

United States Patent and Trademark Office
Registration Examination for Patent Attorneys and Agents
October 15, 2003

Afternoon Session Model Answers

1. ANSWER: (A) is the most correct answer. 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. (B), (C), (D) and (E) are incorrect. 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.

2. ANSWER: (D) is the most correct answer. MPEP §§ 1403 and 1412.03, under the heading "When A Broadened Claim Can Be Presented." A broadening reissue claim must be filed within the two years from the grant of the original patent. (D) is the most correct and the examiner should examine the case as any other application and address appropriate issues concerning reissue examination. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences). Since applicant filed the amendment by Express Mail, the amendment is treated as being filed with the USPTO on the date of deposit with the US Postal Service. Therefore, (A), (B) and (C) are incorrect answers. A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. Choice (E) is not correct since the mere deletion of an element of a claim does not automatically raise a ground of rejection based on the recapture doctrine. See MPEP § 1412.02.

3. ANSWER: (C) is correct. 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)." (A) is incorrect because the patentability of product-by-process claims is based on the product itself. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Where the end products are the same, the process of making limitations do not have to be given weight in ex parte examination. See *Atlantic Thermoplastics Co. v. Faytex Corp.*, 23 USPQ2d 1481, 1490-91 (Fed. Cir. 1992) (product-by-process claims are treated differently for patentability purposes during *ex parte* examination in the USPTO than for infringement and validity purposes during litigation). (B) is incorrect because "[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." MPEP § 2113. "To the extent that the process limitations distinguish the products over the prior art, they must be given the same consideration as traditional product characteristics." *In re Hallman*, 210 USPQ 609, 611 (CCPA 1981). Thus, (C) is correct because applicant can show by factual arguments and/or declarations or affidavits under 37 CFR § 1.132 that the

method of making produces a different product and that the differences are unobvious. (D) is incorrect because it does not tend to show that the products are different. (E) is incorrect because the inventor's awareness of prior art is of no consequence to patentability.

4. ANSWER: (C) is the correct answer. 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d); MPEP § 502 (reproducing Rule 1.6(d)(3)); MPEP § 512 (reproducing Rule 1.8(a)(2)(i)(d)); and MPEP § 1817.01. As stated in MPEP § 1817.01, “[a]ll designations must be made in the international application on filing; none may be added later.” The application will not be accorded an international filing date since the practitioner has tried to cure the failure to designate at least one contracting State by filing a paper using facsimile which is not permitted according to 37 CFR §§ 1.6(d)(3) and 1.8(a)(2)(i)(d). (A) is wrong because applicant has failed to comply with Article 11(1)(iii)(b) on such date. See MPEP § 1810 (reproducing PCT Article 11(1)(iii)(b)). (B) is wrong because according to 37 CFR 1.6(d)(3) and 37 CFR 1.8(a)(2)(i)(d), applicant cannot file an international application by facsimile. See MPEP § 502 (reproducing 37 CFR § 1.6(d)(3)); MPEP § 512 (reproducing 37 CFR § 1.8(a)(2)(i)(d)). Since no designations were included on filing, the application papers cannot be accorded an international filing date. See PCT Article 11(1)(iii)(b). Applicant cannot correct this by filing the designation sheet by facsimile. See MPEP § 502 (reproducing Rule 1.6(d)(3)); MPEP § 512 (reproducing Rule 1.8(a)(2)(i)(d)). (D) is wrong because according to PCT Rule 80.5, when a response is due on a day where the receiving Office is not open for business, applicant has until the next business day. See Appendix T of the MPEP. (E) is incorrect because (C) is correct.

5. ANSWER: (C) is the most correct answer. MPEP § 2163, under the heading “GENERAL PRINCIPLES GOVERNING COMPLIANCE WITH THE “WRITTEN DESCRIPTION” REQUIREMENT FOR APPLICATIONS,” and subheading “New or Amended Claims,” states “A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) (‘[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any ‘aryl or substituted aryl radical’ would be suitable for the purposes of the invention but rather that only certain aryl radicals and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.’).” (A), (B), (D) and (E) are incorrect. Each lists a proper way to demonstrate satisfaction of the written description requirement. MPEP § 2163.02, under the heading “STANDARD FOR DETERMINING COMPLIANCE WITH THE WRITTEN DESCRIPTION REQUIREMENT,” provides that the written description requirement is met “when the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).” Possession may be shown in a variety of ways “including description of an actual reduction to practice, or by showing that the invention was ‘ready for patenting’ such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119

F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991).”

6. ANSWER: (D) is the most correct answer. 37 CFR § 1.56; MPEP § 2001.05. 37 CFR § 1.56(a) sets forth a duty to disclose information that is material to patentability. MPEP § 2001.05 states that “information is not material unless it comes within the definition of 37 CFR 1.56(b)(1) or (b)(2). If information is not material, there is no duty to disclose the information to the Office.” The information that moon dust was never actually used is not material as defined under 37 CFR § 1.56(b)(1) or (2) which state that information is material if “(b)(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office or, (ii) Asserting an argument of patentability.” That the use of the moon dust as part of an erasure formulation was only theorized and not actually used is acceptable as is an example for making it. MPEP § 608.01(p), II, under the heading “Simulated or Predicted Test Results Or Prophetic Examples,” states that “[s]imulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. ... Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted.” Care, however, must be taken not to state that an experiment was actually run or conducted when it was not and that “[n]o results should be presented as actual results unless they have actually been achieved.” MPEP § 2004, item 8. (A) is incorrect. 37 CFR § 1.56(a) requires that individuals associated with the filing and prosecution of a patent application have a duty to disclose information to the Office. 37 CFR § 1.56(c) defines which individuals are associated with the filing and prosecution of a patent application and that “(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are: (1) Each inventor named in the application; (2) Each attorney or agent who prepares or prosecutes the application; and (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.” Point is part of the Sales department and no facts were presented that substantively involved him in the preparation or prosecution of the application. Additionally, as noted in the explanation relating answer to (D), the information given to Point by Tip was not material information. (B) is incorrect. While Tip would be an individual identified under 37 CFR § 1.56(c), there is no material information to be disclosed as noted in the explanation to (D). (C) is incorrect. As noted in the explanation relating to (D), the information is not material. Additionally, as noted in the explanation to answer (A), Point is not an individual defined by 37 CFR 1.56(c) as owing a duty. (E) is incorrect. As there is no requirement that it be explicitly stated that an invention has or has not been actually conducted, as noted in the explanation of (D), the prosecution need not be continued for the purpose of supplying an information disclosure statement regarding the development of the moon rock erasure formulation.

