



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

AUG 12 2002

In re

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

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 18, 27 and 40 of the morning session and questions 32 and 35 of the afternoon session of the Registration Examination held on October 17, 2001. 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 sessions of the Registration Examination. Petitioner scored 67.

On February 1, 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 sessions 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 one additional point for morning question 49. Accordingly, petitioner has been granted one additional point on the Examination. No credit has been awarded for morning question 18, 27 or 40, and no credit has been awarded for afternoon question 32 or 35. Petitioner's arguments for these questions are addressed individually below.

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
  - (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
  - (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.
  - (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
  - (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

18. ANSWER: The most correct answer is (B). MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559

F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner has argued that answer (C) is the most correct answer because “in any claim drawn to a machine, there is only *one* machine irrespective of the number of parts or devices that comprise that machine.” Petitioner’s arguments have been fully considered but are not persuasive. As set forth in MPEP § 2106 IV(B)(2)(a), the Supreme Court stated in *Burr v. Duryee* that a machine is “a concrete thing, consisting of parts or of certain devices and combinations of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). Accordingly, the claim for “a machine” as set forth in answer (C) would be capable of embodying various devices in the alternative or in combination. Rather than one machine, such as a single computer, the claimed “machine” could be embodied by another machine, such as a mechanical adding machine, or by a plurality of machines at once, such as a network of personal computers and file servers. Answer (B) is the most correct answer because, as provided in MPEP § 2106 (IV)(B)(2)(b)(ii), “If the ‘acts’ of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter.” See also *In re Schrader*, 22 F. 3d 290 at 294-95, 30 USPQ2d 1445 at

1458-59 (Fed. Cir. 1994). As further provided in MPEP § 2106 (IV)(B)(1): “Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.” Petitioner argues that answer (B) is not in accord with *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3D 1368, 1373, 47 U.S.P.Q.2d 1596, 1601 (Fed. Cir. 1998), and that “a process consisting solely of mathematical operations is not *per se* unpatentable.” As set forth in MPEP § 2106 (IV)(B)(2)(b), to be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. In both *State Street* and *AT&T*, the claimed computer-related process was limited to a practical application within a technological art. In *State Street*, the mathematical operations resulted in more than just a set of numbers, they resulted in “a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” In *AT&T*, the claims were limited to a long-distance telephone billing process employing the claimed Boolean principle, and the claims did not pre-empt other uses of the claimed Boolean principle.

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

Morning question 27 reads as follows:

27. A U.S. patent application for inventor William Tull discloses a target-shooting gun for improved accuracy, and a bullet impregnated with a new chemical composition. The

new chemical composition minimizes damage to a target struck by the bullet. In a non-final Office action, an examiner includes a restriction requirement between a group of claims drawn to the target-shooting gun (Group 1), and a group of claims drawn to the bullet (Group 2). Which of the following, included in a timely reply to the non-final Office action, preserves Tull's right to petition for review of the restriction requirement, if the requirement is made final?

- (A) A reply that distinctly points out supposed errors in the restriction requirement, and also states, "The restriction requirement is traversed, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (B) A reply that states, "Applicant elects Group 2 and traverses the restriction requirement because the requirement for restriction between Group 1 and Group 2 is in error."
- (C) A reply that distinctly and specifically points out supposed errors in the restriction requirement, and states, "Applicant traverses the restriction requirement and elects Group 2."
- (D) A reply that states, "The restriction requirement between Group 1 and Group 2 is traversed because it is in error, and no election is made, thereby preserving Applicant's right to petition for review of the restriction requirement."
- (E) None of the above.

The model answer is selection (C).

27. ANSWER: (C) is the correct answer. 37 CFR 1.144; MPEP §§ 818.03(a)-(c). (A), (B), and (D) are each incorrect because no supposed errors in the restriction requirement are distinctly and specifically pointed out. (A) and (D) are further incorrect because no election is made. (E) is incorrect because (C) is correct.

Petitioner selected answer (E). Petitioner has argued that the word "supposed" before "errors" indicates that the applicant mistakenly believed the errors to be errors or imagined them to be errors, and that pointing out "supposed errors" would subject the practitioner to disciplinary action under 37 CFR 10.85(a)(2). Petitioner's arguments have been fully considered but are not persuasive. The wording in answer (C) follows 37 CFR 1.111(b) which requires that a reply by the applicant must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action. The term "supposed errors" is referring to what applicant, in good faith, believes to errors.

Furthermore, 37 CFR 10.85 applies to “a practitioner”, 37 CFR 10.1(r) defines a “practitioner”, and the facts do not state that the reply was made by a “practitioner.”

Furthermore, the facts do not clearly establish that a practitioner knowingly advanced a claim or defense that is unwarranted under existing law or unsupported by a good faith argument for an extension, modification, or reversal of existing law. According, 37 CFR 10.85 does not necessarily apply in this case. Furthermore, even if 37 CFR 10.85 did apply, and disciplinary action was required, the disciplinary action would not necessarily take the form of denying Tull his right to petition for review of the restriction requirement. Accordingly, (C) is the most correct answer.

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

Morning question 40 reads as follows:

40. Mike and Alice, who are not related, are shipwrecked on a heretofore uninhabited and undiscovered island in the middle of the Atlantic Ocean. In order to signal for help, Mike invents a signaling device using bamboo shoots. Alice witnesses but does not assist in any way in the development of the invention. The signaling device works and a helicopter comes and rescues Alice. However, Mike remains on the island due to overcrowding on the helicopter. Unfavorable weather conditions have prevented Mike’s rescue to date. Alice comes to you, a registered patent practitioner, to file an application for a patent and offers to pay you in advance. Which of the following is true?

