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

Morning Session Model Answers

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

2. CREDIT GIVEN FOR ALL ANSWERS.

3. ANSWER: (B) is the most correct answer. MPEP § 713.01, under the heading "Scheduling And Conducting An Interview," states "[a]n 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.

4. 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. *Id.* (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.

5. ANSWER: (B) is the most correct answer. MPEP § 2141.01. Quoting from *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987), MPEP 2141.01, under the heading "Prior Art Available Under 35 U.S.C. 102 Is Available Under 35 U.S.C. 103," states "'[b]efore answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102.' Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a

rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ('it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.')." Because the printed publication in (B) was not published until *after* the filing date of the patent application, it does not constitute prior art. (A) is incorrect because the patent pre-dates the application, therefore qualifying as prior art, and comes from the same field as the application, therefore qualifying as analogous. (C) is incorrect because the printed publication pre-dates the application, therefore qualifying as prior art, and concerns the same particular problem sought to be solved in the patent application, therefore qualifying as analogous. (D) is incorrect because the printed publication pre-dates the application, therefore qualifying as prior art, and comes from the same field as the application, therefore qualifying as analogous. (E) is incorrect because the patent issued before the application, therefore qualifying as prior art, and concerns the same particular problem sought to be solved in the patent application, therefore qualifying as analogous. The USPTO classification in a different class does not render the patent non-analogous. *See* MPEP § 2141.01(a) ("While Patent Office classification of references . . . are some evidence of 'nonanalogy' or 'analogy' respectively, the court has found 'the similarities and differences in structure and function of the inventions to carry far greater weight.'").

6. ANSWER: (B) is the most correct answer. 37 CFR § 1.137; and MPEP § 2268. The patent owner will need to file a petition for entry of late papers in order to have their response entered, considered and acted upon. According to MPEP 2268, "[p]ursuant to 37 CFR 1.550(d), an *ex parte* reexamination proceeding is terminated if the patent owner fails to file a timely and appropriate response to any Office . . . An *ex parte* reexamination proceeding terminated under 37 CFR 1.550(d) can be revived if the delay in response by the patent . . . was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b)." (A) is not the most correct answer. In a reexamination proceeding, requests for extensions of time must be filed on or before the day on which action by the patent owner is due pursuant to 37 CFR § 1.550(c). See MPEP § 2265. (C) is incorrect. (C) is inconsistent with MPEP § 2266, which states that if the patent owner fails to file a timely response to any Office action, the reexamination proceeding will be terminated, and after the proceeding is terminated, the Commissioner will proceed to issue a reexamination certificate. There is no provision for issuing a notice of allowance in a reexamination proceeding. Further, (C) is incorrect inasmuch as the examiner should not mail a Notice of Allowance and grant a new patent. (D) is not the most correct answer. In a reexamination proceeding where patent owner fails to file a timely and appropriate response to any Office action, the reexamination proceeding will be terminated via issuance of the Notice of Intent to Issue Reexamination Certificate. See MPEP § 2266. (E) is not the most correct answer. In a reexamination proceeding, requests for extensions of time must be filed on or before the day on which action by the patent owner is due pursuant to 37 C.F.R. § 1.550(c).

7. 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. Bo*wler, 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 by showing that its end product has a substantial, credible, and specific utility. (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.

8. ANSWER: (D) is the most correct answer. As set forth in MPEP § 2135, under the heading "General Requirements of 35 U.S.C. 102(d)," states "(C) The foreign patent or inventor's certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published." Answer (A) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading "General Requirements of 35 U.S.C. 102(d)," states "(A) The foreign application must be filed

more than 12 months before the effective U.S. filing date…." Answer (B) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading "General Requirements of 35 U.S.C. 102(d)," states "(B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns." Answer (C) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading "General Requirements of 35 U.S.C. 102(d)," states "(C) The foreign patent or inventor's certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published." Answer (E) is incorrect because it is one of the four conditions established by 35 U.S.C. § 102(d). MPEP § 2135, under the heading "General Requirement of 35 U.S.C. 102(d)" states "(D) The same invention must be involved." See also MPEP § 2135.01(IV).

9. ANSWER: The most correct answer is (E). See MPEP § 201.11, under the heading "VI. When Not Entitled To Benefit Earlier Of Filing Date, " states "[a]ny claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application. See *In re Chu*, 66. F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994)." Accordingly, claims 1-10 are entitled to the benefit of the filing date of the first application, but claims 11-20 are not entitled to the benefit of the filing date of the first application because claims 11-20 recite an improved capacitor, which was not disclosed in the first application. Claims 1-10 have an effective filing date earlier than the publication date of the article. Claims 11-20 have a filing date later than the publication date of the article. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application. See MPEP 706.02(a), paragraph "*III. 35 U.S.C. 102(a)*." Thus, answers (A)-(D) are incorrect.

10. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2173.02, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Answers (A), (B) and (C) each identify criteria to be analyzed in considering whether claim language is definite, therefore answer (E) which includes each of these answers is the most correct answer. Answer (D) is incorrect since it does not include criteria (C).

11. ANSWER: The correct answer is (C). See MPEP § 706.02(l) *et seq*. In accordance with proper USPTO policy and procedure, the prior art exclusion of 35 U.S.C. § 103(c) can only be invoked when the reference only qualifies as prior art under 35 U.S.C. § 102(f), 35 U.S.C. § 102(g), or 35 USC 102(e) for applications filed on or after November 29, 1999, the application and the reference were commonly owned, or subject to an assignment to the same person, at the time the invention was made, and the reference was used in an obviousness rejection under 35

U.S.C. § 103(a). Answer (A) is incorrect. The prior art exclusion in 35 U.S.C. § 103(c) cannot obviate rejections made under 35 U.S.C. § 102(e). See MPEP 706.02(l)(1). Answer (B) is incorrect. The prior art exclusion in 35 U.S.C. § 103(c) cannot obviate double patenting rejections. See MPEP §§ 706.02(l)(1) and (l)(3).

12. 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 C FR § 1.19.

13. ANSWER: (D) is the most correct answer. 35 U.S.C. § 41(h); MPEP §§ 302.06; 509.02. 35 U.S.C. § 41(h) specifies that the fees "charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director." Since the fee for a document affecting title is charged pursuant to 35 U.S.C. § 41(d)(1), it not subsection (a) or (b), and it is not entitled to a small entity discount. See also MPEP 509.02, which states, "[o]ther fees, established under section 41 (c) or (d) of Title 35, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247. Fees which are not reduced include . . . miscellaneous fees and charges, 37 CFR 1.21." Fees for recording documents affecting title are set under 37 CFR § 1.21(h). See MPEP § 302.06. (A) is entitled to a small entity discount because it is a fee charged pursuant to 35 U.S.C. 41(a)(3)(A). (B) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(a)(5). (C) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(a)(8). (E) is entitled to a small entity discount because it is charged pursuant to 35 U.S.C. 41(b)(1).

14. ANSWER: (A) is the most correct answer. 35 U.S.C. § 112, first paragraph; MPEP §§ 2164.01 and 2164.06(b). MPEP § 2164.01 states "[t]he standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands* , 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term 'undue experimentation,' it has been

interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." See also the discussion of *Enzo Biochem, Inc. v. Calgene, Inc.,* 52 USPQ2d 1129 (Fed. Cir. 1999) in MPEP § 2164.06(b). (B) is incorrect. MPEP § 2107.01, under the heading "III. Therapeutic Or Pharmacological Utility," states "[t]he Federal Circuit has reiterated that therapeutic utility sufficient under the patent laws is not to be confused with the requirements of the FDA with regard to safety and efficacy of drugs to marketed in the United States. . . *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). Accordingly, Office personnel should not construe 35 U.S.C. 101, under the logic of 'practical' utility or otherwise, to require that an applicant demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans." (C) is incorrect. 35 U.S.C. § 112, first paragraph; MPEP § 2107.02. MPEP § 2107.02, under the heading "When Is An Asserted Utility Not Credible," states "Rejections under 35 U.S.C. 101 have been rarely sustained by federal courts. Generally speaking, in these rare cases, the 35 U.S.C. 101 rejection was sustained . . . because . . .[applicant] asserted a utility that . . . was wholly inconsistent with contemporary knowledge in the art. *In re Gazave,* 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967)." The disclosure in (C) is inconsistent with published information. (D) is incorrect. MPEP § 2107.01 under the heading "Relationship Between 35 U.S.C. 112, First Paragraph, and 35 U.S.C. 101," quotes *In re Ziegler*, 992 F.2d 1197, 1200-1201, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) as stating "The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention. ... If the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112." Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. MPEP 2107.01 states that the examiner "must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement." Inasmuch as countervailing evidence has been produced, the lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph to provide an enabling disclosure that is commensurate in scope with the claims.

15. ANSWER: (A) is the most correct answer. The filing of an amendment complying with 37 CFR § 1.116 is a proper reply under 37 CFR § 1.113 to a final rejection. See MPEP § 714.13, under the heading "Entry Not A Matter of Right," which states, in pertinent part , "A reply under 37 CFR 1.113 is limited to: (A) an amendment complying with 37 CFR 1.116." (B) is not the most correct answer because the Notice of Appeal must be accompanied by the appeal fee required by 37 CFR § 1.17(b). (C) is not the most correct answer because the RCE must be accompanied by a submission (*i.e.*, an amendment that meets the reply requirement of 37 CFR § 1.111). (D) is not the correct answer because CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000. See MPEP § 706.07(h), paragraphs I and IV. (E) is not the correct answer since (A) is a proper reply.

