ANSWERS TO THE USPTO AUGUST 1998 EXAM
MORNING SECTION

1. **ANSWER: (A)** is correct because there is compliance with 37 CFR § 1.111(b), which recites, "The reply by the applicant . . . must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action." The court in *In re Vogel*, 164 USPQ 619 (CCPA 1970), cited in MPEP § 804, Part II., A., stated, "By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine,' because the former is broader than the latter." The court went on to state, "A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention."

(B) is wrong because the amendment is not fully responsive to the examiner's rejection as required by MPEP § 714.02. Note that no argument is presented to "distinctly and specifically point out the supposed errors in the examiner's action" as required by 37 CFR § 1.111(b). Note further that the amendment does not change the scope of the claim. The *Vogel* case stated that "a claim reciting a length of 'thirty-six inches' defines the same invention as a claim reciting a length of 'three feet,' if all other limitations are identical." The same point is made in MPEP § 804, Part II., A. (C) is wrong because MPEP § 804.02 recites, "A terminal disclaimer is not effective in overcoming a statutory double patenting rejection." Although helpful, unless a proper reply is filed (see Answer (A)), a terminal disclaimer alone is insufficient.

(D) is wrong because MPEP § 804.02 recites, "The use of a 37 CFR 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate." Note that 37 CFR § 1.131 applies to both affidavits and declarations.

(E) is wrong because the argument addresses the basis of a rejection not made by the examiner, i.e., 35 U.S.C. § 103, and fails to address the double patenting basis of the rejection made by the examiner. Hence, the argument is not responsive to the examiner's rejection as required by MPEP § 714.02.

2. **ANSWERS: Both (A)** and **(E)** are considered correct answers in light of the varying interpretations to be given to the statement that the "published article discusses a pasta maker **very similar** to your client's pasta maker." (Emphasis added.) As explained in MPEP 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." The use of the phrase "very similar" can be understood to mean that the published article explicitly or impliedly taught every aspect of the claimed invention. Under this interpretation, (A) would be correct because the published article is prior art under 35 U.S.C. § 102(a) because, based upon the given facts, the invention "was known . . . by others in this country, or . . . described in a printed publication in this . . . country, before the invention thereof by the

applicant for patent." (B) would not be the correct answer under this interpretation based upon when the one year anniversary date occurs for the published article and when the patent application needs to be filed. 35 U.S.C. § 21(b) states "When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken or the fee paid, on the next succeeding secular or business day." This section of the statute has been interpreted as modifying the one-year or twelve months' periods specified in various other parts of the statute and also for 35 U.S.C. § 102(b). See MPEP § 2133 and *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). Therefore, the article would be a reference under 35 U.S.C. § 102(a) and not under § 102(b), since May 16, 1998, falls on a Saturday. (C) would also not be correct because 35 U.S.C. § 102(d) relates to (1) a patent, not a publication; (2) a reference of the applicant, not another; and (3) a foreign reference, not a U.S. reference. Likewise, the reference in (D) to 35 U.S.C. § 102(e) would not be correct because this section only applies to the filing date of a patent and the reference is a published article.

The phrase, "very similar", could also be taken to mean that the published article did **not** teach every aspect of the claimed invention as required for anticipation under 35 U.S.C. § 102. Based on this interpretation, answers (A), (B), (C), and (D) would be rendered incorrect because they are all based on sections of 35 U.S.C. § 102. Accordingly, answer (E) "None of the above" would be the most correct answer.

3. ANSWER: (E) (D) is wrong because the design for a bouquet does not satisfy the statutory requirement for protection by a plant patent. 35 U.S.C. § 161. MPEP § 1601. (A) is wrong because a tuber propagated plant is expressly excepted from protection under 35 U.S.C. § 161, the Plant Patent Act. MPEP § 1601. (B) is wrong because a plant found in an uncultivated state is expressly excepted from protection under 35 U.S.C. § 161, the Plant Patent Act. MPEP § 1601. (C) is wrong because protection under 35 U.S.C. § 161, the Plant Patent Act, is expressly limited to <u>asexually</u> reproduced plants. MPEP § 1601. While new varieties of <u>sexually</u> reproduced plants may be protected under 7 U.S.C. § 2321, the Plant Variety Protection Act, this Act is not the Plant Patent Act. (E) is correct because (A), (B), (C) and (D) are incorrect.

4. ANSWER: (B) (B) is correct because the parts of the references relied on in the rejections are attributable to Smith. MPEP § 716.10 states that:

> [I]t is incumbent upon the inventors named in the application . . . to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the . . . patentee notwithstanding . . . the inventorship of the patent.

(A) is wrong because 35 U.S.C. § 103(c) is limited to § 102(f) or (g). The court stated the following in *In re Bartfeld*, 17 USPQ2d 1885, 1888 (Fed. Cir. 1991):

> We are not persuaded by these lines of argument, for they contradict the plain language of 35 U.S.C. § 103. The second paragraph of § 103 is expressly limited to subject matter "developed by another person, which qualifies as prior art *only under subsection (f) or (g) of section 102*," (Emphasis added.) We may not disregard the unambiguous exclusion of § 102(e) prior art from the statute's purview.

See MPEP § 2136.05. (C) is wrong because a terminal disclaimer is not appropriate to overcome a 35 U.S.C. § 102(e)/103 rejection. The court in *Bartfeld* stated, "The purpose of a terminal disclaimer is to limit the term of a patent, not to remove a reference as prior art." See MPEP § 2136.05. (D) is wrong because even though D completed the invention on December 28, 1995 in a WTO member country other than a NAFTA country, the earliest date that D is entitled to is January 1, 1996, since 37 CFR § 1.131(a)(2) recites:

> A date of completion of the invention may not be established under this section . . . before January 1, 1996 in a WTO member country other than a NAFTA country.

The Able patent and the CPA application were both filed on December 29, 1995 which is earlier than D's December 28, 1995 date. (E) is wrong because a declaration under 37 CFR § 1.130, to be effective, must declare that the inventions defined by the Smith claims and by the references' claims "are not patentably distinct," and this fact is not recited in the factual scenario. The DIRECTIONS state, "Do not assume any additional facts not presented in the questions." MPEP § 718.

