

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

April 15, 2003

Afternoon Session Model Answers

1. ANSWER: (B) is correct and (A), (C) and (D) are wrong. 37 CFR § 1.27(c)(4) (“The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.”). (E) is also wrong. 37 CFR § 1.27(e)(1) (“Where an assignment of rights...to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.”)

2. ANSWER: (B) is the most correct answer. 35 U.S.C. § 112, second paragraph, and MPEP § 2173.05(c), under the heading “III. Effective Amount.” The claim presented in (B) is improper as “an effective amount” has been held to be indefinite when the claim fails to state the function that is to be achieved and more than one effect can be implied from the specification. *In re Fredericksen* 213 F.2d 547, 102 USPQ 35 (CCPA 1954). It is unclear whether “an effective amount” in (B) is an effective amount to reduce acidity or an effective amount to reduce moisture. The claims presented in (A) and (C) find support in the disclosure, which provides guidelines for determining “an effective amount” for each of the claims in (A) and (C). See MPEP § 2173.05(c) under the heading “III. Effective Amount.” The claim presented in (D) is not indefinite, given that A, B, and C are known materials as set forth in the question and the composition can be determined by the claim language. (E) is incorrect because (B) is correct.

3. ANSWER: (B) is the most correct answer. See 35 U.S.C. § 102(d); MPEP § 2135.01, under the heading “A Continuation - In - Part Breaks The Chain Of Priority As To Foreign As Well As U.S. Parents.” If an applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation - in - part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date of the CIP application is the filing date of the CIP. The applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re van Langenhoven*, 173 USPQ 426, 429 (CCPA 1972); *Ex parte Appeal No. 242 - 47*, 196 USPQ 828 (Bd. App. 1976). (A) is incorrect. 35 U.S.C. § 102(d). (C) is not correct. 35 U.S.C. § 102(d); MPEP § 2135.01, under the heading “An Allowed Application Can Be A ‘Patent’ For Purposes Of 35 U.S.C. 102(d) As Of The Date Published For Opposition Even Though It Has Not Yet Been Granted As A Patent,” citing *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968). An application must issue into a patent before it can be applied in a 35 U.S.C. 102(d) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977). (D) is not correct. 35 U.S.C. § 102(d); MPEP § 2136, under the heading “Defensive Publications Are Not Prior Art As Of Their Filing Date,” citing *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973). (E) is not correct inasmuch as (A), (C) and (D) are not correct.

4. ANSWER: (C) is the most correct answer. As stated in MPEP § 709, under the heading “Request By The Applicant,” subheading “Request for Suspension Under 37 CFR 1.103(b) or (c),” “The Office will not grant the requested suspension of action unless the following requirements are met: (A) the request must be filed with the filing of a CPA or an RCE...(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, *i.e.*, the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension cannot substitute for the submission.” The RCE was improper because no submission in reply to the outstanding Office action accompanied the RCE. Since the RCE was improper, the Office will not recognize the request for suspension. The time period set in the final rejection continues to run from the mail date of the Office action. Since the Office action did not set a period for reply, applicant has a maximum period of six months for reply. A reply was due on February 8, 2003. Since the RCE was improper and the Office did not recognize the request for suspension, the application became abandoned at Midnight of February 8, 2003. (A), (B) and (E) are not correct. As stated in MPEP § 706.07(h), under the heading “Submission Requirement,” “If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 CFR 1.111. See 37 CFR 1.114(c).” An RCE that is not accompanied by a submission is an improper RCE. As stated in MPEP § 706.07(h), under the heading “Initial Processing,” subheading “Treatment of Improper RCE,” “An improper RCE will **not** operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.” The period for filing a proper reply was six months inasmuch as no shortened statutory period for reply was set. A proper reply to the final rejection was not filed. Therefore, the application went abandoned for failure to file a proper reply to the final rejection. (D) is not correct. As set forth in MPEP § 706.07(f) under the heading “Examiner’s Amendments,” paragraph (H), “[a]n 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.”

5. ANSWER: (A) is the most correct answer. See MPEP § 706.02(b), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (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.

