

United States Patent and Trademark Office
Examination for Registration of Patent Attorneys and Patent Agents

April 15, 2003

Morning Session Model Answers

1. ANSWER: (C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP § 2138.05 under the heading “Requirements To Establish Actual Reduction To Practice.” (A) is incorrect. MPEP § 2138.05, under the heading “Requirements To Establish Actual Reduction To Practice.” The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP § 2138.05, under the heading “Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph.” *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require “an inventor or his attorney to drop all other work and concentrate on the particular invention involved”); MPEP § 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP § 2138.06, under the heading “Diligence Required In Preparing And Filing Patent Application.” *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

2. ANSWER: (A) and (D) are accepted as the correct answers. Regarding answer (A), see 35 U.S.C. § 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading “3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request.” (D) was also accepted because the statement characterizes the status of the application as being abandoned, though the application has not necessarily attained abandoned status. The course of action postulated in (D) is a proper reply if the application was abandoned. Accordingly, (D) was accepted as a correct answer under these circumstances. (B) is incorrect. The notice of foreign filing can be filed as late as 45 days after the foreign filing before the U.S. application becomes abandoned. (C) is incorrect. See MPEP § 608.04(a). The improvements would constitute new matter and new matter cannot be added to the disclosure of an application after the filing date of the application. (E) is not correct. The applicant was required to provide notice of foreign filing within 45 days of filing in Japan, and two months have passed. As a result, a petition to revive under 37 CFR § 1.137(b) is required for examination to continue. Also see 37 CFR § 1.137(f).

3. ANSWER: (A) is the correct answer. See 37 CFR § 1.105(a)(3); MPEP § 704.12(b). MPEP § 704.12(b) states “A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or

the reply was ambiguous and a more specific answer is possible.” The given facts do not state that the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible. (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR § 1.105(b). (C) is incorrect because 37 CFR § 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR § 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR § 1.105. (E) is incorrect because (A) is correct.

4. ANSWER: (B) is the most correct answer. See MPEP § 2173.05(h). A Markush group is an acceptable form of alternative expression provided the introductory phrase “consisting of,” and the conjunctive “and” are used. (A) and (D) are incorrect because the conjunctive “or” is used. (C) and (E) are incorrect because the introductory phrase “comprising” is used. (E) is incorrect because R must simultaneously be A, B, C, and D, as opposed to being a single member of the group, *i.e.*, no language provides for the selection of one of the members of the group of A, B, C, and D. MPEP § 2173.05(h).

5. ANSWER: (D) is the most correct answer. 37 CFR § 1.6(d)(3); MPEP § 502.01. MPEP § 501.01, under the heading “Correspondence Relative To Patents And Patent Applications Where Filing By Facsimile Transmission Is Not Permitted,” identifies among the correspondence not permitted to be filed by facsimile transmission “(B) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date, other than a continued prosecution application filed under 37 CFR 1.53(d)” (A), (B) and (C) are incorrect. See 37 CFR § 1.6(d)(3); MPEP §§ 201.06(d), 502.01, 706.07(h) and 714. A request for continued examination (RCE) under 37 CFR § 1.114, which is not a new application, a continued prosecution application (CPA) under 37 CFR § 1.53(d) and an amendment in reply to a non-final Office action may be filed by facsimile transmission.

6. ANSWER: (D) is the correct answer. MPEP § 706.07(b). In both I and III the finality is improper. MPEP § 706.07(b). Therefore (A) and (C) are incorrect. In II the finality is proper. MPEP § 706.07(b). Therefore (B) and (E) are incorrect.

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

8. ANSWER: (E) is the most correct answer. MPEP § 1205, under the heading “Appeal By Patent Applicant,” states that “[a] notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of ‘twice or finally...rejected’ does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing

application, even if the claim was rejected only once in the continuing application.” (A), (B), (C), and (D) are not the most correct answer because a notice of appeal can be filed in a continuing application where at least one of the rejected claims was twice rejected, and one of the rejections may occur in the parent application.

9. ANSWER: (D) is the best answer as the inventions must be the same in the foreign and U.S. applications. 35 U.S.C. § 119(a). As to (A) through (C), see MPEP § 605.07. As to (E), see 35 U.S.C. § 119, which provides that the previously filed application must have been filed in a country that affords similar privileges in the case of applications filed in the United States or to citizens of the United States or in a WTO member country.

