

**United States Patent and Trademark Office**  
**Registration Examination for Patent Attorneys and Agents**  
**October 16, 2002**

**Afternoon Session Model Answers**

1. ANSWER: (D) is the best answer as the inventions must be the same in the foreign and U.S. applications. As to (A) through (C), see MPEP § 605.07 at p. 600-49, right column. 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.

2. 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 C.F.R. § 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 C.F.R. § 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.).

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

4. ANSWER: (E) is correct and (A), (B), (C) and (D) are wrong. As a former employee of the USPTO, the former examiner is incapable of acquiring an interest, directly or indirectly, in a patent application in the manner described in the question during the period of appointment as an examiner, and for one year thereafter. 35 U.S.C. § 4; MPEP § 309. Inasmuch as the former examiner resigned from the USPTO on June 7, 2001, the former examiner is incapable of

acquiring an interest in the application in said manner until June 8, 2002. Registration as a practitioner does not affect the restrictions on the former examiner.

5. ANSWER: Choice (B) is the correct answer. MPEP § 2001.01, and 37 C.F.R. § 1.56(c). MPEP § 2001.01 states that “the duty applies only to individuals, not to organizations...the duty of disclosure would not apply to a corporation or institution as such.” (A) is incorrect because the duty of disclosure applies to each inventor named in the application. 37 C.F.R. § 1.56(c)(1). (C) and (D) are each incorrect because the duty of disclosure applies to an each attorney or agent who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). (E) is incorrect because, in the case of a person who is not a named inventor or an attorney or agent but who prepares or prosecutes the application, the duty of disclosure applies to each such 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. 37 C.F.R. § 1.56(c)(3).

6. ANSWER: (E) is the most correct answer. For (A) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by... providing reasoning or arguments... .” For (B), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by amending the claims... .” For (C) *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a declaration under 37 C.F.R. § 1.132...rebutting the basis or logic of the prima facie showing.” For (D), *see*, “Utility Examination Guidelines,” 66 F.R. 1092, 1099, left column (Jan. 5, 2001). “The applicant can do this by...providing evidence in the form of a...printed publication...rebutting the basis or logic of the prima facie showing.” (A), (B), (C), and (D) alone are not the most correct answer inasmuch (E), referencing all of the above, is the most correct answer.

7. ANSWER: (B) is the correct answer. 37 C.F.R. § 1.133 (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54640-54641 (September 8, 2000). As stated in 65 FR at 54641, left column, “Comment 65: One comment urged that interviews be allowed in a CPA prior to a first action. Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP.” Thus, (B) is correct. (A) is incorrect because interview will not be permitted off Office premises without the authority of the Commissioner. 37 C.F.R. § 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 C.F.R. § 1.133(a)(2). (D) is incorrect because (B) is correct. (E) is incorrect because (A) and (C) are incorrect.

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

9. 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).

10. ANSWER: (B). MPEP § 706.01. (A) and (C) are incorrect. As stated by MPEP § 706.01, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” (D) is incorrect. MPEP § 706.03(d). (E) is incorrect. As stated in MPEP § 706.01, “If the form of the claim (as distinguished from its substance) is improper, an “objection” is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § § 608.01(n).”

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

12. ANSWER: Choice (A) is the correct answer. MPEP § 409.03; MPEP § 09.03(d); and 37 C.F.R. § 1.47(a). (B) and (D) are each incorrect because MPEP § 409.03, subpart (d) states that “The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 C.F.R. § 1.47.” (C) is incorrect because MPEP § 409.03(d) further states that “the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 C.F.R. § 1.47.” (E) is incorrect because each of (B), (C), and (D) are incorrect.

