

**United States Patent and Trademark Office**  
**April 1999 Registration Examination**  
**AM ANSWERS**

1. ANSWER: (D) is the correct answer because (A) and (B) are both correct. 37 CFR § 1.3; MPEP §§ 714.19, items (E),(K); 714.25. (C) is not correct because 37 CFR § 1.136(a)(3) provides that “[a]n authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission.” Answer (E) is not correct because (C) is not correct.

2. ANSWER: (C) is the correct answer. 37 CFR § 1.143; MPEP § 818.03(b). No invention is elected in (C). A provisional election must be made in response to a restriction requirement, even if the restriction requirement is traversed. MPEP § 818.03(b). (A), (B), and (D) are incorrect because they are all proper responses to a restriction requirement. MPEP § 818.03. (E) is incorrect because it includes (C) which is a correct answer.

3. ANSWER: (B) is the correct answer because it contains a false statement regarding design patents. MPEP § 1504.01(a), subsection III. [p.1500-11] (A) is a true statement. MPEP § 1512, subsection III. [p.1500-38]. (C) is true. MPEP § 1504.01(a), subsection I.A.[p.1500-10] (D) is also a true statement. MPEP § 1503.03 [p. 1500-8]. (E) is true. MPEP § 1504.

4. ANSWER: (A) is the correct answer. 35 U.S.C. § 305; 37 CFR § 1.530(d)(3); MPEP §§ 2250; 2258 subsection III. (“A broadened claim: A claim is broader than another claim if it is broader (greater in scope) ‘in any respect,’ even though it may be narrower in other respects. *In re Freeman*, 30 F.3d 1459, 1464, 32 USPQ2d 1444, 1447 (Fed. Cir. 1994).”) The claim is broadened by changing “knife” to “cutting means,” which is not limited to a knife, but may be a blade, scissors, etc.

5. ANSWER: (E) is the correct answer. 37 CFR § 1.48; MPEP § 201.03. Under 37 CFR § 1.48(a), if the correct inventor or inventors are not named in an executed oath or declaration under 37 CFR § 1.63 in a nonprovisional application for patent, the application may be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor. 37 CFR § 1.48(a) requires that the amendment be accompanied by (1) a petition including a statement from each person being added that the error in inventorship occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR § 1.63; (3) the fee set forth in 37 CFR § 1.17(i); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment. (A), (C) and (D) are incorrect inasmuch as an oath or declaration under 37 CFR § 1.63 by each actual inventor has not

been presented. (B) is incorrect because it does not include the fee required and omits the written consent of the assignee. (E) is in accord with MPEP § 201.03 [p.200-6] which provides that “[t]he statement required from each inventor being added may simply state that the inventorship error occurred without deceptive intention. The statement need not be a verified statement.”

6. ANSWER: (A) is the correct answer. 35 U.S.C. § 102(b). The nonprovisional application deposited via Express Mail on Saturday, February 6, 1999, will be given a February 6, 1999, filing date. 37 CFR § 1.10; MPEP §§ 513; 201.04(b) [p. 200-14]. As such, the nonprovisional application was filed on the last day of pendency of the provisional application so as to claim an effective filing date of February 6, 1998. MPEP §§ 201.04(b); 706.02.

7. ANSWER: (A) is the correct answer. 35 U.S.C. § 103, MPEP §§ 2112.01; 2144; 2145, paragraph II; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) and *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The rationale to modify or combine the prior art does not have to be expressly stated in the prior art. MPEP § 2144. (B) is not correct because knowledge of applicant’s disclosure cannot be relied upon to provide the motivation to combine the references relied upon. MPEP §§ 2142; 2144.04 [p.2100-120]. (C) is incorrect. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. MPEP § 2144. (D) is incorrect. The discovery of a new property or use of a previously known composition, even if unobvious from prior art, cannot impart patentability to a claimed composition. MPEP § 2112. (E) is incorrect. MPEP § 2112 [p. 2100-48].

8. ANSWER: (B) is the correct answer. MPEP §§ 201.09; 706.07(b).

9. ANSWER: (D) is the correct answer. 37 CFR § 1.121(a)(2)(ii); MPEP §§ 714.22; 714.24; 608.01(s).

10. ANSWER: (B) is the correct answer. 37 CFR § 1.495(b); MPEP § 1893.01(b)(1).

11. ANSWER: (E) is the correct answer. MPEP § 1400.1.[p. 1400-1] A Continued Prosecution Application is a request to expressly abandon a prior application. It cannot be used to correct an issued patent. MPEP § 201.06(d).