10. ANSWER: (A) is the most correct answer. MPEP § 710.02(d), last paragraph, and 37 CFR § 1.136(a). (B) is incorrect because a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. § 133. (C) and (D) are incorrect because the provisions of 37 CFR § 1.136(a) are available. (E) is incorrect because (A) is correct.

11. ANSWER: (E) is the most correct answer. (A) and (C) can be corrected by a certificate of Correction. MPEP § 1481. (D) can be corrected by a Certificate of Correction. 37 CFR § 1.324; MPEP § 1481. (B) is incorrect. Such a mistake, which affects the scope and meaning of the claims in a patent, is not considered to be of the “minor” character required for issuance of a Certificate of Correction. MPEP § 1481.

12. ANSWER: (B) is the most correct answer. See 35 U.S.C. § 103(a); MPEP §§ 706.02(l)(1) and 2145. The prior art exception in 35 U.S.C. § 103(c) is applicable because the Smith reference is only prior art under 35 U.S.C. § 102(e), (f), or (g), was applied in a rejection under 35 U.S.C. § 103(a), and was commonly owned at the time Potter made the invention claimed by Potter. See MPEP § 706.02(l)(1). Answer (A) is not a correct answer in that one cannot show nonobviousness by attacking the references individually where the rejections are based on a combination of references. See MPEP § 2145. Answer (C) is not a correct answer. An affirmation that the affiant has never seen the invention before is not relevant to the issue of nonobviousness of the claimed subject matter. See MPEP 716. Answer (D) is not a correct answer. Invention must be proved prior to the effective filing date of Smith, which is April 10, 2001. See MPEP § 715. Answer (E) is not a correct answer. A terminal disclaimer and affidavit or declaration under 37 CFR § 1.130 are not proper because the Potter application and the Smith reference are not claiming the same patentable invention. See MPEP § 706.02(k).

13. ANSWER: (C) is the most correct. See MPEP § 1412.02, Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: “No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.” (E) is incorrect because a (C) is correct.

14. ANSWER: (A) is the most correct answer. See 37 CFR § 1.22(a); MPEP § 509. Answers (B) through (E) have no factual basis or foundation in the MPEP.

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

16. ANSWER: (A) is the most correct answer. See 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the filing fee for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. Answers (B), (C), (D) and (E) are incorrect. See 37 CFR § 53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75, and any drawing required by 37 CFR § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

17. ANSWER: (C) is the most correct answer. As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. § 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (B) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).” (D) is incorrect. MPEP § 2165.01, under the heading “Defect In Best Mode Cannot Be Cured By New Matter,” indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. § 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

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

19. ANSWER: (B) is the most correct answer. 37 CFR § 1.133; MPEP § 713.02. As stated in MPEP § 713.02, “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).” (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 CFR § 1.133(a)(1). (C) is incorrect because an interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application. 37 CFR § 1.133(a)(2). (D) is incorrect because (A) and (C) are incorrect. (E) is incorrect because (B) is correct.

20. ANSWER: (D) is the most correct answer. See MPEP §§ 2112.01 and 2131. MPEP § 2112.01, under the heading “Product and Apparatus Claims – When the Structure Recited in the Reference is Substantially Identical to that of the Claims, Claimed Properties or Functions are Presumed to be Inherent” states that “[w]here the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).” Here, the claimed microorganism and the prior art microorganism appear to be the identical. (A) is an incorrect choice. MPEP § 2105, under the heading “Patentable Subject Matter – Living Subject Matter,” states “...the question of whether or not an invention embraces living matter is irrelevant to the issue of patentability.” The Supreme Court has held that biological materials such as microorganisms, and non-human animals, is patentable subject matter, provided it is made by man. Here, Eric’s isolation and purification the microorganism from its natural state (environment) makes it a product of human ingenuity, as opposed to a product of nature. *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). (B) is an incorrect choice. MPEP § 2107.01, under the heading “III. Therapeutic or Pharmacological Utility,” states that the “courts have found utility for therapeutic invention despite the fact that an applicant is at a very early stage in the development of a pharmaceutical product or therapeutic regimen based on a claimed pharmacological or bioactive compound or composition.” See, *Cross v. Iizuka*, 753 F.2d 1040, 1051, 224 USPQ 739, 747-48 (Fed. Cir. 1985). See also, *In re Brana*, 51 F.3d 1560, 34

