

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

Afternoon Session Model Answers

1. ANSWER: (C) is the correct answer. MPEP § 2133.03(e). The issue is whether the invention was in “public use” more than one year prior to the filing of the application. The crux of the issue is whether the agreement, which is the only evidence the examiner relied upon, indicates that a “public” use has occurred. Issues arising under the public use bar of 35 U.S.C. § 102(b) are determined by considering the totality of the circumstances. In re Brigance, 792 F.2d 1103, 1107, 229 USPQ 988, 991 (Fed. Cir. 1986). The circumstances are that: 1) Even if Cone received the ball, she was limited to using it for experimental, not public, uses. And, finally, 2) even though Cone can conduct experiments with the ball, control of the ball remains with Block. In view of all these facts, the totality of the circumstances leads to the conclusion that a “public use” more than one year prior to the filing of the application did not occur. In view of this response, and assuming no other evidence of a public use is available, the rejection under 35 U.S.C. § 102(b) under these grounds should be withdrawn. (A) is wrong because it is not enough that a document is dated more than one year prior to the filing date of an application for it to constitute a statutory bar under 35 U.S.C. § 102(b). The issue to be addressed by Block is whether the examiner appropriately rejected the claim over the “public use” clause of 35 U.S.C. § 102(b), not the “printed publication” clause. (B) is wrong because whether or not the agreement is a printed publication is irrelevant. The rejection is on the grounds of “public use”, not “printed publication”. (D) is wrong because the issue of whether an invention was “known or used by others in this country” is relevant to a rejection under 35 U.S.C. § 102(a), not § 102(b) which is at issue here. Furthermore, the fact that Cone also signed the agreement suggests “others” were associated with the use of the invention which would mean this response is incorrect even if the issue was the propriety of a rejection under 35 U.S.C. § 102(a). In that situation, the issue would not be whether it was used by others, since it plainly was, but rather whether the use was a “public” one. (E) is wrong because it assumes that the issue is whether the invention was “on sale”. While the rejection was under 35 U.S.C. § 102(b), the “public use” clause, not the “on sale” clause is at issue. Whether or not the ball was on sale or not is irrelevant to overcoming the rejection.

2. 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.

3. ANSWER: The correct answer is (C). 37 C.F.R. § 1.173 and MPEP § 1453 both provide for making amendments in reissue applications. 37 C.F.R. § 1.121(h) refers reissue applicants to § 1.173 for making amendments in reissues. (A), (B), and (D) present proper USPTO procedures, and are therefore incorrect answers. (A) is incorrect as it is consistent with current filing requirements of 37 C.F.R. § 1.173 and MPEP § 1411. (B) is incorrect because it is consistent with the holding in *In re Graff*, 42 USPQ2d 1471, and MPEP § 1412.03. (D) is incorrect because 35 U.S.C. § 251 sets a two-year limit for filing broadened reissue applications. MPEP § 1414. (E) is incorrect because (C) is correct.

4. 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.).

5. ANSWER: (A) is the most correct answer. See 37 C.F.R. § 1.48(b) (where the claims covering that inventor’s invention are cancelled, a statement regarding lack of deceptive intent is not required). (B) is incorrect. See 37 C.F.R. § 1.48(e)(2). (C) is incorrect. See 37 C.F.R. § 1.48(c)(5). (D) is incorrect. See 37 C.F.R. § 1.48(d)(1). (E) is incorrect. See 37 C.F.R. § 1.48(a), (b) & (c).

6. ANSWER: (C) is the most correct answer. MPEP § 715.04 pages 700-207 and 208 (8th ed.), under the heading “WHO MAY MAKE AFFIDAVIT OR DECLARATION” states “[t]he following parties may make an affidavit or declaration under 37 C.F.R. [§] 1.131: ... (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.” In addition, 37 C.F.R. § 1.131(a) states “... the inventor of the subject matter of the rejected claim ... or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration...” Accordingly, answer (A) is incorrect because a declaration with less than all named inventors is acceptable when it is shown that less than all named inventors of an application invented the subject matter of the claim under rejection. Answer (B) is incorrect because the declaration was properly signed. Answer (D) is incorrect because 37 C.F.R.

§ 1.131(a) expressly provides for who must sign the declaration. Answer (E) is incorrect because it is the inventor of the subject matter of the claim under rejection who must sign the declaration, not any inventor named on the application.

7. ANSWER. (B) is the most correct answer. As stated in “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000), “Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. § 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999).” However, the pendency is counted against the patent term. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and there fore is not a correct answer. 35 U.S.C. § 119(e)(3).