7. ANSWER: (A) is the best answer. 35 U.S.C. § 102; MPEP § 2131.01, under the heading “Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference,” states “that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of

anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). (B) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent property. See MPEP § 2131.01. (C) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent function of oxygen. See MPEP § 2131.01. (D) is incorrect. The prior art reference, to anticipate the claimed invention, is not required to recognize an inherent ingredient, oxygen. See MPEP § 2131.01. (E) is incorrect because (B), (C), and (D) are incorrect, as explained above.

8. ANSWER: (E) is the most correct, because statements (2) and (3) are true. The entire period for which diligence is required must be accounted for. MPEP § 2138.06, under the heading "The Entire Period During Which Diligence Is Required Must Be Accounted For By Either Affirmative Acts Or Acceptable Excuses," states "[a]n applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough)." MPEP § 2138.06, under the heading "Work Relied Upon To Show Reasonable Diligence Must Be Directly Related To The Reduction To Practice," states "[t]he work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). 'U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue.'" (A) is incorrect because statement (1) is not true – an inventor or his attorney need not drop all other work to establish reasonable diligence. *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974); MPEP § 2138.06. (B) is incorrect because it does not include true statement (3). (C) is incorrect because it does not include true statement (2). (D) is incorrect because it includes false statement (1).

9. CREDIT GIVEN FOR ALL ANSWERS.

10. ANSWER: (E) is the most correct answer. 37 CFR § 1.99; MPEP § 610. Rule 1.99 provides that a third party may submit in a published application a foreign-language publication and an English language translation of pertinent portions of the publication. The submission must "identify the application to which it is directed by application number," . . . "include the fee set forth in § 1.17(p)," include "a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;" . . . a "copy of each listed patent or publication in written form or at least the pertinent portions;" and an "English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon." (A) is incorrect. 37 CFR § 1.99 does not authorize a third-party submission of materials or things other than patents or publications. See 37 CFR § 1.99; MPEP § 610. Thus, submission of a videotape under §1.99 is

not authorized. (B) is incorrect. A third-party submission under 37 CFR 1.99 may not include explanations. See 37 CFR § 1.99(d); MPEP § 610. (C) is incorrect. A third-party submission under 37 CFR 1.99 may not include markings or highlights on the publications. See 37 CFR § 1.99(d); MPEP § 610. (D) is incorrect because a protest cannot be filed in a published application. See 37 CFR § 1.291(a)(1); MPEP 1901.06.

11. ANSWER: (E) is the most correct answer. 35 U.S.C. § 251; 37 CFR § 1.53(f); MPEP § 1403. Filing a broadened reissue application with at least one broadening claim prior to the expiration of the two-year time period set in the statute satisfies the diligence provisions of 35 U.S.C. § 251. The executed reissue oath/declaration and the filing fee may be filed at a later time. According to MPEP § 1403, a reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR § 1.53(f). The reissue applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR § 1.16(e). See MPEP § 1410.01. (A), (B) and (D) are clearly incorrect since the inventors and assignee would be barred from a broadening reissue if filed after the two year period set in the statute. (C) is incorrect since the reissue application was filed without at least one broadening claim prior to the expiration of the two-year time period set in 35 U.S.C. § 251.

12. ANSWER: (C) is the most correct answer. MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of this type of statutory process include ...[a] method of controlling a mechanical robot which relies upon storing data in a computer that represents various types of mechanical movements of the robot, using a computer processor to calculate positioning of the robot in relation to given tasks to be performed by the robot, and controlling the robot’s movement and position based on the calculated position.” (A) is a true statement, and is therefore an incorrect answer. As set forth in MPEP § 2105 a “new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter.” (B) is an incorrect answer. As set forth in MPEP § 2106(IV)(B)(2)(b)(i), under the heading “Safe Harbors,” subheading “Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity),” states that “[e]xamples of claimed processes that do not limit the claimed invention to pre-computing safe harbor include: . . . - selecting a set of arbitrary measurement point values ([*In re*] *Sarkar*, 588 F.2d [1330] at 1331, 200 USPQ [132] at 135).” (D) is an incorrect answer. MPEP § 2106(IV)(B)(2)(b)(i) under the heading “Safe Harbors,” subheading “Independent Physical Acts (Post-Computer Process Activity),” states that “[e]xamples of claimed process that do not achieve a practical application include:-step of ‘updating alarm limits’ found to constitute changing the number value of a variable to represent the result of the calculation (*Parker v. Flook*, 437 U.S.584, 585, 198 USPQ 193, 195 (1978).” (E) is a true statement, and therefore is an incorrect answer. MPEP § 2106(IV)(B)(1), under the heading “Nonstatutory Subject Matter” states “[*In re*] *Warmerdam*, 33 F.3d [1354,] at 1361, 31 USPQ2d [1754,] at 1760 (claim to a data structure per se held nonstatutory).”

13. 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 incorrect. The patentability of a product-by-process claim is determined on the basis of product characteristics, not process steps. (C) is incorrect. 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 (B), is incorrect for the same reason discussed for (B). (E) is incorrect. Like (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 (A).

14. ANSWER: The correct answer is answer (E). See MPEP § 706.02(f)(1) in general and Example 7 in particular. (A) is not correct as the publication under 35 U.S.C. § 122(b) does have a prior art date under 35 U.S.C. 102(e). (B) and (D) are not correct because March 27, 2002 and December 1, 2000 are not the earliest prior art date under 35 U.S.C. § 102(e). The publication has an earlier prior art date than March 27, 2002 and December 1, 2000 because of its benefit/priority claims to the international application and the provisional application. See MPEP § 706.02(f)(1). (C) is not correct as it is not a filing date for any application in this question.