13. ANSWER: (A). MPEP 605.04(a) provides that non-initialed or non-dated alterations are not in accord with 37 C.F.R. § 1.52(c). As to (C) see MPEP § 605.04, which states that the Office will not consider whether noninitialed and/or nondated alterations were made before or after the signing of the oath or declaration but will require a new oath or declaration. As to (C), MPEP § 605.04(a) provides that non-initialed or non-dated alterations are not in accord with 37 C.F.R. § 1.52(c). As to (D), see MPEP § 605.04(a). As to (E), according to MPEP § 605.04(a), it is improper for an applicant to sign an oath or declaration which is not attached to or does not identify the patent application.

14. ANSWER: (D) is correct. (A), (B) and (C) are wrong because MPEP § 601.01(c) states, “Claiming priority is less expensive [than conversion] and will result in a longer patent term.”

Conversion requires payment of the conversion fee. (D) is correct because MPEP § 601.01(c) states, “In addition, if the provisional application was not filed with an executed oath or declaration and the filing fee for a non-provisional application, the surcharge set forth in 37 C.F.R. § 1.16(e) is required. (E) is wrong because the action taken claims priority under 35 U.S.C. § 119(e)(1) rather than conversion under 37C.F.R. § 1.53(c)(3). No surcharge is required.

15. ANSWER: (A) is accepted as the most correct answer. MPEP § 2173.05(e). Claim 2 is indefinite because it is not clear which “said pipe” the claim is referring to since claim 1 recites a copper pipe and an aluminum pipe. Accordingly, claim 2 provides the basis for a proper rejection under 35 U.S.C. § 112, second paragraph. In (B), claim 3 would be construed as definite, inasmuch as “the outer circumference” is an inherent part of the pipe and would not require antecedent recitation. Thus claim 3 does not provide a proper basis for the rejection. Therefore, (B) and (D) would be incorrect. Claim 4 is definite inasmuch as there is antecedent basis for “said plastic valve.” Therefore, (C) and (E) are incorrect.

16. ANSWER: (C). MPEP 2163.03, item I. Original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). (A) and (B) are incorrect. As stated in MPEP 2163.03, item I, “An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” There is no supporting disclosure in the original description of the invention for the holder to a clasp, crimp, or tong. (D) is incorrect. MPEP 2163.03, item IV. A broad generic disclosure is not necessarily a sufficient written description of a specific embodiment, especially where the broad generic disclosure conflicts with the remainder of the disclosure. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). (E) is not correct because (C) is correct.

17. ANSWER: (D) is the most correct answer. MPEP § 608.01(n). (A) is incorrect because a dependent claim must further limit the subject matter of a previous claim. 37 C.F.R. § 1.75(c). The claim in (B) is actually inconsistent with claim 1. (B) is incorrect because there is no antecedent basis for the wheels. MPEP § 2173.05(e). (C) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (D) is correct.

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

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

(II), and see *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980).

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

21. ANSWER: Choice (B) is the correct answer. MPEP § 1205, and 37 C.F.R. § 1.191(a). MPEP § 1205 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.” Choices (A), (C), and (D) are each incorrect because Applicant’s claims were not twice or finally rejected. 37 C.F.R. § 1.191(a). MPEP § 706.01 in pertinent part provides, “The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.” Choice (E) is incorrect because Choices (A), (C), and (D) are incorrect.

22. ANSWERS: (D) and (E) were accepted. As to (D), see MPEP § 201.03 at p. 200-4. The language in answer (D) is literally found in MPEP § 201.03, which states, “Requests under 37 CFR 1.48 are generally decided by the primary examiner except . . . (D) When a second conversion under 37 CFR 1.48(a) is attempted (decided by the Technology Center (TC) Director).” Answer (E) was accepted inasmuch as the word “conversion” in answer (D) and MPEP 201.03 at page 200-4 may be confusing. Although answer (D) references 37 CFR 1.48, which addresses correction of inventorship, answer (D) uses “conversion,” a word that is not typically used when addressing correction of inventorship. To the extent “conversion” in answer (D) and MPEP 201.03 at page 200-4 may be inaccurate terminology in the context in which it was used, it may have caused some candidates to select answer (E), none of the above. Answer (E) is dependent on answer (D). Inasmuch as answer (D) used inaccurate terminology, selection of answer (E) can be a reasonable alternative. Accordingly, answer (E) was accepted at this time. Answers (A), (B) and (C) are independent of the content of answer (D). Thus, selection of these answers, which are incorrect, was not accepted as a correct answer. As to (A) the petition to be filed would be under 37 C.F.R. § 1.183. As to (B), 35 U.S.C. § 116 provides that inventors may apply for a patent jointly. A person not named in the application could not file a petition under 37 C.F.R. § 1.48 as this would not be a joint filing. In accordance with MPEP 1901.05, unless a protestor has been granted access, the protestor is not entitled to any information including the fact that the application exists. MPEP at 1900-6. The patent application process is *ex parte*, and inventorship may only be contested *inter partes* (between opposing parties) in the USPTO through the interference process. MPEP § 1901.07 precludes the protestor from further

participation beyond submission of the protest. See also 37 C.F.R. § 1.291(c). (C) is incorrect at least for the reasons that if the application is involved in an interference the Board will decide the petition. See MPEP § 201.03.

23. ANSWER: (C) is the best choice because there is no provision for design patents under PCT. MPEP § 1502.01. (A) is a true statement. MPEP § 1502.01. (B) is a true statement. MPEP § 1502. (D) is a true statement. MPEP § 1504.01(a), I.A. (E) is a true statement. MPEP § 1504.01(b).

24. ANSWER: (D) is correct. (D) is correct because 35 U.S.C. § 111(b)(2) states, “A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” MPEP § 201. (A) is wrong because an application for reissue must contain the entire specification, including the claims, and the drawings of the patent. 37 C.F.R. § 1.173(a). (B) is wrong because a design patent application contains a single claim. 37 C.F.R. § 1.53(b); MPEP § 1503.03. (C) is wrong because a continuation patent application is a second application for the same invention claimed in a prior nonprovisional application and filed before the original becomes abandoned or patented. MPEP § 201.07. (E) is wrong because 35 U.S.C. § 162 states, “The claim in the specification shall be in formal terms to the plant shown and described.” MPEP § 1605.

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

26. ANSWER: (B) is the most correct answer. The cancellation of Claim 3 overcomes the examiner’s objection. The addition of Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 C.F.R. § 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (C) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (D) alone is not

the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C. Answer (E) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2.

27. ANSWER: (C) is correct 35 U.S.C. § 102(e); MPEP § 804, Chart III-A. (C) is correct because section I. of MPEP § 706.02(f) states, “If (1)...the applications are commonly assigned and (2) the effective filing dates are different, then a provisional rejection of the later filed application should be made.” (A) is wrong because the facts do not indicate prior knowledge or use by others, or that the application Y is patented or published. (B) is wrong because the facts do not indicate that the application Y is patented or published, or the existence of “public use” or “on sale” bars. (D) is wrong. This is a statutory double patenting situation that cannot be avoided by filing a terminal disclaimer. See *In re Bartfeld*, 17 USPQ2d 1885 (Fed. Cir. 1991). MPEP § 706.02(f), section I; MPEP § 804.02, part I. (E) is wrong. It is improper to make a nonprovisional rejection under § 102(e) in the circumstances described in the question. Choice (E) provides for an improper nonprovisional rejection under § 102(e). MPEP § 804, Chart I-A.

28. ANSWER: (E) is the best answer. The declaration need not be notarized. See 37 C.F.R. § 1.63(a). A declaration may be used in lieu of an oath. 37 C.F.R. § 1.68, MPEP 602. As to (A) through (C) see 35 U.S.C. § 115. As to (D), see MPEP § 602.04 at p. 600-34, left column.