8. ANSWER: (C) is the correct answer. 35 U.S.C. § 41(h), 37 C.F.R. §§ 1.17(l) and 1.27(b). (A) is incorrect because 37 C.F.R. § 1.17(p) provides for only one fee for filing an IDS all parties must pay that fee. There is no support in 37 C.F.R. § 1.17(p) for a small entity paying a reduced fee for filing an IDS. (B) is incorrect because it is inconsistent with 37 C.F.R. § 1.8(a)(2)(i)(A). (D) is incorrect because it is inconsistent with 37 C.F.R. § 1.114(a), inasmuch as prosecution is not closed. (E) is incorrect because (C) is correct.

9. 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.

10. ANSWER: (C) is the most correct answer. 37 C.F.R. § 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000). Under 37 C.F.R. § 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 C.F.R. § 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect. (D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

11. ANSWER: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(h)(7).

12. ANSWER: (C) is correct. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance’s device unsatisfactory for its intended purpose. (A) is incorrect. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” MPEP §2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry’s art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

13. ANSWER: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, “Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§

1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...” Thus, choices (C) and (D) are incorrect.

14. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.97(c). (A) and (B) are each incorrect at least because the Office action is non-final and the RCE is improper. 37 C.F.R. § 1.114(b) and MPEP § 706.07(h). According to MPEP § 706.07(h)(III)(A)(1), “If prosecution in the application is not closed, applicant will be notified of the improper RCE and any amendment/reply will be entered.” However, since the submission of the IDS in (A) and (B) is after the mailing of a first Office action, either the fee set forth in 37 C.F.R. § 1.17(p) or a statement as specified in 37 C.F.R. § 1.97(e) is required. 37 C.F.R. § 1.97(c). (C) is incorrect at least because the submission of the IDS is after the mailing of a first Office action, and either the fee set forth in 37 C.F.R. § 1.17(p) or a statement as specified in 37 C.F.R. § 1.97(e) is required. 37 C.F.R. § 1.97(c). (E) is incorrect because (D) is correct.

15. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.121(b), and MPEP § 714, page 700-169 through 172 (8th ed.) (*Amendments, Applicant’s Action*). (A) is incorrect. MPEP § 714, page 700-171 (8th Ed.) (*Amendments, Applicant’s Action*) “After March 1, 2001, all amendments to the specification including the claims must be made by replacement paragraph/section/claim in clean form.” This requirement is regardless of the filing date of the application.” (C) is incorrect. 37 C.F.R. § 1.121(c)(1), and MPEP § 714, page 700-172 (8th ed.) (*Amendments, Applicant’s Action*) “A marked up version does not have to be supplied for any added or cancelled claims.” (D) is incorrect. MPEP § 714, page 700-171 and 172 (8th Ed.) (*Amendments, Applicant’s Action*) all amendments to the specification including the claims must be made by replacement paragraph/section/claim in clean form. Exceptions are not made for inserting priority information. Additionally, the use of replacement pages is not accepted in amending U.S. applications under 37 C.F.R. § 1.121. See Patent Business Goals – Final Rule, 65 *Fed. Reg.* 54639, Response to Comment 61. (E) is incorrect. MPEP § 714.01(e) page 700-174 (8th Ed.) (*Amendments Before First office Action*) A one-month non-extendable time period is given to applicants in which they are to bring the amendment into compliance with 37 C.F.R. § 1.121.

16. 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.

17. ANSWER: The correct answer is (C). Inter partes reexaminations are available only for patents that issued from an original application filed on or after November 29, 1999. 37 C.F.R. § 1.913. An original application is any application other than a reissue application. MPEP § 201.04(a). (A) is incorrect because R2 is a reissue that is based on a patent, which in turn, issued from a patent application that was filed in 1993 (which is before the November 29, 1999 date); and because P3 issued from an application filed before November 29, 1999. (B) is incorrect because R2 is a reissue, and did not issue from an original application, and because an ex parte reexamination of P1 would not permit Mr. Flash to participate in the reexamination. (D) is not the most correct answer because ex parte reexamination of P1 would not permit Mr. Gordon to participate to the same extent as in inter partes reexamination. (E) is incorrect because P3 did not issue from an application filed on or after November 29, 1999.