15. ANSWER: (C) is the most correct answer. 37 §§ CFR 1.6(d)(3); 1.8(a)(2)(i)(F); 1.495(b); MPEP § 1893.01(a)(1), 2nd paragraph. The filing of the copy of the international application and the basic national fee in order to avoid abandonment under 37 CFR § 1.495(b), as appropriate, may not be transmitted by facsimile. See 37 CFR § 1.6(d)(3) and 37 CFR § 1.8(a)(2)(i)(F). (A) is not the most correct answer because facsimile transmission is not permitted in the situations set forth in 37 CFR § 1.6(d). (B) is not the most correct answer

because even though an oath or declaration may be submitted by facsimile transmission as set forth in MPEP § 602, the national stage submission was improper for the reasons discussed in (C). (D) is not the most correct answer because (C) is the most complete answer. Facsimile transmissions may not be used to file a copy of the international application necessary to enter the national stage. (E) is not the most correct answer because facsimile transmission may be used to file certain correspondence in PCT applications. See MPEP § 1805.

16. ANSWER: (C) is the most correct answer. The principle in Statement 3, that consideration of inherent properties is part of proper consideration of the invention as a whole, is recited in MPEP § 2141.02, under the heading “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry,” and in *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977). (A) is incorrect, because the proper question is whether the invention as a whole, not just the differences, would have been obvious. See MPEP § 2141.02, under the heading “The Claimed Invention As A Whole Must Be Considered,” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). (B) is incorrect because an examiner should consider such assertions by an inventor as part of the “subject matter as a whole.” See MPEP § 2141.02 (citing *In re Spohnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969)). (D) and (E) are incorrect because they include incorrect Statements 1 and/or 2.

17. ANSWER: The correct answer is answer (C). 35 U.S.C. § 102(e); MPEP § 706.02(f). The application publication is a proper reference under 35 U.S.C. 102(e) because it was filed by another prior to the filing date of the invention. See MPEP § 706.02(f) et seq. Answer (A) is incorrect. The reference in answer (A) is not a proper reference under 35 U.S.C. § 102(e) because its international filing date was prior to November 29, 2000 thereby failing one of the three conditions for a WIPO publication of an international application to be applied under 35 U.S.C. § 102(e). See MPEP § 706(f)(1), under the heading “I. Determine The Appropriate 35 U.S.C. 102(e) For Each Potential Reference By Following The Guidelines, Examples And Flow Charts Set Forth Below,” subpart (C), which states “[I]f the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined: (1) If the international application meets the following three conditions: (a) an international filing date on or after November 29, 2000 . . . then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).” The reference in (B) is not a proper reference under 35 U.S.C. § 102(e) because the reference is not by another. See MPEP § 706.02(f). The reference in (D) is not a proper reference under 35 U.S.C. § 102(e) because 35 U.S.C. § 102(e) refers to patents and patent applications, not journal articles. See MPEP § 706.02(f)(1). (E) is not correct because (C) is correct and (A), (B) and (D) are incorrect.

18. ANSWER: (C) is the most correct answer. See MPEP § 605.04(b), which states “Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained...When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The U.S.[PTO] should simply be notified of the error and reference to the notification paper will be made on the previously filed oath or declaration by the Office.” (A), (B) and (D) could result in the spelling of Jon's name being corrected in USPTO records, but would do so at a higher cost to applicant,

and therefore neither one is the most correct answer. Furthermore, (A) is also not correct in that if a request to add John Jones as an inventor was to be filed, another request (and fee) to delete Jon Jones would be required. (B) is wrong because a petition under 37 CFR § 1.182 is not required if the error in the name is a typographical error, and the facts specify that the error in the spelling of “John” as “Jon” is a typographical error. (D) is not correct because not only would filing a continuation create an additional expensive, but filing a new application could also delay examination. (E) is not correct because pursuant to 37 CFR § 1.2, business with the Office is to be conducted in writing, and, even more importantly, because “it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant.” MPEP § 605.04(a).

19. ANSWER: (E) is the most correct answer. MPEP § 2144.06, under the heading “Substituting Equivalents Known For The Same Purpose,” states “[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).” (A) is incorrect. MPEP § 2144, under the heading “Rationale Different From Applicant’s Is Permissible,” states “[t]he reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). . .” (B) is incorrect. MPEP § 2144, under the heading “Rationale May Be In A Reference, Or Reasoned From Common Knowledge In The Art, Scientific Principles, Art-Recognized Equivalents, Or Legal Precedent,” states “[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also . . . *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings).” (C) is incorrect. MPEP § 2144.01, quotes *In re Preda*, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) as stating “[i]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” (D) is incorrect. MPEP § 2144.03 under the heading “A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner’s Conclusion,” states “[o]fficial notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. . . . Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961).”

20. ANSWER: (C) is the most correct answer. 35 U.S.C. § 302; 37 CFR § 1.552; and MPEP § 2258. MPEP § 2258, under the heading “Prior Patents Or Printed Publications,” states “[r]ejections on prior art in reexamination proceedings may only be made on the basis of prior patents or printed publications. Prior art rejections may be based upon the following portions of 35 U.S.C. 102: . . .(e).” (A), (B), (D) and (E) are incorrect. MPEP § 2258, under the heading “Matters Other Than Patents or Printed Publications,” states “[r]ejections will not be based on matters other than patents or printed publications, such as public use or sale, inventorship, 35 U.S.C. 101, fraud, etc. In this regard, see *In re Lanham*, 1 USPQ2d 1877 (Comm'r Pat. 1986), and *Stewart Systems v. Comm'r of Patents and Trademarks*, 1 USPQ2d 1879 (E.D. Va. 1986). A rejection on prior public use or sale, insufficiency of disclosure, etc., cannot be made even if it relies on a prior patent or printed publication. Prior patents or printed publications must be applied under an appropriate portion of 35 U.S.C. 102 and/or 103 when making a rejection.” Reexamination is limited to substantially new questions of patentability based on patents and publications.

