

**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**April 17, 2002**

**Morning Session Model Answers**

1. ANSWER: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

2. ANSWER: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30 days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

3. ANSWER: (D). This answer is correct because it would be the best option, as it would give Ms. Bordeaux the filing date of the PCT, specifically 1/10/01, as her U.S. filing date (for the purpose of determining whether information is prior art), it would give her a foreign priority date of 1/10/00, with no further need to provide the foreign priority document; it would also give her the full benefits of filing PCT applications, i.e., a search report and preliminary examination report on her invention(s) prior to filing a national application, so that she has an indication of which claims have the best chance of being determined to be patentable. (A) This answer is incorrect, as it would not give Belle Bordeaux the benefit of a preliminary examination report for

her international application, prior to filing the national application. (B) This answer is incorrect because the procedure would not achieve the objective of obtaining an international preliminary search report. It would give Belle Bordeaux a later U.S. filing date, the filing date of the national application, *e.g.*, 9/10/01; the invention(s) would be subject to U.S. restriction practice; and the applicant would have to provide a certified copy of the foreign priority document. (C) This answer is incorrect, as a provisional application is not entitled to the right of priority of any other application under 35 U.S.C. §§ 119 or 365(a), or to the benefit of an earlier filing date in the United States under 35 U.S.C. §§ 120, 121 or 365(c). (E) is not correct because (A), (B) and (C) are incorrect.

4. ANSWER: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

5. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.114(e), effective date August 16, 2000; *see*, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 FR 50092, 50097 (Aug. 16, 2000). (E) is correct since the provisions of 37 C.F.R. § 1.114 do not apply to design patent applications. Therefore, choices (A) through (D) are incorrect.

6. ANSWER: The most correct answer is (D). See MPEP § 706.07(h), page 700-71, under “IV. IMPROPER CPA TREATED AS RCE.” The request for a second CPA filed on December 28, 2001 is improper because the application in which the CPA was filed in has a filing date of December 29, 2000 and is not eligible for the CPA practice. The CPA practice does not apply to applications that have a filing date on or after May 29, 2000. The Office will automatically treat the improper request for a CPA as a Request for Continued Examination under 37 C.F.R. § 1.114. However, the request for a CPA filed on December 28, 2001 does not satisfy the requirements of 37 C.F.R. § 1.114 to be a proper RCE because it lacks the filing fee required by 37 C.F.R. § 1.17, and the required submission under 37 C.F.R. § 1.114. Therefore, the improper CPA will be treated as an improper RCE and the time period set in the last Office action mailed on June 28, 2001 will continue to run. Since the time period expired on December 28, 2001, the application is abandoned. Answers (A), (B), and (C) are incorrect because the request for a second CPA filed on December 28, 2001 is improper and the amendment was not entered. Answer (E) is incorrect because a request for a suspension of action will not be granted if the CPA or the RCE is improper (*e.g.*, a filing date was not accorded in the CPA or the RCE was filed without a submission). See 37 C.F.R. § 1.103, MPEP § 709, page 700-113.

7. ANSWER: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir.

1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. See *In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

8. ANSWER: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). Also, evidence of common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership. Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a *prima facie* showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

9. 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." (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... ." (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.<sup>65</sup> ...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.<sup>66</sup>" (footnotes not reproduced). (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.<sup>59</sup>" Footnote 59 states, "See MPEP §§ 714.02 and 2163.06 ('Applicant should... specifically point out the support for any amendments made to the disclosure.')." (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."

10. ANSWER: The correct answer is (A). See 37 C.F.R. § 1.48(f)(1) wherein the first submission of an executed oath or declaration under 37 C.F.R. § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship in the unexecuted declaration. Answer (B) is wrong because a new executed oath or declaration was not filed. Answer (C) is wrong because (1) a petition under § 1.48(a) is not required, (2) the petition is incomplete because it lacks a statement by the newly discovered inventor that the error occurred without deceptive intention on his part, and (3) the declaration fails to list the other two inventors. Answer (D) is wrong because (1) a petition under § 1.48(a) is not required and (2) the petition is incomplete because it lacks a new oath or declaration, which lists the newly discovered inventor in addition to the inventors already named. Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

11. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a USPTO published application, based on an earlier international application, has prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, the USPTO published application is entitled to its international filing date of February 27, 1997 for prior art purposes. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority, but not for prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than February 27, 1997. (D) is wrong because the amendments to § 102(e) by the American Inventors Protection Act of 1999 make the national stage entry date irrelevant for prior art purposes.

