

United States Patent and Trademark Office
April 1999 Registration Examination
PM ANSWERS

1. ANSWER: (A) is the correct answer. The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 CFR § 1.53(d), is the date the complete transmission is received by an Office facsimile unit. A CPA may be transmitted to the Office by facsimile as specified in 37 CFR § 1.6(d)(3), but cannot receive the benefit of a certificate of transmission as specified in 37 CFR § 1.8(a)(2)(i)(A). (A) provides that Will's CPA was received in the PTO at 8:50 p.m. Pacific time or 11:50 p.m. Eastern time, i.e. by Friday, February 12, 1999. An amendment can receive the benefit of a certificate of transmission. 37 CFR §§ 1.6(d); 1.8(a). Able's amendment was sent at 8:50 p.m. Pacific time or 11:50 Eastern time, i.e. by Friday, February 12, 1999. Under 37 CFR § 1.8(a)(1), Able's amendment is considered timely, even though received by the PTO on Saturday, because transmission via facsimile began on February 12, 1999, prior to expiration of the set period of time via facsimile, and included a Certificate of Transmission stating the February 12, 1999, date of transmission. 37 CFR §§ 1.6(d); 1.8(a)(1)(i)(B); MPEP § 502.01. (B) is not correct because Will's CPA was not timely filed. Under 37 CFR § 1.8(a)(2), no benefit will be given to a Certificate of Mailing for a CPA and the actual date of receipt is used to determine if the correspondence has been timely filed. In (B), Will's CPA was received in the PTO at 9:05 p.m. Pacific time or 12:05 a.m. Eastern time on Saturday, and would therefore be accorded a receipt date of Tuesday, February 16, 1999 (Monday, February 15, 1999, is a Federal holiday - President's Day). MPEP § 502.01. (C) is not the correct answer because Able's amendment was not timely filed under 37 CFR § 1.8(a)(1). In this case, Able's amendment was received in the PTO at 9:25 p.m. Pacific time or 12:25 Eastern time on Saturday. "Correspondence for which transmission was completed on a Saturday . . . will be accorded a receipt date of the next succeeding day which is not a . . . Federal holiday within the District of Columbia." As such, Able's amendment would be accorded a receipt date of Tuesday, February 16, 1999. (D) is incorrect because (B) is incorrect. (E) is incorrect because (A) is correct.

2. ANSWER: (C) is the correct answer. MPEP § 513 [p. 500-46]. (A) is incorrect. 37 CFR § 1.8(a)(2)(i)(A). The filing date in (A) would be the day the application is received in the PTO. (B) is incorrect because "Express Mail" must be sent by "Express Mail Post Office to Addressee" and not "Express Mail Post Office to Post Office." MPEP § 502 ("Express Mail" Service at p. 500-7). (D) is incorrect. MPEP § 512 ("Office Procedure. A" at p. 500-43). (E) is incorrect because (B) is incorrect.

3. ANSWER: (E) "None of the above" is the correct answer. As noted in MPEP § 410, the first certification requirement set forth in 37 CFR § 10.18(b) "has permitted the PTO to eliminate the separate verification requirement previously contained in 37 CFR . . . 1.27 [small entity statements], . . . 1.52 [English translations of non-English documents], 1.55 [Claim for foreign priority], . . . 1.102 [Petition to make an application special], . . ."

