



OCT 1 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

petitions for regrading his answers to questions 3, 4, 7, 19, 30 and 43 of the morning section and questions 4, 5, 16, 22 and 25 of the afternoon section of the Registration Examination held on October 18, 2000. Petitioner also requests for regrading questions 2, 5, 6, 12, 16-18, 20, 24, 28, 37, 38, and 41 of the morning session, and questions 1, 2, 10, 12, 14, 19-21, 23, 29, 32-38, and 42 of the afternoon session of the examination. 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 59. On January 29, 2001, 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 C.F.R. § 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. Any reference to a practitioner is a reference to 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 PTO 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 subsequent court decision or a notice in the Official Gazette. 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 which 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 2 additional points for morning questions 6 and 30. No credit has been awarded for morning questions 2-5, 7, 12, 16-20, 24, 28, 37-38, 41 and 43 and afternoon questions 1, 2, 4, 5, 10, 12, 14, 16, 19-23, 25, 29, 32-38, and 42. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

I. The fee set forth in 37 C.F.R. § 1.17(i).

II. John's birth certificate showing his date of birth.

III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

(A) I

(B) II

(C) III

(D) II and III

(E) None of the above.

The model answer is selection (E).

MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that submission of a fee is not singularly sufficient to result in the petition being granted because MPEP § 708.02, subpart (VIII) requires the fee to be submitted in combination with the requirements listed therein.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner's arguments neglect the fact that the question states that the requirements of MPEP § 708.02, subpart (VIII) have been fulfilled already - the question states that "you

submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references.” All other requirements of MPEP § 708.02, subpart (VIII) have been fulfilled except the payment of the fee. Accordingly, model answer (E) 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 4 reads as follows:

4. Regarding amendments to the specification of an application or the claims in an application, which of the following is not true?

(A) If an amendment signed by the applicant is received in an application in which there is a duly appointed registered patent attorney or agent, the amendment should be entered and acted upon.

(B) Where, by amendment under 37 C.F.R. § 1.121(a), a dependent claim is rewritten to be in independent form, the subject matter from the prior independent claim is considered to be “added” matter and should be underlined.

(C) Any amendment using parentheses to indicate canceled matter in a claim rewritten under 37 C.F.R. 1.121(a) may be held nonresponsive.

(D) Amendments to the original patent drawings in a reissue application are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as “amended” and with added figures identified as “new” for each sheet changed.

(E) Amendment to the claims in a nonprovisional application, other than a reissue application may be made by specifying only the exact matter to be added or deleted, and the precise point where the deletion or insertion is to be made, where the change is limited to deletions and/or additions of no more than ten words in any one claim.

The model answer is selection (E).

Amendment in said manner is limited to deletions or additions of no more than five words. 37 C.F.R. § 1.121(a)(2)(i)(B). Thus, the answer is not true. (A) is true, and

therefore an incorrect answer. MPEP § 714.01(d). (B) is true, and therefore an incorrect answer. MPEP § 714.22. (C) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(a); MPEP § 714.22. (D) is true, and therefore an incorrect answer. 37 C.F.R. § 1.121(b)(3)(i).

Petitioner argues that answer (A) is correct. Petitioner contends that according to MPEP § 714.13, amendments are not always entered as a matter of right, and that (A) suggests that when an amendment is signed by the applicant and received, the amendment should always be entered and acted upon, making (A) not true.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (A) is not true, MPEP § 714.01(d) states: "If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon." Accordingly, model answer (E) 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 7 reads as follows:

