



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 1, 8, 11, 15 and 24 of the morning section and questions 12 and 27 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 29, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

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 practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 11. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 1, 8, 15 and 24 and afternoon questions 12 and 27. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

1. The model answer: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

Petitioner argues that all selections are correct making answer (E) is correct. Petitioner contends that all selections can be construed to fall under 35 USC 112(6) and therefore all are equally best.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that all selections can be construed to fall under 35 USC 112(6) and therefore all are equally best, the question does not ask which is the only way but what is the best way to recite a claim limitation. The best way is the way that is consistent with the policies and practices of the USPTO as indicated in the instructions. Of the 4 individual possible selections, only selection (C) is consistent with the policies and procedures of the USPTO for meeting 35 USC 112(6) on its face under MPEP § 2181; each of the remaining selections would elicit a presumption of not being under 35 USC 112(6) until the presumption was overcome, and therefore are not as good ways as selection (C). Accordingly, model answer (C) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(1)(3). ~~Also, evidence of common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that all responses are in accord ant therefore no answer is correct. Petitioner contends that (D) is a proper response if the examiner is relying on a 35 USC

102(e) basis, that 35 USC 102(a) may not apply because of priority, that there may be some other reason that 35 USC 102(a) may not apply, and (B) may not be a proper response because antedating an issue date does not overcome the filing date.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is a proper response if the examiner is relying on a 35 USC 102(e) basis, that 35 USC 102(a) may not apply because of priority, that there may be some other reason that 35 USC 102(a) may not apply, and (B) may not be a proper response because antedating an issue date does not overcome the filing date, Petitioner provides no support for the conditions overcoming 35 USC 102(a), only suggesting that there may be such conditions. The instructions clearly indicate that no assumptions beyond the fact pattern should be made. As to the argument that (B) is not a proper response and therefore a valid answer, it is noted that the Petitioner's answer is (E) not (B) and therefore this argument is moot with respect to Petitioner's answer, and that further, selection (B) does not specify which specific date is overcome, but only that the reference in total is overcome, negating the argument that selection (B) is not a proper response. Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that all answers (A) through (D) are correct, making Petitioner's answer (A) correct. Petitioner contends that (B) is true because Ben is only going to appoint a registered practitioner, that ((B), (C) and (D) are not true because powers of attorney are normally sent in by the attorney and not the applicant, and that (C) is untrue because the power may be unexecuted.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that that (B) is true because Ben is only going to appoint a registered practitioner, that ((B), (C) and (D) are not true because powers of attorney are normally sent in by the attorney and not the applicant, and that (C) is untrue because the power may be unexecuted, none of these arguments support Petitioner's answer (A). The closest Petitioner comes to addressing (A) is to assert that Ben can instruct Chris to represent to the Office that Chris has power of attorney, although the fact pattern indicates that Chris does not have such power. This would be a clear violation of 37 CFR 10.23(b)(4). As to (B), that selection specifically states that Ben should send in a power of attorney for anyone he intends to represent him, and is not limited in scope to registered practitioners, and is therefore incorrect. As to the assertion that (B), (C) and (D) are untrue, this is inconsistent with Petitioner's core argument that all are true, and further, the argument that powers of attorney are sent in by attorneys is incorrect, inless one simply defines "send" as "mail", in which case, the reality would be that all powers of attorney are sent in by the postal service, not attorneys. Powers of attorney are certainly sent in by those who execute and authorize their submission, namely applicants. As to the argument that a power may be unexecuted, this is moot with regard to selection (C) which explicitly states the power is executed. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 24 reads as follows:

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "Y". Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick's application. The examiner rejected Brick's claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called "Q," and that although "Y" and "Q" are not the same, it would have been obvious to one of ordinary skill to make changes to the "Q" ball in order to obtain a ball just like Brick's "Y" ball. On August 2, 2001, Brick responds by stating that his new "Y" ball bounces unexpectedly higher than the "Q" ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the "Y" and "Q" balls and showing that the "Y" ball bounces unexpectedly higher than the "Q" ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the "Y" ball as compared to the "Q" ball, it would not have been obvious to one of ordinary skill in the art to make changes to the "Q" ball to obtain Brick's "Y" ball. On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: "The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action." Brick believes he is entitled to a patent to his new bouncing ball "Y." How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick's invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his "Y" ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his "Y" ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the "Q" ball and the "Y" are not identical.