16. ANSWER: (A) is the most correct answer. 35 U.S.C. § 251, MPEP § 1402 (fifth paragraph). MPEP § 1402 states that one of the "most common bases for filing a reissue

application [is] (A) the claims are too narrow or too broad." The claims may be broadened in a reissue application filed by the inventor within two years from the patent issue date. (B) is incorrect since the 4th paragraph of 35 U.S.C. § 251 states that no reissued patent shall be granted enlarging the scope of the clams of the original patent unless applied for within two years from the grant of the original patent. (C) and (E) are incorrect. MPEP § 1402, sixteenth paragraph. 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. See *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (D) is incorrect. MPEP § 201.06. In order to claim benefit under 35 U.S.C. § 120 to a parent application, a divisional application must be filed while the parent patent application is still pending.

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

18. 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.

19. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2131.05, "'Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from

the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102.' *Twin Disc, Inc. v. United States,* 231 USPQ 417, 424 (Cl.Ct.1986) (quoting *In re Self,* 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed.Cir.1999)." Therefore, answers (A) through (D) are incorrect. See also MPEP § 706.02(b) as to ways to overcome a rejection under 35 U.S.C. § 102.

20. ANSWER: (D) is the most correct answer. MPEP § 201.06(c), under the heading "INCORPORATION BY REFERENCE", subheading "B. Application Entitled to a Filing Date," states that "[i]f the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application." (A) and (B) are incorrect because the application filing date will be the date of the filing of the missing drawing figure. See MPEP § 601.01(g). Furthermore, a priority claim under 35 U.S.C. § 120 in a continuation or divisional application does not amount to an incorporation by reference of the application to which priority is claimed. See MPEP § 201.06(c). (C) is incorrect. The continuation application will not be accorded with a filing date of January 3, 2003 with the missing drawing figure. (E) is incorrect because a petition under 37 CFR § 1.53(e) will not be granted if the missing drawing figure is inadvertently omitted by the applicant and not in fact deposited with the USPTO with the application papers.

21. ANSWER: (D) is most correct. MPEP § 706.02(b) (8th ed., Rev. 1) states that "[a] rejection based on 35 U.S.C. § 102(b) may be overcome by…(C) perfecting priority under…35 U.S.C. § 120 by amending the specification of the application to contain a specific reference to a prior application…" Answer (A) is incorrect because a declaration and evidence filed under 37 CFR § 1.131 cannot antedate a reference that qualifies as prior art under 35 U.S.C. § 102(b), a statutory bar. See 37 CFR § 1.131(a); MPEP § 715, "SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE." Answers (B) and (C) are incorrect because, as noted in MPEP § 2131.04, evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Answer (E) is incorrect because to serve as an anticipation when the reference is silent about an asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). See also MPEP § 2131.01, "Multiple Reference 35 U.S.C. 102 Rejections."

22. 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."

23. ANSWER: (C) is the most correct answer. Pursuant to 35 U.S.C. § 112, paragraph 6, *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc), and MPEP § 2181, under the heading "Written Description Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph," "step" plus function limitations shall be construed to cover the corresponding acts disclosed in the specification and their equivalents. Accordingly, the step plus function imitation correspondingly includes acts (1)-(5) and their equivalents. Thus, in order to anticipate, a prior art reference must disclose each and every act, or its equivalent, for the step plus function. If the reference is shown to not disclose one of the acts, or its equivalents, then the reference fails to anticipate, which is the answer set forth in (C). Thus, (C) is the most complete answer. (A) is not the most complete answer because acts (1)-(4) are disclosed in the reference and the equivalent of act (5) has to be dealt with, i.e., the equivalent of continuing to walk may still be met by the reference unless the applicant shows through argument that the reference also fails to contain any equivalent for act (5). Thus, the most complete answer is (C) as compared to (A). (B) is not the most correct answer because once act (5) is removed from the specification, the prior art reference clearly anticipates (since it otherwise expressly has acts (1)-(4) and the other claim limitations) under the above recited facts absent act (5) in the specification. See Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1849; MPEP § 2181. (D) is not the most complete answer the prior art still anticipates the claim. (E) is not the most correct answer because it includes two incorrect answer choices, (B) and (D).

24. ANSWER: (D) is the most correct answer. MPEP § 2181 under the heading "Procedures For Determining Whether The Written Description Adequately Describes The Corresponding Structure, Material, Or Acts Necessary To Support A Claim Limitation Which Invokes 35 U.S.C. 112, Sixth Paragraph." 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means plus function language "shall be construed to cover the corresponding structure, materials, or acts described in the specification and 'equivalents thereof.'" See also *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997)." The examiner has made a prima facie case of equivalent in the Office action to support the rejection based on 35 U.S.C. § 102. By amending the claim to no longer include the means limitation in question, the claim becomes narrower inasmuch as it no longer includes equivalents under 35 U.S.C. § 112, paragraph 6 for examination purposes. Thus, (D) overcomes the lack of novelty rejection under these circumstances. (A) is not the most correct answer because such an amended claim would continue to lack novelty, since both it and the prior art would have the attached bar expressly. Furthermore, such an amendment would introduce new matter lacking support in the application as originally filed. 35 U.S.C. § 112, first paragraph. (B) is not the most correct answer because the "not found in the prior art" argument does not rebut the prima facie case of equivalents raised by the examiner. (C) is not the most correct answer because it does not address the rejection. (E) is not the most correct answer because the amendment would raise a new matter issue.

