

Training Module for Chapter 7 of the MPEP

Summary

Chapter 7: Examination of Applications

Section 704.10 – Requirement for Information

- The examiner or other USPTO employees may require the submission of any information that is reasonably necessary to properly examine a pending application.
- The individuals from whom a request can be made include:
 - (1) any inventor named in the application or any assignee
 - (2) any attorney or agent who prepares or prosecutes the application, and
 - (3) every other person who is substantially involved in the preparation or prosecution of the application and who is associated with the inventor, assignee or with anyone to whom there is an obligation to assign the application.
- The scope of the information that may be requested is broad and includes anything reasonably necessary for the proper examination of the application.
- A complete reply to a request for information is a reply to each enumerated requirement giving either the information required or a statement that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested. (The applicant is required to make a good faith effort to obtain the requested information and to make a reasonable inquiry.)

Section 706 – Rejection of Claims

- If the invention is not considered patentable or not considered patentable as claimed, the claims considered unpatentable will be

rejected.

- In rejecting claims for lack of novelty or obviousness, the examiner must cite the best references at his command. The pertinence of each reference cited must be clearly explained and each rejected claim specified.

NOTE: Prior art may not be used as a basis for rejection if the rights to it are entirely owned by the same person, or subject to assignment to the same person, at the time the claimed invention was made.

- The basic requirements for patentability are :
 - (1) novelty (i.e. not previously anticipated) – USC 102
 - (2) non-obvious to someone skilled in the art – USC 103
 - (3) usefulness – Section USC 101

These basic requirements are in addition to those relating to the patent disclosure itself of (A) a written description, (B) enablement, and (C) best mode.

- The standard used to accept or reject claims is the “preponderance of evidence” test.
- If authorized by the applicant, the examiner may formally amend the application to correct all informalities in the written portions of the specifications as well as errors and omissions in the claims. Such an amendment must be signed by the primary examiner, placed in the file, and a copy sent to the applicant.

[Doug’s Comment: While the above discussion could give one the impression that the examination of patents and rejection of claims is a highly disciplined activity that is well established at the USPTO, the reality may be better characterized with a little humor:

Why did you
become a patent
examiner?

Because I
love rejecting
claims.



One of your most important contributions as a patent practitioner will be to properly prepare your client inventors for the reality that the first response from the USPTO on a patent application may be a rejection. But, that is only the first step in prosecuting his/her patent application.]

Section 706.01 – Rejections Contrasted With Objections

- Difference between rejection and objection:
 - (A) Rejection is because the subject matter is un-patentable.
They can be responded to by an appeal.
 - (B) Objection is due to the “form” of the claim being improper (not the substance) – such as a dependent claim that refers to an independent claim that has been rejected. This can be corrected by a petition.

COMMENT: An examiner may reject a claim based on lack of usefulness (Section 101), but not object to it based on this criteria which goes to the substance of the claim not its form.

Section 706.02 – Rejection on Prior Art

- Causes for rejection:
 - (1) The invention was known or use by others in the U.S. or patented or described in a printed publication in this or a foreign country before the invention thereof by the applicant for patent.
 - (2) The invention was patented in a foreign country or in use or sold in a foreign country for more than one year (12 months) prior to the date of the application.
 - (3) The applicant has abandoned the application.
 - (4) Another U.S. applicant has received an earlier filing date
 - (5) An international applicant received an earlier filing date and the U.S. was a designated country and the application was published in the English language.
 - (6) Another inventor can establish during the course of an interference that he made the invention before the other and had not abandoned, suppressed, or concealed his work.
- Prior art does not need to be in the English language. However, if the examiner bases a rejection on only an English abstract, that abstract must contain sufficient detail to stand alone. Otherwise such a rejection is not appropriate and the burden is on the examiner to request a complete translation of the foreign document.
- For a rejection based on USC 102 (anticipation), the prior art must teach every aspect of the claimed invention explicitly.
- For a rejection based on USC 103 (obviousness), the prior art from multiple sources may be assumed to be joined by one generally skilled in the art. **[Doug's comment: As such, this takes a bit of**

leap-of-faith by the examiner.]

NOTE: If a an application filing claims priority to an earlier foreign or provisional application, the effective filing date is the earlier filing date if the U.S application was filed within 12 months of the earlier application.

General Rule: The effective filing date of an application is the actual filing date of the earliest patent application to which it properly claims priority.



That was your patented move?
Seemed like prior art to me.

Section 706.02(a) – Rejection Under USC 102(a), (b), or (e); Printed Publication or Patent

- If an examiner conducts a search and finds a **printed publication (including a patent)** which discloses the claimed invention, the examiner must determine if a rejection should be made under USC 102 (a), (b), or (e).