USPQ2d 1436 (Fed. Cir. 1995). Citing *Brana*, MPEP § 2107.01 states, “Accordingly, Office personnel should not construe 35 USC 101, under the logic of ‘practical’ utility or otherwise, to require that an applicant demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans.” See also, MPEP § 2107.03, under the heading “Special Considerations for Asserted Therapeutic or Pharmacological Utilities, I. A Reasonable Correlation Between the Evidence and the Asserted Utility is Sufficient,” which states “As a general matter, evidence of pharmacological or other biological activity of a compound will be relevant to an asserted therapeutic use if there is a reasonable correlation between the activity in question and the asserted utility. *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 206 F.2d 881 (CCPA 1981). An applicant can establish this reasonable correlation by relying on statistically relevant data documenting the activity of a compound or composition, arguments or reasoning, documentary evidence (e.g., articles in scientific journals), or any combination thereof. The applicant does not have to prove that a correlation exists between a particular activity and an asserted therapeutic use of a compound as a matter of statistical certainty, nor does he or she have to provide actual evidence of success in treating humans where such utility is asserted. Instead, as the courts have repeatedly held, all that is required is a reasonable correlation between the activity and the asserted use.” Since mice are routinely used to test anti-cancer drugs for their tumoricidal activity, it is reasonable to assume that the compound, spectaculysem, may be useful as a therapeutic agent. (C) is an incorrect choice. MPEP § 2145, under the subheading “X. Arguing Improper Rationales for Combining References. A. Impermissible Hindsight.” If, as acknowledged by the examiner, a novel microorganism has been discovered, then any product which it makes could not have been anticipated by, or obvious over, the prior art. The examiner’s rejection is based purely on hindsight derived from his or her reading of the applicant’s specification.

21. ANSWER: (C) is the most correct answer. MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections,” states “[a] rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.” Answer (C) is not in accordance with the USPTO rules and the procedures set forth in the MPEP. (A), (B) and (D) are incorrect. They are in accord with proper USPTO procedure. See MPEP § 2163.06, under the heading “Review Of New Matter Objections And Rejections.” (E) is not correct because (C) is correct. MPEP § 2163.06.

22. ANSWER: (A) is the most correct answer. MPEP § 2113, under the heading “Product-By-Process Claims Are Not Limited To The Manipulations Of The Recited Steps, Only The Structure Implied By The Steps,” states “‘even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.’ *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).” The issue is whether the claimed mixture Y is the same as or obvious over the patented mixture Y. MPEP § 2113, under the heading

“Once A Product Appearing To Be Substantially Identical Is Found And A 35 U.S.C. 102/103 Rejection Made, The Burden Shifts To The Applicant To Show An Unobvious Difference,” states “[o]nce the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).” Evidence that the two processes produce different properties is germane to the issue of patentability of the product-by-process claim. Accordingly, a comparison of the results obtained by conducting the process recited in the claim versus the process used by patent A and which shows that the claimed product exhibits an unexpectedly lower melting point would be a persuasive demonstration that, although the products would appear to be substantially identical, in fact, they are patentably different. *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). Therefore, the best reply to the outstanding rejection would be to argue that the claimed product has an unexpectedly lower melting point and to support that argument with evidence showing that the result of the patent A process is a mixture with higher melting point as compared to the claimed product. (B) is not the most correct answer. The patentability of a product-by-process claim is determined on the basis of product characteristics, not process steps. (C) is not the most correct answer. The declaration is conclusory, as opposed to being factual. Thus, the argument is not supported by facts. As stated in MPEP § 716.02(c), under the heading “Opinion Evidence,” “Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).” Thus, the reply in (A) is the most correct answer vis-à-vis (C). (D) like answer (B), is not the most correct answer for the same reason discussed for (B). (E) is not the most correct answer. Like answer (C), this reply rightly focuses on product properties. But without the comparative factual evidence to support it, this reply is weaker than one described in answer (A).