4. ANSWER: (B) is the most correct answer. MPEP §§ 706.02(b); 2136.05. (A) and (D) are incorrect because an affidavit under 37 CFR § 1.132 is inappropriate in this situation. MPEP § 715.01. (C) will not result in overcoming the rejection of claims 3 and 4 inasmuch as the disclosure of the Australian patent application only supported claims 1, 2, and 5. (E) is not correct because a terminal disclaimer will not overcome a 35 U.S.C. § 102(e) rejection. MPEP § 2136.05 [p. 2100-87].
5. ANSWER: (D) is the correct answer because a fee is required, but is not included with the petition. 37 CFR § 1.102(c) and (d); MPEP § 708.02 [pp.700-72-73]. (A), (B), and (C) are incorrect because they conform to 37 CFR § 102. (E) is incorrect because (D) is correct.
6. ANSWER: (C) is the correct answer. 35 U.S.C. § 41(h); 37 CFR §§ 1.17(h); 1.20(a); MPEP § 509.02. (A), (B), and (D) are incorrect because there is no reduced fee for small entities for III or IV. MPEP § 509.02. (E) is incorrect because (C) is correct.
7. ANSWER: (E) is the correct answer. "Once a patent issues from a national stage application, the filing date for prior art purposes under 35 U.S.C. § 102(e) is not the international filing date, but is the date on which the requirements of 35 U.S.C. § 371(c)(1), (2) and (4) were met. . . ." MPEP §§ 1895.01, subsection E. [p.1800-130]; 2136.03, subsection II. The effective filing date of O'Malley's patent, therefore, is February 17, 1998 - which is **after** Murphy's U.S. filing date of February 12, 1998. The O'Malley patent is not prior art under 35 U.S.C. §102(e). (A), (B), (C) and (D) are incorrect. 35 U.S.C. §§ 102(b), (c), (e) and (f).
8. ANSWER: (C) is the correct answer. The filing date in Canada is more than 12 months before the U.S. filing date for the same invention and the invention was patented in Canada before the U.S. filing date. MPEP § 2135; 2135.01. (A), (B), and (D) are incorrect. 35 U.S.C. §§ 102(a), (b) and (e). (E) is incorrect because (C) is correct.
9. ANSWER: (E) "None of the above" is the correct answer. There is no statutory bar because the sales did not take place in the United States. MPEP § 2133.03(d). (A), (B), (C), and (D) are incorrect because the requirements of 35 U.S.C. §§ 102(a), (b), (f), and (g) were not satisfied.
10. ANSWER: (C) is the correct answer. Murphy did not invent the subject matter sought to be patented. MPEP § 2137; 2137.01. (A), (B), and (D) are incorrect. 35 U.S.C. §§ 102(a), (b) and (g). (E) is incorrect because (C) is correct.
11. ANSWER: (C) is the correct answer. A German Gebrauchsmuster petty patent is usable in a 35 U.S.C. § 102(d) rejection. MPEP § 2135.01, subsection III. [p.2100-81]. The foreign patent was granted prior to Murphy's U.S. filing date. MPEP § 2135.01, subsection III, (E). Thus, Murphy's German application was filed more than 12 months prior to her U.S. filing date for the same invention and was granted before the U.S. filing

date. (A), (B), and (D) are incorrect. 35 U.S.C. §§ 102(b), (c), and (e). (E) is incorrect because (C) is correct.

12. ANSWER: (E) is the correct answer. Both (C) and (D) are false statements. MPEP § 120 [p. 100-15] states that "if such part of the subject matter was or is disclosed to any person in a foreign country . . . , the principals must not inform such person of the Secrecy Order, but instead must promptly furnish to the Assistant Commissioner . . . the following information . . ." (D) is also a false statement. "Use of facsimile transmission is not permitted. 37 CFR 1.6(d)(6)" MPEP § 120 ("Correspondence"). (A) and (B) are true statements. MPEP §§ 120; 130.

13. ANSWER: (D) is the most correct answer because it includes both (A) and (C). Following the procedure in (A) is in accord with 37 CFR § 1.131 and MPEP § 715.07(c). By following the procedure in (C), the claims are no longer anticipated by Z's patent because particular limitations are now claimed in inventor B's application which are not disclosed or suggested by inventor Z's patent. 35 U.S.C. § 102 (a) and (e); MPEP § 2131. (B) is not correct. 37 CFR § 1.131; MPEP §§ 201.15; 715.07(c); 2132.01; 2136; and 2136.05.

14. ANSWER: (D) is the most correct answer because such a mistake could affect the scope and meaning of the patent and is not considered to be of the "minor" character required for the issuance of a Certificate of Correction. MPEP § 1481. (A) and (B) can be corrected by a Certificate of Correction. MPEP § 1481 [p.1400-47]. (C) can also be corrected by a Certificate of Correction. 37 CFR § 1.324; MPEP § 1481 [p.1400-44].

15. ANSWER: (A) is the correct answer. 37 CFR § 1.104(e); MPEP § 1302.14. (B) is incorrect. As set forth in 37 CFR § 1.104(e), "[f]ailure to file such a statement does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner." (C) and (D) are incorrect. Comments are allowed and must be submitted no later than the payment of the issue fee. MPEP § 1302.14. (E) is incorrect. "[C]omments made by applicants on the examiner's statement of reasons for allowance will not be returned to the examiner after their entry in the file and will not be commented on by the examiner." MPEP § 1302.14 [p. 1300-11]

16. ANSWER: (E) is the correct answer. 37 CFR § 1.162; MPEP §§ 1604; 1605; and 1607.

17. ANSWER: (C) is the correct answer. 37 CFR § 1.111; MPEP § 714.02. (A) is incorrect because the fee must be paid when the request for an extension of time is made. 37 CFR § 1.136(a); MPEP § 710.02(e). (B) is not correct. MPEP §§ 714.19(A); 711.01. An amendment canceling all claims is non-responsive to the Office action. As set forth in 37 CFR § 1.111(b), "In order to be entitled to reconsideration . . . , the applicant . . . must reply to the Office action. The reply . . . must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." MPEP §§ 714.19(A); 711.01.

(D) is not correct and does not comply with 37 CFR § 1.111(b). (E) is incorrect. As set forth in 37 CFR § 1.111(b), "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

18. ANSWER: (A) is the correct answer. MPEP § 2113 citing *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). (B) is incorrect inasmuch as "determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." MPEP § 2113 [p.2100-51] (C) and (D) are incorrect because "[t]he fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope." MPEP § 2173.05(p), item (I). (E) is incorrect. "A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used . . . so long as it is clear that the claim is directed to the product and not the process." MPEP § 2173.05(p), item (I)[p. 2100-174].

19. ANSWER: (C) is the correct answer. 35 U.S.C. § 103; MPEP §§ 2143; 2144; 2145; *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). The motivation to modify the reference may suggest what the applicant has done, but for a different purpose. As discussed in MPEP § 2144 [p.2100-115], "[i]t is not necessary that the prior art suggest the combination to achieve the same advantage . . . [citations omitted]" (A), (B), (D) and (E) are incorrect because they are inconsistent with MPEP §§ 2143, 2144, and 2145, as well as *In re Dillon*, supra.

20. ANSWER: (C) is the correct answer. 35 U.S.C. § 41(a). For fee calculation purposes, MPEP § 608.01(n), subsection G.2.(a) provides that "claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends."

21. ANSWER: (A) is the correct answer. 37 CFR § 1.97(c); MPEP § 609. 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). The filing date of the XYZ patent application is October 5, 1998. The omission of the oath from the XYZ application did not affect the filing date of the XYZ application. 37 CFR § 1.53(b); MPEP § 601.01(a). (B) is not correct because the Zucchini patent was not cited by the Japanese Patent Office. The Zucchini patent was discovered by XYZ. Also, under 37 CFR § 1.97(c), XYZ was **not** required to submit both a fee **and** a statement. (C) is not correct because it did not include either the statement or

fee required by 37 CFR § 1.97(c). (D) is not correct because (B) and (C) are incorrect. (E) is not correct because (A) is correct.

22. ANSWER: (A) is the correct answer. The invention was disclosed in a patent by Apple which issued on October 7, 1997, which is prior to the U.S. patent application by XYZ filed October 5, 1998. 35 U.S.C. § 102(a); MPEP § 2132.

23. ANSWER: (B) is the correct answer. 37 CFR §§ 1.111(b); 1.191(a); and 10.18; MPEP §§ 706.01; 714.02. (A), (C), (D), and (E) are incorrect because they do not constitute a reply and request for reconsideration in accordance with 37 CFR § 1.111.

24. ANSWER: (B) is the correct answer. MPEP §§ 1805; 1834.01. (A),(C), (D) and (E) are incorrect. MPEP § 1805. PCT international applications and papers relating to the applications are specifically excluded from the Certificate of Mailing or Transmission procedures of 37 CFR § 1.8. Also, facsimile may not be used to file applications or drawings for PCT applications. MPEP § 1805.

25. ANSWER: (E) is the correct answer because both (C) and (D) are correct. 37 CFR § 1.75(c); MPEP § 608.01(n) [pp.600-66-67]. (A) and (B) are not correct. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly.”).

26. ANSWER: (E) is the correct answer. There is no maintenance fee for a design patent. 35 U.S.C. § 41(b); 37 CFR §§ 1.362(b); 1.362(c)(4); and MPEP § 2504.

27. ANSWER: (D) is the correct answer. 35 U.S.C. § 121. MPEP § 706.03(k) reads “when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.” 35 U.S.C. § 121 refers to an “independent and distinct” invention being in a divisional application. Including the objected claim in a divisional application is incorrect because it is not “independent and distinct.” (A), (B), (C) and (E) are proper replies which could overcome the rejection.

28. ANSWER: (B) is the correct answer because it is a false statement. MPEP § 1416. (A) is a true statement. MPEP § 1410.01. (C) is true. MPEP § 1412.03 (“When a Broadened Claim Can Be Presented”). (D) is a true statement. MPEP § 1430. (E) is also true. 37 CFR § 1.121(b)(2)(i)(B).

29. ANSWER: (A) is the correct answer. MPEP §§ 2146; 706.02(l); 715.01; 715.01(b); and 716.10. (D) is not the best answer because it does not provide the assignee with the best patent protection. (B) and (C) are incorrect because they are both missing a statement from the assignee. The filing of a terminal disclaimer in (E) is inappropriate.

30. ANSWER: (E) is the correct answer. (A), (B), and (C) would all be considered acceptable. 37 CFR § 1.191; MPEP § 1205 ("the rules no longer require that the notice of appeal identify the rejected claim(s) appealed, or be signed . . .") (D) is incorrect because it does not include (C).
31. ANSWER: (B) is the correct answer. (B) sets forth the latest date that an appeal brief can be filed based on a March 23, 1999, Notice of Appeal filing date. 37 CFR § 1.192; MPEP § 1206. The two month period from the date of the Notice of Appeal is not a statutory period and a proper extension of time can be obtained for an additional five months.
32. ANSWER: (A) is the correct answer. 37 CFR § 1.48(d); MPEP § 201.03. [p.200-11]. Answer (B) is wrong because "[n]o amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application." 37 CFR § 1.53(c); MPEP § 201.04(b). Answer (C) is wrong because a certificate of correction applies only after a patent issues. MPEP § 1481. Answer (D) is not the best answer. MPEP § 201.03. There is no prior nonprovisional application from which a continuing application can be filed. (E) is incorrect because the filing of a new cover sheet is not sufficient to add X as an inventor when the earlier filed cover sheet identified only Y as the inventor and complied with 37 CFR § 1.51(c). MPEP § 201.04 [p.200-12].
33. ANSWER: (A) is the correct answer. MPEP §§ 2131; 2131.03; 2173.05(c). The requirement for "up to 2.5% chromium" reads on an alloy containing no chromium since "up to" requires no minimum and includes zero as a lower limit. *In re Mochel*, 176 USPQ 194 (CCPA 1974). Each other element in the claim is disclosed in the reference, and the range amount of each element in the claim reads on the amount disclosed in the reference for each element. Choice (B) is incorrect because the term "consisting of" excludes the inclusion of nickel from the claimed alloy. Answer (C) is incorrect because "2.6% chromium" is not within the scope of "up to 2.5% chromium" recited in the claim. (D) is incorrect because "6% tungsten" is not within the scope of "at least 7% tungsten" recited in the claim. (E) is incorrect because "at least 2% carbon" is not within the claimed range of "0.5-1.0% carbon."
34. ANSWER: (B) is the correct answer. The claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph. MPEP §§ 706.03(o); 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." MPEP 2163.06, citing *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981) [p.2100-144]. (A) and (C) are incorrect. MPEP § 2165.01(IV).
35. ANSWER: (A) is the correct answer. 35 U.S.C. § 103; MPEP §§ 2141 - 2143; § 2143.01; and § 2145. (B) is incorrect. MPEP § 2145(VIII). (C) is incorrect. MPEP § 2145(IV). (D) is incorrect. MPEP § 2145(III). (E) is incorrect. 35 U.S.C. §§ 102(a) and 103.

36. ANSWER: (B) is the correct answer. 35 U.S.C. § 112, first paragraph; MPEP § 2161. (A) is incorrect. MPEP § 2138.05. (C), (D), and (E) are incorrect. MPEP § 2161.
37. ANSWER: (D) is the correct answer. MPEP § 2111.03. The term "comprising" is inclusive or open ended and does not exclude additional, unrecited elements or method steps. (A) is incorrect because the amount of R in the prior art exceeds the limitation in the claim. (B) is incorrect because the claim does not exclude the glass reinforced adhesive film or its location. (C) is incorrect because the dependent claim is not anticipated by the prior art where the coating thickness is not 0.3mm thick. (E) is not correct because (D) is correct.
38. ANSWER: (D) is the correct answer. MPEP § 710.01(a). ("[I]f the period ends on a Saturday, Sunday, or Federal holiday, the reply is timely if it is filed on the next succeeding business day.") July 5, 1999, was a Federal holiday inasmuch as July 4, 1999, occurred on a Sunday.
39. ANSWER: (B) is the correct answer. MPEP § 608.04(b). (A) is incorrect. 35 U.S.C. § 102(a). (C) is incorrect. 35 U.S.C. § 112, second paragraph; MPEP § 2173.05(h). (D) is incorrect. MPEP § 706.03(u). (E) is not correct because (B) is correct.
40. ANSWER: (B) is the correct answer. 37 CFR §§ 1.8(a)(1); 1.8(b); MPEP §§ 1205; 1206. (A) is incorrect. MPEP § 1205 ("The Patent and Trademark Office does not acknowledge receipt of a Notice of Appeal by separate letter.") (C) is incorrect. MPEP § 1206 ("The Office date of receipt of the Notice of Appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP 512.") (D) is not correct because (A) and (C) are incorrect. (E) is not correct because (C) is not correct.
41. ANSWER: (D) is the correct answer. MPEP § 1402. (IV) is not considered independent grounds for filing a reissue application. "[A]n error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C 251." *Id.* [p.1400-2].
42. ANSWER: (E) is the correct answer because none of the choices provided are in accord with proper PTO practice and procedure. (A) is not correct because no amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to a provisional application after the filing date. 37 CFR § 1.53 (c). (B) is not correct because only a continuation or divisional application may be filed as a CPA. MPEP § 601.01 (p. 600-7). (C) is incorrect because a provisional application is not entitled to the benefit of the earlier filed provisional application. 35 U.S.C. § 111(b)(7); 37 CFR § 1.53(c). (D) is wrong because a continuation-in-part "is an

application filed during the lifetime of an earlier **nonprovisional** application." MPEP § 201.08 (emphasis added).

43. ANSWER: (C) is the correct answer. 35 U.S.C. § 120; MPEP §§ 2133.01; 715; 2126; 2127. AuGratin's new claims to A, B, C **and D** is not supported by AuGratin's parent application. As such, the effective filing date of AuGratin's CIP application for the new claim is April 12, 1999. AuGratin's French Patent No. 1, 234, 567 has a critical reference date of more than one year before his April 12, 1999, effective filing date and cannot be removed as a reference. (A), (B) and (D) are incorrect because the CIP application does not get the benefit of the filing date of the parent application for the new claims. 35 U.S.C. § 120. (E) is incorrect because the new claims provide the supporting disclosure. MPEP § 2163.06.
44. ANSWER: (E) is the correct answer because it includes (A), (B) and (D) which are identified in MPEP § 403 (pp.400-9). (C) is incorrect because a Deposit Account number is not the same as a Customer Number. When authorizing charges to a Deposit Account, it is extremely important that the authorization be clear and unambiguous. MPEP § 509.01.
45. ANSWER: (A) is the correct answer. 35 U.S.C. § 112, first paragraph. (B) and (E) are incorrect because the only element of the table required by the claim is the flat board. (C) and (D) are incorrect because the claim requires only the flat board and securing means.
46. ANSWER: (D) is the correct answer because it is a false statement. MPEP § 1512, II. Inclusion of Copyright Notice [p. 1500-37]. (A), (B), and (C) are true statements. See MPEP § 1512, III. Design Patent/Trademark Overlap and IV. Inclusion of Trademarks in Design Patent Applications [p. 1500-38]. (E) is incorrect because it includes (A) and (B) which are both true statements.
47. ANSWER: (D) is the correct answer because both (B) and (C) are true statements. 37 CFR §§ 1.11(b); 1.14(g). (A) is false. MPEP § 1706. (E) is incorrect because it includes (A) which is a false statement.
48. ANSWER: (B) is the correct answer. MPEP §§ 715.01(c); 716.10. (A) is incorrect because the facts are given that Apple invented that which Carrot claims. 35 U.S.C. § 102(g). (C) is incorrect. 35 U.S.C. § 102(g). (D) and (E) are incorrect. A terminal disclaimer does not overcome a 35 U.S.C. § 102(e) rejection. MPEP § 2136.05.
49. ANSWER: (E) is the correct answer. MPEP § 804.01.
50. ANSWER: (D) is the correct answer. 35 U.S.C. § 112; fifth paragraph; 37 CFR § 1.75(c); MPEP § 608.01 (n) [pp.600-65-66]. (A), (B) and (C) are incorrect because they are dependent on multiple claims in the conjunctive. (E) is incorrect because it depends on claims which follow, as opposed to precede, the claim. 37 CFR § 1.75(c).