7. You, a registered patent practitioner, have agreed to represent an independent inventor in connection with a patent application that was filed in the United States Patent and Trademark Office by the inventor on a pro se basis. As filed, the application lacks an abstract of the disclosure, but included a detailed written description that contained numerous errors. However, when viewed together with four accompanying color photographs, the application disclosure was adequate to enable one of ordinary skill in the pertinent art to make and use the invention. The application also included three independent patent claims, an inventor's declaration in compliance with 37 C.F.R. § 1.63, a small entity statement (independent inventor) under 37 C.F.R. § 1.27, and all necessary small entity filing fees. The inventor has been granted a filing date and has received an official filing receipt. MEGACORP, a very large multi-national corporation, licensed rights in the invention shortly after the application was filed and, therefore, the inventor wants to ensure that the application is properly handled. The inventor has asked you to suggest steps to help expedite prosecution and to remove any formal objections that can be expected from the examiner, without incurring unnecessary government fees. You determine that the first color photograph is the only practical medium by which to disclose certain aspects of the claimed invention, but that the substance of the remaining photographs could readily be illustrated through ordinary ink drawings. Which of the following represents the most reasonable advice to the independent inventor?

(A) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are canceled in favor of corresponding ink drawings labeled Figures 2 through 4; and immediately withdraw the claim for small entity status because of the license to MEGACORP.

(B) Prepare a preliminary amendment to correct errors in the detailed description, add an abstract of the disclosure, revise the existing claims and present additional dependent claims to more fully protect the invention; submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4; and submit a petition for acceptance of Figure 1 in the form of a color photograph along with a proposed amendment to insert language concerning the color photograph as the first paragraph of the specification and the required petition fee.

(C) Prepare a preliminary amendment to correct errors in the detailed description and to present additional dependent claims to more fully protect the invention; and submit a request for approval of drawing changes wherein the first photograph is labeled "Figure 1" and the remaining photographs are cancelled in favor of corresponding ink drawings labeled Figures 2 through 4.

(D) Prepare a preliminary amendment to correct errors in the detailed description and to present additional claims that more fully protect the invention; and immediately withdraw the claim for small entity status because of the license to MEGACORP and submit to the USPTO the difference between the small entity filing fee and the large entity filing fee.

(E) Completely rewrite the written description and claims as part of a new application and file it as a continuation application, including a color photograph as Figure 1, ink drawings as Figures 2-4, a new inventor's declaration and a small entity filing fee.

The model answer is selection (B).

37 C.F.R. § 1.84(a)(2), MPEP § 608.02, "Color Drawings or Color Photographs." (A) is wrong because a petition under 37 C.F.R. § 1.84 is required to avoid an objection to the color photographs. Also, since small entity status was properly established at the time of filing, the inventor is entitled to maintain small entity status until any issue fee is due. 37 C.F.R. § 1.28(b). (C) – (E) are also wrong because they do not provide for the required petition under § 1.84. In (D), the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing

fee. Additionally, (E) is wrong because the inventor would be required to file a large entity filing fee and a continuation application therefore does not achieve the stated goal of avoiding unnecessary government fees.

Petitioner argues that answer (A) is correct. Petitioner contends that the small entity status is incorrect and must be withdrawn immediately. Petitioner's argument matches answer (D) rather than (A).

Petitioner's arguments have been fully considered but are not persuasive. Although small entity status is no longer correct, the change in small entity status after the application was filed does not require the inventor to retroactively pay a large entity filing fee. Accordingly, model answer (B) 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 19 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to

avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

(A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.

(B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.

(C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.

(D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.

(E) (C) and (D) are each an appropriate way to correct the named inventive entity.

The model answer is selection (C).

Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that there was deceptive intent to exclude Leftout, and that the mistake cannot be corrected.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that there was deceptive intent, the question clearly

states “There was never any deceptive intent by either Putin or Leftout concerning the error.” Petitioner was instructed: “Do not assume any additional facts not presented in the questions.” Accordingly, model answer (C) 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 43 reads as follows:

43. Which of the following definitions does not accord with proper USPTO practice and procedure relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped “approved” by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.
- (D) A substitute drawing is usually submitted to replace an original formal drawing.
- (E) A drawing may be declared as informal by the applicant when filed.

The model answer is selection (D).

A substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

Petitioner argues that answer (B) is correct. Petitioner contends that a substitute drawing is submitted to replace the original formal drawing, and that formal drawings are stamped “Approved by Draftsman” rather than “Approved”.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that formal drawings are stamped “Approved by Draftsman,” MPEP § 608.02 under the heading “Definitions” states that “[f]ormal drawings are stamped ‘approved’ by the Draftsperson” and that a substitute drawing is “[u]sually submitted to replace an original informal drawing.” 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.