5. **ANSWER: (B)** is correct because the submission of the drawings completes the missing parts required to accord a filing date for a nonprovisional application. 37 CFR §§ 1.53(b) and 1.81; MPEP § 506.02. (A) is wrong because the application was incomplete when filed, i.e., the drawings required by 37 CFR § 1.81(a) were omitted. MPEP § 506.02. (C) is wrong because a declaration is not one of the essential parts of an application required to accord a filing date for a nonprovisional application. MPEP § 506.02. (D) is wrong because the filing fee is not one of the essential parts of an application required to accord a filing date for a nonprovisional application. MPEP § 506.02. (E) is wrong because the original drawings, notwithstanding their noncompliance with 37 CFR § 1.84, were admitted for examination and thus satisfied the requirement of 37 CFR § 1.81(a), thereby entitling the application to a filing date as of the date of their submission on February 13, 1998.

6. **ANSWER: (C)** (C) is correct because the continuation application was filed claiming the benefit under 35 U.S.C. § 120, and therefore is entitled to the earlier filing

date of its parent, i.e., June 20, 1994. Since this date precedes the issue date of the Johnson '004 patent, i.e., January 10, 1995, the latter is not available as prior art under any subsection of 35 U.S.C. § 102. MPEP § 706.02 (a). (A) is wrong because it ignores the fact that the continuation application was filed claiming the benefit under 35 U.S.C. § 120, and therefore is entitled to the earlier filing date of its parent, i.e., June 20, 1994. Since this date precedes the issue date of the Johnson '004 patent, i.e., January 10, 1995, the latter is not available as prior art under any subsection of 35 U.S.C. § 102. MPEP § 706.02 (a). (B) is wrong because it ignores the fact that the continuation application was filed claiming the benefit under 35 U.S.C. § 120, and therefore is entitled to the earlier filing date of its parent, i.e., June 20, 1994. Since this date precedes the issue date of the Johnson '004 patent, i.e., January 10, 1995, the latter is not available as prior art under any subsection of 35 U.S.C. § 102. MPEP § 706.02 (a). Note that subsection (e) of 35 U.S.C. § 102 applies only where the invention is described in a patent granted on an application for patent by another. (D) is wrong because subsection (d) of 35 U.S.C. § 102 applies only to a situation where the invention was first patented in a foreign country, and the Johnson '004 patent was first patented in the United States. (E) is wrong because subsection (g) of 35 U.S.C. § 102 applies only to a situation where the applicant's invention was made in this country by another, and in the present situation the Johnson '004 patent relates to an invention made by the same applicant.

7. **ANSWER: (E)** The question is directed to which of the following statements regarding a Continued Prosecution Application (CPA) is **not** correct. As presented, (E) is the most correct answer. The statement made in (E) is incorrect because a CPA does not require that any reference be made to the prior application in the first paragraph of the specification. The statements made in (A) through (D) are correct statements pursuant to the rules for a Continued Prosecution Application (CPA) created under 37 CFR §§ 1.6(a)(3) and 1.53(d), effective December 1, 1997.

8. **ANSWER: (E)** is correct. The U.S. design patent application is not entitled to claim the benefit of the British application, since the U.S. application was filed more than 6 months after the filing of the British application MPEP § 1504.10. Professor Yak's activity in the United States occurred less than one year before the U.S. application was filed. Therefore, it is not a bar under 35 U.S.C. § 102(b). (A) is wrong because the U.S. design patent application is not entitled to the benefit of the British filing date. 35 U.S.C. § 172 requires that the U.S. application be filed within six months from the earliest date on which such foreign application was filed. In the present case, the period of time between March 11, 1997, the British filing date, and March 6, 1998, the U.S. filing date, is more than six months. (A) is also wrong because the trade show took place in England, rather than "in this country," as prescribed by 35 U.S.C. § 102(b). (B) is wrong because although the statement is true that the U.S. design patent application is not entitled to the benefit of the British filing date, the statement that the display of the container at the show is a public use bar under 35 U.S.C. § 102(b) is false because the activity did not occur "in this country." (C) is wrong because although the statement is true that the U.S. design patent application is not entitled to the benefit of the British filing date, the statement that Professor Yak's study activity is a public use bar under 35 U.S.C. § 102(b)

is false because the study occurred less than one year before the application was filed. (D) is wrong because the U.S. design patent application is not barred by Professor Yak's study activity in the United States since the activity did not occur more than one year prior to the filing of the U.S. application.

9. ANSWER: (B) is correct because the facts indicate that the inventions are independent and patentably distinct, and that the double patenting rejection is of the obviousness type. MPEP § 804 recites:

> There are . . . two types of double patenting rejections. One is the "same invention" type double patenting rejection . . . . The second is the "nonstatutory-type" double patenting rejection . . . which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes rejections based on . . . obviousness.

(A), (C), and (E) are wrong because although the portions of the statements that recite, "The rejection is improper" are true, the reasons given therefor are not true. The reason given in (A) is not true based on MPEP § 804, which recites, "Before consideration can be given to the issue of double patenting, there must be some common relationship of inventorship and/or ownership of two or more patents or applications." Although the reason given in (C) is factually true, it does not necessarily render the rejection improper, because as shown in MPEP § 804, CHARTS I-B and II-B, provisional double patenting rejections may be justified regardless of whether common ownership existed at the time of applicant's invention. The reason given in (E) is not true based on subsection II.B.3. of MPEP § 804, which recites, "Double patenting rejections in utility-plant situations may be made in appropriate circumstances." (D) is wrong because the statement, "The rejection is proper," is not true. See (B).

10. ANSWER: (E) is correct because MPEP § 1504.03, Part A.4., recites, "Secondary considerations, such as commercial success . . . are relevant to the evaluation of obviousness of a design claim just as in a utility claim," and MPEP § 1504.03, Part B., states:

> The procedure for evaluating *prima facie* obviousness of a design is set forth in *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982). *Rosen* states, essentially, that it is the overall appearance . . . which must be taken into consideration. *Rosen* additionally states, on a procedural level, that the examiner must first provide 'a reference . . . the design characteristics of which are basically the same as the claimed design.' (213 USPQ at 350).