- The general rule is that the examiner would prefer to reject the claims under 102 (b), if possible, because this provision is a “bar” to patentability. That is, the invention as claimed is barred by law from being patented. **The only option by the applicant would be to cancel the claim or amend it to cover different subject matter (that is already disclosed in the application).** Specifically, if the publication date of the reference is more than 1 year prior to the effective filing date of the application, and the reference contains each and every element of the claims, the reference qualifies as “prior art” under 102 (b).

NOTE: If the one year grace period is up on a Saturday, Sunday or National Holiday, the applicant is given until the next working day to file an application without incurring a 102(b) bar.

USC 102 rejections based on publications can be categorized into the following 3 groups:

- (1) 102(a) can result in a rejection based on any type of publication having a publication date before the effective filing date BUT EXCEPTING THE APPLICANT’S OWN WORK.
- (2) 102(b) can result in a rejection based on any type of publication having a publication date more than 1 year prior to the filing date of the application. THIS LIMITS THE APPLICANT’S GRACE PERIOD TO 1 YEAR TO PUBLICIZE AND PROMOTE HIS INVENTION.
- (3) 102(e) can result in a rejection based only on patent publications with a publication date before the effective filing date BUT ONLY IF THE INVENTIVE ENTITY IS DIFFERENT FROM THE CURRENT APPLICATION.

[Doug’s Comment: Before you are ready to take and pass the Patent Bar Exam, you will have to learn all of the nuances associated with the various 102 rejection categories because this material will be extensively tested and there will not be sufficient time during the exam to discover the subtle differences between 102(a), 102(b), and 102(e) rejections.

Before continuing with this training module, it would be worth while to reflect on the three previous paragraphs and note that these rejection categories are not mutually exclusive. For example, a single prior art reference could possibly be used under all three categories. If this is the case, the examiner would choose a 102(b) rejection since this is the most powerful type of rejection that serves as a “statutory bar” to a patent claim. You should understand the origin of this power and how other types of rejections can be overcome.

After reading this Summary and studying the Selected Questions and Answers for this chapter (which follow), you are also urged to carefully review all of the yellow highlighted material covered in Section 706 in the In-Depth Review of Chapter 7 of the MPEP.]

Section 706.02 (c) – Rejections Under 35 USC 102(a) or (b); Knowledge by Others or Public Use or Sale

- USC 102(b) also establishes a “on-sale” and “public-use” statutory bars. Again, these bars relate to activity **occurring more than 1 year prior to the effective filing date** in order to give the applicant a reasonable grace period.

NOTE: The “on-sale” and “public use” activity must occur in the United States to trigger these bars.

- Both “actual sales” and “offers for sale” can trigger the on-sale bar.
- Grace Period: *The applicant is free to disclose, publish, and commercially exploit his invention within a year prior to filing an application in the U.S. (although some activities may affect patentability in foreign countries).*

Section 706.02(d) – Rejections under 35 USC102(c)

- Section 102(c) relates to rejection due to abandonment of an invention. According to this section, “every reasonable doubt concerning abandonment should be resolved in favor of the inventor”.

For example, a deliberate surrender of patent rights to the public would constitute abandonment but delay alone is not sufficient to infer abandonment.

Section 706.02(e) – Rejection Under 35USC102(d)

- Rejections under 102(d) are limited to cases where the applicant filed an application for a foreign patent more than 12 months before **his** effective U.S. filing date AND the foreign patent actually issued.

NOTE: The requirement that the foreign patent must have been issued is often tested.

- Generally, to avoid such a rejection, an applicant who files a foreign application should file a U.S. application within 12 months.

Section 706.02(f) – Rejections Under 35 USC 102(e)

- Section 102(e) authorizes the Examiner to reject claims based on subject matter disclosed in U.S. patents, U.S. patent publications, and World Intellectual Property Organization (WIPO) publications of international applications *as of their filing date*. But the inventive entity must be different!

REMINDER: U.S. applications will be published 18 months after their filing date. So, an application published on a certain date may be assumed to have been filed for at least 18 months prior to that date!

Section 706.02(g) – Rejections Under USC 102(f)

- A patent application can be rejected if the applicant was not the inventor.
- The Examiner must presume that an applicant is the proper inventor unless there is proof that someone else made the invention AND that the applicant gained (derived) knowledge of it by a communication

from the inventor.