12. ANSWER: (E) is the most correct answer. 35 U.S.C. § 102(e)(2), as amended by the American Inventors Protection Act, provides that a United States patent is prior art as of its earliest filing date in the United States. Section 102(e)(2) also specifically notes that a patent is not entitled to any international application filing date for prior art purposes. Because in the above fact pattern, no application was ever filed in the United States, the patent is not entitled to any prior art date earlier than its issue date, December 1, 2001. (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119 only for priority and not prior art purposes. (B) is wrong because while a USPTO published application may be entitled to its international filing date under section 102(e)(1), a United States patent is not entitled to any international filing date under section 102(e)(2). (C) is wrong because while the publication of an international application in English has its own prior art effect as a reference, it is not relevant to the prior art effect of the United States patent. (D) is wrong because national stage entry of an international application is not to be confused with a United States filing date. While the version of section 102(e) that existed prior to the American Inventors Protection Act expressly provided for prior art effect as fulfillment of certain national stage requirements, the amended section 102(e) no longer provides for that prior art effect, thus making national stage entry irrelevant for 102(e) prior art purposes.

13. ANSWER: (C) is the most correct answer. 35 U.S.C. § 41(e) reads “The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof.” The statute, however, does not make a government agency a small entity. Choices (A), (B), (D) and (E) are not correct because 37 C.F.R. § 1.27(a) recites these four items as qualifying for small entity status.

14. ANSWER: (B) is the most correct answer. Third party requesters do not have the option of attending interviews. See 37 C.F.R. § 1.560(a), which provides, in part, “[r]equests that reexamination requesters participate in interviews with examiners will not be granted.” As to (A) and (C) through (E), each item is founded on a portion of § 1.560(b), which states “(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner’s response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.”

15. ANSWER: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris’s associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able’s death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

16. ANSWER: (E) is correct. A communication mailed within the time given for response in accordance with the procedure of 37 C.F.R. § 1.8 or 1.10 is considered timely filed even if it is received after the date a reply is due. In (E), the letter was not mailed in accordance with 37 C.F.R. § 1.8 or 1.10. Therefore, the letter would be considered filed when it is received in the USPTO. 37 C.F.R. § 1.311(a) states, “This three month period is not extendable.” Without complying with 37 C.F.R. § 1.8 or 1.10, the filing date of the letter is the date it was received in the USPTO, i.e., February 15, 2002, which is after the due date for payment of the issue fee, February 13, 2002. (A) is wrong because the reason given for abandonment is incorrect. The application becomes abandoned for the reasons expressed in (E). Although 37 C.F.R. § 1.311(b) provides that the submission of an incorrect issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) operates as a request to charge the correct issue fee, it does not change the fact that Jill’s letter is received by the USPTO after expiration of the non-extendable statutory three month period for payment of the issue fee. (B) is wrong because the application will become abandoned because Jill’s letter will be received by the USPTO after expiration of the non-

extendable statutory three month period. (C) is wrong because the period for payment of the issue fee was not extendable by petition. The period is set by statute. 35 U.S.C. § 151. Abandonment occurred because Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period. A petition for an extension of time was not available in this case. (D) is wrong because the reason for abandonment is wrong. Filing the form is optional. Although 37 C.F.R. § 1.311(b) provides that the submission of a completed Office-provided issue fee transmittal form, PTOL-85B, operates as a request to charge the correct issue fee (or other post-allowance fees set forth in 37 C.F.R. § 1.18) to any deposit account identified in a previously filed authorization to charge fees, it does not change the fact that Jill's letter was received by the USPTO after expiration of the non-extendable statutory three month period.

17. ANSWER: (D) is correct. An original plant or utility application filed on or after May 29, 2000 is eligible for patent term adjustment. See 35 U.S.C. § 154(b), 37 C.F.R. § 1.702 and MPEP § 2730. Since a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000 is eligible for patent term adjustment. See MPEP § 2730. Applications filed on or after June 8, 1995 may accrue patent term extension under 35 U.S.C. § 154(b), but patent term extension is much more limited than PTA and should not be confused with PTA. Accordingly, Answers (A) and (B) are wrong. Answer (C) is wrong because design applications are not eligible for patent term adjustment. See 37 C.F.R. § 1.702 and MPEP § 2730. Answer (E) is wrong because a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 is not a new application and filing an RCE in an application filed before May 29, 2000 will not cause the application to become eligible for patent term adjustment. See MPEP § 2730.