(A) is wrong. 37 CFR § 1.53(c)(3). MPEP § 1504.10 recites, "Design applications may not make a claim for priority of a provisional application under 37 CFR 1.78(a)(3)." (B)

is wrong because MPEP § 1504.03, Part A.1., states that "where the differences between the claimed design and the prior art are limited to the application of ornamentation to the surface of an article, any prior art reference which discloses substantially the same surface ornamentation would be considered analogous art." See *In re Glavas,* 109 USPQ 50 (CCPA 1956). (C) is wrong. MPEP § 1504.01, Part B. The argument in (C) is based purely on function. A design for an article that is dictated purely by the function of the article lacks ornamentality under 35 U.S.C. § 171. (D) is wrong because MPEP § 1504.03, Part A.2., recites, "Note that whether any particular ornamentation is embossed on or impressed in the surface to which it is applied is considered a matter of choice well within the skill of the ordinary designer. See *In re Cornwall*, 109 USPQ 57 (CCPA 1956)."

11. ANSWER: (B) is the most correct answer because in MPEP § 714.12, a final rejection does not preclude consideration of further amendment or argument regarding the rejected claim. (A) is incorrect. The amendment presents a claim drawn to a different invention, i.e., a subcombination, the safety valve. This raises new issues, and the amendment does not remove issues for appeal. Therefore, the amendment is not entitled to entry. MPEP § 714.13. (C) is incorrect. The test data pertains to a combination, safety valve and pneumatic tire inflation devices, which differs from the claimed combination, safety valve boiler. Therefore, the affidavit does not remove issues for appeal, cancel claims, adopt a suggestion of the examiner, or otherwise comply with 37 CFR § 1.116. (D) and (E) are incorrect. The finality of the rejection is not premature inasmuch as the same ground of rejection was repeated. MPEP §§ 706.07(c), (d) and (e). With respect to (E), a 37 CFR § 1.183 petition is inappropriate in this situation. With respect to (D), there is no petition to be filed under 37 C.F.R. § 1.81.

12. ANSWER: (E) is the most correct answer because all the people listed in choices (A) through (D) are entitled to the information as a matter of right regarding the status of the application. MPEP § 102.

13. ANSWER: (A) is correct because the amendment is filed by the principal attorney who has authority to act on behalf of Titan, and the amendment overcomes the rejection. (C) and (D) are incorrect because Harris can no longer file the amendment according to MPEP § 402.05, which recites that "Revocation of the power of the principal attorney revokes powers granted by him or her to other attorneys. Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (in contradistinction to the date of ACCEPTANCE)." (B) and (E) do not overcome the rejection since the limitation in Claim 13 does not limit Claims 11 and 12, which are anticipated.

14. ANSWER: (D) The most correct answer is (D). Mike can properly file the amendment. When a registered practitioner signs a paper in practice before the PTO, such action constitutes a representation that the practitioner is authorized to represent the particular party in whose behalf he acts. 37 CFR § 1.34(a); or MPEP § 402. Answer (A) is incorrect because it does not matter whether Mike is the brother of the attorney of

record or not. Answers (B), (C), and (E) are incorrect because, in accordance with 37 CFR § 1.34(a), Mike does not need to have express authorization to act on behalf of Jones and he would not be violating the PTO Code of Professional Responsibility.

15. ANSWER: (D) is the most correct answer. 37 CFR § 1.97(d). MPEP § 609, page 600-97. When an *Ex parte Quayle* action is issued after a final rejection which has not been withdrawn, the Information Disclosure Statement must follow the rules pursuant to 37 CFR § 1.97(d) which requires that the IDS be filed with a certification as defined in 37 CFR § 1.97(e), a petition requesting consideration of the IDS, and the appropriate petition fee. Answer (A) is not correct because the IDS must be filed within three months of the filing date of the application or before the First Office action is issued for there to be no additional steps required and the fact pattern states that there has already been a second Office action Final Rejection issued. Answers (B), (C), and (E) are not correct because they do not fully comply with 37 CFR § 1.97(d).

16. ANSWER: (E) is the most correct answer because the date that the time period starts running is from the date that the Notice of Appeal is received in the PTO. Although the practitioner used a certificate of mailing dated March 6, 1998, the fact pattern tells you that the notice was actually hand carried, not mailed, to the PTO. When that happens the date of receipt is the date that the paper is delivered to the mail room at the PTO. MPEP § 512, page 500-38. While the time for filing the appeal brief is normally two months from the date of the Notice of Appeal, the two month period is not a statutory period. A proper extension of time can be obtained for an additional five months. 37 CFR § 1.136(a); changes to Patent Practice and Procedure, Final Rule, Federal Register, October 10, 1997, 62 Fed. Reg. 53156.

17. ANSWER: (C) The most correct answer is (C). MPEP §§ 809 and 809.03. Because Claims 1 and 3 are properly divisible inventions, the restriction requirement is proper. The applicant must elect either one of the inventions defined by the claims. The linking claim should be examined with the elected invention. Answers (A), (B) and (E) are wrong because even if you disagree with a restriction requirement, you must file a provisional election to be responsive even though you traverse the requirement or want the requirement reviewed by a petition. MPEP § 818.03. Answer (D) is not correct because the restriction requirement is between the inventions defined by Claims 1 and 3, not Claim 2.

18. ANSWER: (D) is the most correct answer because different embodiments or modifications must be shown in the drawings. MPEP § 1503.01. Answer (A) is a proper statement. MPEP § 1503.01, page 1500-3. Answer (B) is a correct statement. 37 CFR § 1.152(a)(2). Answer (C) is a correct statement. A design application may only contain a single claim. MPEP § 1503.03 and 37 CFR § 1.153(a). Answer (E) is a correct statement which states how designs are evaluated. MPEP § 1504.

19. ANSWER: (D) The correct answer is (D). The Group Director will make the decision on a petition to reopen prosecution. MPEP §§ 1002.02(c) and 1214.07.

Answers (A) - (C) and (E) are incorrect because they are not the official designated in MPEP § 1002.02(c) to decide the petition.