25. ANSWER: The most correct answer is (D). See 35 U.S.C. § 154(b); 37 CFR § 1.702(f); MPEP § 2730 (quoting section 1.702(f)). The application was filed prior to May 29, 2000 and is ineligible for the provisions of Patent Term Adjustment (PTA). Moreover, the filing of a Request for Continued Examination (RCE) under 35 U.S.C. § 132(b) and 37 CFR § 1.114 does not cause an application filed before May 29, 2000 to be entitled to the benefits PTA under the provisions of 35 U.S.C. § 154(b) and 37 CFR §§ 1.702-1.705. See MPEP § 2730. (A) and (B) are not correct answers because the application was filed prior to May 29, 2000, the eligibility date for applications to receive the benefit of PTA provisions of 35 U.S.C. § 154(b) and 37 CFR §§ 1.702 through 705. Answer choice (C) is not correct because utility applications, not design applications are subject to the PTA provisions and the answer suggests that design applications are eligible for PTA. Answer choice (E) is not a correct answer because the application is not eligible for PTA and filing an RCE does not make an ineligible application eligible for PTA. Design patents are granted for fourteen year terms from the grant of the patent. 35 U.S.C. § 171. Utility patents are subject to patent term adjustment. 35 U.S.C. § 154(b)

26. ANSWER: (D) is the most correct answer. MPEP § 714.16, third paragraph, states "a supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s)." Answer (A) is incorrect because a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312 except when submitted in a reissue. See MPEP § 603.01. Answer (B) is incorrect because a supplemental oath or declaration in a reissue will be treated as an amendment under 37 CFR § 1.312 only if filed after allowance. Answer (C) is incorrect because amendments filed after the date the issue fee has been paid are no longer permitted under 37 CFR § 1.312. (E) is wrong because (A) is correct.

27. ANSWER: (C) is the most correct answer. 35 U.S.C. § 101; MPEP 2106, under the heading "A. Identify and Understand Any Practical Application Asserted for the Invention." With regard to computer-related inventions, MPEP § 2106 states that "[a]lthough the courts have yet to define the terms useful, concrete, and tangible in the context of the practical application requirement for such inventions, the following example illustrates claimed inventions that have a practical application because they produce useful, concrete, and tangible results: 'Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held to be directed to patentable subject matter because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle.' *AT&T Corp. v. Excel Communications, Inc*., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999)." See also, *State Street Bank & Trust Co. v. Signature Financial Group Inc.,* 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Answers (A), (B) and (D) are incorrect. MPEP § 2105 states that abstract ideas, laws of nature and physical phenomena have been held by the Supreme Court to be unpatentable subject matter under 35 U.S.C. § 101. Answer (E) is incorrect because answers (A), (B) and (C) are incorrect.

28. ANSWER: (A) is the most correct answer. MPEP § 2144, under the heading "Rationale Different From Applicant's Is Permissible." Patent A suggests an insert with receptacles that are circular and which can be shaped to complement the shape of the object to be received. The

purpose for this in Patent A is to keep the cart organized, not as in the claim to prevent the object from falling and breaking. The difference in objectives does not defeat the case for obviousness because, as MPEP § 2144 states, the "reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) …; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) … ." In other words, it does not matter that Patent A does not appreciate the claimed purpose of preventing breakage. It suggests an insert with receptacles to hold bottles. That is enough to render the claimed subject matter *prima facie* obvious. The *prima facie* case is not rebutted by arguing that the purpose for the claimed insert is different form that specified for the insert described in Patent A. That is why answer (C) is wrong. To rebut the *prima facie* case, the practitioner must show a difference in structure instead. Answer (B) is wrong because the *prima facie* case is not rebutted by showing that Patent A does not teach wine bottles. This is not an anticipation rejection where identity of subject matter might be an issue. This is a question of obviousness. Therefore, it is sufficient to point out that Patent A is a generic teaching of shopping cart inserts that hold objects of any size and shape. (D) is not the most correct answer because what Patent A is interested in doing is irrelevant to the question of obviousness. (E) is not the most correct answer inasmuch as it was not the practitioner's argument. However, the question inquires about the merits of the argument that the practitioner made as set forth in the penultimate sentence of the question, not the merits of some hypothetical reply the examiner may communicate.