18. ANSWER: (B) is the correct answer. 35 U.S.C. § 116 states that “[w]hen an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath,” 37 C.F.R. § 1.63(a)(4) states that the oath “must state that the person making the oath or declaration (2) believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought,” 37 C.F.R. § 1.64(a) states that “[t]he oath or declaration...must be made by all of the actual inventors.” Rocket invented all the claimed elements except for the Y-shaped laces. Torpedo’s contribution to the baseball was the Y-shaped laces. Therefore, Rocket and Torpedo must execute the oath. (A) is incorrect because Rocket is not the sole inventor. (C), (D), and (E) are incorrect because neither Cannon nor Missile contributed to any portion of the claim for which a patent is sought.

19. ANSWER: (D) is the most correct answer. 37 C.F.R. § 1.42 states that “[I]n case of the death of the inventor, the legal representative...of the deceased inventor may make the necessary oath.” (A), (B), and (C) are incorrect because the facts do not reveal an assignment to Paper America. Inasmuch as the given facts show that the officers and employees are not related to the Rocket, they may not act as Rocket’s legal representative.

20. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.10 states that “[a]ny correspondence received by the Patent and Trademark Office (Office) that was delivered by the ‘Express Mail Post Office to Addressee’ service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit in with the USPS.” Although the Rocket application could have been deposited in the USPS as early as October 13, 2001, the facts indicate that the application was not actually deposited until October 22, 2001. MPEP § 573. Therefore, the only filing date that the USPTO will accord the application is October 22, 2001. (A), (B), (C) and (E) are incorrect because the application was not deposited in the USPS on any of these dates.

21. ANSWER: (C) is the correct answer. MPEP § 608.04(c) includes the following recitation:

Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.

See, also, MPEP § 706.03(o), which includes the following recitation:

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.

22. ANSWER: (E) is the correct answer. 35 U.S.C. §251. The reissue permits Smarter to broaden the claimed subject (A) is incorrect. There must be copendency between the divisional application and the original application. 35 U.S.C. § 120. (B) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (C) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*, including a divisional reissue application. MPEP § 1402. (D) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*

23. ANSWER: (A). As to (A) see 37 C.F.R. § 1.10(a), which provides, "Any correspondence received by the [USPTO] that was delivered by the 'Express Mail Post Office to Addressee' service of the United States Postal Service (USPS) will be considered filed in the [USPTO] on the date of deposit with the USPS. The date of Deposit with the USPS is shown by the 'date-in' on the 'Express Mail' mailing label or other official USPS notation." As to (B), (C) and (D), no such procedures are available in the USPTO. (C) is wrong since the claims of the application of Mike and Millie may read on the invention of Jill and Jack in which case an interference would be declared to determine priority and only one application would issue. As to (E), see 37 C.F.R. § 1.10(a), which does not require Mike and Millie to certify when they mailed the application for the USPTO to accord them a filing date of September 15, 2001. Mike and Millie followed to the procedures of § 1.10(a) to be accorded a September 15, 2001 filing date.

24. ANSWER: (E) is the most correct answer. MPEP § 706.02 page 700-20 (8th 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.

25. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(a) and (d). The filing of a request for continued examination, including a submission, after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal is considered a request to withdraw the appeal and reopen prosecution of the application before the

examiner. The submission may be an amendment to the written description. 37 C.F.R. § 1.114(c). See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, third complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(3). The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. The filing of an RCE (with a submission and fee) in an allowed application after the issue fee has been paid without a petition under 37 C.F.R. § 1.313 to withdraw the application from issue “will not operate to avoid issuance of the application as a patent.” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, MPEP § 1216.01; and “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.114(e)(1). “The continued examination provisions of 35 U.S.C. § 132(b) and § 1.114...will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. § chapter 12).” See, “Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule,” 65 F.R. 50092, 50095, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

26. ANSWER: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article “shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*” (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because broadened claims may not be filed in a reexamination. (E) is not the best answer because it is not clear there is an “error” under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

27. ANSWER: The correct answer is (C) because (1) the declaration identified the application and the full name and citizenship of both inventors and (2) a copy of the application was sent to inventor B to review and understand. Answer (A) is incorrect because inventor B never reviewed and understood the application prior to signing the declaration form. Answer (B) is incorrect because (1) each declaration form failed to identify all the inventors (e.g. both inventors A and B) and (2) a copy of the application was not sent to inventor B to review and understand. Answer (D) is incorrect because inventor B never signed the declaration. Answer (E) is incorrect because petitions for nonsigning inventors must be filed under 37 C.F.R. § 1.47, not § 1.48.

Even if the petition is treated under § 1.47 a statement, that B's signature could not be obtained at this time, is insufficient.