24. The model answer: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Brick should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Brick's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Brick's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

Petitioner argues that all answers are correct. Petitioner contends that the best course would be to schedule an interview, and failing that, all selections are equally good, because there is no indication that the recited requests for reconsideration would have any effect.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the best course would be to schedule an interview, and failing that, all selections are equally good, because there is no indication that the recited requests for reconsideration would have any effect, the question asks which of the enumerated selections would be best, not what course would be best in the abstract. That is why selection (B) is the best, because that selection implicitly acknowledges the risk that the request for reconsideration would not overcome the rejection and provides an appeal route. Petitioner fails to explain why his answer (D), which introduces and argument not previously in the record and would require further consideration and is immaterial to a 35 USC 103 rejection, and does not provide the appeal back-up, would be better than (B). Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

(A) Barry's device is too large to combine with Lance's device.

(B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.

(C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.

(D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.

(E) All of the above.

12. The model answer: (C) is correct. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance's device unsatisfactory for its intended purpose. (A) is incorrect. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference .... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry's art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

Petitioner argues that selections (A) through (D) are correct and therefore answer (E) is correct. Petitioner contends that all would be correct given the right set of facts.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that all would be correct given the right set of facts, the instructions indicate that no assumptions beyond the fact pattern should be made. As indicated in the model answer, none of selections (A), (B) or (D) are sufficient given the fact pattern to overcome the rejection. Petitioner has failed to identify what elements in the fact pattern would make (A), (B) or (D) sufficient to overcome the rejection. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. Judy Practitioner is preparing the declaration form (PTO/SB/01) for her clients, inventors A and B, to sign prior to filing their utility patent application. Inventor A lives in California, and inventor B lives in Germany. Prior to sending declaration forms to the inventors, only inventor A had reviewed the final version of the application. Which of the following situations below would result in the declaration form(s) being compliant with 37 CFR 1.63(a) and (b)?

(A) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A with the instruction to return to her after he signs the declaration form. After inventor A returned the form, Judy then proceeded to mail out the declaration form to inventor B. After inventor B signed the declaration, Judy then attached the declaration, signed by both inventors, to the application and filed it with the USPTO.

(B) Judy mailed to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and only inventor A's full name and citizenship. At the same time, Judy sent by facsimile to inventor B only a copy of the declaration form, which identified the application and only inventor B's full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.

(C) Judy sent by facsimile (e.g. fax) to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and both inventors by their full names and citizenships. At the same time, Judy mailed to inventor B a copy of the application and a copy of the declaration form, which identified the application and both inventors by their full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.

(D) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A. Judy then attached the declaration, signed only by inventor A, to the application and filed it with the USPTO.

(E) Judy files a petition under 37 CFR 1.48 just stating that inventor B's signature could not be obtained at this time, and files a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, signed by only inventor A.

27. The model answer: The correct answer is (C) because (1) the declaration identified the application and the full name and citizenship of both inventors and (2) a copy of the application was sent to inventor B to review and understand. Answer (A) is incorrect because inventor B never reviewed and understood the application prior to signing the declaration form. Answer (B) is incorrect because (1) each declaration form failed to identify all the inventors (e.g. both inventors A and B) and (2) a copy of the application was not sent to inventor B to review and understand. Answer (D) is incorrect because inventor B never signed the declaration. Answer (E) is incorrect because petitions for nonsigning inventors must be filed under 37 C.F.R. § 1.47, not § 1.48. Even if the petition is treated under § 1.47 a statement, that B's signature could not be obtained at this time, is insufficient.

Petitioner argues that no answer is correct and therefore credit should be given for any answer. Petitioner contends that selection (C) is a bad answer because applicants generally do not read an application prior to signing a declaration and therefore no answer that fails to specify that the attorney makes the applicant aware of the need to read the application is correct.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (C) is a bad answer because applicants generally do not read an application prior to signing a declaration and therefore no answer that fails to specify that the attorney makes the applicant aware of the need to read the application is correct, there is nothing in the fact pattern that suggests neither inventor did not read the application. In particular, the signing of the declarations is evidence that the inventors did read the application because they certify as such in the declaration. Further, Petitioner admits that his answer (A) is incorrect because "only answer choice (C) ... is the only possible answer." Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy