

**EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES
BEFORE THE U.S. PATENT AND TRADEMARK OFFICE
AUGUST 27, 1997**

MORNING SECTION MODEL ANSWERS

1. ANSWER: (A). By following the procedure in (A), the claims are no longer anticipated by Z's patent because particular limitations are now disclosed in inventor B's application which are not disclosed or suggested in inventor Z's patent. 35 U.S.C. § 102(a) and (e); MPEP 2131. "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*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (B) is not correct because under 35 U.S.C. § 102(e), the effective date of the prior art patent is the filing date of Z's patent (Feb. 5, 1995), which is prior to B's conception (October 10, 1995). 35 U.S.C. § 102(e); MPEP 2136 - 2136.05. Further, the antedating affidavit or declaration under 37 CFR § 1.131 is not effective because the facts do not show a completion of the invention in this country. (C) is not correct because the foreign priority date (June 3, 1996) does not antedate the filing date (February 6, 1995) of Z's patent, which is the controlling date for purposes of overcoming the rejection under 35 U.S.C. § 102(e). 35 U.S.C. § 119; MPEP 201.15. (D) is not correct because (B) and (C) are not correct. (E) is not correct because (C) is not correct.

2. ANSWER: (C). 37 CFR § 1.45; MPEP 605.07. Y made no contribution to the invention, having provided merely mechanical implementation to what inventor X had concluded would improve the results. (A), (B), (D), and (E) describe joint inventorship situations inasmuch as there is no requirement that joint inventors work in the same physical location, that they all be joint inventors to the subject matter of any one claim, that they be employed by the same employer, or that they make equal contributions to the claimed subject matter.

3. ANSWER: (C). See example 1, situation 4 in MPEP 706.02(k). (A) alone is insufficient. It addresses only the provisional double patenting rejection, but not the provisional rejection under 35 U.S.C. § 102(e)/103. MPEP 706.02(k). (B) is incorrect because it is inconsistent with the given facts, i.e., invention AB was invented on October 30, 1996, which is after invention A was invented in September 1996. (D) is incorrect because a petition to waive the provisions of 37 CFR § 1.132 is not needed inasmuch as 37 CFR § 1.132 does not prohibit an affidavit or declaration where substantially the same invention is being claimed. Also, a disclaimer of any patent does not allow for suit against an alleged infringer where substantially the same patentable invention is being claimed. Further, it is unnecessary to disclaim an entire patent where only a terminal disclaimer is needed. (E) is incorrect because it does not address the provisional double patenting rejection, and it does not address the prohibition of the use of 37 CFR § 1.131 affidavits or declarations where the same patentable invention is being claimed. MPEP 706.02(k), 715.05.

4. ANSWER: (E). (E) is the most inclusive answer (it includes each of (A), (B), and (C)); whereas answers (A), (B), (C), and (D) are less inclusive. The given facts make out a *prima facie* case under 35 U.S.C. § 102(a) inasmuch as the same invention was patented in this country before the invention thereof by Z, i.e., before the filing date of Z's application. MPEP 2126, 2126.01, 2132, and 2132.01. Also, a *prima facie* case under 35 U.S.C. § 102(e) is made out because the same invention is described in a patent granted on a patent application by another, i.e., M's application, before the invention thereof by Z, i.e., before the filing date of Z's application. MPEP 2136 - 2136.04. Further, the given facts make out a case for 35 U.S.C. § 102(g) inasmuch as before the invention thereof by Z, i.e., before Z's filing date, the invention was made in this country, i.e., constructively reduced to practice by the filing of M's patent application, by another, i.e., M, who had not abandoned, suppressed or concealed the invention. MPEP 2138, 2138.02, 2138.03, and 2138.05.

5. ANSWER: (D). The second application does not refer to the first application, and the third application refers only to the second application. Therefore, the third application cannot benefit from the filing date of the first application. Inasmuch as the reference has a publication date which is more than one year before the filing date of the second application, and the reference fully describes the claimed invention, the reference is prior art under 35 U.S.C. § 102 against the claims. 35 U.S.C. § 120; MPEP 201.11 (page 200-31). (A), (B), and (C) are incorrect because the third application does not derive the benefit of the filing date of the first application. (E) is incorrect because the rationale is in error. The effective filing date of the third application is September 20, 1995, the filing date of the second application, not January 15, 1997, as stated in answer (E). MPEP 201.11 (page 200-30).