23. ANSWER: (B) is the most correct answer. See 37 CFR § 10.87. As to (A), practitioner may not limit damages under 37 CFR § 10.78. As to (C), see 37 CFR § 10.89(b)(1). As to (D), see 37 CFR § 10.89(c)(4). As to (E), see 37 CFR § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

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

25. ANSWER: (D) is the most correct answer. See MPEP § 1211.02. (D) is not a proper basis for remand because the Board has no authority to require the examiner to consider an affidavit which has not been entered after final rejection and which was filed while the application was pending before the examiner. Pursuant to 37 CFR § 1.195, “[a]ffidavits...submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.” The facts are silent regarding whether such a showing was made. However, as discussed in MPEP § 715.09, “Review of an examiner’s refusal to enter [and consider] an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941).” Thus, remand by the Board cannot be expected. Support for each of answers (A), (B), (C) and (E) is specifically provided for in MPEP § 1211.

26. ANSWER: Answer (A), describing a procedure that is not in accordance with the USPTO rules and the procedures set forth in the MPEP, is the most correct answer. See MPEP § 609, under the heading “Minimum Requirements for an Information Disclosure Statement,” and subheading “B(3). Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97 (d)”, and subheading “B(5) Statement Under 37 CFR 1.97(e).” The statement specified in 37 CFR § 1.97(e) requires that the practitioner certify, after reasonable inquiry, that no item of information contained in the IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of the information disclosure statement. The practitioner cannot certify this because the reference was known to the client before February 11, 2002, the time of filing of the utility application, which was more than three months prior to the filing of the information disclosure statement. Answer (B), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(a), a petition to withdraw the application from issue is not required if a proper RCE is filed before payment of the issue fee. Answer (C), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. A practitioner can file a continuing application on or before the date that the issue fee is due and permit the parent application to become abandoned for failure to pay the issue fee. Answer (D), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(3), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit the express abandonment of the application in favor of a continuing application. Answer (E), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(2), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit consideration of a Request for Continued Examination (RCE) under 37 CFR § 1.114. See also MPEP § 1308.

27. ANSWER (B) is the most correct answer. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947) (holding that the “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 CFR § 1.131(b)); MPEP § 715.07(a). (A) is incorrect. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); MPEP § 715.07(a). Applicant must show evidence of facts establishing diligence. (C) is incorrect. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958) (after conception has been clearly established, diligence must be considered prior to the effective date is clearly established, since diligence then comes into question); MPEP § 715.07(a). (D) is

incorrect. MPEP § 715.07(c). 37 CFR § 1.131(a) provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103 - 182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103 - 465, the Uruguay Round Agreements Act. Not all countries are members of NAFTA or WTO, and prior invention in a foreign country cannot be shown without regard for when the reduction to practice occurred. (E) is incorrect. MPEP § 715.07. Actual reduction to practice generally, but not always, requires a showing that the apparatus actually existed and worked, "There are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204 (Fed. Cir. 1995) (citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

28. All answers were accepted.

29. ANSWER: (A) is the most correct answer. See MPEP § 512, which states "The Certificate of Mailing procedure does not apply to papers mailed in a foreign country." (B) is not correct. See MPEP § 512. Certificate of transmission procedure applies to correspondence transmitted to the Office from a foreign country and an amendment is not prohibited from being transmitted by facsimile and is not precluded from receiving the benefits under 37 CFR § 1.8. (C) is not correct. See MPEP § 609, under the heading "Time for Filing." An IDS will be considered to have been filed on the date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR § 1.8. (D) is not correct. See MPEP § 706.07(h) Comparison Chart. An RCE is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8. (E) is not correct. See MPEP § 1206. An appeal brief is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8 because it is required to be filed in the Office within a set time period which is 2 months from the date of appeal.

30. ANSWER: (B) is the most correct answer. 37 CFR § 1.75(c). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 CFR § 1.75(c). Answer (A) broadens the range by going below the stated limit. Answer (E) broadens by trying to remove a recited component of the second gas, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term "consists" in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language "such as" is improper under 35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

31. ANSWER: (E) is the most correct answer. MPEP § 410 makes clear that the certification requirement set forth in 37 CFR § 10.18(b) "has permitted the PTO to eliminate the separate

verification requirement previously contained in 37 CFR ...1.27 [small entity statements], ...1.52 [English translations of non-English documents], ...1.55 [claim for foreign priority], [and] ...1.102 [petition to make an application special].”