12. ANSWER: (C) is the correct answer. 35 U.S.C. § 119(b); 37 CFR §§ 1.55 and 1.111(b); MPEP § 201.13.

13. ANSWER: (B) is the correct answer. 37 CFR § 1.72(b); MPEP § 608.01(b).

14. ANSWER: (D) is the correct answer. 37 CFR § 1.132; MPEP § 716. (A) is not the most likely action which would overcome the rejection because there is no nexus to show that the claimed method of bonding the carbide insert is responsible for the increased

sales of the gear cutting machine. MPEP § 716.01(b). (B) is not sufficient because it is not based on any factual evidence. MPEP § 716.01(c). (C) is not properly persuasive because it is an admission that the increased sales of Smith's invention were attributed to heavy advertising and not because of the claimed invention. (E) is not correct because (D) is the correct answer.

15. ANSWER: (E) is the correct answer. MPEP §§ 2131.04; 706.02(b). Claim 2 was rejected as being anticipated by the patent to Y. As set forth in MPEP § 706.02(b), a rejection based on 35 U.S.C. § 102(b) can be overcome by "(A) Persuasively arguing that the claims are patentably distinguishable from the prior art; or (B) Amending the claims to patentably distinguish over the prior art." Evidence of secondary considerations is irrelevant to § 102 rejections and thus cannot overcome a rejection so based. MPEP § 2131.04, citing *In re Wiggins*, 488 F.2d 538, 543; 179 USPQ 421, 425 (CCPA 1973).

16. ANSWER: (B) is the correct answer. 37 CFR §§ 1.75(b); 1.75(c). (A) is not supported by the specification. (C) is not correct because it does not differ substantially from Claim 3. MPEP § 706.03(k). (D) and (E) are not supported by the specification. Also, (D) and (E) are multiple dependent claims which are dependent on Claim 3, another multiple dependent claim.

17. ANSWER: (E) is the correct answer. 37 CFR § 10.32(c).

18. ANSWER: (A) is the correct answer. MPEP § 201.04(b). The filing date of Beavis and Barbara's provisional patent application is January 16, 1998, the date the complete provisional application was received in the PTO. 35 U.S.C. § 111(b)(4); MPEP § 201.04(b). Thus, in Beavis and Barbara's case, the last day of pendency is January 16, 1999, which is a Saturday. As set forth in MPEP § 201.04(b), "[s]ince a provisional application can be pending for no more than 12 months, if the last day of pendency is on a Saturday, Sunday, or Federal holiday, copendency would require that the later filed nonprovisional application be filed on or prior to the Saturday, Sunday, or Federal holiday. See 37 CFR 1.78(a)(3)." However, "if a new patent application is deposited in 'Express Mail' in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2)." (A) is the correct answer because the PTO will accord and stamp the "Express Mail" date stamp of January 16, 1999. MPEP § 201.04(b). [p. 200-14]. Answers (B) and (C) are not correct because they are not the latest date that the nonprovisional application can be filed. The filing date of Beavis and Barbara's provisional application was not the day it was mailed, i.e. January 13, 1998, but the date it was received in the PTO, i.e. January 16, 1998. Answers (D) and (E) are incorrect because patent applications cannot be filed by facsimile, nor can a certificate of mailing be used. See 37 CFR §§ 1.6(d)(3); 1.8(a)(2)(i)(A).

19. ANSWER: (C) is the correct answer. 37 CFR § 10.18(a); MPEP § 402 (pp. 400-3). Statement (I) is not true because practitioners are not **required** to advise their clients regarding sanctions. MPEP § 410 (pp.400-30) Statement (III) is also not true. As

set forth in MPEP § 410, “an applicant has no duty to conduct a prior art search as a prerequisite to filing an application for patent.” Accordingly, answers (A), (B), (D) and (E) are incorrect.

20. ANSWER: (E) is the correct answer. There is no copendency between applications E and any prior application. MPEP § 201.11 (“If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first.”). See MPEP § 710.01(a), fourth paragraph.

21. ANSWER: (C) is the correct answer. 35 U.S.C. § 112, first paragraph; MPEP § 2163. See *Gentry Gallery Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Kaslow*, 217 USPQ 1089 (Fed. Cir. 1983). (A) is incorrect. It is inconsistent with the given facts. (B) is incorrect. Claim 2 further limits claim 1 by limiting the shape of the handlebar. (D) is incorrect. There is no new matter in claim 2 inasmuch as the shape of the handlebar was disclosed in the specification. (E) is incorrect. The Lois patent does not describe a “Y” or “U” shaped handlebar.