20. ANSWER: (B) The correct answer is (B). With the new rule changes effective December 1, 1997, hand entry of amendments is no longer permitted. 37 CFR § 1.121(b)(2). Answers (A), (C) and (D) are all changes that were made pursuant to the December 1, 1997, change. 37 CFR §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 CFR § 1.121(b)(2)(i)(A) and MPEP § 1453, page 1400-21.

21. ANSWER: (A) The correct answer is (A). MPEP § 605.04(c). The petition must be filed under 37 CFR § 1.182. Answer (D) is not correct because Certificates of Correction only apply to changes being made to issued patents. MPEP § 1480. Answer (C) is not correct because it is not necessary to abandon the application to make a name change for the inventor, and it does not change the name in Jane's original patent application. Answer (E) is not correct because the appropriate fee was not included. Note that the MPEP indicates that the petition should be directed to the Assistant Commissioner for Patents. Answer (B) is not correct because a name change must be made by petition and accompanied by the required fee.

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

23. ANSWER: (A) is the most correct answer. 35 U.S.C. § 103; MPEP § 2145; *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). (B) is not the most correct answer. Arguments, and conclusory statements by counsel cannot take the place of factually supported objective evidence. *In re Huang*, 100 F.3d 135, 139-140, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); and MPEP § 2145, paragraph (a). (C) is not the most correct answer. The rebuttal evidence is not commensurate in scope with the claimed invention, and no trend to all metals could reasonably be ascertainable in the given facts. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); and MPEP § 2145, paragraph (f). (D) is not the most correct answer. Rebuttal evidence must compare the claimed invention with the specific prior art that was the subject of the rejection. *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ 2d 1040, 1042-1043 (Fed. Cir. 1992); and MPEP § 2145. (E) is not the most correct answer. Evidence of commercial success of articles

not covered by the claims rejected as being obvious is not probative of nonobviousness. *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994); and MPEP § 2145, paragraph (f).

24. ANSWER: (E) is the correct answer because the claim example given in (E) contains unacceptable multiple dependent claim wording. The example given in (E) does not "refer to such other claims in the alternative only." 37 CFR § 1.75(c). See also MPEP § 608.01(n).

25. ANSWER: (B) is the most correct answer. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (although rationale to combine references need not be expressly stated in the prior art, it is error to find obviousness where references "diverge from and teach away from the invention at hand," see *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983)). (A) is not the most correct answer. While this may be true regarding your applicant, case law treats this as a reasonable person. *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (attributing the "hypothetical person" with knowledge of all prior art in the field of the inventor's endeavor is in accord with a plethora of precedent of the U.S. Court of Appeals for the Federal Circuit. See, e.g., *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *Standard Oil Co. v. American Cyanmid Co.*, 774 F.2d 448, 454, 227 USPQ 293, 297 (Fed. Cir. 1985); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)); MPEP § 2144. (C) is not the most correct answer. *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (precedent holds that for the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references. See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)); MPEP § 2144. (D) is not the most correct answer. *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (it is not necessary that the prior art suggest the combination to achieve the same advantage or the same purpose as applicant); MPEP § 2144. (E) is not the most correct answer. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (it is not necessary that the prior art suggest that the claimed invention will have the same or similar utility discovered by applicant); MPEP § 2144.

26. ANSWERS: Both (C) and (D) are accepted as correct answers. The declarations in both (C) and (D) state that the divider and phase comparator were "well-known to those of skill in the art as of June 17, 1997" and that these elements were "routinely built." Answer (C) goes on to state that the declarant "provides details in the declaration concerning the structure and function of the elements." The declaration in (D) goes on to state that these elements were "sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university." As explained in MPEP § 2164.05, "[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement." See also *In re Buchner*,

989 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) ("expert's opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement.") The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. For this reason, (D) is a correct answer. A specification need not disclose what is well-known to those skilled in the art, and may omit that which is well-known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner, supra*; *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). The declarations in (A) and (B) are insufficient because the declarant's assertions that these elements were "well-known" and "routinely built" are conclusory statements unsupported by any other evidence. In effect, the professor is providing expert opinion as to the ultimate legal conclusion, and it must be supported by more than a conclusory statement. *In re Buchner, supra*. Unlike (A) and (B), however, (C) contains additional "details" so as to constitute "something more than a conclusory statement" as referred to in MPEP § 2164.05. As such, credit has been given for answer (C). (E) is incorrect because personal involvement is not required and is more than minimally legally sufficient.

27. ANSWER: (A) is the most correct answer. 37 CFR §§ 1.53(d) and 1.136. The procedure in 37 CFR § 1.53(d) for filing a continuation application is satisfied by (A). There is copendency between the applications and the same invention is being claimed by the same inventor. Inasmuch as an extension of time has been obtained by petition and fee, there is no hiatus between the applications. As such, the continuation application would obtain the benefit of the filing date the first application, which antedates the foreign patent publication date. (B) does not comply with the provision of 37 CFR § 1.53(d)(1)(ii). The first application became abandoned on June 3, 1998, inasmuch as a petition and fee for extension of time until September 2, 1998, was not filed. Therefore, the request was filed after the abandonment of the first application. Consequently, the foreign patent could become a reference under 35 U.S.C. § 102. In (C) and (D), the first application is not copending with the later filed application because the first application became abandoned on June 3, 1998. In (D), the requested extension of time would extend the time for reply to eight months, which is beyond the maximum period set by statute, six months. 35 U.S.C. § 133. In each of (C) and (D), the foreign patent could be prior art under 35 U.S.C. § 102(b) inasmuch as the second application does not have the benefit of the filing date of the first application. In (E), the second application would not be copending with the first application because the request is filed without a petition and fee for a three month extension of time.