28. ANSWER: (A) is the most correct answer. 37 C.F.R. § 1.114(d), last sentence. (B), (C), (D), and (E) are not the most correct answers. Each is recognized as being a "submission" within the scope of 37 C.F.R. § 1.114(c).

29. ANSWER: The model answer is choice (E). 37 C.F.R. §§ 1.217(d), 1.14(c)(2), and MPEP § 103, subsection "Published U.S. Patent Applications." 37 C.F.R. § 1.14 provides that while a published application is still pending the file itself will not be available to the public but copies of the application may be ordered. If a redacted copy of the application was published, copies of the redacted application and redacted materials will be provided under 37 C.F.R. § 1.217(d). Answer (A) is incorrect because at least the redacted portion of any subsequent prosecution history can be ordered. Answer (B) is incorrect. Access is not provided to inspect the application file of pending published applications, MPEP § 103. Only copies of the application file may be ordered. Answers (C) and (D) are incorrect because inspection of the application file of a pending published application is not permitted. MPEP § 103. A member of the public may request only copies of the application file.

30. ANSWER: (A) is the most correct answer. 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. (B) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (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. 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. (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.

31. ANSWER: The most correct answer is (E). The application will not be published and the continuing application will have an effective filing date of January 3, 2000. Answer (A) is incorrect because the nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) must be made upon filing. See 35 U.S.C. § 122(b)(2)(B)(i). Answer (B) is incorrect because the provisional application that resulted from the conversion cannot claim the benefit of the first provisional application filed on January 3, 2000. See 37 C.F.R. § 1.53(c)(4). Answer (C) is incorrect because the application will be abandoned and Smith's right in claiming the benefit of the provisional application will be lost. Answer (D) is incorrect because the nonprovisional application filed on January 2, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71.

32. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.194(b) reads “If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner’s answer.” Choices (A), (B), (C) and (D) are not required by 37 C.F.R. § 1.194, and are therefore incorrect answers to the above question. Further, communications with the Office are to be conducted in writing. 37 C.F.R. § 1.4(d).

33. ANSWER: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

34. ANSWER: (B). See 37 C.F.R. § 1.114(e)(1). Answer (A) is wrong because the issue fee has been paid and § 1.114(a)(1) prohibits an RCE unless a petition under § 1.313 is granted. Answer (C) is wrong for the same reason and further if the application had been abandoned an RCE could not be filed. Answer (D) is wrong because RCE practice does not apply to provisional applications under 37 C.F.R. § 1.114(e)(5). (E) is wrong because, as explained in (B), after the issue fee is paid, you cannot file an RCE unless you have successfully withdrawn the case from issue by petition under 37 C.F.R. § 1.313.

35. ANSWER: (D) is correct and (A), (B), (C), and (E) are wrong. Under 37 C.F.R. § 1.211:

(b) Provisional applications under 35 U.S.C. § 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

Emphasis added.

36. ANSWER: (D) is the most correct answer. There is no such refund permitted since 35 U.S.C. § 42(d) only permits a refund of any fee “paid by mistake or any amount paid in excess of that required.” According to the statute, any refund of an “amount paid in excess” must be based upon an overpayment of a fee that was, in fact, required when the fee was paid. See “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000). As to (A) and (B), see “Changes to Implement the Patent Business Goals; Final Rule,” 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000), which states: “[t]his procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps... . Further, the ‘Petition to Make Special’ procedure will continue to be made available without any anticipated increase in the required petition fee.” As to (C), it contains all of the elements of 37 C.F.R. § 1.155(a), which provides “(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination: (1) The application must include drawings in compliance with § 1.84; (2) The applicant must have conducted a

preexamination search; and (3) The applicant must file a request for expedited examination including: (i) The fee set forth in § 1.17(k); and (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.” As to (E), it contains all of the elements of 37 C.F.R. § 1.155(b), which provides “(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.”

37. ANSWER: (D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Einstein. 35 U.S.C. § 302. (A) This is incorrect because a statement by the currently named inventor as required by 37 C.F.R. § 1.324(b)(2) and the fee required by 37 C.F.R. § 1.20(b) have not been filed. (B) This is incorrect, as in *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application, does not apply here, as a reissue application can only be filed by the inventor(s) or assignee(s). See MPEP § 1412.04. (C) This answer is incorrect because it refers to sales, as opposed to patents or printed publications. (E) The option of requesting *inter partes* reexamination is not available in this scenario, as the patent in question issued from an original application which was filed prior to the critical date of November 29, 1999. Only patents which issued from original applications filed in the United States on or after November 29, 1999, are eligible for *inter partes* reexamination (37 C.F.R. § 1.913).