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

30. ANSWER: Choice (D) is the correct answer. MPEP § 812.01. Choices (A), (B), and (C) are each incorrect because MPEP § 812.01 reads, “If, on examination, the examiner finds the elected claims to be allowable and no traverse was made, the letter should be attached to the Notice of Allowability form PTOL-37 and should include cancellation of the nonelected claims, a statement that the prosecution is closed, and that a notice of allowance will be sent in due course.” Choice (E) is incorrect because only choice (D) is correct.

31. ANSWER: (B). MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-

Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (D) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

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

33. ANSWER: (D) is correct. (A), (C), and (E) are wrong because MPEP § 706.07(f), paragraph (I), states, “Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant’s authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 C.F.R. § 1.136(a).” (B) is wrong because MPEP § 706.07(f), paragraph (H), states, “Note that an examiner’s amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.”

34. ANSWER: (D) is correct. 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a) states, “[A]pplicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed...” (A) is wrong because the response was not timely filed since it was received by the USPTO after the SSP expired. (B) and (C) are wrong. The reply was not filed on May 14, 2002, because the conditions of 37 C.F.R. § 1.10(b) were not satisfied. For example, the number of the “Express Mail” mailing label must have been placed on each page of the response prior to the original mailing by “Express Mail.” The petition should not be expected to be granted inasmuch as the papers did not include the number of the “Express Mail” mailing label on them. See § 1.10(c)(2), (d)(2), and (e)(2). (E) is wrong because 37 C.F.R. § 1.10(b) requires that “the number of the ‘Express Mail’ mailing label must have been placed on each page of the response prior to the original mailing by ‘Express Mail.’” Emphasis added.

35. ANSWER: (C). As to (C), according to MPEP § 608.01 at p. 600-58, “In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric units (SI) followed by the equivalent English units when describing their inventions in the specifications of patent applications.” As to (A), see MPEP § 601.05 at p. 600-21 and 37 C.F.R. § 1.76 (d)(3), regarding

the oath or declaration controlling over the application data sheet. See also MPEP § 608.01(a) at p. 600-61. As to (B), see MPEP § 608.01(a) at p. 600-60 regarding hyperlinks. As to (D), see 37 C.F.R. § 1.52(a); and MPEP § 608.01. As to (E) see MPEP § 608.01 at p. 600-56 and 37 C.F.R. § 1.52.

36. ANSWER: (C) is correct. 37 C.F.R. § 1.251(a)(3). (C) is correct because there is compliance with 37 C.F.R. § 1.251(a)(3). (A) is wrong because along with a copy of the record, he is required to provide a list of all correspondence, and a statement that the copy is complete and accurate and that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(ii). (B) is wrong because along with a list of all correspondence and a statement that the copy of his record of all the correspondence is complete and accurate, he is required to provide a copy of his record of all the correspondence, and the statement must recite that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(1)(i). (D) is wrong because the statement omits the recitation that he is not aware of any correspondence between his office and the USPTO that is not among his records. 37 C.F.R. § 1.251(a)(2)(ii). (E) is wrong because the statement omits the recitation that the copy of his record of all the correspondence is complete and accurate. 37 C.F.R. § 1.251(a)(1)(iii).

37. ANSWER: (D) is the most correct answer. Reference characteristics mentioned in the detailed description must appear in the drawings. 37 C.F.R. §§ 1.83(a) and 1.84(p)(5); MPEP § 608.02. As to (A), (B), (C), and (E), see MPEP § 608.01(a).

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

39. ANSWER: (A). Item (A) should read, “The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole.” As to (B) through (E), see 37 C.F.R. § 1.73; MPEP § 608.01(a) and (d).

40. ANSWER: (C) is the most correct answer. See MPEP § 2128 under the subheading “Date of Availability,” of the heading “Electronic Publications As Prior Art.” (A) is wrong. See MPEP § 2129 under the heading “A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art.” (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (D) is wrong. See MPEP § 2128.01 under the heading “A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public.” (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); MPEP § 2129 under the heading “Admissions By Applicant Constitute Prior Art.”