Afternoon question 4 reads as follows:

4. In January 1997, Chris invents an electrical door stop for automatically stopping a door at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

1. A door stop for automatically stopping the pivoting action of a door by pressing downward, said door stop comprising:
a) first means attached to a door for receiving a downward movement;
b) second means for actuating a mechanism for engaging the floor surface in response to the downward movement of the first means, said first and second means being operatively connected.

Which of the following is true?

(A) Since Sam knew of the doorstop at the restaurant and not Chris, there is no duty to disclose the Shack restaurant doorstop. An attorney need not disclose that which is within his personal knowledge in an information disclosure statement.

(B) Since Sam discovered the Shack restaurant device after he had started writing the application, the invention was fully disclosed to Sam. There is no need to disclose that which occurs after an inventor completes his application disclosure.

(C) Sam needs to disclose only patents or printed publications to the USPTO to satisfy the duty of disclosure. Since Sam was unaware of any patent or printed publication for

the Shack restaurant doorstop, Sam does not need to file an information disclosure in this regard.

(D) Chris should file a request for reexamination seeking to have the Shack restaurant door stop considered.

(E) None of the above.

The model answer is selection (E).

Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstop occurred prior to the filing date. Moreover, the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-4. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.

Petitioner argues that answer (D) is correct. Petitioner contends that while prior art applied may only consist of prior art patents or printed publications, the facts leave open the possibility that such prior art exists.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that to assume proper prior art (referring to patents or printed publications) does not exist would be improper exam procedure, in fact, to assume that such prior art **does** exist would be improper exam procedure. The question does not mention patents or printed publication, therefore the existence of patents or printed publications must be assumed, which is in violation of the instructions mandate not to "assume any additional facts **not presented** in the questions." Accordingly, model answer (E) 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 5 reads as follows:

5. Which of the following is a proper basis for establishing a substantial new question of

patentability to obtain reexamination in accordance with proper USPTO practice and procedure?

(A) An admission per se by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.

(B) A prior art patent that is solely used as evidence of an alleged prior public use.

(C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.

(D) A printed publication that is solely used as evidence of an alleged prior offer for sale.

(E) None of the above.

The model answer is selection (E).

35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. § 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. MPEP § 2217. An admission, per se, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure. The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

Petitioner argues that answer (A) is correct. Petitioner contends that the answer states that the invention was on sale or in public use more than one year before any patent application was filed in the USPTO, and that this fact completes the missing requirement of an admission combined with a printed publication or prior art patent.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the answer states there was an admission combined with other evidence, the answer only mentions "An admission. . . **that** the claimed

invention was on sale or in public use. . .” There is no additional evidence, only the admission. Accordingly, model answer (E) 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.

Afternoon question 16 reads as follows:

16. In June 1995 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 1997, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor’s garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 1997. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising:
circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:

- a) adapting a television remote control device to emit signals to open a garage door;
- b) pointing said television remote control device at said garage door; and
- c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

(A) Since the television and remote control were sold in June 1995, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.

(B) Although the device was bought in June 1995, Michael did not use it to open a garage door until 1997. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1995, and 35 U.S.C. § 102(b) does not apply.

(C) Since the television remote control device was in public use more than one year prior

to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.

(D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.

(E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

The model answer is selection C.

When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. Cf. *Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), *aff'd*, 456 F.2d 592, 172 USPQ 324 (CA 3), *cert. denied*, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (B), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (A) is correct. Petitioner contends that the method for opening a garage door with using a remote control device to emit signals is known, thus claim 12 should be barred as well as claim 11. Petitioner further argues that allowing patents on new uses of preexisting articles would be more useful in the chemical or biotechnology arts.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that claim 12 should be barred, the facts do not state that the method of using a **television** remote control to open a garage door was known. Thus, this method is patentable. Moreover, the argument that new uses of preexisting articles would be useful to biotechnology or chemical arts is not relevant. 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.

Afternoon question 22 reads as follows:

22. A rejection based on 35 U.S.C. § 102(a) cannot be overcome by:

(A) Filing an affidavit under 37 C.F.R. § 1.132 showing that the reference invention is not by “another.”

(B) Perfecting a claim to priority under 35 U.S.C. § 119(a)-(d).

(C) Filing an affidavit under 37 C.F.R. § 1.131 “swearing back” of a U.S. patent which substantially shows or describes, and claims the same patentable invention as the rejected invention.

(D) Amending the claims to patentably distinguish over the prior art.

(E) Persuasively arguing that the claims are patentably distinguishable from the prior art.

The model answer is selection (C).

37 C.F.R. § 1.131 requires that the reference not claim the same patentable invention as the rejected invention. (A), (B), (D), and (E) are wrong because MPEP § 706.02(b) identifies these answers as actions that can be taken to overcome a 35 U.S.C. § 102(a) rejection.

Petitioner argues that answer (A) is correct. Petitioner contends that filing an affidavit under 37 C.F.R. § 1.132 is usually submitted to overcome obvious rejections, not rejections based on 35 U.S.C. § 102(a), and that the word “another” is ambiguous.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that “another” is ambiguous, the wording in answer (A) is taken directly from MPEP § 706.02(b): “A rejection based on 35 U.S.C. 102(a) can be overcome by: . . . (D) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by ‘another.’”. Accordingly, model answer (C) 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.

Afternoon question 25 reads as follows:

25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.

II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.

III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I
- (B) II
- (C) III
- (D) I and II
- (E) None of the above.

The model answer is selection B.

MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that the word "any" in I. means that a rebuttal may be made during the first office action, second, or at any time the examiner makes such a statement, and that there is no point during prosecution where the examiner may make a statement of common knowledge without the applicant being able to rebut the same.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a rebuttal can be made during any office action, MPEP § 2144.03 states that "[i]f applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art," and "applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." Thus, the applicant's rebuttal cannot be made after "any" Office action, but must be made after the Office action in which the well known statement was made. 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.

Petitioner's alternative arguments have been considered but are not persuasive. Concerning 2 AM - The question did not ask whether or not ABC Corp. has an interference claim, but what should Sam Practitioner do knowing that ABC Corp. wished to provoke an interference.

Concerning 5 AM - Petitioner's argument is not clear; there was no 103 rejection in the question.

Concerning 6 AM - The question asks about evidence, and remarks in a reply or brief may be used as evidence. MPEP § 2172 (II).

Concerning 16 AM - The correct answer does not contain the phrase "reference patent" that petitioner argues is ambiguous; the wording of the answer is taken directly from MPEP § 901.01 and is the best answer.

Concerning 17 AM - Rene may not enlarge the scope of her patent in reexamination. MPEP 2209.

Concerning 20 AM - The question clearly states "the benefit of priority is desired in a reissue patent application." According to MPEP 1417, such a claim must be made even if the claim was made in the previous application for which the patent was granted.

Concerning 24 AM - The content of the professor's statement is irrelevant; according to MPEP 708.02 (V.) the statement should have been made by the applicant, assignee, or an attorney/agent registered to practice before the Office, not a professor.

Concerning 37 AM - The question does not ask about the period for reply, the question asks: "What was the date of abandonment?" MPEP 710.01(a) states "the application is regarded as abandoned after midnight the date the period for reply expired." An example similar to the question is given, in which it is made clear that the abandonment date may be a Saturday since the reply was due on a business day.

Concerning 41 AM - The PTO cannot narrow claims for the applicant, by mistake or otherwise.

Concerning 20 PM - All of the claims recite the particular elements A, B, and C as essential.

Concerning 21 PM - Applicant may not explain proposed changes in the Remarks section, applicant must file a separate letter. MPEP 608.02(r).

Concerning 38 PM - The wording in answer (A) is acceptable, see MPEP 608.01(n)(I)(A)
Acceptable Multiple Dependent Claim Wording.

ORDER

For the reasons given above, 2 points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 61. 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.



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