38. ANSWER: (E), which includes answers (A) and (D), is the correct answer. Answer (A) is correct. Where an application is filed identifying the inventorship but an executed declaration under 37 C.F.R. § 1.63 has not been filed, the first submission of an executed declaration under 37 C.F.R. § 1.63 will automatically act to correct the earlier identification of the inventorship. 37 C.F.R. § 1.48(f)(1). Answer (D) is correct. A continuation using a copy of a declaration under 37 C.F.R. § 1.63 from a prior application may be filed naming fewer than all the named inventors in the prior application provided a request for deletion of an inventor accompanies the declaration copy. 37 C.F.R. § 1.53(b)(1), 37 C.F.R. § 1.63(d)(1)(iv), and 1.63(d)(2). Answer (B) is incorrect. Where a declaration under 37 C.F.R. § 1.63, signed by at least one of the inventors, has been submitted to the Office, submission of a second executed declaration under 37 C.F.R. § 1.63 setting forth a different inventive entity will not act to correct the inventorship absent a petition under 37 C.F.R. § 1.48(a). 37 C.F.R. § 1.48(f)(1). Answer (C) is incorrect. Inventorship cannot be corrected by adding an inventor through the filing of a continued prosecution application, rather a petition under 37 C.F.R. § 1.48 is required. 37 C.F.R. § 1.53(d)(4).

39. ANSWER: (E) is the correct answer as both answers (A) and (C) are in accordance with Office practice. Answer (A) is a correct answer as the payment of the small entity filing fee will be treated as a written assertion of entitlement to small entity status pursuant to 37 C.F.R. § 1.27(c)(3). Answer (C) is a correct answer as once small entity status is properly established on filing of the application small entity fees may continue to be paid without regard to a change in status, such as for a claim fee, until the issue fee is due pursuant to 37 C.F.R. § 1.27(g)(1). Answer (B) is not a correct answer. Although a new determination of entitlement to small entity status is made upon payment of the issue fee, a written assertion of entitlement to small entity

status is not required at this time. Once established, small entity status remains in effect unless the facts change. . Answer (D) is not a correct answer. At the time of payment of the issue fee the registered practitioner cannot rely upon the previous written assertion of small entity status completed at the time of filing the application. Applicant must conduct a new investigation as to entitlement to small entity status at the time of payment of the issue fee pursuant to 37 C.F.R. § 1.27(g)(1). If small entity status is determined to continue to be appropriate at the time of payment of the issue fee, a small entity issue fee can be paid based on such determination and a written assertion need not be presented at that time pursuant to 37 C.F.R. § 1.27(e)(1).

40. 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.

41. ANSWER: All answers accepted.

42. ANSWER: (E) is the most correct answer. 37 C.F.R. § 1.33(c). (A) is incorrect. MPEP § 403, p.400-9. Powers of attorney to firms filed in executed applications filed after July 2, 1971, are not recognized by the Patent and Trademark Office. However, the firm's address will be considered to be the correspondence address. (B) is incorrect. MPEP § 402.02, and 406. The associate attorney may not appoint another attorney. (C) is incorrect. 37 C.F.R. § 1.36. An assignment will not itself operate as a revocation of a power or authorization previously given. (D) is incorrect. MPEP § 402.05. Revocation of the power of the principal attorney or agent revokes powers granted by him or her to other attorneys or agents.

43. ANSWER: The correct answer is (B). See MPEP § 201.13. An application must be filed in the U.S. within 12 months from the earliest foreign filing, except as provided in 35 U.S.C. § 119(c). Therefore, you would have one year from December 28, 2000 to file in the U.S. because invention X was first filed in Germany on December 28, 2000. Thus, you have until December 28, 2001 and the USPTO is open for business. The exception in 35 U.S.C. § 119(c) does not apply because the German application was abandoned after the filing of the second foreign application, the French application. Further, the subsequently filed application must be filed in the same country. Answer (A) is not the latest date to file.. See 35 U.S.C. § 21 and MPEP § 201.13, Part D. Answer (C) is too late to obtain the right of priority for invention X inasmuch as the USPTO was open for business on December 28, 2001. Answers (D) and (E) are also too late to obtain the right of priority for invention X as it was disclosed in a foreign application more than a year prior to those dates.

44. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 101, and MPEP § 2173.05(h)(II). (A) is incorrect because the claim presented in (A) attempts to claim a process without setting forth any steps involved in the process. MPEP § 2173.05(q). (C) is incorrect because the claim presented in (C) recites "an effective amount" without stating the function that is to be achieved, and more than one effect can be implied from the specification. *In re Frederickson* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether "an effective amount" in (C) is an effective amount to increase stickiness or an effective amount to

increase hardness. MPEP § 2173.05(c)(III). (D) is incorrect because it is unclear whether “preferably between 15 and 20 degrees Celsius” is a limitation on the scope of the claim presented in (D). MPEP § 2173.05(c)(I). (E) is incorrect at least because the claim presented in (E) claims both a composition and a process of using it. MPEP § 2173.05(p)(II). Further, the portion of the claim in (E) drawn to a process of using the composition does not set forth any steps involved in the process. MPEP § 2173.05(q).

45. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.33(a)(1) (effective November 7, 2000) “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54617 (September 8, 2000). 37 C.F.R. § 1.33(a)(1), in pertinent part provides, “Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.” As stated in 65 FR at 54617, middle column, “The parties who may so change the correspondence address would include only the one inventor filing the application, even if more than one inventor was identified on the application transmittal letter.” Since (A), (B), and (C) are provided for in 37 C.F.R. § 1.33(a)(1), (D) is correct. (E) is incorrect because (D) is correct.

46. ANSWER: (D) is the correct answer. 37 C.F.R. § 1.105(a) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). (A) is specifically stated as an example in 37 C.F.R. § 1.105(a)(1)(v). (B) and (C) are given as examples in 65 FR at 54634, left column, where the Office may require the submission of information. (E) is incorrect because (D) is correct.

47. ANSWER: The model answer is choice (A). MPEP § 608.05 and § 608.05(a) and (b), computer program listing of more than 300 lines (up to 72 characters per line) must be submitted on a compact discs. See 37 C.F.R. §§ 1.96(c) and 1.52(e). Tables over 50 pages and computer program listings of any size under 300 lines (up to 72 characters per line) may be submitted on compact disc. If the table and/or computer program listing is submitted on compact disc then a duplicate copy of each compact disc must also be submitted. Answer B is incorrect since only CD-R and CD-ROM are acceptable media for submitting computer program listing not floppy discs; and it is applicant’s option to file the table on CD-R/CD-ROM media rather than paper. Answer C is incorrect since only CD-R and CD-ROM are acceptable media for submitting computer program listings of over 300 lines, not floppy discs, magnetic tape or paper. Answer D is incorrect because it is not mandatory to submit tables over 50 pages on compact disc while it is mandatory to submit computer program listings over 300 lines (up to 72 characters per line) on compact disc. Also, only CD-R and CD-ROM are acceptable media for submitting computer program listings and tables, not floppy discs, magnetic tape or paper. Answer E is incorrect because only tables over 50 pages, computer program listings and genomic sequence information may be filed on compact disc. 37 C.F.R. § 1.52(e). Also, the compact disc must be provided in duplicate.

48. ANSWER: The correction answer is (B). No extensions of time under 37 C.F.R. § 1.136 are permitted. See 37 C.F.R. § 1.85(c). Therefore, the drawings must be filed three months from the mailing date of the Notice of Allowability, which is June 26, 2002. Answer (A) is not the latest date. Answers (C), (D) and (E) are incorrect as no extensions of time are permitted.

49. ANSWER: (D) is the correct answer. In addition to the surcharge, only what was required in the notice, an executed declaration should be filed. 37 C.F.R. § 1.48(f)(1). As to (A), it is improper to continue to represent that Stripe is an inventor when it is recognized that Stripe is not an inventor. 35 U.S.C. § 116, third paragraph. As to (B), a request to delete an inventor is not necessary because the inventors are not considered named until an executed declaration has been filed. As to (C), a petition under 37 C.F.R. § 1.47 would only be appropriate if Stripe was an inventor. Since he is not, then no declaration naming him should be submitted. As to (E), to avoid abandonment of the application, the missing parts must be filed within the time period set forth in the notice, or as extended by applicant.

50. ANSWER: (D) is the most correct answer. MPEP § 608.01(n), part “IV. Claim Form and Arrangement.” A claim which depends from a dependent claim should not be separated therefrom by any claim which does not also depend from said “dependent claim.” (A), (B), and (C) are incorrect because they are practices permitted by the MPEP. See MPEP § 608.01(n), subsection “IV. Claim Form and Arrangement.” (E) is incorrect because it represents a practice encouraged by MPEP § 608.01(m). See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995).