21. ANSWER: (A) is the most correct answer. 37 CFR § 1.111; MPEP § 714.02. Section 1.111 states in pertinent part: “(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, . . . must reply and request reconsideration or further examination, with or without amendment. . . . (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. . . .The applicant’s or patent owner’s reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.” MPEP § 714.02 states “In all cases where reply to a requirement is indicated as necessary to further consideration of the claims . . . a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.” (B) and (C) are not the most correct answers. 37 CFR § 1.111; MPEP §§ 714.02 and 714.04. Neither reply specifically points out the supposed errors in the examiner’s action and neither reply present arguments pointing out how the newly presented claims overcome the rejections. (D) is not the most correct answer. See 37 CFR § 1.114. A request for continued examination can only be made if prosecution of an application is closed. In this question the Office action is a non-final office action. (E) is not the most correct answer since (A) is correct and (B), (D) and (D) are incorrect.

22. ANSWER: (E) is the correct answer. (A) is not in accord the patent laws, rules and procedures as related in the MPEP. Regarding (A), MPEP § 601.05, states (“[i]f an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed 37 CFR 1.63 declaration setting forth a different incorrect citizenship of inventor B, the Office will capture the citizenship of inventor B found in the application data sheet. Applicant, however, must submit a supplemental oath or declaration under 37 CFR 1.67 by inventor B setting forth the correct citizenship even though it appears correctly in the application data sheet.

... If, however, the error is one of residence, no change would be required (37 CFR 1.76(d)(2)).” (B) is not in accord the patent laws, rules and procedures as related in the MPEP. As for (B), MPEP § 602, under the heading “Sole Or Joint Designation,” states “[w]hen joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name.” The examiner should notify the inventors that their oaths or declarations are defective and that new oaths or declarations are required. (C) is incorrect. MPEP § 608.01(n), under the heading “II. Treatment Of Improper Dependent Claims,” states “[c]laims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36.” The claim should not be rejected. Further as for (C), MPEP § 608.01(n), under heading “III. Infringement Test,” states “[a] dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.” (D) is not in accord the patent laws, rules and procedures as related in the MPEP. As for (D), MPEP § 609, under heading “(B)(5) Statement Under 37 CFR 1.97(e),” states “[t]he date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner.”

23. ANSWER: (A) or (D) is accepted as correct. As to (A), MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[i]n limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document.” In the facts, the “published abstract provides an adequate basis for concluding that claim 1 is *prima facie* obvious under 35 USC 103.” As to (D) MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[c]itation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Int. 2001) (unpublished).” (B) is incorrect. MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” indicates that documents that are not in English can form the basis of a prior art rejection, although they must be translated first in order to make clear the facts that the examiner is relying on. (C) is incorrect. MPEP § 706.02, under the heading “Reliance Upon Abstracts And Foreign Language Documents In Support Of A Rejection,” states “[w]hen an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full-text document.” (E) is incorrect. See, e.g., MPEP § 2121.01. Whether a disclosure is enabling is a fact-dependent determination that must be made on a case-by-case basis. Even pictures may constitute an enabling disclosure in some cases (MPEP § 2121.04).

24. ANSWER: The filing date of the nonprovisional application, (B), is the correct answer. See MPEP § 201.04(b), which states “[t]he [Uruguay Agreement Round Act] provides a mechanism to enable domestic applicants to quickly and inexpensively file provisional applications. Under the provisions of 35 U.S.C. § 119(e) applicants are entitled to claim the benefit of priority in a given application in the United States. The domestic priority period will not count in the measurement of the 20-year patent term. See 35 U.S.C. 154(a)(3). Thus, domestic applicants are placed on the same footing with foreign applicants with respect to the patent term.” A provisional application is filed under 35 U.S.C. § 119(e) and according to 35 U.S.C. § 154(a)(3), such a filing date is not taken into account in determining patent term. Therefore, (A) is incorrect. The fact pattern states that benefit was properly claimed in the international application to both the provisional application and the national application and that the national stage application filed under 35 U.S.C. § 371 claimed benefit to the filing date of the nonprovisional application under 35 U.S.C. § 120. According to 35 U.S.C. § 154(a)(2), where an application contains a reference to an earlier filed application or applications under 35 U.S.C. § 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed; in this fact pattern that date would be (B), the filing date of the nonprovisional application. The filing date of the international application, (C), is not correct in view of 35 U.S.C. § 154(a)(2) since the international application claimed the benefit under 35 U.S.C. § 120 to the filing date of the nonprovisional application. The date of commencement of the national stage in the United States, (D), is not correct, since the date of commencement of the national stage in the U.S. is not relevant in the determination of the patent term of a patent issuing from the national stage of the international application. Furthermore, as noted in (B) above, since the international application claims the benefit under 35 U.S.C. § 120 to the nonprovisional application, the patent term of the patent issuing from the national stage is measured from the filing date of the nonprovisional application. Finally, the issue date, (E), is not correct, because in 1994, 35 U.S.C. § 154 was amended to provide that for applications filed on or after June 8, 1995, the term of a patent begins on the date the patent issues and ends on the date that is twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. § 120, 121, or 365(c), twenty years from the filing date of the earliest of such application(s).

25. ANSWER: (E) is the most correct answer. Both (A) and (C) are correct. MPEP § 2163.01, under the heading “Support For The Claimed Subject Matter In The Disclosure,” states that “[I]f the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph, or denial of the benefit of filing date of a previously filed application.” (B) is incorrect. MPEP § 2163.01 states that unsupported claims “should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented.” (D) is incorrect because (B) is incorrect.