6. ANSWER: (C) is the most correct answer. See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03. Since (A), and (B) are incorrect, (E) is incorrect.

7. ANSWER: (A) is the most correct answer. See 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the oath or declaration for an application filed under 37 CFR § 1.53(b) can be submitted after the filing date. Answers (B), (C), (D) and (E) are incorrect. 37 CFR § 1.53(b); MPEP § 601.01. 37 CFR § 1.53(b) provides that a filing date is granted on the date on which a specification as prescribed by 35 U.S.C. § 112 containing a

description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Office. Thus, (B), (C), (D) and (E) are needed to obtain a filing date.

8. ANSWER: (B) is the most correct answer. See 37 CFR §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), under the heading “Specification and Drawings,” and MPEP § 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 CFR § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

9. ANSWER: (C) is the most correct answer. MPEP § 106 states: “[t]he 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. See 37 CFR § 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.” (A), (B), (D), and (E) are incorrect. MPEP § 409.03(i) is directly contrary to answer (A), and provides that a non-signing inventor cannot revoke or give a power of attorney without agreement of all named inventors or the 37 CFR § 1.47(b) applicant. (B) is incorrect. MPEP § 106 does not empower an inventor who has assigned his or her rights to exclude a non-signing joint inventor from accessing an application in which the latter party is named as a joint inventor. (E) is incorrect. MPEP § 106. Corporation D, as an assignee of a part interest, cannot exclude the non-signing joint inventor from access to the application. See also, MPEP § 106.01, which states “While it is only the assignee of record of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.” (D) is incorrect because MPEP § 409.03(i) states that a nonsigning inventor is entitled to inspect any papers in the application, and order copies at the price set forth in 37 CFR § 1.19.

10. ANSWER: (B) is the most correct answer. 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) is the most correct answer. See MPEP §§ 306 and 307. MPEP § 306 states, “In the case of a division or continuation application, a prior assignment recorded against the

original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications.” MPEP § 307 states, “Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee’s name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.” A new assignment document need not be recorded for a divisional or continuation application where the assignment recorded in the parent application remains the same. Accordingly, answers (A), (B) and (D) are incorrect. In addition, (A), (B) and (D) are incorrect because unless an assignee’s name and address are identified in item 3 of PTOL-85B, the patent will issued to the application and the assignee information, even if recorded, will not appear on the patent. (C) is incorrect for the same reason. (B) is also incorrect. There is no connection between the filing receipt, PAIR or the patent application publication and the recorded assignment. Assignment data is reflected on the filing receipt, PAIR, or a patent application publication when applicant includes assignment information for purposes of publication of the application on the transmittal letter. Assignment data printed on the patent will be based solely on the information supplied on the Issue Fee Transmittal Form PTOL-85B. See MPEP §§ 1309 and 1481. Accordingly, answer (E) is correct and answer (C) is incorrect.

12. ANSWER: (D) is the most correct answer. See MPEP § 2292. As to (A) see 37 CFR § 1.602(a). As to (B) see 37 CFR § 1.601(m), which provides that the senior party has earliest effective filing date. As to (C), see MPEP § 2285 regarding merger of reissues and reexamination proceedings. As to (E), (D) is true.

13. ANSWER: (D) is the most correct answer. MPEP § 509.03, under the heading “Correcting Errors In Small Entity Status,” states “37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2).” (A), (B), (C), and (E) are not correct. Small entity status was not appropriate when the assertion of small entity status was filed with the application on November 1, 2002 and none of the actions recited in (A), (B), (C), and (E) would correct the error in claiming small entity status. The only mechanism for correcting a good faith error in claiming small entity status is by filing a request in compliance with 37 CFR § 1.28(c).

