



awarded for the afternoon section, as a result of the Director of OED's November 3, 1994 Decision on Request for Reconsideration of Decision on Regrade. Finally, in the Director of OED's December 8, 1994 Decision on Request for Reconsideration of Decision on Regrade, two points were added to Petitioner's score for the morning section, raising it to 58, and sufficient points were added to result in a passing score on the afternoon section. Thus, as of this Petition to the Commissioner, Petitioner must acquire twelve additional points on the morning section of the examination to achieve a passing grade.

In the January 24, 1995 Petition to the Commissioner, Petitioner continues to challenge the Director's grading of twelve questions in the morning section. Specifically, Petitioner requests review of the answers to questions 1, 2, 4, 13, 14, 15, 20, 24, 25, 27, 30, and 36.

#### Opinion

Pursuant to 37 C.F.R. § 10.7(c), Petitioner must particularly point out in the request for regrade the errors which Petitioner believes occurred in the grading of his or her examination. The directions to the morning section state: "No points will be awarded for incorrect answers or unanswered questions." Therefore, the burden is upon the Petitioner to show that his or her chosen answer is the most correct answer.

The directions to the morning section also state:

Do not assume any additional facts not presented in the questions. When answering

each question, unless otherwise stated, assume that you are a registered patent agent. The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with U.S. patent statutes, the PTO rules of practice or procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question.

For the following reasons, two points will be added to the Petitioner's score for Question 14, but points will not be added for Questions 1, 2, 4, 13, 15, 20, 24, 25, 27, 30, and 36.

Question 1:

Question 1 read as follows:

All of the claims in an application were finally rejected under 35 U.S.C. 103. . . . The examiner in the first action on the merits, without applying any new references, rejected all of the claims in the [continuation] application on the same grounds as in the parent application and made the rejection final. Which of the following would be a proper response to have the finality of the rejection withdrawn in the continuation application?

(A) File a timely notice of appeal and appeal brief, appealing the final rejection on the ground that the finality of the rejection is premature.

. . . .

(D) File a petition to the Commissioner requesting withdrawal of the final rejection on the ground that the finality of the rejection on a first action on the merits is improper where a continuation application contains material which was presented after a final rejection in the parent application and was denied entry by the examiner because it raised new issues.

. . . .

In the model answers issued by the Director of OED, choice (D) was stated as the correct answer on the basis of MPEP §§ 706.07(b), 706.07(c) and 706.07(d).

Petitioner selected answer (A). Petitioner argues that, under 37 C.F.R. § 1.191(a), the process of appeal from the decision of the examiner to the Board of Patent Appeals and Interferences is available to the applicant once the final rejection of the continuing application on the first office action has occurred. In accordance with MPEP § 706.07(c), however, any question as to the prematureness of a final rejection may "not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences." Thus, Petitioner's argument lacks merit.

Question 2:

Question 2 read as follows:

Which of the following statements regarding a petition to defer issuance of a patent is true?

. . . .

(C) If a petition to defer issuance of a patent is granted, the issuance is deferred for a period up to one month only, in the absence of extraordinary circumstances or a requirement of the regulations.

(D) A petition to defer issuance of a patent must be filed to permit all divisions of a reissue application to issue simultaneously.

. . . .

In the model answers, choice (C) was stated as the correct answer on the basis of 37 C.F.R. §§ 1.177 and 1.314 and MPEP § 1306.01.

Petitioner selected answer (D). Petitioner submits that a desire to have all divisionals of a reissue application issue simultaneously would qualify as the showing of "good and sufficient reasons" required by 37 C.F.R. § 1.314 to defer issuance of a patent. Petitioner cites MPEP § 1306.02 to show that a request for simultaneous issuance of patents will be granted if the conditions stated therein are met. Unless otherwise ordered by the Commissioner, however, "all the divisions of a reissue will issue simultaneously." 37 C.F.R. § 1.177. Thus, a desire to have all divisionals of a reissue application issue simultaneously is not a reason to defer the issuance of a patent, because they will issue simultaneously without issuance being deferred by petition. Therefore, Petitioner's argument lacks merit.