Section 706.02(h) – Rejections Under 35 USC 102(g)

- Section 102(g) bars the issuance of a patent where another made the invention in the U.S. before the applicant and had not abandoned, suppressed, or concealed it.
- This section relates to the broader subject of interference. An interference is decided in favor of the party entitled to priority.
- The party who filed the application is called the “senior party” in an interference matter. All other parties are “junior parties”.
- During an interference, the Board of Patent Appeals and Interferences acquires jurisdiction over the involved patent file and retains this jurisdiction until the interference is terminated (after a final Board judgment and a two month additional period for possible judicial review).
- It should be noted that during examination, an Examiner can also issue a rejection of claims under 102(g) without referring the application to the Board if the subject matter has actually been reduced to practice by another before the applicant’s invention and there has been no abandonment, suppression, or concealment by the other party.

NOTE: “Actually reduced to practice” implies the construction of a physical embodiment of the invention or performed the inventive process, and it worked as intended. Actually reduction to practice is in distinction to constructive reduction to practice which occurs by the act of filing a patent. Thus, hard evidence is required to prove an actual reduction to practice.

Section 706.02(j) – Contents of 35 USC 103 Rejection

- Section 103 defines the non-obvious requirement for patent protection.
- This section authorizes a rejection when the claimed invention is obvious in light of one or more prior art references. When issuing a rejection under Section 103, the following factual inquiries must be considered by the examiner:
 - (1) The scope and content of the prior art
 - (2) The difference between the claimed invention and the prior art, and
 - (3) The level of skill in the prior art.
- To support the conclusion that the claimed invention is directed to obvious subject matter, the references must expressly or implicitly suggest the claimed invention, or the examiner, must present convincing reasoning as to why a skilled artisan would have found the claimed invention to have been obvious in light of the reference.
- This person of ordinary skill in the art (sometimes referred to as a “POSITA”) is a theoretical person of normal skill in the art related to the invention.

NOTE: A POSITA is also used in other contexts in patent law, including whether a claim satisfies the enablement requirement (i.e. whether a POSITA could make or use the invention without undue experimentation.)

Section 706.03 – Rejection Not Based on Prior Art

- Section 101 defines what type of subject matter may be patented. Rejection may be made for lack of utility such as merely a mathematical principle not directed to statutory subject matter, as defined in Section 101.

NOTE: In general an invention must be useful in order to be patentable.

- Section 112 contains 3 separate requirements:

- (1) best mode
- (2) enablement
- (3) written description.

Section 706.03(a) – Rejection Under 35 USC 101

- Section 101: Whoever invents or discovers any new and useful:

- (1) process
- (2) machine
- (3) manufacture
- (4) composition of matter

or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

- Example of subject matter that may not be patented:

- (1) Printed Matter
- (2) Naturally Occurring Article (that is substantially unaltered)
- (3) A Mathematical Principle
- (4) Abstract Concept

- The utility requirement is satisfied if the invention has either (1) a well-established utility disclosed in the specification.
- FOR REGISTRATION EXAMINATION PURPOSES, THE UTILITY REQUIREMENT IS A VERY LOW BAR.

To lack utility, the invention must be completely absurd.

- Example of an invention tested on the registration exam that did not comply with the utility requirement include:

- (1) a perpetual motion machine
- (2) a machine that changes the taste of food based on a magnetic field
- (3) a “cold fusion” process for producing energy
- (4) a method for increasing energy output of fossil fuels upon combustion in a magnetic field
- (5) a complex invention used as a landfill.

Section 706.03(c) - Rejection Under 35 USC, First Paragraph

- The first paragraph of Section 112 contain 3 requirements, previously discussed:

- (1) written description requirement
- (2) the enablement requirement
- (3) the best mode requirement.

Not only are these requirements applicable to the specification, but the claims may also be rejected for failure to comply with these requirements.

- The general test to determine whether an application complies with the written description requirement is whether it is sufficient to show that the applicant was in **possession** of the claimed invention as of the filing date of the application.
- The description of the invention must be clear, complete and concise.
- The enablement requirement requires an applicant to provide enough detail describing the invention to enable one of ordinary skill in the art to make and use the invention **without undue experimentation.**

NOTE: If the claims are broad, yet the specification only provides narrow disclosure, the enablement requirement is not likely to be satisfied.

- The best mode requirement is a subjective inquiry and requires that the applicant disclose the applicant’s preferred manner of making and using the claimed invention. **BUT IT IS NOT NECESSARY FOR**

THE APPLICANT TO POINT OUT WHICH MODE DISCLOSED IS, IN FACT, THE PREFERRED MODE!

NOTE: A rejection based on failure to set forth the best mode is rare, mostly because subjective evidence concerning the applicant is rarely uncovered. But, in any case, the best mode must be disclosed so that the applicant can not limit his disclosure only to the second best mode and save the best mode for himself.