14. ANSWER: (C) is the most correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

15. ANSWER: (A) is the most correct answer. See MPEP § 2137.01, under the heading “The Inventor Is Not Required To Reduce The Invention To Practice,” citing *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982). (B) is not correct. MPEP § 2137.01, under the heading “An Inventor Must Contribute To The Conception Of The Invention,” citing *Fiers v. Revel*, 25

USPQ2d 1601, 1604 - 05 (Fed. Cir. 1993); and *In re Hardee*, 223 USPQ 1122, 1123 (Dep. Asst. Comm'r Pat. 1984). (C) is not correct. MPEP § 2137.01, under the heading "As Long As The Inventor Maintains Intellectual Domination Over Making The Invention, Ideas, Suggestions, And Materials May Be Adopted From Others," citing *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965); and *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, 23 USPQ2d 1622, 1626 (Fed. Cir. 1992). (D) and (E) are not correct. 35 U.S.C. § 116; MPEP § 2137.01, under the heading "Requirements For Joint Inventorship."

16. ANSWER: (C) is the most correct answer. When the specification expressly provides a special definition for a term used in the claims, the term must be given that special meaning. See MPEP § 2111.01. (A) is incorrect because a term is given its plain meaning only when the specification does not provide a definition for the term. See MPEP § 2111.01 (B) is incorrect because the specification defines the term as being inclusive of elemental copper. See MPEP § 2111.01. (D) is incorrect because it does not take into account the definition of copper found in the specification. See MPEP § 2111.01.

17. ANSWER: (A) is the correct answer. See 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.

18. ANSWER: (D) is the most correct answer. A non-provisional application filed without at least one claim is regarded as incomplete and will not be accorded a filing date. 35 U.S.C. § 111(a); 37 CFR § 1.53(b); MPEP § 506. (A) is wrong because the component parts of a provisional application necessary to obtain a filing date do not include claims. 35 U.S.C. § 111(b); 37 CFR § 1.53(c); MPEP § 506 under heading "Incomplete Provisional Applications." (B) and (C) are wrong because "[a]n error in or failure to identify inventorship does not raise a filing date issue." MPEP § 506.02. (E) is wrong. Under 37 CFR § 1.8(a)(2)(i)(A) no benefit is accorded to a certificate of mailing date. The effective date is the actual date of receipt, and not the certificate of mailing date.

19. ANSWER: (A) is the most correct answer. As stated in MPEP § 2107.01 under the heading "IV. Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101," "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, under the heading "II. Examination Guidelines For The Utility Requirement," 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, under the heading "II.

Examination Guidelines For The Utility Requirement,” 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. See MPEP § 713.01. An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. (A) is incorrect. 37 CFR § 1.133(a)(2); MPEP § 713.02. Section 713.02 states that although “[a] request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications[,] [a] request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).” (C) is incorrect. MPEP § 713.03. Larry is only sounding out the examiner and has no authority to commit Joe to any agreement reached with the examiner. (D) is incorrect. MPEP § 713.09. Jane has no right to an interview following the final rejection. Although such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration, interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. (E) is incorrect because D is incorrect.

21. ANSWER: (B) is the most correct answer. See MPEP § 708.02, under the heading “IV. Applicant’s Age.” (A) is wrong because MPEP § 708.02, under the heading “IV. Applicant’s Age, states, “[a]n application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement. No fee is required with such a petition.” (C), (D), and (E) are wrong because a fee is required with respect to each petition. MPEP § 708.02, under the headings “II. Infringement,” “VII, Inventions Relating To Recombinant DNA,” and “X. Inventions Relating To HIV/AIDS and Cancer,” respectively.

22. ANSWER: (D) is the most correct answer. See 35 USC §§ 102(e) and 103(c); MPEP § 706.02(l)(1). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g), and that are applied in a rejection under 35 U.S.C. § 103(a). In this situation, the Smith reference was applied in a rejection under 35 U.S.C. § 102(e) and not under 35 U.S.C. § 103(a). See MPEP § 706.02(l)(1). Therefore, the reply in answer (D) would not overcome the rejection. Answer (A) is a proper reply in that it addresses the examiner’s rejection by specifically pointing out why the examiner failed to make a *prima facie* showing. See MPEP § 706.02(b). (B) is incorrect inasmuch as it is a proper reply. See MPEP § 706.02(b). Answer (C) is incorrect inasmuch as it is a proper reply. See MPEP 706.02(b). Answer (E) is not a correct answer because answers (A), (B) and (C) all are replies that are in accordance with the USPTO rules and procedures set forth in the MPEP.