Question 4:

Question 4 read as follows:

In early 1992, Acme, a company based in France, developed a widget. Acme filed a patent application in the French Patent Office on May 9, 1992 and filed a corresponding patent application in the USPTO on May 4, 1993. All research activities for the inventions disclosed and claimed in the U.S. and French applications took place in France. The U.S. patent application contains four claims: . . . . The French application only supports claims 1 and 3 of the U.S. application. During the course of prosecution of the U.S. application, the examiner

properly rejected all of the claims under 35 U.S.C. 102(e) as being anticipated by a U.S. patent assigned to Z. . . . Which of the following proposed arguments or actions would properly overcome the examiner's rejection or effect withdrawal of the rejection with respect to all of the claims in the U.S. application?

(A) File a claim for a right of priority based on the earlier filing date in France along with a certified copy of the French patent application.

(B) File an amendment canceling claims 2 and 4, and file a claim for a right of priority based on the earlier filing date in France along with a certified copy of the French patent application.

. . . .

The model answers stated that choice (B) was the correct answer on the basis of 35 U.S.C. §§ 102(e) and 119; 37 C.F.R. §§ 1.131; MPEP § 2153; In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); and In re Slayter, 276 F.2d 408, 125 USPQ 345 (C.C.P.A. 1960).

Petitioner selected answer (A). In petitioner's view, the act of filing a claim for a right of priority based on the earlier filing date in France, along with a certified copy of the French patent application, would be acceptable to properly overcome the examiner's rejection or effect withdrawal of the rejection with respect to all of the claims in the U.S. application. Petitioner overlooks that claims are entitled to the benefit of a foreign priority date only if the disclosure in the foreign application would support the claims under 35 U.S.C. § 112, ¶ 1. In re Gosteli, 872 F.2d at 1010, 10 USPQ2d at 1616. In the scenario of Question 4, the filing of a claim for a right

of priory based on the earlier filing date in France would be insufficient to overcome the rejection of claims 2 and 4 because those claims are not supported in the foreign application. Claims 2 and 4 therefore are not entitled to the foreign priority date. For this reason, choice (A) is not correct.

Question 13:

Question 13 read as follows:

On April 7, 1994, you deposited a patent application in the PTO. . . . [P]age 6 of the specification of the application [was] missing. . . . Which of the following procedures will result in the application being accorded an April 7, 1994 filing date?

(A) File a petition with the requisite fee requesting that the application be accepted without the omitted page 6, and include an amendment canceling from the specification all incomplete sentences and renumbering the pages present in consecutive order and include a supplemental oath by the inventor stating that the invention is adequately disclosed in the application as amended for the purposes of an original disclosure and filing date.

. . . .

(E) File an amendment canceling page 6 from the specification, renumbering the pages present in consecutive order, and canceling from the specification all incomplete sentences, and request that the application be accorded a filing date of April 7, 1994.

The model answers stated that choice (A) was the correct answer on the basis of MPEP § 608.01.

Petitioner selected answer (E). Petitioner argues that, under MPEP § 203.06, the application was in effect complete without page 6 and that the missing page should be handled by an

amendment. Petitioner also relies upon 37 C.F.R. § 1.53(e), as permitting waiver of minor informalities, and upon MPEP § 710.02, which relates to shortened statutory period and time limit actions.

The directions to the morning section instruct applicants that the correct procedure is the one which should be followed in accordance with, among other things, the MPEP. Section 608.01 of the MPEP directly addresses applications filed without all the pages of the specification. It provides the following instructions:

If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences . . . .  
. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration . . . .

MPEP § 608.01 specifically calls for the procedure described in choice (A). The procedure described in choice (E) deviates from that called for in a number of important ways (e.g., choice (E) does not specify the filing of a petition, petition fee, or oath or declaration) and thus choice (E) was not the best answer. Moreover, cancellation of page 6, as called for in choice (E), would be inappropriate given that page 6 was never part of the application. Choice (A) is the best answer.

Question 14:

Question 14 read as follows:

You are representing a client who has a patent involved in a reexamination proceeding. All of the claims in the reexamination proceeding have been finally rejected under 35 U.S.C. 103 based solely on the patent to Smith. The patent to Smith discloses, but does not claim, a device similar to that claimed in your client's patent. Your client informs you that after she reviewed the final rejection, she ran tests on her claimed device and on a device similar to the device disclosed in the Smith patent. . . . If the results were presented in declaration form, would the comparative tests and results be of any probative value?

(A) No, because such declarations cannot be filed in a reexamination proceeding.

(B) No, because comparative tests and results must be based on a comparison with a device which is identical to that disclosed in the Smith patent.

. . . .

Petitioner selected answer (A). In the model answers, choice (B) was stated as the correct answer on the basis of 37 C.F.R. § 1.132 and MPEP § 716.