Section 706.03(o) – New Matter

- No amendment may introduce new matter into the disclosure of the invention.
- Once the USPTO assigns an application filing date, the applicant cannot add “new matter” into the application.

THIS CONCEPT OFTEN TESTED IN THE EXAM IN VARIOUS FORMS

- If an applicant could add new matter to a pending application while retaining the filing date, the applicant could effectively circumvent the priority rules.
- The priority rule is that the patent is given to the first to file an application for an invention unless another reduced the invention to practice before the other's filing date and did not abandon, suppress, or conceal the invention.
- Of course, new material may be added to a continuation in part – with a new filing date.

Section 706.03(x) – Reissue

- An issued patent may be corrected by reissue to correct an error which was made without deceptive intent and as a result of the error the

patent is wholly or partly invalid.

- The most common reasons for filing a reissue application are:

- (1) the claims are either too narrow or too broad
- (2) the disclosure contains inaccuracies
- (3) the applicant failed to or incorrectly claimed foreign priority
- (4) the applicant failed to make reference to or incorrectly made reference to prior co-pending applications.

NOTE: An applicant's failure to timely file a divisional application covering a non-elected invention following a restriction requirement is not considered an error that renders a patent wholly or partly invalid. Thus, failure to timely file a divisional application is not correctable through the reissue process.

- 35 USC 251 FORBIDS THE GRANTING OF A REISSUE "ENLARGING THE SCOPE OF THE CLAIMS OF THE ORIGINAL PATENT UNLESS THE REISSUE IS APPLIED FOR WITHIN 2 YEARS FROM THE GRANT OF THE ORIGINAL PATENT. THIS IS AN ABSOLUTE BAR THAT CANNOT BE EXCUSED! (The reissue may be granted some time after the application is made and the final action may take more than 2 years.) *This is a frequently tested principle.*

Section 706.07 – Final Rejection

- Generally, an examiner may issue 2 types of rejections:
 - (1) non-final, and
 - (2) final.
- A second of any subsequent action on the merits shall be "final" except where the examiner introduces a new ground for rejection.

If the new grounds are necessitated based on the information submitted in an information disclosure by the applicant, the rejection may be final. That is, the final rejection is proper when the

applicant's amendment is the cause of the new grounds (rather than something new from the examiner).

- Reply to a final rejection or action must include cancellation of, or appeal from the rejection of each rejected claim.
- Claims of a new application may be finally rejected in the first Office Action if it is a continuing application and all of the claims are drawn from the earlier application.

NOTE; SEVERAL QUESTIONS IN THE EXAM TEST BANK ARE DIRECTED AT THE PERMISSIBILITY OF ISSUEING A FINAL OFFICE ACTION WHEN IT IS THE FIRST OFFICE ACTION IN A CONTINUING APPLICATION. The answer to these questions is generally that a final rejection is allowed because the claims could have been finally rejected if entered in the parent application.

- Any questions as to the premature nature of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. (This is a matter of practice and is distinct from the substance of the rejection.)

Section 710 – Petition to Make Special

- Generally, the USPTO examines new applications in the order of their effective filing date.
- However, the USPTO does make exceptions to this rule in special cases. To receive expedited examination, an applicant must file a petition to “make special”. The petition must indicate why the applicant believes he is entitled to expedited examination.
- TWO COMMONLY TESTED SITUATIONS ARE PETITIONS TO MAKE SPECIAL ON AN APPLICANT’S AGE OR HEALTH.

For age, the applicant must be 65 years or older and evidence must be

provided. (A statement from the applicant or a registered practitioner is sufficient.)

For health, the USPTO considers a doctor's medical certificate as acceptable evidence of an applicant's poor health.

NOTE: Petitions to make special based on age or health **do not require a petition fee. THE LACK OF A FEE FOR THESE CASES IS A COMMONLY TESTED TOPIC.**

- Other cases where a petition to make special does not require a fee are for applications that:
 - (1) Enhance the quality of the environment
 - (2) Contribute to the development or conservation of energy resources
 - (3) Contribute to countering terrorism.

Section 710 – Period for Reply

- The maximum period for reply to an Office Action is 6 months!
- Shortened periods are used in practically all cases. For example, 3 months. However, 30 days is the shortest allowed period for response.
- If an applicant responds after the period for reply but before 6 months, a request for extension of time along with the appropriate fee is required.
- If an applicant does not reply within 6 months, the application becomes abandoned for failure to reply.

NOTE: The actual time for a reply is computed from the date stamped or printed on the Office Action to the date of receipt by the USPTO of the applicant's reply.

- The USPTO does not count fractions of a day and the applicant's reply is due on the corresponding day of the month 6 months (or any lesser number of months specified) after the Office Action is issued).