22. ANSWER: (B) is the correct answer. 37 CFR § 1.510; MPEP §§ 2210; 2214. (A), (C), (D) and (E) are incorrect because they are required as specified in 37 CFR § 10.510(b)(1), (2), (3) and (4).

23. ANSWER: (B) is the correct answer. 37 CFR §§ 1.36; 10.40(a); 10.40(b)(4); MPEP § 402.06. (A) is incorrect. The timing is inconsistent with MPEP § 402.06. (C) and (E) are incorrect. 37 CFR § 10.40(b)(4). (D) is incorrect. The PTO Disciplinary Rules do not impose the “obligation” to inquire.

24. ANSWER: (D) is the correct answer. 37 CFR § 1.75(c); MPEP § 608.01(n). (A) is incorrect. The claim does not refer back in the alternative only. (B) and (C) are incorrect. They do not further limit the claims from which they depend, which already include D as an element. (E) is incorrect. Multiple dependent claim 3 serves as a basis for multiple dependent claim 4, which is not permitted. 37 CFR § 1.75(c), third sentence.

25. ANSWER: (A) is the correct answer. 37 CFR § 1.97(b); MPEP § 609(B)(1) [p. 600-106]. (B) is not correct because it is not the latest date. (C) and (D) are incorrect. An Information Disclosure Statement (IDS) will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission. (C) did not include a certificate of mailing and (D) used an incorrect “Express Mail” service designation. 37 CFR § 1.10. (E) is incorrect because filing the IDS before the Notice of Allowance will require Bert and Ernie to pay the fee set forth in 37 CFR § 1.17(p) given that Bert and Ernie did not file a statement under 37 CFR § 1.97(e). An IDS filed pursuant to 37 CFR § 1.97(c) will be considered provided that the IDS is accompanied by either (1) a statement as specified in 37 CFR § 1.97(e); or (2) the fee set forth in 37 CFR § 1.17(p). MPEP § 609(B)(2)) [pp. 600-106-107].

26. ANSWER: (D) is the correct answer. MPEP § 804, subsection I (Instances where Double Patenting Issue Can Be Raised) [p.800-15]. III is not correct because “[d]ouble patenting does not relate to international applications which have not yet entered the national stage in the United States.” *Id.* (A), (B) and (C) are incorrect because they include III. (E) is not the most correct answer because it omits II, which is included in (D).

27. ANSWER: (D) is the correct answer. 35 U.S.C. § 102(e). (B) is not correct because “known or used” implies knowledge that is publicly accessible. Priscilla’s composition was not publicly known. “The statutory language ‘known or used by others in this country’ (35 U.S.C. § 102(a)), means knowledge or use which is accessible to the public.” MPEP § 2132, subsection I. [p.2100-66] citing *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). There are no given facts showing that Priscilla’s patent application was accessible to the public, 35 U.S.C. § 122, or that she disclosed her invention to the public before her patent issued. (A) is incorrect. Inasmuch as Priscilla’s patent is not being used to reject Bruce’s claimed process, the difference in their processes does not show any impropriety in the rejection. (C) is incorrect. 35 U.S.C. § 102(e). (E) is incorrect because (B) is incorrect.

28. ANSWER: (D) is the correct answer. 37 CFR §§ 1.131; 1.78(a)(3); 1.56; 1.53(c); MPEP §§ 201.11; 711.03(c), part III, subparts C.1 [p. 700-95] and I [p.700-108]. (A), (B), (C) and (D) are incorrect. The Smith publication would be a statutory bar under 35 U.S.C. § 102(b) to each nonprovisional application, each of which is filed more than one year after the Smith publication date. (E) is also incorrect because the nonprovisional application is filed later than 12 months after the date on which the provisional application was filed. MPEP § 201.11. Thus, petitioning to revive the abandoned provisional application, even if successful, would not prevent the Smith publication from being a statutory bar.

29. ANSWER: (E) is in accord with MPEP § 608.01(p), “Improper Incorporation” [p. 600-73]. (A) is incorrect because it does not include the affidavit or declaration required by MPEP § 608.01(p). (B) is not correct because essential material may not be incorporated by reference to a magazine article and (B) does not state that an amendment has been filed to amend the specification to include the material incorporated by reference. MPEP § 608.01(p). (C) is incorrect because the new application would still contain the same objectionable material and be subject to the same objection. (D) is incorrect because the amendment still needs to be accompanied by an affidavit stating that the amendatory material was the same as that incorporated by reference as required by MPEP § 608.01. The petition and fee are superfluous.