6. ANSWER: (C). Only (C) meets the requirements of PCT Article 31(6)(a).

7. ANSWER: (B). The first application is fatally defective because of insufficient disclosure to support allowable claims due to lack of a disclosure enabling one skilled in the art to make the invention. Where, in such case, a second application is filed as a continuation-in-part of the first application to supply the deficiency, the second application is not entitled to the benefit of the filing date of the first application, and a rejection under 35 U.S.C. § 102 is proper. 35 U.S.C. §§ 102 and 120; MPEP 201.11 (page 200-31 to 200-32). In the given facts, the second application is a continuation-in-part application because it adds matter not disclosed in the first application, i.e., "an enabling disclosure." MPEP 201.08. (A), (B), and (C) are incorrect because the rejection is proper, and the explanations are unfounded. (E) is incorrect because GATT does not cause Great Britain or other foreign countries to be "in this country" for purposes of the Patent Statute. See, e.g., MPEP 2132, and 2133.03(d).

8. ANSWER: (B). An applicant need not have actually reduced the invention to practice. Therefore, the specification need not include a written description of the actual reduction to practice. The description meeting the enablement requirement of 35 U.S.C. § 112, first paragraph, may be prophetic, as opposed to a "working" example, if an example is disclosed. MPEP 2164.02. (A), (C), (D), and (E) are required by 35 U.S.C. § 112, first paragraph.

9. ANSWER: (D). When a claimed composition or machine is disclosed identically by a reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." *In re Donohue*, 226 USPQ 619 (Fed. Cir. 1985); *In re Samour*, 197 USPQ 1, (CCPA 1978); MPEP 2131.01. (A) is erroneous because although as a general rule only one reference should be used in making a rejection under 35 U.S.C. § 102, as described in MPEP 2131.01, it is proper to use multiple references to prove a reference contains enabled disclosure, to explain the meaning of a term in the primary reference, or to show that a characteristic which is not disclosed is inherent. (B) is erroneous because motivation is not required. *In re Donohue, supra*; MPEP 2131.01. (C) is erroneous because the publication taught all the elements. MPEP 2131.01. (E) is erroneous because it was necessary to prove that the publication contains an enabling disclosure by showing that the public had possession of the invention more than one year before the application was filed. MPEP 2131.01.

10. ANSWER: (A). A provisional rejection under 35 U.S.C. § 102(e)/103 is authorized where two applications of different inventive entities are copending and the filing dates differ, and the applications have a common assignee or common inventor. 35 U.S.C. § 122; MPEP 706.02(k). In (A), the rejection would be improper inasmuch as there is no common inventor and no evidence of a common assignee. In (B), the rejection would be appropriate inasmuch as there is a common inventor. In (C), the rejection would be appropriate inasmuch as there is a common inventor and common assignee. In (D) and (E), the rejection would be appropriate inasmuch as there is a common assignee.

11. ANSWER: (B). Prior to filing a first, original application, no interview is permitted. MPEP 713.02. (A) is true. MPEP 713.05. (C) is true. MPEP 713.02. (D) is true. MPEP 713.04. (E) is true. MPEP 713.05.

12. ANSWER: (A). 35 U.S.C. § 103. (B) is wrong because evidence of secondary considerations cannot overcome a rejection under 35 U.S.C. § 102. *In re Wiggins*, 179 USPQ 421 (CCPA 1973); MPEP 2131.04. (C) is wrong because such arguments are "not 'germane' to a rejection under section 102." *Twin Disc, Inc. v. U.S.*, 231 USPQ 417, 424 (Ct. Cl. 1986) (quoting *In re Self*, 213 USPQ 1, 7 (CCPA 1982)); MPEP 2131.05. (D) cannot overcome the rejection because "others" in 35 U.S.C. § 102(a) refers to any entity which is different from the inventive entity, and the entity need only differ by one person to be "by others." See *In re Katz*, 215 USPQ 14 (CCPA 1982); MPEP 2132. (E) is wrong because (B), (C), and (D) are wrong.

13. ANSWER: (C). 37 CFR § 1.56; MPEP 2001.04. "There is no duty to submit information which is not material to the patentability of any existing claim." (A) is wrong because the amendment will be entered per MPEP 714.01(d). (B) is wrong because the amendment does not comply with 37 CFR §§ 1.119, 1.121, and 1.124, and could not be entered. As stated in 37 CFR § 1.124, "[w]hen an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion." See also MPEP 714.24. (D) and (E) do not place the application in condition for allowance because the claims submitted by Jones,

which read upon the prior art disclosed by Jones to P, are still contained in the application.

14. ANSWER: (E). (E) comports with MPEP 608.01(p), "Improper Incorporation," p.600-63. (A) and (C) are incorrect because the given facts do not state that the amendment is accompanied by an affidavit or amendment executed by the applicant or practitioner representing applicant, stating that the amendatory material consists of the same material incorporated by reference. (B) does not follow the procedure adopted by the PTO, and described in MPEP 608.01(p) for overcoming improper incorporation. (D) is incorrect because essential material may not be incorporated by reference to a magazine article. The given facts in (D) do not state that an amendment has been filed to amend the specification to include the material incorporated by reference.

15. ANSWER: (C). The petition to revive the provisional application in accordance with 37 CFR § 1.139(b) is filed within one year of the date of abandonment of the provisional application. If the petition to revive the provisional application is granted, Jones' nonprovisional application may claim the benefit of the filing date of the provisional application under 37 CFR § 1.139(b) since the nonprovisional application is filed within twelve months from the filing date of the provisional application. See 37 CFR § 1.78(a)(3); MPEP 201.11. The Gezer publication is prior art under 35 U.S.C. § 102(a) against the claim(s) of the nonprovisional application because the publication was published less than one year prior to the earliest effective filing date of the Jones' nonprovisional application. and Jones can antedate the publication with an antedating affidavit under 37 CFR § 1.131. The duty of disclosure regarding Gezer publication is met. See 37 CFR § 1.56. (A) and (B) are incorrect since they do not seek to revive the provisional application, and without benefit of the filing date of the provisional application, the Gezer publication is prior art under 35 U.S.C. § 102(b) against the claim(s) of the nonprovisional application. The 35 U.S.C. § 102(b) rejection cannot be overcome by an affidavit under 37 CFR § 1.131 because the applications filed in (A) or (B) were filed more than one year after February 2, 1996, the date of the publication. (B) is incorrect for the additional reason that (D) is incorrect. The nonprovisional application is not copending with the provisional application because it is filed more than twelve months from the filing date of the provisional application. 37 CFR §§ 1.78(a)(3) and 1.139(e); MPEP 201.11. (E) is incorrect because a provisional application does not obtain the benefit of the filing date of any earlier application. 37 CFR § 1.53(b)(2)(iii).

16. Deleted.

17. ANSWER: (D). Only (D) satisfies the provisions of 37 CFR § 1.495(b)(2).

18. ANSWER: (C). MPEP 1207; 37 CFR§ 1.116(b). The response in (C) is directed to a response "complying with a formal requirement of the Examiner." MPEP 1207 provides that "[t]o expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to . . . adopt examiner suggestions." The requirements of 37 CFR § 1.116(b) are triggered if the response involves an amendment touching the merits of C's application. (A), (B), and (D) involve responses touching the merits of C's

application. (A) is directed to a response presenting the argument in a more defensible light. The argument necessarily touches the merits of the application. (A) is also directed to a response that "adds additional claims." MPEP 1207 recites, "[I]f the amendment . . . presents additional claims without canceling a corresponding number of finally rejected claims, . . . it will not be entered." (B) is directed to a response "amending the claims into process claims." Since all of the finally rejected claims are directed to an article of manufacture, amending the claims into process claims necessitates a new search and introduces new issues. MPEP 1207 recites, "[I]f the amendment necessitates a new search . . . or otherwise introduces new issues, it will not be entered." In (D), the amendment of all the independent claims necessitates a new search, raises the issue of new matter, or otherwise introduces new issues. MPEP 1207 provides that "if the amendment necessitates a new search, raises the issue of new matter, . . . or otherwise introduces new issues, it will not be entered." Although the response in (D) is "accompanied by a declaration from the inventor," the answer is silent with respect to whether or not the declaration satisfies the requirement of 37 CFR § 1.116(b) of "a showing of good and sufficient reasons why they [the amendments] are necessary and were not earlier presented." (E) is wrong because it is directed to the responses of answers (A) and (D), both of which are wrong.

19 ANSWER: (D). MPEP 1503.02 recites the following:

Structure that is not part of the claimed design but is considered necessary to show the environment in which the article is used may be represented in the drawing in broken lines. Additionally, a portion of an article that is not considered part of the design may be shown in broken lines, *In re Zahn*, 204 USPQ 988 (CCPA 1980). A broken line showing is for illustrative purposes only and forms no part of the claimed design.

(A) is incorrect because it indicates that broken lines may be used to show "[a] less important aspect of the claimed design." MPEP 1503.02 makes clear that broken lines are not permitted for the purpose of indicating that a portion of an article is of lesser importance in the design, *In re Blum*, 153 USPQ 177 (CCPA 1967); that broken lines indicate the environmental structure or the portion of the article depicted in broken lines forms no part of the design, and that broken lines do not indicate the relative importance of parts of a design. (B) is incorrect because broken lines may not properly be used to show hidden planes and surfaces. 37 CFR § 1.152. (C) is incorrect because broken lines may not be used to show indicia, lettering, or other ornamentation. Surface indicia embodied in the article must be shown in the drawings. MPEP 1503.02. (E) is wrong because it refers to answers (A) and (D), both of which are wrong.

20. ANSWER: (E). 37 CFR § 1.248(a) provides that "[s]ervice of papers must be . . . on the party if there is no attorney or agent." Thus, service of papers on the applicant in the case of a *pro se* application is proper. (A) recites a method of service of papers which is proper according to 37 CFR § 1.248(a)(4). (B) refers to a method of service of papers which is proper according to 37 CFR § 1.248(a)(1). (C) refers to a proper method of service of papers according to 37 CFR § 1.248(a)(2). (D) refers to a proper method of service of papers according to 37 CFR § 1.248(a)(3). (E) is the most correct answer because it refers to "[a]ll of the above." The

DIRECTIONS state that “[w]here choices (A) through (D) are correct and choice (E) is ‘All of the above.’ the last choice (E) will be the most correct answer and the only answer which will be accepted.”

21. ANSWER: (A). A doctoral thesis is a printed publication if it is shelved at a university library and indexed by subject and cataloged in the library card catalog. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986); MPEP 2128.01. Since the effective date of the thesis as a printed publication precedes the date of the invention, the thesis is available as a reference to defeat patentability of the invention under 35 U.S.C. § 102(a). (B) is incorrect because indexing a thesis by graduating class affords no rational relationship to the subject matter of the thesis, and could not reasonably be located by persons interested and ordinarily skilled in the subject matter of the thesis, exercising reasonable diligence. *In re Cronyn*, 13 USPQ2d 1070 (Fed. Cir. 1989). (C) is incorrect because a paper presented to members of the university graduate committee is insufficient to constitute a publication, i.e., dissemination to others of written copies of the orally presented thesis. *In re Bayer*, 196 USPQ 670 (CCPA 1978); MPEP 2128.01. (D) is incorrect because the answer does not indicate that the presentation occurred in the United States. 35 U.S.C. § 102(a); MPEP 2128.01. Answer (E) is incorrect because answer (A) is correct.

22. ANSWER: (E). 37 CFR § 1.637(c)(3) indicates that (A) and (B) shall be included in a preliminary motion seeking to designate an application or patent claim to correspond to a count. (C) is incorrect because no fee for the preliminary motion is required. Answer (E) is the most correct answer because it recites, “(A) and (B),” both of which are correct. The DIRECTIONS state that “[w]here two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices.”

23. ANSWER: (D). MPEP 306 states that “[i]n the case of a . . . continuation-in-part, a prior assignment of the original application is not applied to the . . . continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. . . . [C]ontinuation-in-part applications require a new assignment if they are to be issued to an assignee.” Accordingly, the preparation and filing of papers assigning the continuation-in-part application to Golf, Inc., as recited in answer (D), is the correct course of action. (A), (B), and (C) are incorrect because the assignment of the original application does not give Golf, Inc. the rights to the subject matter added in the continuation-in-part application. (B) is also incorrect because Golf, Inc. would not own the rights on a patent when it issues. (E) is incorrect because it is improper under 37 CFR § 3.81 to list Golf, Inc. as assignee.

24. ANSWER: (A). (A) is in accord with MPEP 602.03. (B) and (E) are incorrect because the wording of a declaration cannot be amended after it has been signed. MPEP 602.01. (C) is incorrect because the inventor must indicate his or her country of citizenship in a declaration pursuant to statutory requirement. 35 U.S.C. § 115. (D) is incorrect because statutory requirement of 35 U.S.C. § 115 cannot be waived by the Office. MPEP 602.03.

25. ANSWER: (E). 37 CFR § 1.196(b); MPEP 1214.01. (A) and (C) are both correct responses

to a new ground of rejection entered by the Board. The procedure in (A) is in accord with the discussion in MPEP 1214.01 regarding an appellant filing a request for reconsideration by the Board of the rejection under 37 CFR § 1.197(b) within 1 month from the date of the decision, the period set by 37 CFR § 1.197(b). The procedure in (C) is in accord with the discussion in MPEP 1214.01 regarding an appellant's right to amend the claims involved to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Appellant may also submit a showing of facts under 37 CFR § 1.131 or 37 CFR § 1.132, if appropriate. (E) is the most correct answer because it states that "[b]oth (A) and (C) are correct," and, in fact, both (A) and (C) are correct. The DIRECTIONS state, "Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices." (B) is incorrect because the new rejection is not considered final for purposes of judicial review. 37 CFR § 1.196(b). (D) is incorrect because the basis for the affirmed rejection is not open to further prosecution by amending Claim 1 to define over Leary. MPEP 1214.07 states, "Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that the prosecution of the case is definitely closed, the appellant clearly is not entitled to have such amendment entered as a matter of right."

26. ANSWER: (E). All the claims are proper. 35 U.S.C. § 251; MPEP 1412.03. An amendment broadening the scope of the claims in a reissue application is proper if the reissue application is made within two years of the issue date of the original patent. Here the patent issued on April 5, 1994, and the reissue application was filed just within two years from the issue date of the patent. Amended Claim 1 broadens the original Claim 1 from comprising 20 to 30 percent active component to comprising 10 to 40 percent active component, and is supported by the disclosure. Added Claim 2 narrows the percent preservative from 5 to 20 percent preservative to 10 to 15 percent preservative, and is supported by the disclosure. Added Claim 3 broadens from 20 to 30 percent active component to 20 to 35 percent active component, narrows from 5 to 20 percent preservative to 10 to 15 percent preservative, narrows from 40 to 85 percent water to 50 to 70 percent water, and is supported by the disclosure.

27. ANSWER: (D). See PCT Article 11.

28. ANSWER: (E). The advice given in both (A) and (B) is correct and should be told to Jones. (A) is correct because 35 U.S.C. § 251 prohibits introduction of new matter. 35 U.S.C. § 251; MPEP 1411.02. (B) is correct because a claim directed to the omitted embodiment may not be supported under 35 U.S.C. § 112, first paragraph by the original disclosure. (C) is incorrect because Jones has two years from date of issue to enlarge the scope of the claims, if Jones is entitled to the broader scope. 35 U.S.C. § 251 and MPEP 1412.03. (D) is incorrect because Jones can submit an affidavit that attests to the loss of the patent instead of submitting the original patent. 37 CFR § 1.178.

29 ANSWER: (C). MPEP 1605. I is false because adding description to correct deficiencies in a plant patent application does not always constitute new matter. II is false because the rules on deposits of biological materials do not apply to plant patent applications. III is true because a

method claim is improper in a plant patent application and must be canceled. Inasmuch as the question seeks which statements are false, and statement III is true, answers (A), (B), (D), and (E), which refer to III, are incorrect to the extent they are true. Answer (C) is wholly false. Therefore, (C) is the most correct answer.

30. ANSWER: (A). MPEP 2202, 2204, and 2205. Prior art references may be cited to the PTO for placement into the file of an issued patent. MPEP 2202. (A) complies with 35 U.S.C. § 301, and is correct because an explanation is required of how the person submitting the prior art considers it to be pertinent and applicable to the patent. MPEP 2205. (B) is not correct because citations of prior art may be filed during the period of enforceability of the patent, which includes the 6 year period after the expiration of the patent. MPEP 2204. (C) is not correct because prior art may be entered into a patent file regardless of whether reexamination is warranted. (D) is not correct because a fee is not required. MPEP 2202.

31. ANSWER: (B). (B) conforms with 37 CFR § 1.75(c). Answer (A) is not a correct answer because there cannot be only two claims in a patent with multiple dependent claims. The multiple dependent claim cannot depend from a single claim. Answer (C) is not correct. See MPEP 608.01(n). Answer (D) is not correct. Nothing in 37 CFR § 1.75 prohibits an amendment from adding multiple dependent claims. Answer (E) is not correct. See 37 CFR § 1.16(d).

32. ANSWER: (D). 35 U.S.C. § 102(e), and 35 U.S.C. § 371(c) (1),(2), and (4)

33. ANSWER: (A). It is the only answer that addresses the fact that the claimed invention relates to a specific use, i.e., high temperature lubrication, which is not taught by the reference publication. 35 U.S.C. § 102. (B) is erroneous because the argument addresses "use with high speed aircraft," whereas the claimed invention relates to high temperature lubrication, and the argument does not address high temperature lubrication. (C) is erroneous because the argument addresses "good lubrication properties," while the claimed invention relates to high temperature lubrication. (D) is erroneous because the argument addresses the age of the reference; unclaimed subject matter, i.e., the process of preparing the mixture; and conjecture, i.e., the possibility the prior art tested a contaminated specimen. The argument in (D) shows no patentable distinction between the claimed invention and the prior art. (E) is erroneous because the argument addresses an unsupported distinction.

34. ANSWER: (C). 37 CFR § 1.75(c); MPEP 608.01(n). For fee calculation purposes, a multiple dependent claim is considered to be the number of claims to which direct reference is made therein. Also for fee calculation purposes, any claim depending from a multiple dependent claim is considered to be the number of claims to which direct reference is made in the multiple dependent claim. Using the given facts, the fee is calculated as follows:

	Ind.	Dep.
1. Independent	1	
2. Dependent on claim 1		1
3. Dependent on claim 1		1

4. Dependent on claims 2 and 3		1
5. Independent	1	
6. Dependent on claim 1, 2 or 5		3
7. Dependent on claim 6		3
	2	
Total		9

Inasmuch as Claim 4 is an improper multiple dependent, it counts as one claim, as opposed to being two claims. Thus, there are 11 total claims for fee calculation purposes.

35. ANSWER: (D). Power to inspect may be given by the attorney of record. See 37 CFR § 1.14(a), and MPEP 104. (A) and (E) are incorrect since company Z is not an assignee of record, and therefore, permission to inspect given by company Z is not proper. (B) and (C) are incorrect statements of the law and PTO policy set forth in MPEP 104.

36. ANSWER: (B). (B) clearly reduces issues for appeal by canceling a claim, and is the most correct answer in accordance with MPEP 714.13, and 37 CFR § 1.116. Choices (A), (C), (D), and (E) are wrong. By adding at least one new claim, or by amending one or more claims, (A), (C), (D), and (E) require more than a cursory review by the examiner, and they do not necessarily reduce the issues for appeal. Thus, such amendments are not entitled to be entered. See 37 CFR § 1.116, MPEP 714.12, 714.13

37. ANSWER: (E). (E) complies with MPEP 708.02; 37 CFR § 1.102. Choices (A), (B), (C), and (D) are wrong because each one may serve as a basis to make an application special.

38. ANSWER: (D). The procedure in (D) complies with 37 CFR § 1.36, which reads, in pertinent part, as follows: "an attorney or agent may withdraw, upon application to and approval by the Commissioner." MPEP 402.06 provides that "The **withdrawal is effective when approved** rather than when received." (Emphasis in original statement). (A), (B), (C) and (E) are inconsistent with the provisions of 37 CFR § 1.36, and the practice described in MPEP 402.06.

39. ANSWER: (B). (B) complies with 37 CFR § 1.136 (a)(2); and MPEP 710.02(e). Choices (A), (C), (D), and (E) are wrong because the fee paid in these answers covers more or less time than the period of time required of an extension of time on July 22, 1996. The petition and fee must be filed within the extended time period for response. 37 CFR § 1.136; MPEP 710.02(e).

40. ANSWER: (E). 37 CFR § 1.97(b)(3); MPEP 609. No petition, certification, or fee is needed because the IDS was filed before the first Office action. (A), (B), (C), and (D) are not in accordance with 37 CFR § 1.97, and MPEP 609, pp. 600-93 and 600-97.

41. ANSWER: (E). 37 CFR § 1.97(d); MPEP 609. (A) though (D) are wrong because the IDS was filed more than three months after the filing date of the application, and after the Notice of Allowance was mailed. Applicant must now comply with 37 CFR § 1.97(d)(2).

42. ANSWER: (D). The provisions of 35 U.S.C. § 119(d) are satisfied by (D). (A) is wrong because there is no claim for priority under 35 U.S.C. § 119(b). (A), (B), and (C) are wrong because they do not provide for a certified copy of the foreign application. 35 U.S.C. § 119(b). (E) is wrong because patent applicants may base their claim for benefit of foreign priority on either a foreign patent application or an inventor's certificate where they have discretion to file for either type of protection. 35 U.S.C. § 119(d).

43. ANSWER: (B). 35 U.S.C. § 121. The third sentence of 35 U.S.C. § 121 prohibits use of a patent issuing on an application with respect to which a requirement for restriction has been made, on a divisional application filed as a result of the requirement if the divisional application is filed before the issuance of the patent. (A), (C), (D), and (E) are incorrect because the two patent applications are not copending. The patent issued before the divisional application was filed. Thus, the latter application, which was filed after issuance of the patent, does not obtain the benefit of the filing date of the first application, and the latter application is subject to rejection under 35 U.S.C. §§ 101, 102, and/or 103 based on the patent.

44. ANSWER: (C). 37 CFR §§ 1.11, and 1.12; MPEP 301.01. 37 CFR 1.12(b) states that "[a]ssignment records . . . relating to any pending . . . application are not available to the public." (A) is wrong because an interference file is open if the interference involved a patent and the interference has terminated. 37 CFR § 1.11(e). (B) is wrong because all papers relating to a reexamination proceeding which have been entered of record in a reexamination file are open to the public. 37 CFR § 1.11(d). (D) is wrong because assignment records relating to issued patents are open to the public. 37 CFR § 1.12(a). (E) is wrong because the records relate to an issued patent. Referring to assignment documents, MPEP 301.01 states, "if a document covers . . . a patent in addition to one or more patent applications, it will be available to the public *ab initio*; and if it covers a number of patent applications, it will be so available as soon as any one of them is patented."

45. ANSWER: (B). 37 CFR § 1.34; MPEP 405. (A) is false. MPEP 402.06. (C) is false. 37 CFR § 10.158(a). (D) is false. 37 CFR § 10.160. (E) is false because (D) is false

46. ANSWER: (C). 35 U.S.C. § 116, second paragraph; MPEP 409.03(a), and 605.07. X must file an application on behalf of himself and Y, the joint inventor. (A), (D), and (E) are incorrect because they provide that X would file an application for patent as the sole inventor when actually the application by X must be made on behalf of himself and the omitted inventor. 35 U.S.C. § 116, second paragraph. (B) incorrect because there are no provisions for allocating the filing fee, or making rights dependent upon payment of fees. The entire filing fee must be paid. 35 U.S.C. § 41(a)(1). (D) is also incorrect because X cannot properly request that joint inventor Y be barred from joining in the application, and Y can join in the application. (E) is also incorrect because X cannot properly request, and the PTO cannot bar Y from patent rights to which he may be entitled.

47. ANSWER: (A). 35 U.S.C. §§ 101, 120, and 122; Chapter 100 of the MPEP. Only by permitting the pending application to become abandoned and not referring to it in another

application, which may mature into a patent, may the disclosure in the pending application remain confidential. Also, the described procedure provides the client with an opportunity to obtain a patent on the newly developed invention without causing the uric acid-containing invention to be disclosed. (B) allows the public to see the previously filed application. (C) and (E) do not maintain the uric acid composition in confidence if a patent is granted on the amended application. (D) improperly seeks to use a reissue application where no patent has issued.

48. ANSWER: (B). See MPEP 608.01(p). Answers (A), (C), and (D) are incorrect. MPEP 608.01(p). Answer (E) is incorrect because it does not meet the requirements for non-essential or essential material. MPEP 608.01(p).

49. ANSWER: (C). Interviews may be held without charge for an extension of time during the six month statutory period for responding to an Office action. MPEP 706.07(f). Choices (A), (B), and (E) are wrong because interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without charge for an extension of time. MPEP 713.09. (D) is wrong because interviews are permitted after final rejection in accordance with MPEP 713.09.

50. ANSWER: (E). 35 U.S.C. § 112, second paragraph; MPEP 706.03(d), and 2173.05(d). (A), (B), (C) and (D) are wrong because the terms "for example," "like," "for instance," and "such as" lead to confusion over the scope of the claims.