28. ANSWER: (D) is the most correct answer. 37 CFR § 1.137(b). The petition to revive the provisional application, and required fees are promptly filed in accordance with 37 CFR § 1.137(b) following Smith's learning of the abandonment of the application. The facts present a case of unintentional abandonment. If the petition to revive the provisional application is granted, Smith's application may claim the benefit of the filing date of the provisional application since the application is filed within twelve months from the filing date of the provisional application. See 37 CFR § 1.78(a)(3); MPEP §

201.11. If the petition is granted, the Allon publication is prior art under 35 U.S.C. § 102(a) against the claim(s) of the application because the publication was published less than one year before the earliest effective filing date of Smith's application, and Smith can antedate the publication with an antedating affidavit under 37 CFR § 1.131. The duty of disclosure regarding the Allon publication is met. See 37 CFR § 1.56. (A) is incorrect because the regulations **do** provide for revival of abandoned provisional applications after the expiration of 12 months from the filing date provided the provisional application cannot be pending more than 12 months. 37 CFR § 1.137(b). (B) and (C) are incorrect. In addition to not following the procedure of 37 CFR § 1.137(b) for reviving the provisional application, they also incorrectly treat the abandonment as being improper. The abandonment is proper because no reply was timely filed to the notice regarding missing parts. (E) is incorrect because a petition and fee for a two month extension of time are inappropriate. Also, the fee for a petition to revive for unintentional abandonment is omitted. The petition and fee for a two month extension of time are ineffective inasmuch as they are filed after the time period set for reply to the notice regarding missing parts and any extension of such time. The duty of disclosure is met by (D), but not by (E). 37 CFR §§ 1.56 and 1.97.

29. ANSWER: (A) is the most correct answer. 37 CFR § 1.111(b). (A) complies with proper PTO practice and procedure because the practitioner is arguing that the claims are patentable over a patent used in the rejection, shows "supposed errors" in the examiner's action, and replies to the ground of rejection by addressing a patent which was applied as a reference. (B) is wrong and not in accord with proper PTO practice and procedure. (B) does not represent the most appropriate action because the CIP application gets the benefit of the filing date of the parent *pro se* application only for the subject matter disclosed in both the parent and CIP applications. The improvement is not disclosed in the parent application. Thus, benefit of the earlier filing date does not obtain for the improvement which is disclosed by the reference patent. 35 U.S.C. § 120. Also, the effective date of the reference is before the date of the *pro se* application. (C) is also not in accord with proper PTO practice and procedure. (C) does not represent the most appropriate action because the Rule 132 affidavit does not address the relevancy of the test data to the improvement of the process described in the reference patent. Thus, the affidavit does not comply with 37 CFR § 1.132, and MPEP § 716.02(b). (D) is not in accord with proper PTO practice and procedure, and does not represent the most appropriate action because the reference patent is available as prior art under 35 U.S.C. § 103 under 35 U.S.C. § 102(e) as of its December 11, 1995, filing date, which predates the February 3, 1997, filing date of the CIP application. (E) is not in accord with proper PTO practice and procedure, and does not represent the most appropriate action. The filing date of the reference patent, December 11, 1995, cannot be antedated by a Rule 131 affidavit inasmuch as the improvement was invented on January 3, 1998, which is after the filing date of the reference patent. 37 CFR § 1.131.

30. ANSWER: (B) is the correct answer. 35 U.S.C. § 119(b); 37 CFR §§ 1.55 and 1.111(b); MPEP § 201.13. (B) complies with proper PTO practice and procedure. To perfect a claim of foreign priority, the claim for benefit of foreign priority must be filed,

and a certified copy of the foreign application, along with an English translation of the foreign application. Additionally, the practitioner replies to the rejection by pointing out that the reference is no longer available as prior art. (A), (C), (D), and (E) are not in accord with proper PTO practice and procedure. No certified copy of the priority document and English translation thereof has been filed in (C), (D), and (E). 35 U.S.C. § 119(b). Further, (A) lacks a reply required by 37 CFR § 1.111(b). (C), (D), and (E) are not in accord with the procedures in 37 CFR § 1.55, and MPEP § 201.13, including omitting to file a certified copy of the foreign application, and an English translation of the German language application.

31. ANSWER: (C) (C) is sufficient disclosure of a specific utility. *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974); MPEP § 2107.01(c)(i). (A) doesn't specifically describe utility. See *In re Joly*, 376 F.2d 880, 153 USPQ 45 (CCPA 1967). (B), (D), and (E) are insufficient disclosures of a specific utility. MPEP §§ 2107.01(b)(i) and 2107.02. Regarding (B), see *In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966). With respect to (D), see *In re Ziegler*, 992 F.2d 1197, 1201, 26 USPQ2d 1600 (Fed. Cir. 1993). With respect to (E), see *Kwai v. Metlesics*, 480 F.2d 880,178 USPQ 158 (CCPA 1973).

32. ANSWER: (B) is the most correct answer because in 37 CFR § 1.193(a)(2), the "individual rejections" in the final rejection were rejections under 35 U.S.C. § 103 over A in view of B, and over A in view of C. There was no individual rejection under 35 U.S.C. § 103 in the final rejection over A in view of B and C. In (A), (C), (D), and (E), there are no new grounds of rejection. Regarding (A), (C), and (D), there is no new ground of rejection where the statutory basis for the rejection remains the same, and the evidence relied upon to support the rejection remains the same, even if there is a change in discussion or rationale for supporting the rejection. *In re Kronig*, 539 F.2d 1300, 1302-1303, 190 USPQ 425, 426-427 (CCPA 1976); 37 CFR § 1.193(a). In (C) and (D), the rejection was stated in the final Office action, and due to an amendment under 37 CFR § 1.116, became applicable to a claim that was amended. The advisory action gave the appellant fair notice that the amended claim would be rejected on the same grounds as in the final Office action. In (E), there is no change in the rejections between the final Office action and on appeal. In (A), (C), (D), and (E), Appellant's appeal brief should address each rejection from which appeal is taken, i.e., which is not a new ground of rejection. See also Changes in the Patent Practice and Procedure, Final Rule published in the Federal Register, 62 Fed. Reg. 53168 (October 10, 1997).