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

19. ANSWER: (B). 37 C.F.R. § 1.153(d)(I)(i)(B). A design application is eligible for continuing prosecution application procedures. 37 C.F.R. § 1.114 (e)(4) explains that RCE procedure is not available for design applications, therefore (A) and (C) are wrong. Answer (D) is wrong because under 37 C.F.R. § 1.53(d) the filing date of the application (A#1) must be before May 29, 2000. Answer (E) is wrong for the same reason.

20. ANSWER: The model answer is choice (E). 37 C.F.R. § 1.14(b)(4). MPEP § 102, “Information as to status of an Application.” Under 37 C.F.R. § 1.14, the Office may provide status information for pending patent applications that claim the benefit of the filing date of an application for which status information may be provided. Hence information will only be available on this basis for subsequently filed applications. Answer (A) is incorrect because information may be available for subsequently filed applications. Answers (B) and (C) are incorrect because only status information, not copies of the application, are provided. Answer (C) is also incorrect because a claim for benefit under 35 U.S.C. § 120 must be made before status information will be provided. Answer (D) is incorrect because status information is only given for subsequently filed applications.

21. ANSWER: (C) is the most correct answer. See 37 C.F.R. § 1.322(a)(2)(i) (“There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section”). See MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. See 37 C.F.R. § 1.322(a)(2)(ii) (“Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office”).

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

23. ANSWER: The correct answer is (E). PCT Article 22 was recently amended to permit applicant to delay entry into the national stage until 30 months from the earliest claimed priority date, regardless of whether a Demand was filed within 19 months from said date. The change is effective for international applications where the former Article 22 time limit of 20 months expired on or after 01 April 2002.

24. ANSWER: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration

nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Block should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Block's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Block's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

25. ANSWER: (E) is correct. (A), (B), (C), and (D) are wrong because 35 U.S.C. § 154(a)(2), in pertinent part, provides that a patent "grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States... ." An adjustment of the patent term due to examination delay for original patent applications filed on or after June 8, 1995, and before May 29, 2000, is provided by 37 C.F.R. § 1.701. As to (D), the period of adjustment for the application involved in the interference is not adjusted by the period prosecution is suspended in an application related to the application in interference. The period of adjust for the application in interference is governed by the provisions of 37 C.F.R. § 1.701(c)(1)(i), as opposed to the provisions of 37 C.F.R. § 1.701(c)(1)(ii), which pertain to adjustment of the term of an application wherein prosecution is suspended due to an interference proceeding not involving that application. As to (E), the adjustment involves extending the patent term from the expiration date of the patent by the period of the delay. The manner of calculating the period of the delay is provided in subsection 701(c)(1)(i), which recites:

With respect to each interference in which the application was involved, the number of days...in the period beginning on the date the interference was declared...to involve the application in the interference and ending on the date that the interference was terminated with respect to the application... .

26. ANSWER: (B) is the most correct answer. Under 37 C.F.R. § 1.26(b), "Any request for refund must be filed within two years from the date the fee was paid." *See*, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54608, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.26(a). *See*, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54608, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (C) is not the most correct answer. 37 C.F.R. § 1.52(b)(6) provides that other than in a reissue application, the paragraphs of the specification of an application may be numbered at the time the application is filed. *See*, "Changes to Implement the Patent Business Goals, Final Rule," 65 F.R. 54604, 54620



(left column), 54621 (Comments 22, 23, 24, and 25, and responses) (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.52(d)(2) provides for that an English language translation of the non-English language provisional application will not be required in the provisional application. (E) is not the most correct answer. 37 C.F.R. § 1.52(e)(5). See, “Changes to Implement the Patent Business Goals, Final Rule,” 65 F.R. 54604, 54621, left column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

27. ANSWER: The best answer is (E). The original deadline for responding to the Office action was one month from December 12, 2001, *i.e.* January 12, 2002. A one-month extension of time would be required for a response filed from January 12, 2002 to February 12, 2002. Answers (B) and (D) are incorrect because the responses are not timely. Answer (B) is also incorrect because a proper reply must include an election even if the restriction requirement is traversed (MPEP § 818.03(b)). Furthermore, although small entity status entitles an applicant to pay reduced fees, small entity status does not change the manner in which restriction requirements are considered. Answer (A) is incorrect because the reply must be in writing. See, *e.g.*, MPEP § 818.03(a). Answer (C) is incorrect because the Reply to Office Action does not make an election and because it does not specifically point out the supposed errors in the Examiner’s action. See MPEP § 818.03(a).

