure enables each of the claims. MPEP § 2163.06(I). (E) is incorrect because (B) is correct.

38. ANSWER: (A) is the correct answer. 37 CFR 1.97(b)(4) and (c), effective date November 7, 2000; *see*, “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54630 (September 8, 2000); and 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 (Aug. 16, 2000); MPEP § 609, paragraph III.B(1)(b) (pg. 600-125) (8th Ed.). (A) is correct since November 15, 2000, is “before the mailing of a first Office action after the filing of a request for continued examination under § 1.114” (37 CFR 1.97(b)(4)). As stated in 65 FR 54630, column 2, “As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination”; MPEP § 609, paragraph III.B (1)(b) (pg. 600-125) (8th Ed.). Thus, choices (B) and (C) are each incorrect as they are subject to the requirements of 37 CFR 1.97(c). (E) is incorrect since (A) is correct.

39. ANSWER: The most correct answer is (C). The petition for extension of time filed June 18, 2001 provided applicant with a one-month extension of time from the original due date, June 16, 2001 (not from the date the petition was filed). See MPEP § 710.01(a). Thus, the extended due date was Monday, July 16. Since an additional extension of time is needed, (B) is incorrect. Under the provisions of 37 CFR 1.136(a)(3), applicant’s statement is treated as a constructive petition for extension of time. MPEP § 710.02(e). (A) is incorrect because applicant’s statement in the Remarks portion of the Amendment acted as a constructive petition for extension of time and, therefore, the Amendment is timely. There is no need for the petition to appear in a separate paper, so (D) is not correct. (E) is incorrect because (A) and (D) are both incorrect.

40. ANSWER: (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101. As to answers (C) and (E), since Alice is not a joint inventor and she does not have sufficient proprietary interest in the invention, she may not file a patent application on Mike’s behalf. 35 U.S.C. § 116; 37 CFR 1.47(b). As to (B), you ordinarily may not accept payment from someone other than your client. 37 CFR 10.68(a)(1). As to (D), inventorship cannot be changed when there is deceptive intent.

41. ANSWER: (E) is the correct answer. 37 CFR 1.114 (effective August 16, 2000); “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (August 16, 2000); MPEP § 706.07(h), paragraph I (pg. 700-69) (8th Ed.). (A) is a final action (37 CFR 1.113). 65 FR 50097, column 1, states in pertinent part, “...an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex Parte Quayle*, 1935 Comm’r Dec. 11 (1935)).” Thus (A), (B), (C) and (D) are individually correct, and (E), being the most inclusive, is the most correct answer.

42. 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 CFR 1.75(c). Dependent claim 6 (Answer E) improperly seeks to broaden Claim 1 by omitting an element set forth in the parent claim.

43. ANSWER: (E) is the correct answer. (A) is incorrect because it is permitted experimental testing. MPEP §§ 2133.03(e)(3) and (6). (B) and (D) are each incorrect because the sales occurred outside of the United States. 35 U.S.C. § 102(b); MPEP §§ 706.02(c) and 2133.03(d). (C) is incorrect as it provides the basis for a rejection under 35 U.S.C. § 103, but not 35 U.S.C. § 102(b).

44. ANSWER: (A) 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 § 609, paragraph III. B (1)(b) (pg. 600-125) and MPEP 706.07(h), paragraph II (pg. 700-69) (8th Ed.). In (A), the information disclosure statement, is a submission under 37 CFR 1.114(c), and the RCE was filed before the payment of the issue fee. 37 CFR 1.114(a)(1). (B) is incorrect because the request for continued examination was filed after payment of the issue fee, and is filed without a petition under 37 CFR 1.313 being granted. Therefore (B) does not satisfy the provision of 37 CFR 1.114(a)(1). (C) is incorrect because the application becomes abandoned on February 14, 2001 for failure to pay the issue fee. Therefore the request for continued examination does not satisfy the provision of 37 CFR 1.114(a)(2). (D) is incorrect because a petition under 37 CFR 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. 37 CFR 1.313(d). Thus, the request for continued examination in (D) does not satisfy the provision of 37 CFR 1.114(a)(1). (E) is incorrect because (A) is correct.

45. ANSWER: (B) is correct because 37 CFR 1.217(a) permits such action within 16 months after the filing date for which a benefit is sought under 35 U.S.C. § 119(a), and 12 months is within 16 months. (A) and (C) are wrong because provisional and reissue applications are excepted from the publication provisions of 37 CFR 1.211(a) by 37 CFR 1.211(b). (D) is wrong because the provisions for publication of a redacted application do not apply when the foreign application is more extensive than the US application. (E) is wrong because 37 CFR 1.221(b) limits the period for filing a request for re-publication under such circumstances to 2 months from the date of the patent application publication.

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

47. ANSWER: (A) is the correct answer. 37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

48. ANSWER: The most correct answer is (D). MPEP § 710.02(e) at p. 700-77. (A) and (B) are not true because the amendment is treated as timely. (C) is incorrect because there is no authority for giving 30 days from the notification mailing date to request an extension time. 37 CFR 1.136; MPEP § 710.02(a). (E) is untrue because (D) is true.

49. ANSWER: (D) is correct and (A), (B), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application. ... (d)...If...the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation number for the application. This procedure does not obtain in the circumstance described in (B) inasmuch as the EFS copy of the application was not filed within one month of the mailing date of the first Filing Receipt including a confirmation number for the application.

50. ANSWER: (B) is the most correct answer. Admissions by applicant constitute prior art. 37 CFR 1.104(a)(3). As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that

the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler’s admission of the Aokage reference as prior art before the PTO during the prosecution of the ’922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to “all the claims” of the three Subera applications, that “the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner” (emphasis added). In view of this explicit admission, the district court’s decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court’s decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.)

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

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).