33. ANSWER (A) is the correct answer because in 37 CFR § 1.193(b), after prosecution is reopened, amendments and affidavit evidence can be properly presented to and considered by the examiner only if the practitioner files a reply under 37 CFR § 1.111, as opposed to electing to reinstate the appeal. The procedures in (C) and (D), which attempt to reinstate the appeal by filing a supplemental appeal brief accompanied by an amendment and/or affidavit, are not permitted. 37 CFR § 1.193(b)(2)(ii). (B) is not the most correct answer inasmuch as the given facts do not specify that the reply is being filed under 37 CFR § 1.111 as required by 37 CFR § 1.193(b)(2)(i) or that the reply

brief is being filed in response to an examiner's answer as required by 37 CFR § 1.193(b)(1). Moreover, (B) fails to fully respond to the Examiner's new rejection of Claims 1 **and** 2 under 35 U.S.C. § 103 over X in view of Y. The procedure in (E) is likewise inadequate. Contrary to the practitioner's argument, the examiner is permitted to reopen prosecution where a new rejection must be made. 37 CFR § 1.193(b)(2). Further, the practitioner's argument in (E) that the invention provides unexpected results is not properly acceptable in place of evidence in the record, e.g., an affidavit or declaration. *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); MPEP §§ 716.01(c) and 2145.

34. ANSWER: (C) is the most correct answer. The procedure in (C) follows the practice set forth in 37 CFR § 1.53(d), including subsection (d)(4). A newly executed oath or declaration is not needed inasmuch as none is required when a continuation application is filed under the continuing prosecution application procedure in § 1.53(d). The procedure in (A) is improper because it omits a statement in the petition identifying B as the inventor being deleted and acknowledging that B's invention is no longer being claimed and no petition fee is included. MPEP § 201.03, page 200-9. The procedure in (B) is improper for incompleteness because the petition fee has not been paid. The procedure in (D) is improper because you cannot add an inventor when you file a CPA and C was not named as an inventor in the prior application. The request is treated as naming A and B as inventors, 37 CFR § 1.53(d)(2)(iii), and inventorship is not corrected. See also Changes in the Patent Practice and Procedure, Final Rule published in the Federal Register, 62 Fed. Reg. 53141 (October 10, 1997). (E) is incorrect because the procedures in (A) and (B) are incomplete, and do not correct inventorship, and the procedure in (D) is improper for correcting inventorship by adding an inventor.

35. ANSWER: (C) is the correct answer because in 37 CFR §§ 1.33(b) and 1.191, an unsigned notice of appeal filed with an unsigned authorization to charge the appeal fee to a deposit account as payment of the notice of appeal fee is unacceptable as lacking the appeal fee. While 37 CFR § 1.191(b) provides that a notice of appeal need not be signed, it does not apply to an authorization to charge a deposit account, even if it is included in the notice of appeal. 37 CFR § 1.33(b). See also Changes in the Patent Practice and Procedure, Final Rule published in the Federal Register, 62 Fed. Reg. 53167 (October 10, 1997). (A), (B), (D), and (E) comply with proper practice and procedure. In (A), the notice and authorization to charge the appeal fee to a deposit account is signed, and Claims 1-5 have been twice rejected. In (B) and (D), the notice and authorization to charge the appeal fee to a deposit account is signed, and claims 1-5 have been twice rejected. There is no requirement in 37 CFR § 1.191 that the claims be twice rejected in the same application. In (B), there is no requirement in 37 CFR § 1.191 that the appealed claims be identified in the notice of appeal. In (E), the appeal brief was filed where the reply time is two months from the notice of appeal, and an extension of time for five months was requested and the requisite extension of time fees paid. 37 CFR §§ 1.192(a) and 1.136.

36. ANSWER: (C) is the most correct answer because, in accordance with 37 CFR §§ 1.8 and 1.53, there is no continuity between the prior application and the CPA

application. A certificate of mailing may not be used for filing a request for a continued prosecution application. 37 CFR § 1.8(a)(2)(i)(A). The prior application became abandoned on May 5, 1998, for failure to pay the issue fee. 37 CFR § 1.135(a); MPEP § 1306; 37 CFR § 1.311(a); 35 U.S.C. § 151. The request was filed on May 6, 1998, after the prior application became abandoned. Thus, the request does not satisfy the requirement of 37 CFR § 1.53(d) that the request be filed before the abandonment of the prior application. If continuity with the prior application cannot be established upon petition to revive, the application may be accorded a filing date upon petition under 37 CFR § 1.53(e) to convert the application to a 37 CFR § 1.53(b) application.

In (A), the CPA division application is improper, and should not be assigned a filing date. A CPA application must be filed before the abandonment of the prior application. 37 CFR § 1.53 (d)(1)(ii)(B). The request for the CPA was filed in the sixth month after the Office action setting a three month shortened statutory period for reply. The authorization to charge small entity fees under 37 CFR § 1.16 does not authorize payment of extension of time fees, which are set in 37 CFR § 1.17. The prior application became abandoned on May 21, 1998, for lack of a timely reply with request for an extension of time. In (B), the CPA application is not abandoned. The practitioner may obtain up to a five month extension of time to file the filing fee and surcharge. The time period for responding to the Notice To File Missing Parts is not a statutory period. Therefore, the practitioner may utilize the maximum time permitted by rule, 37 CFR § 1.17(a)(5). Regarding (D), no CPA application can be properly filed based on a prior provisional application. 37 CFR § 1.53(d). Regarding (E), a CPA based on a utility application results in the filing of another utility application. The CPA uses the file wrapper and specification of the prior application. 37 CFR § 1.53(d)(2)(iv). Any design application claiming status as a divisional application of a utility application must be filed under 37 CFR § 1.53(b), as opposed to 37 CFR § 1.53(d).

37. ANSWER: (B) The question is directed to which of the following does **not** comply with PTO practice and procedure regarding the reply. As presented, (B) is the most correct answer. The reply in (B) is incomplete regarding Claims 1-3, and no request and fee have been filed for an extension of time to file the notice of appeal. Therefore, the notice of appeal is untimely, and abandonment is not avoided. An applicant is not entitled to be given a new time period for reply, even if consideration of the rejection of Claims 1-3 was inadvertently omitted, where the omission occurs in a reply to a final rejection. An applicant filing a proposed amendment under 37 CFR § 1.116 or arguments in reply to a final Office action has no assurance that such reply will necessarily result in allowance of the application. The only reply under 37 CFR § 1.113(a) that ensures avoidance of abandonment is a timely filed notice of appeal and appeal fee under 37 CFR § 1.191.