28. ANSWER: The best answer is (C). Answers (A) and (B) are incorrect because they attempt to distinguish the claim on the basis of a feature that is not recited in claim 6, *i.e.*, the substance is interspersed throughout the salt lick. *Cf.* claim 8. Answer D similarly relies on a feature that is not set forth in claim 6, *i.e.*, presence of substance XYZ. With regard to Answer (E), a mere conclusory statement that the claim was carefully drafted to distinguish over the prior art is unlikely to be persuasive without reference to distinguishing features set forth in the claim.

29. ANSWER: The best answer is (C). MPEP § 2141.01(a). Answer A is incorrect because under the facts of the question there is no teaching or suggestion to combine the teachings of Deere and Doe. Moreover, what is inherent is not necessarily obvious. Answer B is incorrect because the test under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. The test is not whether it would have been obvious to the inventor. Answer (D) is incorrect at least because the background facts specifically state that the specification is fully enabling. Similarly, Answer (E) is incorrect because the question specifically states that the specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ.

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

31. ANSWER: (A). See MPEP § 706.02(b) page 700-23 (8<sup>th</sup> ed.), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (B), and (C) are incorrect because they present showings that support the rejection. See MPEP § 706.02(b), *supra*. (D) are not correct because to perfect priority under 35 U.S.C. §§ 119(e) or 120 it is, *inter alia*, necessary to amend the specification of the application to contain a specific

reference to a prior application having a filing date prior to the reference. See MPEP § 706.02(b), supra. Furthermore, the declaration is not to be amended. (E) is incorrect because (B), (C) and (D) are incorrect.

32. ANSWER: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered coinventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

33. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.105, and 37 C.F.R. § 1.56(c). A named inventor, and an attorney who prepares and prosecutes the application, are identified in 37 C.F.R. § 1.56(c), and an assignee is specified in 37 C.F.R. § 1.105(a)(1). Therefore (D) is correct. (E) is incorrect because (D) is correct.

34. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.121(c) and (d), and MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant's Action*). (A) is incorrect. MPEP § 714.22, page 700-196, 197 (8<sup>th</sup> Ed.) (*Entry of Amendments*). Applicant may resubmit the amendment within any remaining period of time (set in the final rejection). No further extension of time or new time periods which might serve to extend the six month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may resubmit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an extension beyond the six-month statutory deadline. (B) is incorrect. MPEP § 714.22(a), page 700-198, (*Amendments Consolidating All Claims*). Applicants have the opportunity to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. This may be done at any time during prosecution of the application, though the entire clean claim set is subject to the provisions of 37 C.F.R. §§ 1.116(b) and 1.312. (C) is incorrect. MPEP § 714, page 700-169 through 172 (8<sup>th</sup> Ed.) (*Amendments, Applicant's Action*) While the first portion of the answer is correct because amendments to the drawings must be submitted on a separate paper showing the proposed changes in red for to the specification including the claims must be made by replacement paragraph/section/claim in clean form. This requirement is regardless of the mailing date of the Office action.

35. ANSWER: The correct answer is (D). The practice is set out in MPEP §1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect

because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP §1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously unclaimed subject matter.

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

37. 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 C.F.R. § 1.608 instead of 37 C.F.R. § 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 C.F.R. § 1.132.