NOTE: If the Office Action is issued on the 31st of a month and is due a month with only 30 days, the due date is the 30th day of the month that it is due.

Section 711 – Abandonment of Patent Application

- An application become abandoned if the applicant fails to reply to an Office Action within the maximum statutory period (that is, 6 months). Even if a shortened statutory reply period is requested, the application is not abandoned until the time allowed for an extension has lapsed (6 months).
- Abandonment may result from either failure to reply within the statutory period or insufficiency of reply.
- When an amendment is filed after the expiration of the statutory period, the application is abandoned and the remedy is to petition to revive it. A petition to revive may be appropriate if applicant's failure to reply was either unavoidable or unintentional.

Section 713 – Interviews

- Interviews with the examiner concerning an application and other pending matters before the USPTO must be conducted on Office premises and within Office working hours.
- An interview for the discussion of patentability of a pending application will not occur before the first Office Action (unless the application is continuing application or the examiner considers that the interview would advance the prosecution of the application).
- In all cases involving an applicant's position of why favorable treatment should be considered, a written statement covering these reasons must be filed by applicant.
- The following are considered to be interviews with an examiner:
 - (1) a personal appearance before the examiner

- (2) a telephone conversation
- (3) a video conference
- (4) an e-mail

presenting matters for the examiner's consideration.

Section 714 – Amendments, Applicant's Action

- Depending on timing, amendments fall into 3 categories:
 - (1) Amendments made before the first Office Action (called a “preliminary amendment”) and before or after any subsequent Office Action not containing a final rejection.
 - (2) Amendments made after a final rejection
 - (3) Amendments made after the date of filing a notice of appeal.
- The most common amendment comes in category (1), above.
- All amendments must be in writing and must address every rejection and objection stated by the examiner. If not, the amendment is improper.
- After a final rejection has been entered, the applicant has 3 choices:
 - (1) the applicant may abandon the application
 - (2) the applicant may submit a request for continued examination (“RCE”) which reopens the prosecution. This effectively turns a final rejection into a non-final rejection upon payment of the fee
 - (3) the applicant may appeal the examiner's decision to the Board of Patent Appeals and Interferences.
- Amendments will only be accepted after final rejection in 3 limited circumstances:
 - (1) an amendment may cancel claims or comply with any requirement of form as set forth in a previous Office Action

(2) an amendment presenting claims in a better form for consideration upon appeal.

(3) an amendment touching the merits of the application that were not presented earlier.

NOTE: A COMMONLY TESTED TOPIC IS THE CIRCUMSTANCES IN WHICH AN AMENDMENT MAY BE PROPERLY FILED AFTER FINAL REJECTION. GENERALLY, THE ANSWER IS LIMITED TO THE 3 LIMITED CIRCUMSTANCES, ABOVE.

- An amendment document must include where appropriate:

- (1) a Specification Amendment
- (2) a Claims Amendment
- (3) a Drawing Amendment
- (4) Remarks

all starting on a separate sheet of paper.

NOTE: The USPTO is also authorized to make amendments (with applicant's consent) to the specification, including the claims, of any pending application by "examiner's amendment" in the interest of expediting prosecution.

Section 715 – Swearing Back of Reference – Affidavit or Declaration Under 37 CFR 1.131

- When any claim of an application or a patent under re-examination is rejected due to prior art, the owner of the application or patent may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim(s) prior to the effective date of the reference or activity upon which the rejection is based.
- This procedure is limited to (1) the United States, (2) NAFTA countries, and (3) WTO countries.

NOTE: Prior invention may not be established under this Section 131

affidavit or declaration if either:

(1) The rejection is based on a U.S. patent or U.S. patent application publication of a pending or patented application to someone else who claims the same patentable invention because this becomes a matter of an interference.

(2) the rejection is based upon a statutory bar (e.g. where the prior art publication is more than 1 year prior to applicant's or owner's effective filing date because this constitutes a "statutory bar" under Section 102(b). Another example is when the prior art reference is a foreign patent for the same invention to the same applicant issued more than 12 months prior to the filing date of the filing date of the U.S. application because this is a statutory bar based on Section 102(d).

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- **UNDERSTANDING WHEN A SECTION 131 AFFIDAVTS OR DECLARATION CAN BE USED IS AN IMPORTANT CONCEPT OFTEN TESTED ON THE EXAM.**
 - A Section 131 affidavit has limited use because more frequently than not, other factors bar its application.

SPECIFIC NOTE: A Section 131 affidavit cannot be used of overcome any statutory bar (such as Section 102(b) or 102(d)). Nor can it be used to overcome a patent reference claiming the same invention (because an interference or double patenting rejection is appropriate).