Petitioner has shown through the analysis of the possible answer selections that Question 14 and its respective answers were sufficiently unclear so as to make the determination of the most correct answer unreasonably difficult. MPEP § 716 provides that an affidavit or declaration will only be considered after a final rejection if the final rejection contained a new ground of rejection or if the applicant shows good and sufficient reasons why the affidavit or declaration was not earlier presented. Thus, there was no clearly correct answer to Question 14. Two

points will therefore be added to the Petitioner's score for this question.

Question 15:

Question 15 read as follows:

Jack and Jill are research engineers employed by the Full Bucket Corporation (FBC). . . . Jack invented a novel water bucket . . . . Shortly thereafter, Jill made a modification of Jack's water bucket. . . . On January 5, 1993, FBC's patent counsel filed a patent application on Jack's invention naming Jack as the applicant. On February 9, 1993, FBC's patent counsel filed a patent application on Jill's invention naming Jill as the applicant. . . . On March 31, 1994, the examiner made a proper provisional rejection of Jill's claims under 35 U.S.C. 102(e)/103 as being obvious over the claims in Jack's application in view of a patent to Smith which issued in 1990. The examiner also provisionally rejected the claims on the ground of obviousness-type double patenting. Which of the following proposed arguments or actions would properly overcome or effect the withdrawal of the provisional rejections?

(A) File a single application combining the subject matter of both copending applications before the response to the rejection is due and expressly abandon Jack's and Jill's applications.

. . . .

(D) File a response traversing the examiner's rejection of Jill's claims on the ground that Jack and Jill's applications are commonly owned by FBC and file a terminal disclaimer signed by an officer of FBC.

. . . .

In the model answers, choice (A) was stated as the correct answer on the basis of 35 U.S.C. § 102(e) and 103; 37 C.F.R. §§ 1.131 and 1.132; and MPEP §§ 706.02, 2153, 2187, 2188.02.

Petitioner selected choice (D). Petitioner argues that choice (A) is not responsive to the question because the abandonment of the application would not overcome or effect the withdrawal of the provisional rejection. Contrary to Petitioner's arguments, choice (A) is correct. When the subject matter of Jack and Jill's inventions are combined in one application, and Jack and Jill's separate application's are withdrawn, then Jill's invention would not be described in an application filed before her new application. Consequently, the basis for the provisional rejection would be removed.

Petitioner argues that choice (D) would overcome the rejection in that, under MPEP § 706.02, Jill's invention would not qualify as prior art against Jack's invention because at the time the inventions were made they were owned by the same entity. As MPEP § 706.02 explains, however, the subject matter that is disqualified as prior art under the last paragraph of 35 U.S.C. § 103 "is strictly limited to subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 102(g). If the subject matter qualifies as prior art under any other subsection (e.g., subsection 102(a), 102(b), or 102(e)) it will not be disqualified as prior art under 35 U.S.C. 103, last paragraph." MPEP § 706.02 also states that "[t]he disclosure of an earlier filed patent application which issues as a patent continues to be prior art

under 35 U.S.C. 102(e) against a later invented and filed application of another inventor even though the patent and the later invention were owned by, or subject to an obligation of assignment to, the same person at the time the later invention was made." Thus, the fact that Jack and Jill's application are commonly owned by FBC would not be a sufficient ground to overcome or effect the withdrawal of the examiner's obviousness rejection under 35 U.S.C. § 102(e)/103.

Petitioner also relies on MPEP §§ 804.02 and 806.04(i) as providing that an obviousness-type double patenting rejection may be overcome by filing a terminal disclaimer. The filing of a terminal disclaimer would not, however, overcome the examiner's obviousness rejection under 35 U.S.C. § 102(e)/103.

Question 20:

Question 20 read as follows:

Your office is located [in] Seattle, Washington. Your client, Johnny Appleseed, has an application pending in the PTO for a cider press. The application is under final rejection and the three month shortened statutory period for response set by the examiner will expire today, April 13, 1994. . . . You are considering using one of the following procedures to file the continuation application:

I. Utilize the Express Mail, "Post Office to Addressee" delivery service of the U.S. Postal [S]ervice, place the "Express Mail" mailing label number and a proper certificate of mailing by "Express Mail" on the application papers, and deposit the envelope with the U.S. Postal Service on April 13, 1994.