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

33. ANSWER: (A) and (E) are accepted as correct answers. Regarding (E), see MPEP § 2131. To anticipate a claim, the elements of a reference “must be arranged as required by the claim...” See MPEP § 2131, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In (E), the on/off switch of Lancer’s toothbrush is arranged differently than that of the claimed toothbrush. (A) is accepted as correct because the given facts do not specify the location of the power supply as being included within the toothbrush. Though the description of the toothbrush as being electric can imply an inherent source of power, it may also may imply an external power source for the electric toothbrush. Accordingly, (A) is also accepted as a correct answer in the circumstances. (B) is incorrect because evidence of secondary considerations, such as commercial success, is irrelevant to a 35 U.S.C. § 102 rejection. See MPEP § 2131.04. (C) is incorrect. “Arguments that the alleged anticipatory prior art... ‘teaches away from the invention’ ...[are] not ‘germane’ to a rejection under section 102.” MPEP § 2131.05 (quoting *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986)). (D) is incorrect. “The term ‘others’ in 35 U.S.C. 102(a) refers to any entity which is different from the inventive entity. The entity need only differ by one person to be ‘by others.’ This holds true for all types of references eligible as prior art under 35 U.S.C. 102(a) including publications...” MPEP § 2132. Here, because Lancer is only one of three inventors of the claim, the patent is by others.

34. ANSWER: (A) is the most correct answer. MPEP § 2144.03 provides that when an applicant seasonably traverses an officially noticed fact, the examiner may cite a reference teaching the noticed fact and make the next action final. Here, applicant did seasonably traverse the noticed fact by demanding proof in response to the rejection. It is therefore an appropriate action by the examiner. It is also an appropriate action because the examiner should vacate a rejection based on official notice if no support for the noticed fact can be found in response to a challenge by the applicant. See *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970) (“[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work” and “[a]llegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should also be supported”). (B) is incorrect because (A) is correct. (C), (D), and (E) are incorrect because action III is improper. An applicant is entitled to respond to a rejection by requesting reconsideration, with or without amending the application. 37 CFR § 1.111(a)(1). Applicant is also required to timely challenge a noticed fact in order to preserve the issue for appeal. MPEP § 2144.03.

35. ANSWER: (E) is correct because 37 CFR § 1.321(a) states, in pertinent part, that “any patentee may disclaim or dedicate to the public...any terminal part of the term, of the patent granted.” 35 U.S.C. § 173 states, “Patents for designs shall be granted for the term of fourteen years from the date of grant.” (A) is wrong because such action would not permit Igor to financially exploit any portion of the term of his patent, since 37 CFR § 3.56 indicates that the result is a conditional assignment, which is regarded as an absolute assignment for Office purposes. (B) is wrong because 37 CFR § 1.321(a) provides for dedication to the public of “the entire term, or any terminal part of the term” only. “[T]he first five years of the patent term” does not qualify as a terminal part of the term. (C) is wrong because Igor would not achieve his objective of dedicating at least a portion of his patent term to the public, since the term of the design patent would expire on January 23, 2015. 35 U.S.C. § 173. (D) is wrong because 37 CFR § 1.321(a) restricts a disclaimer to “any complete claim or claims” or “the entire term, or any terminal part of the term” of a patent. “Royalties received from licensing” are not addressed by 37 CFR § 1.321(a).

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

37. ANSWER: (A) is the most correct answer. MPEP § 1214.06, under the heading “Examiner Sustained in Whole or in Part.” Under the heading “No Claims Stand Allowed” it states “Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected.” (B) and (C) are not the most correct answers. These options would apply to applications where the Board reversed the rejection of the dependent claims and affirmed the rejection of the independent claim. (D) is not correct. The Board does not render a decision on objected to claims. See 37 CFR § 1.191(c). (E) is not correct because the mailing of a Board decision does not abandoned an application. See 37 CFR § 1.197(a).