41. ANSWER: (E) is the most correct answer. MPEP § 706.02 page 700-20 (8<sup>th</sup> ed.), under the heading “DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION” states “[t]he effective filing date of a U.S. application may be determined as follows: ... (B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. § 112 by the earlier parent application have the effective filing date of that earlier parent application.” Accordingly, the effective filing date of claims 1-10 is 1995 and the effective filing date of claims 11-15 is 2000. Answers (A) and (B) are incorrect because they do not account for the two different effective filing dates. Answers (C) and (D) are both correct, therefore answer (E) which includes both (C) and (D) is the most correct answer.

42. ANSWER: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. See *In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. See *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. See *In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

43. ANSWER: (D). “It is not necessary in order to establish a prima facie case of obviousness...that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by the applicant.” *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (emphasis in original).

Thus, “[i]t is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.” MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Here, T suggests the combination with P to achieve a different advantage or result, *i.e.*, waterproofing, from that discovered by applicant, *i.e.*, reducing breakage. Answers (A) - (C) are incorrect because the suggestion to combine does not need to be for the same purpose as applicant discloses in the application. Dillon, 919 F.2d at 692, 16 USPQ2d at 1900; MPEP § 2144 (“Rationale Different from Applicant’s is Permissible”). Answer (E) is incorrect because an applicant is under no obligation to submit evidence of non-obviousness unless the examiner meets his or her initial burden to fully establish a prima facie case of obviousness. MPEP § 2142.

44. ANSWER: (D). There is no requirement as to the inventive entity being the same. As to (A), see 37 C.F.R. § 1.55(a)(2). As to (E), see MPEP 201.14 at p. 200-82 (right column). As to (C), see MPEP 201.14(a). As to (B), see 37 C.F.R. § 1.55(a)(1)(i) and MPEP 201.14(a).

45. ANSWER: The best choice is (D). Choices (A), (B), (C) and (E) are each TRUE statements. See MPEP at pp. 100-13, 100-12, 100-8 and 100-18, respectively. Choice (D) is NOT TRUE because only the assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. MPEP at p. 100-16. An assignee of record of a part interest is, however, entitled to inspect the application. *Id.*

46. ANSWER: (D) is the best answer. MPEP § 1901.04. (A) is a true statement. MPEP § 1901.01. (B) is a true statement. MPEP § 1901.02, paragraph (G). (C) is a true statement. MPEP § 1901.03. (E) is a true statement. MPEP § 1907.

47. ANSWER: (E) is correct and (A), (B), (C) and (D) are incorrect. As MPEP § 303 states: “Certified copies of patent applications as filed do not include an indication of assignment documents. Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by 37 C.F.R. § 1.19.” (B) is incorrect because the fee required by 37 C.F.R. § 1.19(b)(5) has not been paid for the requested certified copy of assignment records.

48. ANSWER: Choice (B) is the correct answer. MPEP § 402; 37 C.F.R. § 1.34. MPEP § 402 states that “Powers of attorney or authorizations of agent naming firms of attorneys or agents filed in patent applications will not be recognized.” (A) and (D) are each incorrect because according to 37 C.F.R. § 1.34(b), “A principal registered attorney or agent, so appointed, may appoint an associate registered attorney or agent who shall also then be of record.” (C) is incorrect. As stated in MPEP § 402, “Powers of attorney and authorizations of agent under 37 C.F.R. § 1.34(b) naming one or more registered individuals, or all registered practitioners associated with a Customer Number, may be made. See MPEP § 403 for Customer Number practice.” (E) is incorrect because, as set forth in MPEP § 402.07, “A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 C.F.R. § 3.73(b).”

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

50. ANSWER: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The 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.” MPEP § 2144 (citing *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)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris 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. (C) is incorrect. “The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Barry’s device does not teach away from a person of ordinary skill in the art combining it with Lance’s device.