Selected Questions and Answers for Chapter 7

Question 7-1 (oct03am-3A)

Inventor Joe is anxious to get a patent with the broadest claim coverage possible for the invention. Joe retained a registered practitioner, Jane, to obtain the advantage of legal counsel in obtaining broad protection. Jane filed a patent application for the invention. The inventor heard that, although patent prosecution is conducted in writing, it is possible to get interviews with examiners. Joe believes an interview might hasten the grant of a patent by providing the examiner a better understanding of the true novelty of

the invention. Which of the following are consistent with the patent law, rules and procedures as related by the MPEP regarding usage of interviews?

- (A) Prior to the first Office action being mailed the inventor calls the examiner to whom the application is docketed to offer help in understanding the specification.
- (B) After receiving the first Office action Jane calls the examiner for an interview for the purpose of clarifying the structure and operation of the invention as claimed and disclosed, because the examiner's analysis regarding patentability in the rejection is novel and suggests that the examiner is interpreting the claimed invention in a manner very different from the inventor's intent.
- (C) Jane has Larry, a registered practitioner in the Washington D.C. area, who is more familiar with interview practice to call the examiner. Jane gives Larry a copy of the first Office action, which suggests that the primary examiner's analysis is incorrect, and offers to explain why. Jane instructs Larry that because Larry is unfamiliar with the inventor, Larry should not agree to possible ways in which the claims could be modified, or at least indicate to the examiner that Jane would have to approve of any such agreement.
- (D) Jane calls the primary examiner after receiving the final rejection, demanding that the examiner withdraw the finality of the final action. When the examiner states that the final rejection is proper, Jane demands an interview as a matter of right to explain the arguments.
- (E) (B) and (D).

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.

Question 7-2 (Oct03am- 26A)

When, in accordance with the patent laws, rules and procedures as related in the MPEP, is a supplemental oath or declaration treated as an amendment under 37 CFR 1.312?

- (A) When filed in a nonprovisional application after the Notice of Allowance has been mailed.
- (B) When filed in a reissue application at any point during the prosecution.
- (C) When filed in a nonprovisional application after the payment of the Issue Fee.
- (D) When filed in a reissue application after the Notice of Allowance has been mailed.
- (E) (A) and (D).

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.

Question 7-3 (Oct03pm-17a)

A patent application was filed on November 1, 2000 for the invention of J.J. Smithy. The application has no priority or benefit claims to any other application. Claims in the application are separately rejected under 35 USC 102 as being anticipated by each of the following references. Which reference can be properly applied under 35 U.S.C. 102(e) in accordance with the patent laws, rules and procedures as related in the MPEP?

- (A) A WIPO publication of an international application under PCT Article 21(2), which has an international filing date of October 3, 2000, was published in English and designated the United States.
- (B) A U.S. patent by J.J. Smithy that has a filing date of September 5, 2000.
- (C) A U.S. application publication under 35 U.S.C. 122(b) by inventor Jones that was filed on August 8, 2000.
- (D) A journal article by Marks published on October 11, 2000.
- (E) All of the above.

ANSWER: The correct answer is answer (C). 35 U.S.C. § 102(e); MPEP § 706.02(f). The application publication is a proper reference under 35 U.S.C. 102(e) because it was filed by another prior to the filing date of the invention. See MPEP § 706.02(f) et seq. Answer (A) is incorrect. The reference in answer (A) is not a proper reference under 35 U.S.C. § 102(e) because its international filing date was prior to November 29, 2000 thereby failing one of the three conditions for a WIPO publication of an international application to be applied under 35 U.S.C. § 102(e).

[Doug's Comment: This is a older question made up by the USPTO. It is unlikely that it would appear precisely in this from on a current bar exam. More likely, the dates would be advanced and answer (A) would be acceptable.]

See MPEP § 706(f)(1), under the heading “I. Determine The Appropriate 35 U.S.C. 102(e) For Each Potential Reference By Following The Guidelines, Examples And Flow Charts Set Forth Below,” subpart (C), which states “[I]f the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined: (1) If the international application meets the following three conditions: (a) an international filing date on or after November 29, 2000 . . . then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).” The reference in (B) is not a proper reference under 35 U.S.C. § 102(e) because the reference is not by another. See MPEP § 706.02(f). The reference in (D) is not a proper reference under 35 U.S.C. § 102(e) because 35 U.S.C. § 102(e) refers to patents and patent applications, not journal articles. See MPEP § 706.02(f)(1). (E) is not correct because (C) is correct and (A), (B) and (D) are incorrect.

Question 7-4 (Oct03pm-21a)

Which of the following would comply with the patent laws, rules and procedures as related in the MPEP and would be a fully responsive reply to a non-final Office action on the merits rejecting all the claims in the application as being unpatentable under 35 USC 102 and/or 103 over prior art references?

- (A) A timely filed and properly signed written reply which does not include an amendment to the claims, but includes a request for the examiner's rejections to be reconsidered supported by arguments replying to every ground of rejection and distinctly and specifically points out the supposed errors in every rejection. and pointing out the specific distinctions believed to render the claims patentable over any applied references.
- (B) A timely filed and properly signed written reply which includes an amendment canceling all the claims in the application and adding new claims, and a request for the examiner's rejections to be reconsidered in view of the newly presented claims.

- (C) A timely filed and properly signed written reply which does not include an amendment to the claims, but does generally alleges that the claims define a patentable invention.
- (D) A timely filed and properly signed written request for continued examination (RCE).
- (E) All of the above.

ANSWER: (A) is the most correct answer. 37 CFR § 1.111; MPEP § 714.02. Section 1.111 states in pertinent part: “(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, ... must reply and request reconsideration or further examination, with or without amendment. ... (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner 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. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. ...The applicant’s or patent owner’s reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. 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.” MPEP § 714.02 states “In all cases where reply to a requirement is indicated as necessary to further consideration of the claims ... a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.” (B) and (C) are not the most correct answers. 37 CFR § 1.111; MPEP §§ 714.02 and 714.04. Neither reply specifically points out the supposed errors in the examiner’s action and neither reply present arguments pointing out how the newly presented claims overcome the rejections. (D) is not the most correct answer. See 37 CFR § 1.114. A request for continued examination can only be made if prosecution of an application is closed. In this question the Office action is a non-final office action. (E) is not the most correct answer since (A) is correct and (B), (D) and (D) are incorrect.

Question 7-5 (Ap03am-12a)

The Potter patent application was filed on June 6, 2002, claiming subject matter invented by Potter. The Potter application properly claims priority to a German application filed on June 6, 2001. A first Office action contains a rejection of all the claims of the application under 35 USC 103(a) based on a U.S. patent application publication to Smith in view of a U.S. patent to Jones. A registered practitioner prosecuting the Potter application ascertains that the relevant subject matter in Smith’s published application and Potter’s claimed invention were, at the time Potter’s invention was made, owned by ABC

Company or subject to an obligation of assignment to ABC Company. The practitioner also observes that the Smith patent application was filed on April 10, 2001 and that the patent application was published on December 5, 2002. Smith and Potter do not claim the same patentable invention. To overcome the rejection without amending the claims, which of the following timely replies would comply with the USPTO rules and the procedures set forth in the MPEP to be an effective reply for overcoming the rejection?

- (A) A reply that only contains arguments that Smith fails to teach all the elements in the only independent claim, and which specifically points out the claimed element that Smith lacks.
- (B) A reply that properly states that the invention of the Potter application and the Smith application were commonly owned by ABC Company at the time of the invention of the Potter application.
- (C) A reply that consists of an affidavit or declaration under 37 CFR 1.132 stating that the affiant has never seen the invention in the Potter application before.
- (D) A reply that consists of an affidavit or declaration under 37 CFR 1.131 properly proving invention of the claimed subject matter of Potter application only prior to June 6, 2001.
- (E) A reply that consists of a proper terminal disclaimer and affidavit or declaration under 37 CFR 1.130.

ANSWER: (B) is the most correct answer. See 35 U.S.C. § 103(a); MPEP §§ 706.02(l)(1) and 2145. The prior art exception in 35 U.S.C. § 103(c) is applicable because the Smith reference is only prior art under 35 U.S.C. § 102(e), (f), or (g), was applied in a rejection under 35 U.S.C. § 103(a), and was commonly owned at the time Potter made the invention claimed by Potter. See MPEP § 706.02(l)(1). Answer (A) is not a correct answer in that one cannot show nonobviousness by attacking the references individually where the rejections are based on a combination of references. See MPEP § 2145. Answer (C) is not a correct answer. An affirmation that the affiant has never seen the invention before is not relevant to the issue of nonobviousness of the claimed subject matter. See MPEP 716. Answer (D) is not a correct answer. Invention must be proved prior to the effective filing date of Smith, which is April 10, 2001. See MPEP § 715. Answer (E) is not a correct answer. A terminal disclaimer and affidavit or declaration under 37 CFR § 1.130 are not proper because the Potter application and the Smith reference are not claiming the same patentable invention. See MPEP § 706.02(k).

Question 7-6 (Ap03pm-21a)

In accordance with the USPTO rules and the procedures set forth in the MPEP, a petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant's birth certificate showing applicant's age is 62.

- (B) The petition is supported by applicant's unverified statement that applicant's age is 65.
- (C) The petition is supported by applicant's statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 CFR 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant's statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

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

Question 7-7 (Oct02am-17a)

Which of the following statements is true?

- (A) In the context of 35 USC 102(b), a magazine need only be placed in the mail to be effective as a printed publication.
- (B) The earliest date declassified printed material may be taken as *prima facie* evidence of prior knowledge under 35 USC 102(a) is as of the date the material is cataloged and placed on the shelf of a public library.
- (C) Declassified printed material is effective as a printed publication under 35 USC 102(b) as of the date of its release following declassification.
- (D) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed on or after November 29, 2000.
- (E) The American Inventors Protection Act (AIPA) amended 35 USC 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 USC 102(e) based on their earliest effective filing date only against applications filed prior to November 29, 2000 which have been voluntarily

published.

ANSWER: (C) is correct. MPEP § 707.05(f) states, “In the use of [declassified material] ... as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.” (A) is wrong. MPEP § 706.02(a) states, “A magazine is effective as a printed publication under 35 U.S.C. § 102(b) as of the date it reached the addressee and not the date it was placed in the mail.” (B) is wrong. MPEP § 707.05(f) states, “For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. § 102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time.” (D) and (E) are wrong. The AIPA amended 35 U.S.C. § 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 U.S.C. § 102(e) based on their earliest effective filing date against applications filed on or after November 29, 2000, and applications filed prior to November 29, 2000 which have been voluntarily published. MPEP § 706.02(a).

Question 7-8 (Ap00am-36a)

A petition to make a patent application special may be filed without fee in which of the following cases?

- (A) The petition is supported by applicant’s birth certificate showing applicant’s age is 62.
- (B) The petition is supported by applicant’s unverified statement that applicant’s age is 65.
- (C) The petition is supported by applicant’s statement that there is an infringing device actually on the market, that a rigid comparison of the alleged infringing device with the claims of the application has been made, and that applicant has made a careful and thorough search of the prior art.
- (D) The petition is accompanied by a statement under 37 C.F.R. § 1.102 by applicant explaining the relationship of the invention to safety of research in the field of recombinant DNA research.
- (E) The petition is accompanied by applicant’s statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

ANSWER: (B). (A) is wrong because MPEP § 708.02, IV, recites, “An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement. No fee is

required with such a petition.” (C), (D), and (E) are wrong because a fee is required with respect to each petition. MPEP § 708.02, II, VII, and X, respectively.

Question 7-9 (Ap00pm-21a)

Mr. Roberts, an American citizen touring a vineyard, saw a unique grape-squeezing machine in France. The machine was highly efficient, and produced excellent wine. The vineyard owner was not hiding the machine. It was out of public view and was the only one of its kind. The vineyard owner had built it himself several years earlier, and no drawing or technical description of the machine was ever made. The vineyard made only local sales of its wines. Using his photographic memory, Roberts went back to his hotel and made technical drawings of what he had seen. Upon his return to the United States, Roberts promptly prepared and filed a patent application directed to the machine. Which of the following statements is correct?

- (A) Roberts may not obtain a patent on the machine because it was known by others before Mr. Roberts made technical drawings of the machine.
- (B) Roberts may not obtain a patent on the machine because wine made by the machine had been sold more than a year before Roberts’ application filing date.
- (C) Roberts is entitled to a patent because a goal of the patent system is public disclosure of technical advances, and the machine would not have been disclosed to the public without Roberts’ efforts.
- (D) Roberts may not obtain a patent on the machine because the vineyard owner was not hiding the machine and therefore the machine was in public use more than a year before Roberts’ application filing date.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

ANSWER: (E). Roberts is not entitled to a patent because he did not himself invent the subject matter sought to be patented. 35 U.S.C. § 102(f). Therefore, statement (C) cannot be correct. Statement (A) is incorrect because, although the machine was known by others, it was not known by others in this country as required under 35 U.S.C. § 102(a). Similarly, statements (B) and (D) are incorrect because, even if there was a sale or public use more than a year before Roberts’ filing date, it was not “in this country” as required by 35 U.S.C. § 102(b).

In-Depth Review of Chapter 7

Please click on the link, below, to bring up a special version of Chapter 7 in the MPEP that has been prepared exclusively by **PassPatentBar** to complete your review of this chapter. It is recommended that you quickly scan through most of this chapter while reading only those sections, about 10% of the total, that are **highlighted in yellow**. When you are finished with this review, please return here by using the return arrow at the top-left on your screen.

A careful review of the highlighted portions of Section 706 is encouraged!

[Chapter 7 MPEP](#)