38. ANSWER: (E) is the most correct answer. As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR § 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR § 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

39. ANSWER: (D). MPEP § 710.02(e), under the heading “Final Rejection – Time For Reply” states, “If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application...” Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, *i.e.*, May 31, 2000. 37 CFR § 1.192(a) recites, in pertinent part, “Appellant must, within two months from the date of the

notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate.” (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

40. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 111(b)(2); 37 CFR § 1.51(c); MPEP §§ 601 and 601.01(b). 35 U.S.C. § 111(b)(2) states that “[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” The documents and other components recited in answers (A) through (C) and (E) are required in a provisional application. See 35 U.S.C. § 111(b); 37 CFR § 1.51(c).

41. ANSWER: (B) is the most correct answer. See MPEP § 2143.03. To establish *prima facie* obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art. (A) is incorrect. See MPEP § 2141.01(a). Although an argument that the reference is nonanalogous art may be appropriate, it is overcome by the acknowledgment that the reference may be reasonably pertinent to the applicant’s endeavor to solving the particular problem with which the inventor was concerned. As discussed in MPEP § 2141.01(a), under the heading “To Rely On A Reference Under 35 U.S.C. 103, It Must Be Analogous Prior Art,” which quotes *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), to rely on a reference as a basis for rejection of the applicant’s invention, “the reference must either be in the field of the applicant’s endeavor or, if not, be reasonably pertinent to the particular problem with which the inventor was concerned.” Here, the argument acknowledges that reference may be reasonably pertinent to the applicant’s problem solving endeavor. (C) is incorrect. U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. See MPEP § 2136.02 under the heading “The Supreme Court Has Authorized 35 U.S.C. 103 Rejections Based On 35 USC 102(e).” (D) is incorrect. MPEP § 716.01(c), under the heading, “To Be Of Probative Value, Any Objective Evidence Should Be Supported By Actual Proof,” states “Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results....” It also quotes from *In re De Blauwe*, 736 F.2d 699, 222 USPQ 191, 196 (Fed. Cir. 1984), “It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification does not suffice.” *De Blauwe*, 736 F.2d at 705, 222 USPQ at 196. Here, the conclusory statement in the specification does not suffice. (E) is incorrect. MPEP § 2145, subsection VIII (under the heading “Arguing About The Age Of References”), quoting from *In re Wright*, 569 F.2d 1124, 193 USPQ 332, 335 (CCPA 1977), states “The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem.” Here, the mere fact that the Foreman patent issued 105 years before the filing date of the pending patent application is unpersuasive of the non-obviousness of the applicant’s claim

42. ANSWER: (E) is the most correct answer. See MPEP § 706.02(b), 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.

43. ANSWER: (A) is the most correct answer. See 37 CFR § 1.33(c). (B) is incorrect. See MPEP § 403. Powers of attorney to firms filed in executed applications filed after July 2, 1971, are not recognized by the Patent and Trademark Office. However, the firm's address will be considered to be the correspondence address. (C) is incorrect. See MPEP §§ 402.02 and 406. The associate attorney may not appoint another attorney. (D) is incorrect. 37 CFR § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (E) is incorrect. See MPEP § 402.05. Revocation of the power of the principal attorney or agent revokes powers granted by him or her to other attorneys or agents.

44. ANSWER: (C) is the most correct answer. A *prima facie* case of obviousness exists where the claimed ranges and the prior art are close enough that one of ordinary skill in the art would have expected them to have the same properties. See MPEP § 2144.05. In Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985), a claim recited a titanium base alloy consisting essentially of 0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, and the balance titanium. A prior art reference described two similar alloys: (i) one with 0.25% molybdenum, 0.75% nickel, and balance titanium; and (ii) another with 0.31% molybdenum, 0.94% nickel, and balance titanium. The court held:

As admitted by appellee's affidavit evidence from James A. Hall, the Russian article discloses two alloys having compositions very close to that of claim 3, which is 0.3% Mo and 0.8% Ni, balance titanium. The two alloys in the prior art have 0.25% Mo-0.75% Ni and 0.31% Mo-0.94% Ni, respectively. The proportions are so close that prima facie one skilled in the art would have expected them to have the same properties. Appellee produced no evidence to rebut that prima facie case. The specific alloy of claim 3 must therefore be considered to have been obvious from known alloys.

Id. Thus, (A) is incorrect. (B) and (D) are incorrect because a claim is anticipated by a prior art reference only when the prior art discloses, either expressly or inherently, every limitation of the claimed invention. (E) is incorrect because (C) is correct.