29. ANSWER: (B) is the most proper answer. MPEP § 2128.02, under the heading "Date of Accessibility Can Be Shown Through Evidence of Routine Business Practices," states, in reliance upon *Constant v. Advanced Micro-Devices, Inc*., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), *cert. denied*, 988 U.S. 892 (1988), and *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986), "Evidence showing routine business practices can be used to establish the date on which publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary." Answer (A) is incorrect. MPEP § 2128.01, under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public," states "[a] doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior art as a 'printed publication.' *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). Even if access to the library is restricted, a reference will constitute a 'printed publication' as long as a presumption is raised that the portion of the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978)." Answer (C) is incorrect. MPEP § 2128.01, under the heading "Orally Presented Paper Can Constitute A 'Printed Publication' If Written Copies Are Available Without Restriction," states, in reliance upon *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985): "[a] paper which is orally presented in a forum open to all interested persons constitutes a 'printed publication' if written copies are disseminated without restriction." Answer (D) is incorrect. MPEP § 2128.01, under the heading "Internal Documents Intended To Be Confidential Are Not Printed Publications," states, in reliance upon *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Int. 1987), *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970), and *Northern Telecom Inc. v. Datapoint Corp*., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). "[d]ocuments and

items only distributed internally within an organization which are intended to remain confidential are not 'printed publications' no matter how many copies are distributed." Answer (E) is incorrect. MPEP § 2128.02, under the heading "A Journal Article or Other Publication Becomes Available As Prior Art on Date of It Is Received by a Member of the Public," states, in reliance upon *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956): "[a] publication disseminated by mail is not prior art until it is received by at least one member of the public."

30. ANSWER: (B) or (D) is accepted as the correct answer. As to (B) and (D), see MPEP § 706.02(l)(2), under the heading "II. Evidence Required To Establish Common Ownership." (B) is accepted because applicants, *e.g.*, inventors, have the best knowledge of the ownership of their applications, and because their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. (D) reproduces the example set forth under the foregoing heading. (A) is incorrect because applicants or the representatives of record have the best knowledge of the ownership of their applications, and because their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO. (C) is incorrect because the statement does not establish common ownership at the time the later invention was made. 35 U.S.C. § 103(c). (E) is incorrect because it does not establish that the prior art invention and the claimed invention are entirely or wholly owned by the same person. MPEP § 706.02(l)(2).

31. ANSWER: (C). 35 U.S.C. § 305; MPEP §§ 2258 and 1412.03. MPEP § 2258, under the heading "Claims In Proceeding Must Not Enlarge Scope Of The Claims Of The Patent," states "[w]here new or amended claims are presented . . . the claims of the reexamination proceeding should be examined under 35 U.S.C. 305, to determine whether they enlarge the scope of the original claims. 35 U.S.C. 305 states that 'no proposed amended or new claim enlarging the scope of the claims of the patent will be permitted in a reexamination proceeding...'." Under the further subheading "Criteria for Enlargement of the Scope of the Claims," MPEP § 2258 states "A claim presented in a reexamination proceeding 'enlarges the scope' of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, i.e., what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination." MPEP § 1412.03, under the heading "New Category of Invention Added In Reissue – Broadening," states "[t]he addition of process claims as a new category of invention to be claimed in the patent (*i.e.,* where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546, 1549 (Bd. Pat. App. & Inter. 1989)." MPEP 2258, under the further subheading "Rejection of Claims Where There Is Enlargement," states "[a]ny claim in a reexamination proceeding which enlarges the scope of the claims of the patent should be rejected under 35 U.S.C. 305." Since no claims drawn to a method were ever presented during prosecution of Patent X (claims 1 through 4 "are the only claims that were ever presented during prosecution of the application that matured into Patent X"), the claim recited in (C) is not directed to "the invention as claimed." (A), (B), and (D) are all incorrect because each of their claims are directed to a hydrocyclone separator apparatus, *i.e.*, "the invention as claimed," and they do not enlarge the scope of the claims in Patent X. (E) is an incorrect answer because (C) is the correct answer.

32. ANSWER: (B) is the most correct, as only statement (2) is true. The examiner has the initial burden to establish a reasonable basis to question the enablement provided. MPEP § 2164.04 states "[i]n order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)." Answer (A) is incorrect, because statement (1) is not true. The examiner may not analyze enablement before construing the claims. MPEP § 2164.04. Answer (C) is incorrect, because statement (3) is not true. The examiner must give reasons for the uncertainty of the enablement, even when there is no evidence of operability without undue experimentation other than the disclosed embodiments. *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). MPEP § 2164.04 states "[a]ccording to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement." Answer (D) is incorrect because it includes false statement (1). Answer (E) is incorrect because it includes false statements (1) and (3).