23. ANSWER: (C) is the most correct answer. See MPEP § 1206, specifically the Examiner Note for Form Paragraph 12.69.01 (“This form paragraph should be used only when no supporting reasons are presented in the brief.”). If the examiner disagrees with the reasons given, the reason for disagreement should be addressed in the Examiner’s Answer. As discussed at MPEP § 1208, in the Examiner Note 2 for Form Paragraph 12.55.01 “If the brief includes a statement that a grouping of claims does not stand or fall together but does not provide reasons,

as set forth in 37 CFR 1.192(c)(7), [the examiner is to] notify appellant of the non-compliance using form paragraphs 12.69, 12.69.01 and 12.78.” As discussed at MPEP § 1208, in the Examiner Note for Form Paragraph 12.55.02, if the examiner disagrees with appellant’s statement in the brief that certain claims do not stand or fall together, the examiner explains in the examiner’s answer why the claim grouping listed in the brief is not agreed with and why, if appropriate, *e.g.*, the claims as listed by the appellant are not separately patentable. Answer (A) is incorrect. See MPEP § 1206, Form paragraph 12.17. The Appeal Brief was filed less than seven months after the Notice of Appeal was filed. The applicant should be notified of the deficiency and provided an opportunity to request a five-month extension of time. Answer (B) is incorrect. See MPEP § 1206, Form paragraph 12.12. Answer (D) is incorrect. Where the applicant omits the statement required by 37 CFR § 1.192(c)(7) yet presents arguments in the argument section of the brief, the applicant should be notified of the noncompliance and given time to correct the deficiency. See 37 CFR § 1.192(c)(7); and MPEP § 1206, under the heading “Appeal Brief Content,” subheading “7. Grouping of Claims,” wherein it states, “Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief...the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).” See also MPEP § 1206, under the heading “Review of Brief By Examiner,” wherein it states that “if a brief is filed which does not comply with all the requirements of [37 CFR § 1.192](c), the appellant will be notified of the reasons for noncompliance. Appellant will be given the longest of any of the following time periods to correct the defect(s): (A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer; (B) within the time period for reply to the action from which appeal has been taken; or (C) within 2 months from the date of the notice of appeal under 37 CFR 1.191.” Answer (E) is incorrect. MPEP § 1206, under the heading “Appeal Brief Content,” states “Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c).”

24. ANSWER: (A) is the most correct answer. 37 CFR 1.114, MPEP § 609, paragraph III. B(1)(b), under the heading “RCE and CPA,” and MPEP 706.07(h), under the heading “II. Submission Requirement.” In (A), the information disclosure statement, is a submission under 37 CFR § 1.114(c), and the RCE was filed before the payment of the issue fee. 37 CFR § 1.114(a)(1). (B) is incorrect because the request for continued examination was filed after payment of the issue fee, and is filed without a petition under 37 CFR § 1.313 being granted. Therefore (B) does not satisfy the provision of 37 CFR § 1.114(a)(1). (C) is incorrect because the application becomes abandoned on February 14, 2001 for failure to pay the issue fee. Therefore the request for continued examination does not satisfy the provision of 37 CFR § 1.114(a)(2). (D) is incorrect because a petition under 37 CFR § 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. 37 CFR § 1.313(d). Thus, the request for continued examination in (D) does not satisfy the provision of 37 CFR § 1.114(a)(1). (E) is incorrect because (A) is correct.

25. 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 CFR § 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 CFR § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 CFR § 1.111, it also is an incorrect answer to the above question.