45. ANSWER: (B) is the most correct answer. MPEP § 1208.01 states: "Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a)." Thus, to avoid waiver of the right to contest the examiner's action, the appellant must file a timely petition. (A) is incorrect because the question of whether an answer contains a new ground of rejection is a petitionable, not appealable, matter. See MPEP § 1201. (C) is incorrect because an amendment or new evidence is needed to overcome the new ground of rejection and merely presenting arguments will not succeed. (D) is incorrect because the entry of the amendment or evidence is subject to the provisions of 37 CFR §§ 1.116 and 1.195 and there is no assurance that the examiner will approve entry. (E) is incorrect because it will constitute a waiver on the question of whether an impermissible new ground of rejection has been entered.

46. ANSWER: (D) is the most correct answer. Under 37 CFR § 1.85(a), correcting the drawings to comply with 37 CFR § 1.84(a)(1) and (k), and making them suitable for reproduction is a *bona fide* response. (A), (B), and (C) are not the most correct answer. In each, Smith seeks to

hold the requirement in abeyance. As stated in 37 CFR § 1.85(a), “Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action.” See also, MPEP § 608.02(b), under the heading “Informal Drawings,” which states “[u]nless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance. A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (37 CFR 1.135(c)).” (E) is not the most correct answer inasmuch as (A), (B), and (C) are not the most correct answers.

47. ANSWER: (C) is the most correct answer. MPEP § 608.01, under the heading “Illustrations In The Specification,” states “[t]he specification, including any claims...may not contain drawings or flow diagrams.” With respect to answers (A) and (B), see MPEP § 608.01, under the heading “Illustrations In The Specification,” states, “[t]he specification, including any claims, may contain chemical formulas and mathematical equations...” As to answer (D), see MPEP § 608.01(m), which states that periods may not be used elsewhere in the claim except for abbreviations and that each claim begins with a capital letter and ends with a period. As to (E), see MPEP § 608.01, which states, “The...claims may contain tables only if necessary to conform to 35 U.S.C. 112.”

48. ANSWER: (D) is the most correct answer. Gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP § 716.03(b).

49. ANSWER: (A) is the most correct answer. See MPEP § 2106.02 under the heading “Affidavit Practice (37 CFR 1.132).” Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a *prima facie* case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02, under the heading “Arguments of Counsel,” and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02, under the heading “Affidavit Practice (37 CFR 1.132),” and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02, under the heading “Affidavit Practice (37 CFR 1.132),” and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, under the heading “Referencing Prior Art Documents,” and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

50. ANSWER: (D) is the most correct answer. See MPEP § 2173.05(c), under the heading “Open-Ended Numerical Ranges.” Paraphrasing the explanation therein, when an independent

claim recites a composition comprising “at least 20% iron” and a dependent claim sets forth specific amounts of non-iron ingredients which add up to 100%, apparently to the exclusion of iron, an ambiguity is created with regard to the “at least” limitation unless the percentages of the non-iron ingredients are based on the weight of the non-iron ingredients. On the other hand, a composition claimed to have a theoretical content greater than 100% (*i.e.*, 20-80% of iron, 20-80% of gallium, and 1-25% of copper) is not necessarily indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. Here, because the invention is a non-theoretical alloy, the sum of the claimed constituents cannot exceed 100% unless the percentage is based on weight. In (D), the sum of elements (B) and (C) is 81% by volume, leaving only 19% for iron. Claim 1, however, requires “at least 20% iron,” rendering Claim 2 ambiguous as to the percentage of element A. (A) is incorrect. The sum of gallium and copper components is 80%, leaving a possible 20% of the composition for element iron. Claim 1 requires “at least 20% iron,” which includes 20% iron. Therefore, the sum of iron, gallium and copper components in Claim 2 is 100%. (B) is incorrect. “At least 20% iron” includes 21% iron, “at least 10% gallium includes 11% gallium, and “at least 10% copper” includes 10.01% copper. (C) is incorrect. “At least 20% iron” includes 20% iron, “at least 10% gallium includes 10% gallium, and “at least 10% copper” includes 10% copper. (E) is incorrect because Claim 1 uses the open transition phrase “comprising,” which permits additional elements to be added to the composition. Nothing in the problem indicates that an additional component, silver, cannot be added to the composition.