(A) is not the most correct answer. Where the reply to a non-final action is incomplete, applicant may be granted a shortened statutory period of time within which to supply the omission, and applicant may supply the omitted reply within the newly set shortened statutory period of time, or within the maximum period for reply set by statute if a request

for a five month extension of time and appropriate fee are filed. 37 CFR §§ 1.135 and 1.136(a). (C) is not the most correct answer. The provisions of 37 CFR § 1.135(c) permit the filing of a continuing application as an alternative to completing a reply. *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, 53156, and in the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. (D) is not the most correct answer. A reply must be fully responsive. 37 CFR § 1.111. The examiner need not find that failure to provide a complete reply a second time is inadvertent where the practitioner was previously notified of the deficiencies. 37 CFR § 1.135(c). *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, 53156, and in the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. The application becomes abandoned for failure to reply within the time period. 37 CFR § 1.135(a). (E) is not the most correct answer inasmuch as (A), (C), and (D) are in accord with proper PTO practice and procedure.

38. ANSWER: (A) is the most correct answer because, in accordance with 37 CFR § 1.137(a) and MPEP § 711.03(c), a successful petition to revive should include the petition to revive, the appropriate petition fee, terminal disclaimer, disclaimer fee, reply to the Office action, and a showing that the entire delay in the filing of the reply from the due date to the filing of a grantable petition was unavoidable. P's non-diligence in failing to seek revival of the abandoned application cannot be charged to inventor A, in view of evidence demonstrating that P knowingly concealed abandonment from inventor A, and then covered up the abandonment by billing for work not performed, and giving misleading statements regarding the pendency of the application. (B) and (C) are not the most correct answers. In (B) and (C), X's statement is hearsay, as opposed to direct evidence, regarding A's acts, including A's diligence, and the communications A received from or had with P. Direct evidence of unavoidable delay must be presented. *Krahn v. Commissioner of Patents and Trademarks*, 15 USPQ2d 1823 (E.D. Va. 1990). In (B), the terminal disclaimer and disclaimer fee are not required since the application was filed after June 8, 1995. In (C), the effort to revive neither addresses nor demonstrates that unavoidable delay included any diligence by the applicant to know the status of the application. Applicant's diligent inquiry into the status of the application is required. *Douglas v. Manbeck*, 21 USPQ2d 1697 (E.D. Pa. 1991). (D) is not the most correct answer. In addition to filing an unnecessary terminal disclaimer, the petition does not show that A made diligent inquiry about the status of the application, and otherwise omits significant amounts of direct evidence that the entire delay in filing the reply was unavoidable. (E) is not the most correct answer because (A) is the most correct answer.

39. ANSWER: (A) is the most correct answer. 37 CFR § 1.131; MPEP § 715.03. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974). (B) and (C) are incorrect. To overcome a reference indirectly, as in (B) and (C), a showing of prior completion of a different species should be coupled with a showing that the claimed species would have been an obvious modification of the species completed by applicant. *In re Spiller, supra; In re Clark*, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966); MPEP § 715.03. (D) is incorrect because the declaration cannot be used to antedate a statutory bar, and the reference is a statutory bar under 35 U.S.C. § 102(b) inasmuch as it issued

more than one year before the Jones application was filed. 37 CFR § 1.131. (E) is incorrect because the declaration is ineffective to overcome a U.S. patent where there is no patentable distinction between the claims of the application and of the patent. *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); MPEP §§ 715.05 and 2308.01.

40. ANSWER: (B) is the most correct answer. *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958); *In re van Langehoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972); MPEP § 2258. Rejections may properly be made on intervening printed publications where the patent claims under consideration are entitled to only the filing date of the patent and are not supported by an earlier U.S. patent application whose filing date is claimed. (A) is incorrect. A rejection previously considered by the Office may not be raised by the examiner. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996); MPEP § 2258. (C) is incorrect. A statutory bar cannot be antedated with a antedating declaration or affidavit. 35 U.S.C. § 102(b); 37 CFR § 1.131; MPEP § 2258. (D) is incorrect. An examiner cannot use what was applied during the initial prosecution. See, generally, *In re Portola* , 42 USPQ2d 1295 (Fed. Cir. 1997); MPEP § 2258. (E) is incorrect. Rejections should be based on prior art patents or printed publications, not on inventorship, even where the evidence is a document containing admissions against interest regarding inventorship. See *In re Lanham*, 1 USPQ2d 1877 (Comm'r Pat. 1986); *Stewart Systems v. Com'r. Patents and Trademarks*, 1 USPQ2d 1879 (E.D. Va. 1986); MPEP § 2258.

41. ANSWER: (E) is the most correct answer. None of the procedures comply with proper PTO practice and procedure to fix the problem. 35 U.S.C. § 21; 37 CFR § 1.7; MPEP § 710.06; §711.02; §711.03(c). (A) is incorrect. Although the petition was filed within two weeks of the date of receipt of the Office action, a substantial portion of the reply period (at least one month) had not elapsed on the date of receipt, and the petition did not contain an explanation of how the presented evidence establishes the date of receipt of the Office action at the attorney's office. MPEP § 710.06 (PETITIONS TO RESET A PERIOD FOR RESPONSE DUE TO LATE RECEIPT OF A PTO ACTION). (B) is incorrect. Although the postmark date is later than the mail date printed on the Office action, the reset period would run from the postmark date shown on the envelope, as opposed to the date of receipt of the Office action. MPEP § 710.06 (PETITIONS TO RESET A PERIOD FOR RESPONSE DUE TO A POSTMARK DATE LATER THAN THE MAIL DATE PRINTED ON A PTO ACTION). (C) is incorrect. Although the postmark date is later than the mail date on the Office action, the petition should have been filed within two weeks of the date of receipt of the Office action at the attorney's office. MPEP § 710.06. (D) is incorrect. A petition to withdraw the holding of abandonment, as opposed to a petition and fee to revive the application as unavoidably abandoned, or as unintentionally abandoned, should be filed. The petition must include the practitioner's statements attesting to the fact that a search of the file jacket and docket jackets indicates that the Office action was not received, and referring to an attached copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed. MPEP § 711.02 (PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION). The

given facts do not state that such statements and evidence, which are required for a petition to withdraw the holding of abandonment, are provided with the petition in (D). Thus, the petition in (D) is inadequate to withdraw the holding of abandonment. Moreover, the petition in (D) does not comply with 37 CFR § 1.137(a) to be granted. It contains no showing that the delay was unavoidable (e.g., it omits the information and evidence needed for the petition to withdraw the holding of abandonment) required under 37 CFR § 1.137(a)(3), and a proposed reply to the Office action does not accompany the petition. Also, the petition in (D) does not comply with 37 CFR § 1.137(b) to be granted. It contains no statement that the entire delay in filing the required reply was unintentional as is required under 37 CFR § 1.137(b)(3).