33. ANSWER: (D) is correct. "Inherent components of elements recited have antecedent basis in the recitation of the components themselves." MPEP § 2173.05(e). The MPEP provides an analogous example: "the limitation 'the outer surface of said sphere' would not require an antecedent recitation that the sphere have an outer surface." *Id.* (A), (B), (C), and (E) are all examples of things which inherently have the claimed characteristic and do not have an antecedent basis problem; that is, all circles have a center, all ellipses have a major diameter, all spheres have an outer surface, and all rectangles have an area, and these characteristics need not be provided with express antecedent basis. The ellipse example is from *Bose Corp. v. JBL Inc.*, 61 USPQ2d 1216, 1219 (Fed. Cir. 2001) ("There can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter."). The lever recited in (D) is not an inherent component of a machine and therefore requires express antecedent basis.

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

due and permit the parent application to become abandoned for failure to pay the issue fee. (D), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(3), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit the express abandonment of the application in favor of a continuing application. (E), stating a procedure that conforms with the USPTO rules and the procedures set forth in the MPEP, is an incorrect answer. Under 37 CFR § 1.313(c)(2), a petition to withdraw the application from issue can be filed after payment of the issue fee to permit consideration of a Request for Continued Examination (RCE) under 37 CFR § 1.114. See also MPEP § 1308.

35. ANSWER: (E) is the most correct answer because (B) and (C) together are correct. Regarding (B), see MPEP § 2163.02, which states, "Whenever the [written description] issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)." Regarding (C), see MPEP § 2163.02, which states, "The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.' *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed." (B) alone and (C) alone are incorrect inasmuch as they do not address each of the examiner's rationales for the rejection. (A) is incorrect. MPEP § 2161. The written description requirement is separate and distinct from the enablement requirement of 35 U.S.C. § 112, first paragraph. The argument does not address and otherwise traverse the rejection that was made. (D) is incorrect. MPEP § 2163.03, under the headings "RELIANCE ON FILING DATE OF PARENT APPLICATION UNDER 35 U.S.C. 120," and "RELIANCE ON PRIORITY UNDER 35 U.S.C. 119." The related case must be an application having a filing date to which the instant application is entitled, *e.g.*, a parent or provisional application. The argument does not show the instant application is related to the "related application" under 35 U.S.C. §§ 119 or 120. (B) alone is not correct because (C) is also correct. (C) alone is not correct because (B) is also correct.

36. ANSWER: (D) is the correct answer. See MPEP §§ 706.07(h), under the heading "X. After Appeal But Before Decision By Board," and 1215.01. As explained in MPEP § 1215.01, "The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission." Thus, the filing of the RCE without the fee results in the withdrawal of the appeal in this application and passage of the application to issue with the allowed claims 6-10 after the cancellation of both rejected claims 1-

3 and claims 4 and 5 which are allowable except for their dependency from rejected claim 1 (A) is incorrect. As also explained in MPEP § 1215.01, although an application under appeal having no allowed claims will be considered abandoned by the filing of an improper RCE, an application having allowed claims will be passed to issue with the allowed claims. Upon withdrawal of appeal, claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. See MPEP § 1215.01. All rejected claims, such as claims 1-3, and claims which are allowable except for their dependency from rejected claims, such as claims 4 and 5, will be canceled. (B) is incorrect. As explained in MPEP § 706.07(h), under the heading "After Appeal But Before Decision By The Board," proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that the filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission. (C) is incorrect for the reasons explained for (A), and because claims 4 and 5 will be canceled. (E) is incorrect. The RCE, which was filed without the fee, is improper. Thus, as explained in MPEP § 706.07(h),. under the heading, "After Appeal But Before Decision By The Board," proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that the filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission.

37. ANSWER: (E) is the correct answer. 35 U.S.C. § 102(b); 37 CFR § 1.111(b); MPEP §§ 706.02(b), 2131 and 2131.03. As stated in MPEP 2131, under the heading "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim," "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.03, under the heading, "Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With 'Sufficient Specificity.'" states "When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with 'sufficient specificity to constitute an anticipation under the statute.'" A claim containing a limitation that the grit particle size is 5-7 microns would not be anticipated by the applied reference, because the applied reference discloses a different grit particle size well outside that range. (A) is incorrect. MPEP § 2123(8th Ed.). Patents are relevant as prior art for all they contain and are <u>not</u> limited to their preferred embodiments. *See In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) and *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 975 (1989). (B) is incorrect. See MPEP § 2131.04. Evidence of secondary considerations such as unexpected results is irrelevant to 35 U.S.C. § 102 rejections and thus cannot overcome a rejection so based. *See In re Wiggins*, 488 F.2d 538, 543,179 USPQ 421, 425 (CCPA 1973). (C) is incorrect. See MPEP § 715, under the heading "Situations Where 37 CFR 1.131 Affidavits or Declarations Are Inappropriate." An affidavit or declaration under 37 CFR § 1.131 is inappropriate where the reference publication date is more than 1 year prior to applicant's effective filing date. Such a reference is a "statutory bar" under 35 U.S.C. § 102(b) as referenced in 37 CFR § 1.131(a)(2). (D) is also incorrect. See MPEP § 2131.05. Arguments

that the alleged anticipatory prior art is "nonanalogous art" are not "germane" to a rejection under 35 U.S.C. § 102. *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982).