II. Utilize Federal Express® mail delivery service, place the "Express Mail" mailing label number and a proper certificate of mailing by "Express Mail" on the application papers, and deliver the envelope to Federal Express® on April 13, 1994[.]

III. Deposit the envelope with sufficient postage as first class mail with the U.S. Postal Service on April 13, 1994, and include with the application papers a proper certificate of mailing on a separate paper.

Which of the above procedures, if any, will assure that the continuing application will be granted a filing date of April 13, 1994?

(A) I

. . . .

(D) I and III

. . . .

In the model answers, choice (A) was stated as the correct answer on the basis of 37 C.F.R. §§ 1.8 and 1.10; and MPEP §§ 502, 512, and 513.

Petitioner selected answer (D). Petitioner argues that, according to 37 C.F.R. § 1.8, mailing a continuation application as first class mail with a certificate of mailing would be sufficient to insure a mailing date of April 13, 1994. Under 37 C.F.R. § 1.8(a)(2)(i)(A), however, certificate of mailing practice cannot be used in "[t]he filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date." As is explained clearly in MPEP § 512, "the filing of a paper for the purpose of obtaining a continuation or divisional application under 37 C.F.R. 1.60 or 1.62 is excluded from the Certificate

practice under 37 C.F.R. § 1.8(a)(2)(i)(A) since it is considered to be the filing of a national application." Thus, under option III the continuing application would not be granted a filing date of April 13, 1994. Choice (D) therefore is improper.

Question 24:

Question 24 read as follows:

Employees Able and Baker work for Comic Company, each with knowledge of the other's work and with obligation to assign to Comic inventions conceived while employed by Comic. Able and Baker conceive a first invention. Baker conceives a second invention, which is an improvement on the first invention. On January 5, 1990, a first patent application was filed in the PTO naming Able and Baker as inventors. The first application contains claims 1-10. The examiner required restriction between the first invention set forth in claims 1-5, and the second invention set forth in claims 6-10. The first invention was elected without traverse. The examiner held claims 6-10 withdrawn, examined claims 1-5 on their merits, and passed the application to issue. On March 3, 1992, a patent naming Able and Baker as inventors was granted on the invention of claims 1-5. On April 6, 1993, a second application was filed in the PTO claiming only the second invention (claims 6-10 of the first application) and naming Baker as inventor. The claim in the second application \_\_\_\_\_ rejected under 35 U.S.C. 102(e)/103 as obvious over the patent granted on March 3, 1992 in view of a secondary reference because \_\_\_\_\_.

(A) may be properly .. the patent is prior art even though the second application and the patent are commonly owned.

. . . .

(C) may not be properly .. the first and second applications are commonly owned.

. . . .

In the model answers, choice (A) was stated as the correct answer based of 35 U.S.C. § 102(e).

Petitioner selected answer (C), and now relies on MPEP § 706.02 as providing that the patent would not be prior art against the later application because the patent and application are commonly owned. As explained above with reference to Question 15, the disclosure of an earlier filed patent application which issues as a patent can be prior art under 35 U.S.C. § 102(e) against a later invented and filed application of another inventor even though the patent and the later invention were owned by the same person at the time the later invention was made. Thus, answer (C) is not correct.

Question 25:

Question 25 read as follows:

On November 19, 1990, inventor Wilson filed a patent application in the PTO. . . . During reexamination, the examiner rejected claim 1 as being anticipated by the Murr reference. . . . An antedating affidavit has been prepared showing that on April 4, 1988, Wilson conceived his claimed invention in Missouri. The affidavit further shows that coupled with due diligence beginning in March of 1989, Wilson reduced his invention to practice in Kansas on May 1, 1990. In which of the following situations, if any, would the affidavit be effective to overcome the rejection?

(A) The Murr reference is an article in a magazine which was first received by subscribers on February 6, 1989.

. . . .

(D) The Murr reference is a U.S. patent granted on January 5, 1993 on an application filed in the PTO on April 2, 1990 which discloses, but does not claim, "a widget consisting of A, B, C, and D." The patent is a continuation-in-part (CIP) of an original application filed in the PTO on February 2, 1988, but abandoned on April 16, 1990 for failure to prosecute. The original application only supports "a widget consisting of A, B, C and E."

(E) None of the above.

The model answers provide choices (D/E) as the correct answers based on 35 U.S.C. § 102(e); 37 C.F.R. § 1.131; and MPEP § 715.