26. ANSWER: (B) is the most correct answer. MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Can Be Used,” provides that an affidavit under

37 CFR § 1.131 may be used to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(a) but not 35 U.S.C. § 102(b). Also, MPEP § 716 provides that objective evidence traversing a rejection may be presented in a timely submitted affidavit under 37 CFR § 1.132. As for (A), an affidavit under 37 CFR § 1.131 would not serve any useful purpose in those situations. See MPEP § 715. Regarding (C), an affidavit under 37 CFR § 1.131 would be inappropriate. See MPEP § 715, under the heading “Situations Where 37 CFR 1.131 Affidavits or Declarations Are Inappropriate.” As for (D) and (E), a reply including affidavits under 37 CFR § 1.131 and 37 CFR § 1.132 normally would be considered untimely under the circumstances set forth in those answers. See 37 CFR §§ 1.116, 1.192(a) and 1.195. Also, see MPEP §§ 715.09 and 716.01. Consequently, (B) is the most correct answer.

27. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2133.03(b), under the heading “I The Meaning Of ‘Sale’,” subheading “A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent,” “[a]n assignment or sale of the rights, such as patent rights, in the invention is not a sale of ‘the invention’ within the meaning of section 102(b). The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986).” (A) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “A. Conditional Sale May Bar a Patent,” states “[a]n invention may be deemed to be ‘on sale’ even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).” (B) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “Nonprofit Sale May Bar a Patent,” states “[a] ‘sale’ need not be for profit to bar a patent. If the sale was for the commercial exploitation of the invention, it is ‘on sale’ within the meaning of 35 U.S.C. 102(b). *In re Dybel*, 524 F.2d 1393, 1401, 187 USPQ 593, 599 (CCPA 1975) (‘Although selling the devices for a profit would have demonstrated the purpose of commercial exploitation, the fact that appellant realized no profit from the sales does not demonstrate the contrary.’). (C) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b), under the heading “I. The Meaning Of ‘Sale’,” subheading “A Single Sale or Offer To Sell May Bar a Patent,” states “[e]ven a single sale or offer to sell the invention may bar patentability under 35 U.S.C. 102(b). *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92, 94 (1876); *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 836-37, 23 USPQ2d 1481, 1483 (Fed. Cir. 1992).” (D) is incorrect because it is within the scope of “on sale” as it is used in 35 U.S.C. § 102(b). MPEP § 2133.03(b) quotes *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.2d 1041, 1047, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001) as stating “As a general proposition, we look to the Uniform Commercial Code (‘UCC’) to define whether ... a communication or series of communications rises to the level of a commercial offer for sale.”

28. ANSWER: (B). 37 CFR § 1.83(a); MPEP §§ 608.01(l) and 706.03(o). MPEP § 608.01(l) states “[w]here subject matter not shown in a drawing...is claimed in the specification as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter...It is the drawing...that [is] defective, not

the claim. It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing...” MPEP § 608.02(d) and 706.03(o). MPEP § 706.03(o), state “[i]f subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(I).” (A), (C), and (D) are incorrect. See the foregoing quotation from MPEP § 706.03(o). (A) and (C) also are incorrect because objections to drawings are petitionable, not appealable. MPEP §§ 608.02, under the heading “Receipt of Drawing After Filing Date,” and 1002. (D) is incorrect because the petition, filed more than six months after the final rejection, is not timely. A timely petition would be filed within two months from the mailing date of the action or notice from which relief is requested. See 35 U.S.C. § 133; 37 CFR §§ 1.181(f), 1.134 and 1.135(a); and MPEP § 710.01. (E) is incorrect because (B) is correct.

29. ANSWER: The correct answer is (C). See 35 U.S.C. § 172; MPEP § 1504.02. 35 U.S.C. § 172 provides that the time specified in 35 U.S.C. 102(d) shall be six months in the case of designs. Thus, to avoid a statutory bar under 35 U.S.C. § 102(d), the U.S. design patent application must be made within six months of the foreign filing, *i.e.*, by August 6, 2003. MPEP § 1504.02 states “[r]egistration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 102(d), whether or not the foreign grant is published. (See *Ex parte Lancaster*, 151 USPQ 713 (Bd. App. 1965); *Ex parte Marinissen*, 155 USPQ 528 (Bd. App. 1966); *Appeal No. 239-48*, Decided April 30, 1965, 151 USPQ 711, (Bd. App. 1965); *Ex parte Appeal decided September 3, 1968*, 866 O.G. 16 (Bd. App. 1966). The basis of this practice is that if the foreign applicant has received the protection offered in the foreign country, no matter what the protection is called (‘patent,’ ‘Design Registration,’ etc.), if the United States application is timely filed, a claim for priority will vest. If, on the other hand, the U.S. application is not timely filed, a statutory bar arises under 35 U.S.C. 102(d) as modified by 35 U.S.C. 172. In order for the filing to be timely for priority purposes and to avoid possible statutory bars, the U.S. design patent application must be made within 6 months of the foreign filing.” (A) and (B) are incorrect because they are after the six month period. (D) is not correct because it is not the latest date for filing as required by the question. (E) is not correct because answer (C) is correct.

30. ANSWER: (A) is the correct answer. MPEP (8th Ed.) § 715.07, under the heading “Facts and Documentary Evidence” states that “The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference. ... In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.” Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith’s and Jones’s declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of

the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final. (B) and (C) are incorrect choices since the evidence of record shows that Smith and Jones are unable to overcome the prior art. (D) is wrong because an original copy of the published figure which shows that Smith and Jones were not in possession of the claimed invention prior to Bell and Watson publication cannot help their case. (E) is incorrect because prior art under 102(a) is not a statutory bar.

31. ANSWER: (A) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01 As provided in 37 CFR § 1.53(f) and MPEP § 601.01(a), the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. (B), (C), (D) and (E) are incorrect. 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 § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

32. ANSWER: (E) is the most correct answer. MPEP § 410 states that the certification requirement set forth in 37 CFR § 10.18(b) “has permitted the USPTO to eliminate the separate verification requirement previously contained in 37 CFR ...1.48 [correction of inventorship in a patent application], ...1.55 [claim for foreign priority], ...1.102 [petition to make an application special], [and] ... 1.125 [substitute specification].”

33. ANSWER: (E) is the most correct answer. MPEP §§ 2141, 2142, 2143 and 2143.01. Regarding (C) MPEP 2142 under the heading “ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS,” states “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 for decisions pertinent to each of these criteria.” MPEP § 2143 states the same criteria, and further “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” Regarding motivation, MPEP 2143.01 states “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” The examiner has not shown any suggestion or motivation, either in the prior art or in the knowledge generally available to one of ordinary skill in the art, to

modify the known plastic composition. Regarding (D) MPEP § 2142 states “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.” (E) is the most correct answer since it addresses both issues raised by the examiner, obviousness and evidence of improved results. (C) alone is incorrect inasmuch as it does not address the examiner’s comments regarding improved results. (D) alone incorrect because it does not address the examiner’s burden of presenting a *prima facie* case of obviousness. (A) is not correct. MPEP § 2129. Admissions by applicant can be used as prior art. (B) is not correct. MPEP § 2144. It is not necessary for a finding of obviousness that prior art be combined for the same advantage or result as applicant.

34. 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, subsection “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.

35. ANSWER: (A) is the correct answer. See MPEP § 716.10, which states "Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. . . . An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982)." (B) is insufficient in the absence of "objective evidence that an art recognized problem existed in the art for a long period of time without solution." MPEP § 716.04 under heading "THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS." Regarding (C), see MPEP § 716.06: "[M]ore than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985)." (D) is insufficient in the absence of evidence demonstrating that the sales are attributable to the technical merits of the invention rather than to other factors, such as "heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re*

Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973)." MPEP § 716.03(b) under heading "COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION." (E) is incorrect because (A) is correct.

36. ANSWER: The correct answer is (E), "None of the above." (A) is incorrect because the G patent is a 35 U.S.C. § 102(b) statutory bar. See MPEP § 715 under heading "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," states "(A) Where the reference publication date is more than 1 year prior to applicant's or patent owner's effective filing date. Such a reference is a 'statutory bar' under 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2)." (B) is incorrect because 37 CFR § 1.131 expressly provides that prior invention may not be established under the rule "if the rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in 37 CFR 1.601(n)." 37 CFR § 1.131(a)(1). Regarding (C), see MPEP § 715, under heading "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," which states "(G) Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964)." Regarding (D), see MPEP § 715, under heading, "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate," which states "(C) Where the reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than 12 months prior to the filing date of the domestic application. See 35 U.S.C. 102(d)."

37. ANSWER: (D) is most correct answer. As explained at MPEP § 2107.02, II, B, under the heading "No Statement of Utility for the Claimed Invention in the Specification Does Not Per Se Negate Utility," the fact that a specification does not contain a statement of utility for the claimed invention does not *per se* negate utility. This is because a claimed invention may have a well-established utility, and an invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention and (ii) the utility is specific, substantial, and credible. In this case, the declarations specify a specific substantial and credible utility and explain why the declarants (*i.e.*, persons of ordinary skill in the art) would immediately appreciate that the applicant's claimed composition would possess this utility. (A) is incorrect. A lack of utility deficiency under 35 U.S.C. § 101 also creates a lack of utility deficiency under the first paragraph of 35 U.S.C. § 112 as fully explained at MPEP § 2107.01, under the heading "IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101." (B) is not the most correct answer. 35 U.S.C. § 101 (and the first paragraph of 35 U.S.C. § 112) requires that the utility be specific. Therefore, the disclosure of a general utility such as "useful biological" properties does not satisfy this requirement as fully explained at MPEP § 2107.01, under the heading "I. Specific And Substantial Requirements." Response (C) also would not be persuasive since the rejection is based on the fact that the applicant's specification fails to identify any

specific and substantial utility for the claimed composition or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. This is explained at MPEP § 2107.01. The fact that the claimed composition has unambiguously proven to be useful for curing a form of cancer previously thought to be incurable does not negate these specification deficiencies. That is, notwithstanding this unambiguous proof, the fact remains that the applicant's specification fails to identify any specific and substantial utility for the composition. Moreover, it is clear that the specification would not make this specific usefulness immediately apparent to those familiar with the technological field of the composition since the cancer was previously thought to be incurable. Finally, response (E) also would not be persuasive. Under current USPTO policy and procedure, the examiner is not required to present evidence in support of a rejection based on lack of utility where, as here, the specification does not identify a specific, substantial and credible utility and does not appear to provide sufficient information such that a well-established utility would be apparent to a person with ordinary skill in the art. See MPEP § 2107, under the heading "II. Examination Guidelines For The Utility Requirement."

38. ANSWER: (E) is the most correct answer. MPEP §§ 306 and 307. MPEP § 306 states, "In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications." MPEP § 307 states, "Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied." A new assignment document need not be recorded for a divisional or continuation application where the assignment recorded in the parent application remains the same. Accordingly, (A), (B) and (D) are incorrect. In addition, (A), (B) and (D) are incorrect because unless an assignee's name and address are identified in item 3 of PTOL-85B, the patent will issued to the applicant and the assignee information, even if recorded, will not appear on the patent. (C) is incorrect for the same reason. (B) is also incorrect. Assignment data is reflected on the filing receipt, PAIR, or a patent application publication when applicant includes assignment information for purposes of publication of the application on the transmittal letter. Assignment data printed on the patent will be based solely on the information supplied on the Issue Fee Transmittal Form PTOL-85B. See MPEP §§ 1309 and 1481. Accordingly, (E) is correct and (C) is incorrect.

39. ANSWER: The correct answer is (D). PCT Article 11(1)(iii)(e); 35 U.S.C. § 363; 37 CFR § 1.431(a); MPEP § 1810. Under PCT Article 11(1)(iii)(e) to be accorded an international filing date an application must have "a part which on the face of it appears to be a claim or claims." (A) and (C) are incorrect. Under PCT Rule 19.4 if an application is not filed in the prescribed language or is filed by an applicant for which the Office to which the application is submitted is not competent, such application will be forwarded to the International Bureau which will act as receiving Office and accord a filing date as of the date of receipt in the USPTO. (B) is not correct. The Request may be signed by an attorney or agent who is registered to practice before the USPTO. In such a situation the application will be accorded an international filing date of September 18, 2002, and under PCT Article 14 an invitation to correct the defect will be

mailed. See MPEP § 1805, paragraph 7; MPEP 1810, under the heading “The ‘International Filing Date,’” second paragraph. (E) is also incorrect. Under PCT Rules 14.1(c), 15.4(a), 16.1(f), and 16bis.1 the fees may be paid at a date later than the original receipt date.

40. ANSWER: (B) is the most correct answer. 35 U.S.C. § 102(e)(1) provides that a US published application of a national stage of an international application filed on or after November 29, 2000 has a prior art effect as of its international filing date, if the international application designated the United States, and was published in English. Because in the above fact pattern, the international application designated the United States and was published in English, and was filed on or after November 29, 2000, the USPTO published application is entitled to its international filing date of January 5, 2001 for prior art purposes under 35 U.S.C. § 102(e)(1). See Example 4 of MPEP § 706.02(f)(1). (A) is wrong because the Japanese filing date is relevant under 35 U.S.C. § 119(a) only for priority and not prior art purposes. (C) and (E) are wrong because they recite prior art dates that are later than January 5, 2001. (D) is wrong because the prior art date under 35 U.S.C. § 102(e)(1) is earlier than the application publication date, June 6, 2002.

41. ANSWER: (D) is the most correct answer. 37 CFR § 1.111(b); MPEP §§ 818.03(a)-(c). MPEP § 818.03(a) states “[a]s shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) . . . Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error.” An election must be made even if the requirement is traversed. MPEP § 818.03(b). Answer (A) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action, and no election is made. 37 CFR § 1.143. MPEP § 818.03(a) states “[a] mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR 1.111.” Answer (A) is also incorrect because no election is made. MPEP § 818.03(b) states, “[a]s noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed. (B) is incorrect. MPEP § 818.03 since the traversal does not distinctly point out the supposed errors in the examiner’s action. (C) is incorrect since no election is made. See MPEP § 818.03(b) (E) is incorrect because (D) is correct.

42. ANSWER: (C) is the most correct answer. 37 CFR § 1.193(a)(2); MPEP § 1208.01. If the claimed invention is rendered obvious by Smith in view of Jones and Brown, the statement of rejection must include all three references. Reliance on Brown to support the rejection is a different rejection from a rejection relying only on Smith in view of Jones. In accordance with MPEP § 1208.01, the Board will not consider the teachings of Brown because Brown was used to support the rejection, but was not listed in the statement of the rejection. As stated in MPEP § 1208.01, “Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).” Therefore, (B) and (D) are clearly wrong. (A) is incorrect. The decision cannot affirm the rejection since there is no motivation for combining the teachings of Smith and Jones absent the teachings of Brown. Therefore, the rejection must be reversed, not affirmed.

43. ANSWER: (E) is the most correct answer. See 37 CFR § 1.76(d)(3); MPEP § 601.05. The oath or declaration filed under 37 CFR §§ 1.63 or 1.67 governs any inconsistency with the Application Data Sheet (ADS) when the inconsistency relates to the setting forth the citizenship of the inventor(s) even if the ADS was filed after the filing of the oath or declaration. (A) is incorrect because an ADS is a voluntary submission in either a provisional application or a nonprovisional application. See 37 CFR 1.76(a). (B) is an incorrect answer because the information related to the naming of inventors 37 CFR § 1.41(a)(1) and the information relating to setting forth citizenship 35 U.S.C. § 115 is governed by the oath or declaration filed under 37 CFR §§ 1.63 or 1.67 regardless if the two documents are filed simultaneously. (C) is an incorrect answer because the ADS will govern an inconsistency concerning the claiming of domestic priority information. See 37 CFR § 1.76(d)(2). (D) is an incorrect answer because the information related to the naming of inventors 37 CFR § 1.41(a)(1) and the information relating to setting forth citizenship 35 U.S.C. § 115 is governed by the oath or declaration filed under 37 CFR §§ 1.63 or 1.67 regardless of whether or not the ADS is filed after the oath or declaration under 37 CFR §§ 1.63 or 1.67.

44. ANSWER: (B) is the most correct answer. MPEP § 2111.03 (fourth paragraph) states, in reliance upon *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976), that “[t]he transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” (A) is incorrect. The statement is contradicted by MPEP § 2111.03 (second paragraph), which states, in reliance upon *Genentech, Inc. v. Chiron Corp.*, 112, F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) that “[t]he transition term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. (C) is incorrect. The statement is contradicted by MPEP § 2111.03 (third paragraph), which states, in reliance upon *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931) that “[t]he transitional phrase ‘consisting of’ excludes any element, step, or ingredient not specified in the claim.” (D) is incorrect. The statement is directly contradicted by MPEP § 2111.03 (third paragraph), which states “[a] claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.” (E) is incorrect because (A), (B) and (C) are incorrect.

45. ANSWER: (B) is the most correct answer. 37 CFR § 1.192(c)(7); MPEP § 1206, under the heading “Appeal Brief Content,” subheading “(7) Grouping of Claims.” 37 CFR § 1.192(c)(7) requires that an appellant perform two affirmative acts in the brief to receive separate consideration of the patentability of a plurality of claims that are subject to the same rejection. The appellant must (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable. Since the appellant here has only performed the two affirmative acts with respect to claims 1, 4 and 6, these are the claims that the Board must consider separately for patentability. The examiner has no input on the grouping of claims. (D) is incorrect inasmuch as § 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. See MPEP § 1206, subheading subheading “(7) Grouping of Claims.” Where the grouping of claims section is inconsistent with the arguments section as in the facts of this case, the examiner should have notified the appellant that the brief was in noncompliance as per 37 CFR § 1.192(d). See *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020

(Bd. Pat. App. & Int. 1991). However, failure of the examiner to note noncompliance does not require the Board to separately consider claims which have not been specifically argued in the brief. (A) is incorrect inasmuch as the two affirmative acts required by § 1.192(c)(7) to have the separate patentability of a plurality of claims subject to the same rejection considered, i.e., (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable, have not been presented for each of claims 1-10. (C) is incorrect because the provisions of § 1.192(c)(7) have been satisfied for claims 1, 4 and 6. (E) is wrong because the provisions of § 1.192(c)(7) have been satisfied. (A), (C) and (D) are incorrect answers.