42. **ANSWER: (C)** is the most correct answer. Although the article names a liquid composition and discloses a utility for it, even an incredible utility, the article is not enabling because it does not disclose the composition or manner of making the liquid. *In re Hoeksema,* 158 USPQ 596 (CCPA 1968); MPEP § 2121.02. (A) is incorrect. No distinction is made in the Patent Statute between a foreign and U.S. publication. MPEP § 2121. A picture of an article showing all of the claimed structural features and how they are put together is enabling. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir 1928); MPEP § 2121.04. (B) is incorrect. No utility need be disclosed for a reference to be anticipatory of a claim to an old compound. *In re Schoenwald*, 22 USPQ2d 1671 (Fed. Cir. 1992); MPEP § 2122. (D) is incorrect. Drawings in a design patent can anticipate the claimed invention in a utility patent. MPEP § 2125. (E) is incorrect. The U.S. publication disclosing the article and how the claimed structural features are put together would be considered to be an enabling disclosure. MPEP § 2121.04.

43. **ANSWERS: (A) and (B)** are the most correct answers because they are both not in accord with proper PTO practice and procedure. MPEP 710.06 provides that "[i]f the error is brought to the attention of the Office within the period for response set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for response, if requested to do so by the applicant, **to substantially equal the time remaining in the response period**." (Emphasis added.) Since the errors in both (A) and (B) were called to the examiner's attention more than one month after the date of the Office action, the Office would set a new period of response "to substantially equal the time remaining in the response period." Under this definition, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a "**three** month shortened statutory period" is not in accord with proper PTO practice and procedure. MPEP § 710.06, first paragraph, also provides that the Office will set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. (C) and (D) are in accord with proper PTO practice described in the first paragraph of MPEP § 710.06. (E) is in accord with proper PTO practice described in the fourth paragraph of MPEP § 710.06

44. **ANSWER: (B)** is the most correct answer. MPEP 1810; PCT Article 11. As presented, element I is identified in section (1)(iii)(b) of PCT Article 11; elements II and

IV are not mentioned in PCT Article 11; element III is found in section (1)(iii)(e) of PCT Article 11; and element V is set forth in section (1)(ii) of PCT Article 11.

45. ANSWER: (A) is the most correct answer. 37 CFR § 1.137(b). See *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, 53162-53163, and in the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. (B) is not correct. The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 U.S.C. § 133 and 37 CFR § 1.137(a) where the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. The provisions of 37 CFR §§ 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. Unless the applicant is informed in writing prior to expiration of the period for reply to a final rejection that the application is allowed, it is the applicant's responsibility to timely file a notice of appeal and fee to avoid abandonment of the application. (C) is not correct. The filing of a continuing application without payment of the issue fee is not an acceptable proposed reply in an application abandoned for failure to pay the issue fee. The "required reply" to the Notice of Allowance and Issue Fee Due is the issue fee. 37 CFR § 1.137(a); *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, 53157, and the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. (D) is not correct. Delay in paying the issue fee until the industry or a competitor shows interest in the invention is the antithesis of unavoidable or unintentional delay. It is an intentional abandonment of the application, and precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR § 1.137; *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988); *Federal Register* of October 10, 1997, 62 *Fed. Reg.* 53131, 53159, and the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. (E) is not correct because (B), (C), and (D) are incorrect.

46. [DELETED]

47. ANSWER: (C) is correct because Mr. Goody is a registered patent agent, and therefore, authorized by Part 10 of Title 37 of the Code of Federal Regulations "to represent applicants before the Office in the preparation and prosecution of applications for patent." By requesting that Wesson, his client, obtain a license or an assignment document necessary and proper to perform services authorized by law for which he has been retained, Mr. Goody is serving his client's interests, acting in accordance with proper PTO practice and procedure, and complying with the PTO Code of Professional Responsibility. (A), (B), (D), and (E) are wrong because each recites actions which involve state regulated legal activities: drafting of legal documents, such as assignment agreements, or advising a client regarding legal matters, or the circumstances giving rise to a "shop right." These activities are restricted to lawyers. Hence, a patent agent who engages in these activities may be regarded as engaging in the unauthorized practice of law.

48. ANSWER: (C) is true because Star is the assignee of record of the entire interest

in Jack's patent application. MPEP § 106 recites, "The assignee of record of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his or her own choice. (See 37 CFR 3.71.) Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect." (A), (B), and (D) are wrong because Omega is an exclusive licensee and not the assignee of record of the entire interest in Jack's patent application. MPEP § 106.01 recites, ". . . [I]t is only the assignee of record of the entire interest who can intervene in the prosecution of an application . . . ." (E) is wrong because Omega is an exclusive licensee and may not be excluded from access to Jack's patent application file. MPEP § 106.01 recites, "While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application . . . to the exclusion of the applicant, . . . a licensee of exclusive right is entitled to inspect the application."

49. ANSWER: (C) is correct because October 2, 1996, was the date on which the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) were completed; PCT Articles 11 and 20; PCT Rule 47.1(c); and 35 U.S.C. § 102(e) which states that a person shall be entitled to a patent *unless* "the invention was described in a patent granted on . . . an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent." See MPEP § 1895.01. (A) and (B) are incorrect because the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) were not complete as of those dates. (D) and (E) are incorrect because the requirements of 35 U.S.C. § 371 (c)(1), (2), and (4) were complete before those dates as explained above for (C).

50. ANSWER: (D) is the most correct answer. 35 U.S.C. § 102(d) and MPEP § 2135 expressly list (A), (B), (C), and (E) as the four conditions which, if all are present, establish a bar against the granting of a patent in this country. The foreign patent or inventor's certificate described in (D) need not be published to establish a 35 U.S.C. § 102(d) bar. MPEP 2135.