38. ANSWER: (D) is the most correct answer. 37 CFR § 1.197(c); MPEP § 1214.06. This case is specifically set forth in MPEP § 1214.06 under the heading "Claims Stand Allowed." Answers (A), (B) and (C) apply only if no claims stand allowed in the application. They are incorrect because the facts state that claim 3 was allowed. See MPEP § 1214.06, under the heading "No Claims Stand Allowed." (B) is incorrect. See MPEP § 1214.06 under the heading "Claims Stand Allowed." Where one or more other claims stand allowed, the examiner is not authorized to convert to independent form a dependent claim that has been objected to (but not allowed or rejected) based on its dependency to a rejected claim. (C) is incorrect. See MPEP § 1214.06 under the heading "Claims Stand Allowed." Where one or more other claims stand allowed, the examiner is not authorized to provide appellant with time to rewrite a dependent claim into independent form where the dependent claim was objected to (but not allowed or rejected) based on its dependency to a rejected claim.

39. CREDIT GIVEN FOR ALL ANSWERS.

40. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2111.03 states "[t]he transitional term 'comprising' [Answer (A)], which is synonymous with 'including' [Answer (D)], 'containing' [Answer (B)], or 'characterized by' [Answer (C)], is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. Since Answers (A), (B), (C) and (D) are all open-ended transitional phrases they are incorrect answers.

41. ANSWER: The correct answer is (E). MPEP § 608.01(n), under the heading "B. Unacceptable Multiple Dependent Claim Wording." Multiple dependent claims in proper form depend on preceding claims and refer to the claims from which they depend in the alternative only. Answer (A) is incorrect. See MPEP § 608.01(n), under the heading "B. Unacceptable Multiple Dependent Claim Wording," and subheading "1. Claim Does Not Refer Back In the Alternative Only," second example. A proper multiple dependent claim must refer back in the alternative only. Answer (B) is incorrect. See MPEP § 608.01(n), under the heading "B. Unacceptable Multiple Dependent Claim Wording," and subheading "1. Claim Does Not Refer Back In the Alternative Only," fifth example. A proper multiple dependent claim refers back in the alternative only. Answer (C) is incorrect. Answer (C) reproduces the example in MPEP § 608.01(n), under the heading "B. Unacceptable Multiple Dependent Claim Wording," and subheading "3. References to Two Sets of Claims to Different Features." A proper multiple dependent claim refers in the alternative to only one set of claims. Answer (D) is incorrect. See MPEP § 608.01(n), under the heading "B. Unacceptable Multiple Dependent Claim Wording," and subheading "2. Claim Does Not Refer to a Preceding Claim," second example. A proper multiple dependent claim depends only from preceding claims.

42. ANSWER: (E) is the most correct answer. MPEP § 1002.02(c) identifies among the matters petitionable to and decided by the Technology Center Directors "Petitions from a final decision of examiner requiring restriction in patent applications, 37 CFR 1.144, MPEP § 818.03(c)." Hence (A), and (C), which provide for review before the Board of Patent Appeals

and Interferences are clearly erroneous. Since the restriction requirement is not yet "final" no review is possible at this juncture. Answers (A), (B), (C), and (D) are also incorrect because no claim is under rejection hence no appeal is possible. See MPEP § 1205, which provides that under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134.and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

43. ANSWER: The answer is (C). See 37 CFR § 1.75(c); MPEP 608.01(n). Rule 1.75(c) provides that "[o]ne or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application." See also MPEP § 608.01(n), under the heading "III Infringement Test," second paragraph, wherein it states, "[t]he test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends." For answer (A), see MPEP § 608.01(n), under the heading "III Infringement Test," second paragraph, wherein it states, "[t]he test is not one of whether the claims differ in scope." For answer (B), see MPEP § 608.01(n), under the heading "III Infringement Test," second paragraph, wherein it states, "[a] dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim." For answers (D) and (E), see MPEP § 608.01 (n), under the heading "III Infringement Test," fifth paragraph, wherein it states, "[t]he fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction."

44. ANSWER: (A) is the most correct answer. See 35 U.S.C. 122(b)(2)(B)(iii); 37 CFR § 1.213; MPEP § 901.03 for information on nonpublication requests. See 37 CFR § 1.137(f); MPEP § 711.03(c), under the heading "3. Abandonment for Failure to Notify the Office of a Foreign Filing After Submission of a Non-Publication Request." (B) is incorrect. The notice of foreign filing can be filed as late as 45 days after the foreign filing before the U.S. application becomes abandoned. (C) is incorrect. See MPEP § 608.04(a). The improvements would constitute new matter and new matter cannot be added to the disclosure of an application after the filing date of the application. (D) is not correct. The applicant is required to provide notice of foreign filing, not merely rescind the nonpublication request within the appropriate time. (E) is not correct. The applicant was required to provide notice of foreign filing within 45 days of filing in Japan, and two months have passed. As a result, a petition to revive under 37 CFR § 1.137(b) is required for examination to continue. Also see 37 CFR § 1.137(f).