- (A) Since Mike invented the invention, Alice cannot properly file an application for a patent in her name even though Mike is unavailable.
- (B) Since Mike is unavailable, you may properly file an application for a patent without his consent. You can accept the money from Alice as payment for the application.
- (C) Since Mike is not available and cannot be reached, Alice may properly sign the declaration on his behalf since she has witnessed the invention and knows how to make and use it.

- (D) Alice should file an application in her name since she has witnessed the invention and knows how to make and use it. Subsequently, when Mike becomes available, the inventorship may be changed to the correct inventorship.
- (E) Even though Mike and Alice are not related, Alice may properly file an application on Mike's behalf.

The model answer is selection (A).

40. ANSWER: (A) is true since only the inventor may file for a patent. 35 U.S.C. § 101. As to answers (C) and (E), since Alice is not a joint inventor and she does not have sufficient proprietary interest in the invention, she may not file a patent application on Mike's behalf. 35 U.S.C. § 116; 37 CFR 1.47(b). As to (B), you ordinarily may not accept payment from someone other than your client. 37 CFR 10.68(a)(1). As to (D), inventorship cannot be changed when there is deceptive intent.

Petitioner has argued that some assumption about Alice's proprietary interest in the invention was necessary to answer the question. Based on the assumption that Alice had a proprietary interest in the invention, petitioner chose (C). Petitioner's arguments have been fully considered but are not persuasive. No assumption needs to be made about Alice's proprietary interest to determine that (A) is a correct answer. Alice was not an inventor, and the application therefore cannot properly be filed in her name. Accordingly, (A) is the most correct answer.

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

Afternoon question 32 reads as follows:

32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the

payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

The model answer is selection (E).

32. ANSWER: (E). As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that (D) is the most correct answer because the priority claim could be made under 35 U.S.C. § 365(c) rather than under 35 U.S.C. § 120. It is true that 37 CFR 1.53(b) and 37 CFR 1.78(a)(3) provide that the claim may be made under 35 U.S.C. 120, 121, or 365(c). However, petitioner did not choose answer (D). Petitioner chose answer (C) to afternoon question 32. Regarding answer (C), petitioner states that "(C) is not the most correct answer because it is not completely true and accurate." Petitioner has quoted language from 37 CFR 1.501(b) that requires the person making the citation to submit the citation papers without any identification of the person making the submission if that person wishes his or her identity to be excluded from the patent file and kept confidential. Petitioner has not provided convincing reasons why answer (C) should be accepted as the most correct answer to afternoon question 32.

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

Afternoon question 35 reads as follows:

35. Tony, a client, comes to you with regard to a competitor's two published patent applications, A and B, which were published one month ago. Tony shows you several material prior art publications and patents that he discovered for the first time while cleaning out his brother-in-law's attic last week. Assume no Notice of Allowance has been mailed in application A and a Notice of Allowance has been mailed in application B. Tony wants to know if it is too late to submit the information to the USPTO for consideration by the examiner. He also wants to know how it is accomplished, if the applicant needs to be served a copy, whether a fee is required and whether an explanation is needed for each reference. Which of the following is not accurate with respect to proper USPTO procedure?

- (A) The submission by Tony of patents or publications relevant to pending published application A will be permitted without the necessity of paying the processing or petition fee required by 37 CFR 1.17(i) if the patents or publications are submitted within two months of the publication of the competitor's application.
- (B) Each submission must identify the application to which it is directed by application number and include: (1) the appropriate fee set forth in 37 CFR 1.17(p); (2) a list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication; (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.
- (C) The submissions by Tony of patents or publications relevant to both of the pending published applications A and B need not be served upon the applicant.
- (D) The submissions by Tony of patents or publications relevant to the pending published applications A and B shall not include any explanation of the patents or publications, or any other information.
- (E) The submission by Tony of patents or publications relevant to pending published application B will be permitted only if accompanied by the processing fee as set forth in 37 CFR 1.17(i).

The model answer is selection (C).

35. ANSWER: (C). 37 CFR 1.99(c) requires service on the applicant and provides "[t]he submission under this section must be served upon the applicant in accordance with §

1.248.” (A) contains all of the elements of 37 CFR 1.99(a). (B) contains all of the elements of 37 CFR 1.99(b). (D) contains all of the elements of 37 CFR 1.99(d). (E) contains all of the elements of 37 CFR 1.99(e).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (D) is the best answer because Tony could wait for one or both patents to issue from the respective applications, then file for reexamination of one or both patents. If Tony chose such an alternative, he would be required (under 37 CFR 1.510(b)(1)) to include a statement pointing out each substantial new question of patentability based on the prior art publications and patents. Answer (D) is not the best answer because answer (D) specifies that the submissions are made “relevant to the pending published applications A and B.” It is improper for petitioner to assume that Tony could wait for one or both patents to issue from the respective applications because such an assumption contradicts the facts set forth in answer (D). Answer (C) is the most correct answer. As provided in 37 CFR 1.99(d), a third-party submission in a published application “shall not include any explanation of the patents or publications, or any other information.”

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 68. 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  
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