26. ANSWER: (A) is the most correct answer. MPEP § 715.07, under the heading “Facts and Documentary Evidence” states that “The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. ... The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)) at least the conception being at a date prior to the effective date of the reference. ... In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.” Here, the co-inventors admit, and the documentary exhibits relied upon demonstrate that they failed to reduce the claimed invention to practice prior to the publication date of the Bell and Watson reference. It is also apparent that due to the lack of an antenna in the cell phone described in Smith’s and Jones’s declarations and journal article, that the cell phone which was reduced to practice prior to the publication date of the Bell and Watson article would not have worked for its intended purpose. Accordingly, the examiner should maintain the rejection and make it final. (B) and (C) are incorrect choices since the evidence of record shows that Smith and Jones are unable to overcome the prior art. (D) is wrong because an original copy of the published figure which shows that Smith and Jones were not in possession of the claimed invention prior to Bell and Watson publication cannot help their case. (E) is incorrect because prior art under 102(a) is not a statutory bar.

27. ANSWER: (E) is the most correct answer. MPEP § 2112, under the heading “Something Which Is Old Does Not Become Patentable Upon The Discovery Of A New Property,” states that “claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).” The issue is whether the argument has persuasively rebutted the examiner’s *prima facie* case of anticipation. The argument does not rebut the *prima facie* case. The claim is directed to a string consisting only of material Z. Patent A teaches each every element of that string; *i.e.*, the string shape, material Z, and the string only consists of material Z. There is nothing different between the string of the claim and that of patent A. Under those circumstances, examiner correctly stipulated that the stretchability of the claimed string; *i.e.*, the ability to stretch the string beyond its initial unstretched length, would be an inherent property of the disclosed string. Whether or not patent A teaches the stretchability of its string is not defeating. Even if Mr. Bock had discovered a new property for the string, it would still not render the claim patentable. *In re Best, supra*. Here all the product elements are the same and examiner made out a proper *prima facie* case of anticipation. The burden now shifts to the practitioner to show that the patent string is not the same. The reply, which seeks to establish a difference in properties without showing a concomitant difference in product material and shape is not persuasive as to error in the rejection. All the other answers are wrong. (A) is not the most correct answer. See MPEP § 2112. (B) is not the most correct answer. The anticipation

rejection was correctly established and was not rebutted by the argument. (C) is not the most correct answer. See MPEP § 2112, discussing when a reference can anticipate based on an inherent, as opposed to an expressly or implicit, disclosure. (D) is not the most correct answer. In discussing the stretchability property, the recited ability to stretch the string beyond its initial unstretched length was equally addressed.

28. ANSWER: (D) is the most correct answer. 37 CFR § 1.75; MPEP § 608.01(n). As explained in MPEP § 608.01(n), under the heading “Multiple Dependent Claims,” subheading “Acceptable Multiple Dependent Claim Wording” the multiple dependent claim wording of new claims 16-27 is proper. See, for example, “any one of the preceding claims,” and “in any of claims 1-3 or 7-9.” 37 CFR § 1.75(c) states “For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.” Therefore, claims 16-27 would each have a claim value of eleven and the total number of claims for fee calculation is one hundred forty-seven ($12 \times 11 = 132 + 15 = 147$). Answers (A) and (B) are incorrect because they are not the correct total. Answer (C) is incorrect because the multiple dependent claims have not been calculated in accordance with 37 CFR § 1.75. Answer (E) is incorrect because the question asks for the total after the amendment adding claims 16-27 has been entered.

29. ANSWER: (A) is the most correct answer. MPEP § 2121, under the heading “What Constitutes An ‘Enabling Disclosure’ Does Not Depend On The Type Of Prior Art The Disclosure Is Contained In,” states, in reliance upon *In re Moreton*, 288 F.2d 708, 711, 129 USPQ 227, 230 (CCPA 1961): “The level of disclosure required within a reference to make it an ‘enabling disclosure’ is the same no matter what type of prior art is at issue.... There is no basis in the statute (35 U.S.C. 102 or 103) for discriminating either in favor of or against prior art references on the basis of nationality.” Answer (B) is incorrect. MPEP § 2121, under the heading “Prior Art Is Presumed To Be Operable/Enabling,” states that “[w]hen the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable.” Answer (C) is incorrect. MPEP § 2121.01, under the heading “35 U.S.C. 103 Rejections And Use Of Inoperative Prior Art,” quotes *Symbol Technologies Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) as stating that “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.” Answer (D) is incorrect. MPEP § 2121.01 states that “[a] reference contains an ‘enabling disclosure’ if the public was in possession of the claimed invention before the date of invention.” Answer (E) is incorrect because answers (B), (C) and (D) are incorrect.

