



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 7, 11, 12, 42 and 43 of the morning 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 67. On August 6, 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 two points for morning question 11 and 12. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning questions 7, 42 and 43. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

7. The model answer: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. *See In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. *See In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. *See In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Petitioner argues that answer (C) is correct. Petitioner contends that the statement in (D) is correct and therefore presents an incorrect answer because attorney argument is relevant to showing lack of obviousness and the presence of a property evidencing obviousness can be supported by attorney argument, and the statement in (D) is correct and therefore presents an incorrect answer because data not covering the full range of claims fails to provide a nexus.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the statement in (D) is correct and therefore presents an incorrect answer because attorney argument is relevant to showing lack of obviousness and the presence of a property evidencing obviousness can be supported by attorney argument, and the statement in (D) is correct and therefore presents an incorrect answer because data not covering the full range of claims fails to provide a nexus, selections (C) and (D) read differently than the interpretations suggested by the petitioner.

Selection (C) says that data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims. The presented fact that one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims demonstrates the nexus that petitioner asserts is missing. The unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. *See In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d).

Selection (D) says that unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney. The presented fact that no factual evidence is available to the applicant on its face negates any capacity of attorney argument to support a conclusion of non-obviousness. Secondary considerations are based upon factual, not conclusory, findings. Whether arguments could support factual evidence is not at issue because the stated fact pattern explicitly negates the existence of factual evidence, rendering the cited court cases by petitioner moot.

Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

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

Morning question 42 reads as follows:

42. Applicant Homer filed a non-provisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

(A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.

(B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.

(C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.

(D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.

(E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

42. The model answer: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a *bona fide* attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a *bona fide* attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

Petitioner argues that no answer is correct and therefore all answers should receive credit. Petitioner contends that (D) is incorrect because the amendments failed to comply with 37 CFR 1.121 and there is no evidence that the response was in good faith and therefore the application should have been held abandoned.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is incorrect because the amendments failed to comply with 37 CFR 1.121 and there is no evidence that the response was in good faith and therefore the application should have been held abandoned, the facts in (D) show that the amendment was proper and made in good faith, and therefore would not be held to be improper, leading to abandonment. In particular, selection (D) states that the proposed amendments are marked in red, consistent with 37 CFR 1.121's allowance for any equivalent marking system, of which red-lining is an example, and that the arguments support the patentability of the claims, evidencing a good faith advancement of the

prosecution. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

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

Morning question 43 reads as follows:

43. The Commissioner may issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office:

(A) only if demanded by a third party having standing with the Office and the third party pays the fee required by 37 CFR 1.20(a).

(B) without notifying the patentee, (including any assignee of record) if the correction is of a nature that the meaning intended is obvious from the context of the portion of the patent where the mistake occurs.

(C) only if the request for correction relates to a patent involved in an interference.

(D) acting *sua sponte*, after first notifying the patentee, for mistakes that the Office discovers.

(E) only if patentee or the patentee's assignee makes a request.

43. The model answer: (D) is the most correct answer. 37 U.S.C. § 254, 37 C.F.R. § 1.322(a)(1)(ii), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). (A) is incorrect. 37 C.F.R. § 1.322(a)(2), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). Third parties do not have standing to demand that the Office issue or refuse to issue a certificate of correction. (B) is incorrect. 37 C.F.R. § 1.322(a)(4), and MPEP § 1480, page 1400-63, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The Office will not issue a certificate of correction under 37 C.F.R. § 1.322 without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard. Additionally, the Office has the discretion to decline to issue a certificate of correction even though an Office mistake exists if the Office mistakes are of a nature that the meaning intended is obvious from the context. (C) is incorrect. 37 C.F.R. § 1.322(a)(3) and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). A request for a certificate of correction to correct a mistake in a patent incurred through the fault of the Office may relate to any issued patent including those involved in interference. Where the request relates to a patent involved in an interference, the request must comply with the requirements of 37 C.F.R. § 1.322 and be accompanied by a motion under 37 C.F.R. § 1.635. (E) is incorrect. 37 C.F.R. § 1.322(a)(1), and MPEP § 1480, pages 1400-63 and 64, (8<sup>th</sup> Ed.), (*Certificates of Correction – Office Mistake*). The

Commissioner may also issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office, acting *sua sponte* for mistakes that the Office discovers or acting on information about a mistake supplied by a third party.

Petitioner argues that answer (E) is correct. Petitioner contends that selection (D) is incorrect because such certificates of correction can only be made where the error is clearly disclosed in the record, and absent such a showing only selection (E) offers a mechanism for correction.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (D) is incorrect because such certificates of correction can only be made where the error is clearly disclosed in the record, and absent such a showing only selection (E) offers a mechanism for correction, the fact pattern explicitly indicates the Office will correct a mistake in a patent, which is part of the record. Accordingly, model answer (D) 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.

**ORDER**

For the reasons given above, two points have 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.



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