30. ANSWER: (C) is the correct answer. 37 CFR § 1.75(c). As set forth in the disclosure and in FIG. 1, “The piston portion 12 also includes a cylindrical side surface 20 that meets the bottom surface 18 at the circumference of the bottom surface 18.” (A) is not correct because it contains incorrect reference characters and is not supported by the disclosure. (B) is incorrect because the disclosure states that “The bottom surface 18 of the piston portion 12 is preferably made of a non-stick material such as nylon or teflon.” It is

the bottom surface of the piston portion which is made of nylon and not the piston portion itself. (D) is not correct because "said bottom surface" has no antecedent basis in Claim 1. (E) is incorrect because (C) is the correct answer.

31. ANSWER: (C) is the correct answer. (A) is not correct because there is no antecedent basis for "said bottom surface" and "said cylindrical surface." (B) is not correct because it is not known what is in Claim 2 and whether or not there is antecedent basis for "said bottom surface" and "said cylindrical surface." Questions 61 and 62 are independent of each other and the dependent Claim 2 set forth in Question 61 cannot properly be relied upon to respond to Question 62. (D) is not correct because (A) and (B) are not correct. (E) is not correct because (A) is not correct.

32. ANSWER: (A) is the correct answer. MPEP § 706.02(l). (B) is incorrect. MPEP § 706.02(l), item II.B. (C), (D) and (E) are incorrect because no evidence of common ownership is presented. MPEP § 706.02(l). (D) and (E) are also incorrect because no response under 37 CFR § 1.111 has been filed.

33. ANSWER: (D) is the correct answer. 35 U.S.C. § 154(a); MPEP §§ 1309; 1309.01. (A) and (B) are incorrect. MPEP § 1309.01 ("[P]riority under 35 U.S.C. 119(e) to one or more U.S. provisional applications is not considered in the calculation of the twenty year term.") (C) is incorrect. 35 U.S.C. § 154(a). (E) is incorrect. 35 U.S.C. § 154(a).

34. ANSWER: (B) is the correct answer. 37 CFR § 1.121; MPEP § 714.22. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made and is limited to five words or less. (A) is incorrect because there are two occurrences of "steam" appearing in line 4 and the exact point where the insertion is to be made has not been specified. (C) is incorrect because the amendment does not specify the exact point where the insertion of "two" is to occur. (D) is incorrect because the amendment would insert more than five words. (E) is incorrect because it fails to identify the correct point where the insertion is to be made.

35. ANSWER: (C) is the correct answer. 35 U.S.C. § 151; 37 CFR § 1.8; MPEP §§ 505; 1306. (A) is incorrect. The procedure complies with 35 U.S.C. §§ 21(b) and 151. (B) is not correct. The procedure complies with 35 U.S.C. § 151. (D) is not correct. The procedure complies with 35 U.S.C. §§ 21(b); 151, and 37 CFR § 1.8. (E) is incorrect because (A) and (D) are incorrect.

36. ANSWER: (E) is the correct answer. 35 U.S.C. §§ 253; 282.

37. ANSWER: (E) is the correct answer. 37 CFR § 1.530(d)(2)(i)(A); MPEP § 2234. (A) is incorrect. Additions to claims are indicated by underlining. 37 CFR § 1.530(d)(2)(i)(C). (B) is incorrect. 37 CFR § 1.530(d)(i)(C). (C) is incorrect. There is no requirement that the number of new claims equal the number of cancelled claims. 37 CFR § 1.530(d). (D) is incorrect. 37 CFR § 1.530(d)(2)(i)(B).

38. ANSWER: (C) is the correct answer. 37 CFR § 1.192(c)(7)-(8); MPEP § 1206 [pp.1200-8,9]. (A) is incorrect. The separate patentability of claims 2, 3 and 8 is neither pointed out or argued. (B) is incorrect. The separate patentability of the very important claims 1, 2, 3, 5, 6, and 8 is not pointed out and argued. (D) is incorrect. The separate patentability of the very important claims is not argued. (E) is incorrect because (A), (B) and (D) are incorrect.

39. ANSWER: (E) is the correct answer. MPEP § 409.01 [p. 400-21]. A new power of attorney is needed only if the deceased inventor was the sole inventor, which he or she was not in the given facts. (A) is not correct because a new power of attorney is only necessary if the deceased inventor is the sole inventor or all the powers of attorney in the application have been terminated. MPEP §§ 409.01; 409.01(f). Likewise, (B), (C) and (D) are incorrect based on MPEP § 409.01(f).

40. ANSWER: (D) is the correct answer. 35 U.S.C. § 121; MPEP § 804.01. (A), (B) and (C) are incorrect. The use of the patent as a reference against the divisional application is prohibited by 35 U.S.C. § 121. (E) is not the most correct answer because the petition does not stay the period or necessity to reply to the rejection. 37 CFR §§ 1.111; 1.181(f).

41. ANSWER: (E) All of the above. See MPEP § 201.03 (pp. 200-3 - 200-4) As set forth in MPEP § 201.03, (A) is decided by the Board of Patent Appeals and Interferences; (B) is decided in the PCT Legal Office; (C) is decided in the Office of Petitions; and (D) is decided by the Group Director.

42. ANSWER: (C) is the correct answer. MPEP § 2163.06. "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. § 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). (A) is incorrect because it adds new matter to the specification. (B), (D), and (E) are incorrect because they identify an incorrect basis, i.e. 35 U.S.C. § 132, for the rejection.

43. ANSWER: (A) is the correct answer. MPEP § 2173.05(b) [p. 2100-166]. (B) is not a correct answer inasmuch as such limitation was held to be definite in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986) cited in MPEP § 2173.05(b) [p. 2100-166]. The limitation recited in choice (C) was likewise found to be definite by the court in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) cited in *supra*. (D) is incorrect because it includes (B). (E) is incorrect because it includes (B) and (C).

44. ANSWER: (D) is the correct answer. 35 U.S.C. § 251 ("No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."); MPEP § 1403 ("A reissue filed on the 2-year anniversary date is considered as filed within 2 years.") [p. 1400-3].

45. ANSWER: (D) is the correct answer. 37 CFR §§ 1.53(b) and 1.171 (“An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided ....”). MPEP §§ 1403 (“A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR 1.53(f).”); 1410; 1410.01.

46. ANSWER: (C) is the correct answer. 35 U.S.C. § 103; MPEP §§ 2145; 716.02(a). (A) is not correct because it is based upon arguing limitations which are not claimed. MPEP § 2145, VI. (B) is based upon the opinion of one person and is not supported by any factual evidence. MPEP § 716.01(c). (D) is incorrect. The age of the Gage reference, in and of itself is not persuasive of nonobviousness. MPEP § 2145, VIII [p. 2100-137]. (E) is not correct. MPEP § 2145, VII (“Arguing Economic Infeasibility”).

47. ANSWER: (D) is the correct answer. 37 CFR § 1.53(d)(2) (“The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed.”); MPEP §§ 201.06(d) [p.200-38]; 601.01 (“37 CFR 1.53(d) sets forth the filing date requirements for a continued prosecution application.”). (A), (B), (C) and (E) are incorrect because the specification, claims, drawing, and declaration or oath of the previous application are utilized in a CPA. 37 CFR § 1.53(d)(2)(iv). The filing fee may be filed later. 37 CFR § 1.16(l).

48. ANSWER: (E) is the correct answer. 37 CFR § 1.121(a)(2)(ii); MPEP § 608.01(n). (A) is incorrect because the claim number is underlined, as are all the words in the claim even though no matter is added. 37 CFR § 1.121(a)(2)(ii). (B) and (C) are incorrect because the claim does not refer back in the alternative only. MPEP § 608.01(n). (D) is incorrect because the claim number is changed and omitted words are not bracketed. 37 CFR § 1.121(a)(2)(ii).

49. ANSWER: (B) is the correct answer. 35 U.S.C. § 102(b); MPEP § 2112.02 [p.2100-51]. (A) is incorrect because the claim is anticipated. 35 U.S.C § 102(b). (C) is incorrect because the process is not disclosed and current PTO guidelines support the claim. MPEP § 2112.02. (D) is incorrect because the process is anticipated. 35 U.S.C. § 102(b). (E) is incorrect because (B) is incorrect.

50. ANSWER: (E) is the correct answer because it identifies both (A) and (D). (A) is not a proper dependent claim because “up to” 300 amps would include 0-300 amps which is outside of the 100-300 amp range disclosed in the specification. (D) is not a proper dependent claim because the phrase “at least” would encompass ranges outside those disclosed in the specification. MPEP § 2111.03. Use of the phrase “further comprising” adds an additional amplifier and woofer, which are not supported by the disclosure which describes only one amplifier and one woofer. (B) is a proper dependent claim because the wattage is within the wattage range limitation set out in claim 1. (C) is a proper dependent claim because the voltage and wattage are within the limitations for the same set forth in claim 1.