45. ANSWER: (E) is the most correct answer. As set forth in MPEP § 2127, under the heading "Abandoned Applications, Including Provisional Applications," and subheading,

"Abandoned Applications Disclosed to the Public Can Be Used as Prior Art," states "the subject matter of an abandoned application, including both provisional and nonprovisional applications, referred to in a prior art U.S. patent may be relied on in a 35 U.S.C. 102(e) rejection based on that patent if the disclosure of the abandoned application is actually included or incorporated by reference in the patent. Compare *In re Lund*, 376 F.2d 982, 991, 153 USPQ 625, 633 (CCPA 1967) (The court reversed a rejection over a patent which was a continuation-in-part of an abandoned application. Applicant's filing date preceded the issue date of the patent reference. The abandoned application contained subject matter which was essential to the rejection but which was not carried over into the continuation-in-part. The court held that the subject matter of the abandoned application was not available to the public as of either the parent's or the child's filing dates and thus could not be relied on in the 102(e) rejection.)." (A) is incorrect since an abandoned patent application may become evidence of prior art. Answers (B), (C) and (D) are incorrect due to the use of the word "only". Answer (E) does not include the term "only". In addition, Answer (C) and (D) are also incorrect due to the inclusion of the phrase "as of its filing date". As set forth above, "An abandoned patent application becomes available as prior art only as of the date the public gains access to it. See 37 CFR 1.14(e)(2)."

46. ANSWER: The correct answer is (C). 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, under the heading "Internal Documents Intended To Be Confidential Are Not 'Printed Publications," citing In re George, , 2 USPQ2d 1880 (Bd. Pat. App. & Int. 1987) states "Research reports disseminated in-house to only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing." 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 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 an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. 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 an improper response to the question because it is a

correct statement of claim interpretation during patent prosecution. 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 an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. 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 an improper response to the question because it is a correct statement of claim interpretation during patent prosecution. 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."

48. ANSWER: (C) is the most correct answer. 35 U.S.C. § 102(b); MPEP § 2133.03(b). MPEP § 2133.03(b), under the heading "I. The Meaning Of "Sale," and subheading "D. A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent," states "'[a]n assignment or sale of the rights, such as patent rights, in the invention is not a sale of 'the invention' within the meaning of section 102(b).'" The sale must involve the delivery of the physical invention itself. *Moleculon Research Corp. v. CBS, Inc*., 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986)." (A) is incorrect. Although reexaminations are limited to prior art patents and printed publications, that limitation is not present in original prosecution. MPEP § 2133.03(b) states "An impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed. Cir. 1995)." (B) and (D) are incorrect. There is no requirement that on-sale activity be public. See MPEP § 2133.03(b), under the heading "III. Sale By Inventor, Assignee Or Others Associated With The Inventor In The Course Of Business," and subheading "A. Sale Activity Need Not Be Public." (E) is wrong at least because an on-sale bar does not require an actual sale. A bar can also be based on an offer to sell. MPEP § 2133.03(b), under the heading "II. Offers For Sale."

49. ANSWER: (D) is the correct answer. See MPEP § 2173.05(c), under the heading "Open-Ended Numerical Ranges." Paraphrasing the explanation therein, when an independent claim recites a composition comprising "at least 20% iron" and a dependent claim sets forth specific amounts of non-iron ingredients which add up to100%, apparently to the exclusion of iron, an ambiguity is created with regard to the "at least" limitation unless the percentages of the non-iron ingredients are based on the weight of the non-iron ingredients. On the other hand, a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of iron, 20-80% of gallium, and 1-25% of copper) is not necessarily indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. Here, because the invention is a non-theoretical alloy, the sum of the claimed constituents cannot exceed 100% unless the percentage is based on weight. In (D), the sum of elements (B) and (C)

is 81% by volume, leaving only 19% for iron. Claim 1, however, requires "at least 20% iron," rendering Claim 2 ambiguous as to the percentage of element A. (A) is incorrect. The sum of gallium and copper components is 80%, leaving a possible 20% of the composition for element iron. Claim 1 requires "at least 20% iron," which includes 20% iron. Therefore, the sum of iron, gallium and copper components in Claim 2 is 100%. (B) is incorrect. "At least 20% iron" includes 21% iron, "at least 10% gallium includes 11% gallium, and "at least 10% copper includes 10.01% copper. (C) is incorrect. "At least 20% iron" includes 20% iron, "at least 10% gallium includes 10% gallium, and "at least 10% copper" includes 10% copper. (E) is incorrect because Claim 1 uses the open transition phrase "comprising," which permits additional elements to be added to the composition. Nothing in the problem indicates that an additional component, silver, cannot be added to the composition.

50. 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 x 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.