38. ANSWER: (D) is the most correct answer. A reference is a “printed publication” if one of ordinary skill in the art can locate it with reasonable diligence. Its availability as prior art under § 102(b) depends upon proof of when the reference was “published” or became publicly accessible. Here, (D) is the correct answer because the Japanese patent application was published, *i.e.*, “laid open,” more than 1 year before applicant’s filing date. (C) is incorrect

because it was posted or published less than one year after applicant's filing date. (B) is incorrect because (1) the database retrieval date is after applicant's filing date, (2) the printout does not include the date on which the MEDLINE abstract was publicly posted and (3) reliance is on the printout per se not the actual article (reliance on the actual article would require getting the article and an English translation as well as determining the date when the journal was publicly available). (A) is incorrect because there is no evidence when the journal was publicly available. The examiner was unable to determine the actual date of publication.(E) is incorrect because (A), (B) and (C) are incorrect

39. ANSWER: (C) is the most correct answer. Under 37 C.F.R. § 1.53(d), "(1) A continuation...application...of a prior nonprovisional application may be filed as a continued prosecution application provided that: (i) The prior nonprovisional application is either: a utility...application that was filed under 35 U.S.C. § 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application." (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing a divisional application as a CPA of a prior provisional application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a continuation-in-part application as a CPA of a prior complete nonprovisional utility application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

40. ANSWER: (D) is the most correct answer. (A) and (B) are incorrect because, pursuant to MPEP § 503, the return postcard itself must specifically itemize the component parts of the new application. (C) is incorrect because, pursuant to MPEP § 503, the number of pages of each of the component parts of an application must be specified to obtain prima facie evidence of what was filed. In light of (A), (B), and (C) being incorrect, (E) is also incorrect.

41. ANSWER: Answer (A) is the best answer because it is an incorrect statement. See 37 C.F.R. § 1.131, which reads in relevant part:

(a)(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

(D) is correct statement. MPEP § 715.07. (B), (C) and (E) are also correct. 37 C.F.R. § 1.131. 35 U.S.C. § 104 (see history).

42. ANSWER: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a *bona fide* attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a *bona fide* attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

43. ANSWER: (D) is the most correct answer. 37 U.S.C. § 254, 37 C.F.R. § 1.322(a)(1)(ii), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). (A) is incorrect. 37 C.F.R. § 1.322(a)(2), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). Third parties do not have standing to demand that the Office issue or refuse to issue a certificate of correction. (B) is incorrect. 37 C.F.R. § 1.322(a)(4), and MPEP § 1480, page 1400-63, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The Office will not issue a certificate of correction under 37 C.F.R. § 1.322 without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard. Additionally, the Office has the discretion to decline to issue a certificate of correction even though an Office mistake exists if the Office mistakes are of a nature that the meaning intended is obvious from the context. (C) is incorrect. 37 C.F.R. § 1.322(a)(3) and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). A request for a certificate of correction to correct a mistake in a patent incurred through the fault of the Office may relate to any issued patent including those involved in interference. Where the request relates to a patent involved in an interference, the request must comply with the requirements of 37 C.F.R. § 1.322 and be accompanied by a motion under 37 C.F.R. § 1.635. (E) is incorrect. 37 C.F.R. § 1.322(a)(1), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The Commissioner may also issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office, acting *sua sponte* for mistakes that the Office discovers or acting on information about a mistake supplied by a third party.

44. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.48(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, “Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)...” (A), (B), and (C) are provided for in 37 C.F.R. § 1.33(b). Thus (E), the most inclusive answer, is correct.

45. ANSWER: (E). See MPEP § 706.02(b) page 700-23 (8<sup>th</sup> ed.), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

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

47. ANSWER: (C). 35 U.S.C. §§ 111(b)(7), 119(e); 37 C.F.R. § 1.55, 1.78(a)(4); MPEP § 201.04(b) – page 200-16, and 201.15. (C) is true because X is not entitled to the Canadian application priority date because the nonprovisional application was filed more than one year from the filing date of the Canadian application. Furthermore, a provisional application is not entitled to claim priority based on any other application under 35 U.S.C. §§ 119, 120, 121, and 365. The earliest date that the nonprovisional application is entitled to claim is the January 19, 2001 date. Where applicant is not entitled to a priority date, MPEP § 201.15 states that an examiner may make a rejection based on an intervening reference. (A) is false because priority may not be claimed to the Canadian application because over 12 months elapsed between the filing of the Canadian application and the filing of the non-provisional US application and no priority claim is available via the provisional application. (B) is false. The patent term will be measured from the filing date of the provisional application. See MPEP § 201.04(b), page 200-16. (D) is false because (A) and (B) are false. (E) is false because (C) is true.

48. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

49. ANSWER: All answers accepted.

50. ANSWER: (A) is the most correct answer. 35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).