46. ANSWER: (C) is the best answer. 35 U.S.C. § 102; MPEP §§ 2111 and 2131. MPEP § 2131, under the heading, “To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Here, every element of the claim is found in Patent A. See MPEP 2111, under the heading “Claims Must Be Given Their Broadest Reasonable Interpretation,” where it explained that “[d]uring patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification,” and cites *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) to explain that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” (A) and (B) are incorrect. MPEP § 2111. The claim, as written, is not allowable over Patent A since Patent A disclosed every element recited in the claim. (D) is incorrect. There is no need to search again for a building material, this time looking for balsa wood. The claim has not been amended to be directed to balsa wood. Since it still broadly recites “wood,” Patent A that discloses pine remains germane and anticipates the claim. (E) is incorrect for one or more reasons. It is incorrect because it wrongly agrees with the practitioner’s argument that Patent A is poor reference. It also is incorrect because it seeks to reject the claim over 35 U.S.C. § 112, second paragraph, for indefiniteness. The claim is clear on its face and there is nothing indefinite about what the claim says. This answer makes the mistake of confusing breadth with indefiniteness. The claim is broad but it is definite.

47. ANSWER: (C) is the most correct answer. 35 U.S.C. § 102(a); MPEP § 2132. As set forth in MPEP § 2132, under the heading “II. ‘In This Country,’” subheading “Only Knowledge or Use In The U.S. Can Be Used in a 35 U.S.C. 102(a) Rejection,” states “[t]he knowledge or use relied on in a 35 U.S.C. 102(a) rejection must be knowledge or use ‘in this country.’ Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under 35 U.S.C. 102(a). *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). Note that the changes made to 35 U.S.C.104 by NAFTA (Public Law 103-182) and Uruguay Round Agreements Act (Public Law 103-465) do not modify the meaning of ‘in this country’ as used in 35 U.S.C. 102(a) and thus ‘in this country’ still means in the United States for purposes of 35 U.S.C. 102(a) rejections.” See also MPEP § 706.02(c), “[t]he language ‘in this country’ means in the United States only and does not include other

WTO or NAFTA member countries.” Since “in this country” means in the United States for purposes of 35 U.S.C. § 102(a) rejections, (A), (B), (D) and (E) are incorrect.

48. ANSWER: (C) is correct. 37 CFR § 1.181(f); MPEP §§ 714.13 and 1002: 37 CFR § 1.181(f) provides “The mere filing of a petition will not stay the period for reply to an Examiner’s action which may be running against an application, nor act as a stay of other proceedings.” MPEP §§ 714.13 states “[i]t should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner’s action which may be running against an application.” See also MPEP § 1002. Thus, if a petition to vacate a final rejection as premature is filed within 2 months from the date of the final rejection, the period for reply to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full reply to the rejection within the period for reply, the case is not abandoned. (C) is correct because the petition does not stay the time for responding to the final and a reply should be filed within the shortened statutory period to avoid fees. (A) is incorrect because any reply after the shorted statutory period set for reply in the final rejection will require at least payment of fees for an extension of time. MPEP § 1002 states “The mere filing of a petition will not stay the period for replying to an examiner’s action which may be running against an application, nor act as a stay of other proceedings (37 CFR 1.181(f)). For example, if a petition to vacate a final rejection as premature is filed within 2 months from the date of the final rejection, the period for reply to the final rejection is not extended even if the petition is not reached for decision within that period.” (B) is incorrect because the application will be abandoned 6 months after the date of the final rejection for lack of reply to the final rejection, 35 U.S.C. 133, and a status inquiry filed 6 months after filing the petition would be in an abandoned application. Moreover, a petition status inquiry filed at any time is not a proper reply to the final rejection. See 37 CFR §§ 1.113(c) and 1.116. (D) is incorrect because the filing of a petition does not stay the period for reply. 37 CFR § 1.181(f); MPEP §§ 714.13 and 1002. (E) is incorrect because (C) is correct, and (A), (B) and (D) are incorrect.

49. ANSWER: (E) is the most correct answer. 37 CFR § 1.75(c); MPEP § 608.01(n), under the heading “II. Treatment Of Improper Dependent Claims,” 37 CFR § 1.75(c) provides “One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.” Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. See MPEP §§ 608.01(l) and 2163. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 CFR § 1.75(c). Claim 11 is an improper dependent claim because it is inconsistent with and does not further limit the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 redefines the minimum memory by setting a lower minimum of ½ gigabyte.

50. ANSWER: (C) is the most correct, as a 35 U.S.C. § 102(g) rejection requires actual reduction to practice by another, and lack of abandonment, suppression, or concealment. MPEP § 2138 states “35 U.S.C. 102(g) may form the basis for an ex parte rejection if: (1) the subject matter at issue has been actually reduced to practice by another before the applicant’s invention; and (2) there has been no abandonment, suppression or concealment. See, *e.g.*, *Amgen, Inc. v.*

Chugai Pharmaceutical Co., 927 F.2d 1200, 1205, 18 USPQ2d 1016, 1020 (Fed. Cir. 1991); *New Idea Farm Equipment Corp. v. Sperry Corp.*, 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990); *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434, 7 USPQ2d 1129, 1132 (Fed. Cir. 1988); *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1444-46, 223 USPQ 603, 606-08 (Fed. Cir. 1984).” (A) is incorrect, as actual reduction to practice is not sufficient to establish a 35 U.S.C. § 102(g) rejection where the subject matter has been abandoned, suppressed, or concealed. MPEP § 2138. (B) is incorrect, as abandonment, suppression, or concealment is not sufficient to establish a 35 U.S.C. § 102(g) rejection where the subject matter has been reduced to practice in that conception alone is not sufficient. See *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1445, 223 USPQ 603, 607 (Fed. Cir. 1984). MPEP § 2138. (D) is incorrect because no prior patent application is required for a § 102(g) rejection. MPEP § 2138. Similarly, (E) is incorrect, because no prior patent application nor issued patent is required for a rejection under 35 U.S.C. § 102(g).