Petitioner selected choice (A). In the Petitioner's view, the Wilson affidavit would be more effective in overcoming the rejection in the scenario of choice (A) than of choice (D). Petitioner cites MPEP § 715 as providing that an affidavit may overcome a reference where the date of the reference is less than one year prior to the applicant's effective filing date. Petitioner's reliance on this section is misplaced, however, because the date of the magazine article described in choice (A), February 6, 1989, is more than one year before Wilson's effective filing date, November 19, 1990. As is stated in MPEP § 715, the filing of an affidavit under 37 C.F.R. § 1.131 is not appropriate "[w]here the reference publication date is more than one year back of applicant's or patent owner's effective filing date. Such a reference is a 'statutory bar.'" The Wilson affidavit therefore would not be effective in overcoming the rejection in the scenario posed in choice (A). Consequently, choice (A)

cannot be the right answer. Moreover, even if the affidavit would not be effective in the situation posed in choice (D), this would in no way make choice (A) the best answer given that choice (E) provided a "None of the above" option.

Question 27:

Question 27 read as follows:

You are prosecuting a patent application on behalf of Smith. The application was filed in the PTO on February 1, 1992. The application contains one independent claim (claim 1) and five dependent claims (claims 2-6). All of the claims were allowed by the examiner in a first Office action. The issue fee has been paid. The application is scheduled to issue on May 3, 1994. Today, April 13, 1994, Smith brings to your attention a U.S. patent issued to Jones. The patent would anticipate claim 1 in Smith's application under 35 U.S.C. 102(b). Which of the following would be the most appropriate procedure to have the patent to Jones considered by the examiner?

. . . .

(B) File a petition with the proper fee requesting withdrawal of the application from issue so that the Jones patent can be considered in a file wrapper continuation application.

(C) File a proper information disclosure statement with the proper fee disclosing the Jones patent.

. . . .

The model answers provide choice (B) as the correct answer on the basis of 37 C.F.R. §§ 1.62, 1.312 and 1.313; and MPEP §§ 609, 714.16 and 1308.

Petitioner choose (C) and now argues that choice (C) is better than choice (B) because the fact pattern does not disclose whether Mr. Smith would desire the filing of a continuing application. This argument disregards the fact that Question 27 asks which of the actions would be the most appropriate to have the patent to Jones considered by the examiner. As stated in MPEP § 609, "[i]nformation disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file." Thus, the filing of an information disclosure statement as provided in choice (C) would not be the appropriate procedure to have the patent to Jones considered by the examiner.

Question 30:

Question 30 read as follows:

You are prosecuting a patent application on behalf of a client in which you received an Office action dated December 6, 1993, finally rejecting claims 4 and 6 under 35 U.S.C. 103 and allowing claims 1 to 3 and 5. The examiner set a three month shortened statutory period for response to the Office action. On January 28, 1994, you filed a response to the final rejection which included an affidavit directed to a long felt need and the commercial success of the claimed invention. On April 8, 1994, the examiner mailed an advisory action denying entry of the affidavit questioning why the affidavit[] [was] not earlier presented. Today, April 13, 1994, you filed a proper petition and fee for a one month extension of time in order to file a continuing application to have the affidavit considered. Assume no further requests for an extension of time are requested, what is the very last date on which the continuing application can

be filed and be entitled to the benefit of the filing date of the rejected application?

. . . .

(C) Monday, May 9, 1994

. . . .

(E) Wednesday, June 6, 1994

In the model answers, choice (C) was stated as the correct answer on the basis of 35 U.S.C. § 133; 37 C.F.R. § 1.136(a); and MPEP § 710.02(e).

Petitioner selected answer (E). Petitioner argues that a continuation application filed on May 9, 1994 would not be entitled to the filing date of the earlier application, and thus that choice (C) was not the best answer, because April 6, 1994 would be the last day to properly request a one month extension and pay the one month extension fee. Petitioner apparently arrives at April 6, 1994 by allowing for a three month response period after the December 6, 1993 Final Office action and for a one-month extension of time. Petitioner argues that the most acceptable choice would be Wednesday, June 6, 1994 because a continuation application may be filed at any time prior to abandonment of an application, and that abandonment in this case would occur six months after the December 6, 1993 Final Office action (i.e., on June 6, 1994).

Petitioner's arguments are not persuasive. MPEP § 710.02(e) provides that

if an applicant initially responds within two months from the date of mailing of any final rejection setting a three-month shortened statutory period for response

and the Office does not mail an advisory action until after the end of the three-month shortened statutory period, the period for response for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond six months from the date of the final rejection.