30. ANSWER: Statement (E) is false, and is thus the most correct answer. Since a redacted copy of the application was used for publication purposes, 37 CFR § 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” For (A) and (B), see 37 CFR § 1.14(b)(2). For (C) see 37 CFR §§ 1.14(b)(2) and (c)(1)(i). As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 CFR § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

31. ANSWER: (B) is the most correct answer. See MPEP § 1209, under the heading “Participation by Examiner.” As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998).

32. ANSWER: (C) is the best answer. MPEP §§ 2107.01 and 2107.02. MPEP § 2107.01, under the heading “Therapeutic or Pharmacological Utility,” cites *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956); *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); and *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980) as taking the position that “[i]nventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology.” MPEP § 2107.02, under the heading “The Claimed Invention Is The Focus Of The Utility Requirement,” states “...regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not “credible,” do not render the claimed invention lacking in utility. See, e.g.,...*In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964) (‘Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes ‘indicated’ in the specification as possibly useful.’).” The issue is whether Mr. Bloc has disclosed a specific utility for the claimed compound Y sufficient to satisfy the practical utility requirement of 35 U.S.C § 101. According to the set of facts, we know that compound Y is an intermediate in the chemical manufacture of synthetic Z. We are given two utilities for synthetic Z: 1) alleviating pain, a utility it shares with the natural form of Z; and, 2) curing cancer. The examiner focuses on the disclosure that synthetic Z is a cure for cancer. Even if one were to agree that synthetic Z’s ability to cure cancer amounts to an incredible utility, a claim to the intermediate compound Y would not run afoul of the utility requirement of 35 U.S.C. § 101 where another substantial, credible and specific utility is alternatively demonstrated. Here, the specification discloses that synthetic Z, like the natural form of Z, alleviates pain. The alleviation of pain is another substantial, credible and specific utility and serves to give compound Y an alternative utility to that of being used to make a cancer-curing substance. An applicant need not show that all disclosed utilities are credible. An applicant need only show that one of the disclosed utilities is in fact credible. *In re Gottlieb, supra*. The establishment of a credible, substantial and specific utility renders the disclosure of an additional incredible utility superfluous, and therefore ultimately irrelevant. Accordingly, Mr. Bloc’s best course of action is to make the argument that he has disclosed another substantial, credible, and specific utility, notwithstanding the disclosure of curing cancer. (A) is not the most correct answer. The advice could prevent him from getting a patent to which he may be entitled. (B) is not the most correct answer. A cure for cancer is ostensibly incredible. It is hardly a response to the examiner’s rejection to ask for the chance to prove one can cure cancer. (D) is not the most correct answer. While it is true that the utility requirement is addressed to the claimed invention, which here is compound Y not synthetic Z, it is not enough to respond by repeating what the invention is but, rather, to show that the invention has indeed a substantial, credible, and specific utility. Whatever is claimed as the invention, it must comply with the utility requirement of 35 U.S.C. § 101. Here the examiner states that the claim does not comply, as evidenced by the incredible utility of the final product. It is Mr. Bloc’s responsibility to then show that compound Y does comply with 35 U.S.C. § 101. (E) is not the most correct answer. Noting that synthetic

Z is modeled on natural Z does not go far enough in establishing a substantial, credible and specific utility for compound Y. It is synthetic Z's therapeutic ability to alleviate pain which establishes the necessary alternative utility.

33. ANSWER: (E) is the most correct answer. MPEP § 103, under the heading "Published U.S. Patent Applications" states that "If a patent application has been published pursuant to 35 U.S.C. 122(b), then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee." (A) and (B) are not correct. 37 CFR § 1.14(c)(2). Once an application has been published, a copy is available to the public upon written request and payment of a fee. (C) and (D) are not correct. As stated in MPEP § 103, under the heading "Published U.S. Patent Applications," if the published patent application is pending, the application file itself will not be available to the public for inspection."

34. ANSWER: (C) is the most correct answer. See MPEP §§ 706.03(o) and 2143.03. MPEP § 2143.03, under the heading "Limitations Which Do Not Find Support In The Original Specification Must Be Considered," states: "When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (*i.e.*, new matter)." In (C), the examiner considered the new matter as required. MPEP § 706.03(o) states, "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, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." (A) is incorrect. An amendment adding new matter is not necessarily a non-*bona fide* response as (A) implies. Moreover, abandonment is not proper after the expiration of the period for response since even if the response is considered non-responsive, applicant would be notified and given the remaining time period plus available extensions of time to reply. See MPEP § 714.03. (B) is incorrect. The mere fact that a claim recites new matter does not mean that the claim lacks utility. See MPEP § 2107.01, under the heading "Relationship Between 35 U.S.C. 112, First Paragraph, And 35 U.S.C. 101," discussing the difference between new matter under 35 U.S.C. § 112(1) and lack of utility under 35 U.S.C. § 101. (D) is incorrect because it contradicts MPEP § 2143.03, which requires the examiner to consider new matter. (E) is incorrect inasmuch as (A), (B), and (D) are incorrect and (C) is correct.

35. ANSWER: (E) is the most correct answer. See 35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. §§ 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. See MPEP § 2217. An admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be

properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure. The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

36. ANSWER: (D) is the most correct answer. Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

37. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 41(h)(1); 37 CFR §§ 1.17(e) and 1.114; and MPEP § 509.02. (A) is incorrect because there is no support for (A) in 37 CFR § 1.102. (B) is incorrect because there is no support for (B) in 37 CFR § 1.8. (C) is incorrect because it is inconsistent with 35 U.S.C. § 42(d); 37 CFR § 1.26. *Miessner v. United States*, 228 F.2d 643, 644 (D.C. Cir. 1955). (E) is incorrect because (D) is correct.

38. ANSWER: (C) is the most correct answer. See 37 CFR § 1.116; MPEP § 1207, first paragraph. Answers (A), (B), and (D) are purely fictional. With respect to answer (E), see MPEP § 1207, first paragraph.

39. ANSWER: (E) is the most correct answer. For (A) *see*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by... providing reasoning or arguments...” For (B), *see* MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “The applicant can do this by amending the claims...” For (C) *see*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “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*, MPEP § 2107, under the heading “Examination Guidelines For The Utility Requirement,” penultimate paragraph, which states “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.

40. ANSWER: (D) is the correct answer. See MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

41. ANSWER: (A) is the most correct answer. In accordance with MPEP § 2172, under the heading “II. Evidence To The Contrary,” states that evidence that shows a claim does not correspond in scope with that which applicant regards as applicant’s invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, under the

heading “II. Evidence To The Contrary,” states, “As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” (C) is incorrect. MPEP § 2172, under the heading “III. Shift In Claims Permitted,” indicates that the second paragraph of 35 U.S.C. § 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, under the heading “III. Shift In Claims Permitted,” indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. § 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

42. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(b); MPEP § 2131. Citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131, under the heading, “To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim” states, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” The claim is directed to a method of use that is not disclosed by the reference. Answer (A) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed composition is the same as that disclosed in the prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of “the composition is effective for treating cancer,” is only a statement of the inherent properties of the composition. Where the claimed and prior art products are identical in structure or composition, or are produced by identical processes, a *prima facie* case of anticipation has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). The burden is shifted to applicant to show that the prior art product does not necessarily possess the characteristics of the claimed product. The reference is prior art under 35 U.S.C. § 102(b), and therefore the claim is anticipated. Answer (B) is incorrect. 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01, and 2112.02. The claimed composition is the same as that disclosed in the prior art, because it is made from the same starting material subjected to the same processing steps. The recitation of a composition “for treating cancer” reflects only a preamble statement of an intended use of the claimed composition, which does not limit the scope of the claim. Answer (C) is incorrect. See 35 U.S.C. § 102(b); MPEP §§ 2112, 2112.01. The claimed method is the same as that disclosed in the prior art, because it subjects the same starting material to the same manipulative steps. The recitation of making “a cancer-treating composition” reflects only a preamble’s statement of an intended use of the claimed composition, which does not further limit the claimed method. Answer (E) is incorrect, because (A), (B), and (C) are incorrect.

43. All answers accepted.

44. ANSWER: (B) is the most correct answer. Any person at any time may file a request for reexamination. 35 U.S.C. § 302. As to (A) loser may appeal to District Court under 35 U.S.C. § 146. As to (C), there is no prohibition regarding spouses, family members, and other relatives. As to (D) according to 35 U.S.C. § 4, employees are prohibited during the period of their employment and one year thereafter. As to (E), (B) is true.

45. ANSWER: (D) is the most correct answer. See 37 CFR § 1.313(b); MPEP §§ 609, subpart (B)(4) and 1308. After payment of the issue fee it is impractical for the Office to consider any information disclosures. As to (A), a prior art statement is applicable only to patent, not application, files. 37 CFR § 1.501. As to (B), duty of disclosure continues until the patent is issued. As to (C), the patent should not be allowed to issue since it may contain invalid claims. As to (E) no amendment is entitled to entry after payment of the issue fee. 37 CFR. § 1.312(b).

46. ANSWER: (C) is the most correct answer. The internal report was intended to be confidential and therefore is not a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (A) is incorrect. An orally presented paper can be a “printed publication” if copies are available without restriction. The paper is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (B) is incorrect. The thesis is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.01. Answer (D) is incorrect. An electronic publication disclosed on the Internet is considered to be publicly available as of the date the item was posted. The reference is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128. Answer (E) is incorrect. There is no need to prove that anyone actually looked at a document. The manual is a “printed publication” under 35 U.S.C. § 102(b). See MPEP § 2128.

47. ANSWER: (B) is the most correct answer, and (A) and (C) are wrong. MPEP § 715.05 states “[i]f the patent is claiming the same invention as the application and its issue date is one year or more prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. § 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed.Cir. 1997) (holding that application of 35 U.S.C. § 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.)”. (D) is wrong. See MPEP § 2307 (“The fact that the application claim may be broad enough to cover the patent claim is not sufficient. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950)”). (E) is also wrong. See MPEP § 2307 (“If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent...then under the provisions of 35 U.S.C. § 135(b), an interference will not be declared unless at least one of the claims which were in the application...prior to expiration of the one-year period was for ‘substantially the same subject matter’ as at least one of the claims of the patent.”).

48. ANSWER: (D) is the most correct answer. See 35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP 2127 and 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As

stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

49. ANSWER: (B) is the most proper answer. MPEP § 2111, under the heading “Claims Must Be Given Their Broadest Reasonable Interpretation,” states, in reference to *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969): “The court explained that ‘reading a claim in light of the specification,[’] to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed [sic, *disclosed*] limitations which have no express basis in the claim.” Answer (A) is incorrect because, as pointed out in MPEP § 2111.01, the court in *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)), states: “It is well settled that ‘claims are not to be read in a vacuum and limitations therein are to be interpreted in light of the specification in giving them their “broadest reasonable interpretation.””” Answer (C) is incorrect because MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states that “[w]hen not defined by applicant in the specification, the words of a claim must be given their plain meaning.” Answer (D) is incorrect because MPEP § 2111.01 states that it is only when the specification provides a definition for terms appearing in the claims can the specification be used to interpret the claim language. Answer (E) is incorrect. See MPEP § 2111.01, under the heading “Plain Meaning Refers To The Meaning Given to The Term By Those Of Ordinary Skill In The Art,” states, in reliance upon *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), that there is “one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim.”

50. ANSWER: (E) is the most correct answer. Both (A) and (C) are correct. MPEP § 2163.01, under the heading “Support For The Claimed Subject Matter In The Disclosure,” states that “[I]f the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph, or denial of the benefit of filing date of a previously filed application.” (B) is incorrect. MPEP § 2163.01 states that unsupported claims “should not be rejected or objected to on the ground of new matter. As framed by the court in *In*

re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented.” (D) is incorrect because (B) is incorrect.