This provision is directly applicable in the scenario posed in Question 30. Thus the period of response for the purpose of determining the amount of any extension fee would be April 8, 1994, the date on which the advisory action was mailed. If a request for a one-month extension is filed, as stated in Question 30, then the last date on which the continuing application can be filed and be entitled to the benefit of the earlier filing date is Monday, May 9, 1994. A filing on June 6, 1994 could only have been proper if the applicant were to request more than a one-month extension of time. Given that the question posits that no further requests for extension of time are filed other than the request for a one-month extension, choice (E) cannot be correct.

Question 36:

Question 36 read as follows:

On January 3, 1991, you filed a first patent application in the PTO containing 5 claims and naming Smith and Jones as the inventors. The examiner made a restriction requirement and required election between claims 1-3 of Group I and claims 4 and 5 of Group II. You elected the claims of Group I without traverse. . . . [Y]ou filed a second application containing only the claims of Group II and naming Smith as the inventor. The specification of the second application does not make reference to the first application. On April 20, 1993, you filed a

third application which you designated as a continuation-in-part (CIP) application of the second application naming Smith, Jones and Amos as inventors. The second application went abandoned on May 28, 1993 for failure to prosecute. The CIP contains the original Group II claim and presents five new claims, in addition to the Group II claims, directed to an improvement of the invention defined by the claims of Group II. . . . Which of the following statements with respect to the benefit of the filing date of an earlier filed application is true?

. . . .

(B) The second application is entitled to the benefit of the filing date of the first application, but only if the specification in the second application is amended to make reference to the first application.

. . . .

(E) The third application is not entitled to the benefit of the filing date of the second application or the first application for any of the claimed subject matter because the subject matter of the third application is not identical with the subject matter of either the first or second applications.

In the model answers, choice (B) was stated as the correct answer on the basis of 35 U.S.C. § 120; and MPEP § 201.11.

Petitioner selected answer (E). Petitioner now argues that the filing date of the second application is superfluous, and that choice (B) does not relate to the facts of the question, because the second application was abandoned. According to Petitioner, the second application does not receive the benefit of an earlier filing date and can not be acted upon unless revived by a petition according to 37 C.F.R. § 1.13.

In Petitioner's view, the only next logical choice to Question 36 is (E). Petitioner argues that a continuation-in-part application is not entitled to the earlier filing date of either the first or second application because its subject matter is not identical with the subject matter of either the first or second applications. Petitioner reads MPEP § 201.11 to provide that a continuation-in-part that recites a feature which was not disclosed or adequately supported by a proper disclosure in the parent application is not entitled to the benefit of the filing date of the parent application.

Petitioner's argument is based on an improper reading of MPEP § 201.11. This section states that "[a]ny claim in a continuation-in-part application which is directed solely to subject matter adequately disclosed under 35 U.S.C. 112 in the parent application is entitled to the benefit of the filing date of the parent application." Question 36 states that the CIP contains the original Group II claims that were filed in the second application, and that each of the applications complied with the requirement of 35 U.S.C. § 112. Thus, the Group II claims in the CIP application would be entitled to the benefit of the filing date of the second application, and choice (E) was therefore inappropriate.

Further, the filing date of the second application is not superfluous, as Petitioner alleges, because the Group II claims in the CIP application are entitled to that filing date. Although it went abandoned, the second application may be revived

for the sole purpose of achieving continuity. See MPEP § 711.03(c). An application will be entitled to the benefit of the filing date of an earlier application only if the later application contains a specific reference to the earlier filed application. 37 C.F.R. § 120. Amendment of the second application to make reference to the first application thus would be necessary to achieve continuity. For these reasons, choice (B) is the proper answer to Question 36.

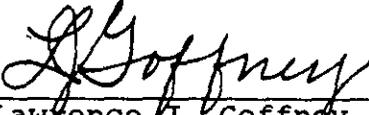
CONCLUSION:

Petitioner's grade is modified for the Morning Section to reflect an additional two points for Question 14. The final grade for the Morning Section is 60 points.

ORDER

Upon consideration of the petition to the Commissioner, it is

ORDERED that the petition is denied.

 12/6/95  
\_\_\_\_\_  
Lawrence J. Goffney  
Acting Deputy Assistant Secretary of  
Commerce and Acting Deputy Commissioner  
of Patents and Trademarks

cc: