



SEP 5 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, 5, 6, 11, 31 and 50 of the morning section and questions 1, 2, 19, 20 and 30 of the afternoon section of the Registration Examination held on October 18, 2000. 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 64. 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 an additional one point for morning question 50. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning questions 3, 5, 6, 11, 31 and afternoon questions 1, 2, 19, 20 and 30. 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 argues that a fee alone is not sufficient for a petition to grant it based on age or poor health when it is not a petition for the "asking". Petitioner contends that submitting a fee alone is not sufficient without also submitting other documentation.

Petitioner's arguments have been fully considered but are not persuasive. Under the special circumstance described in this question, inventor's health and age are

legitimate reasons for waiving the petition fee. However, the factual pattern in this question does not preclude the submission of the fee set forth in 37 CFR §1.17 (I). Submitting the fee would be sufficient to result in the petition being granted.

Contrary to petitioner's statement that it requires accompanying other documentation with the fee for a special status application, MEPE 708.02 explains that submission of the fee set forth in 37 C.F.R. § 1.17(I) is sufficient to result in the petition being granted. 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 5 reads as follows:

5. You filed a U.S. patent application for Pete, obtaining an effective filing date of January 5, 1999, for a legal slot machine, fully disclosing and claiming only one claim as follows. Claim 1. A slot machine comprising: a cylindrical drum mechanically coupled to a motor; an electronic random data generator electrically coupled to the motor; and a push button coupled to the random data generator. You received a non-final Office action dated September 20, 1999. The examiner rejected claim 1 under 35 U.S.C. 102(e) as anticipated by a U.S. patent dated May 4, 1999 to Bud. The examiner stated and pointed out that the Bud patent, filed January 7, 1998, disclosed a slot machine with a cylindrical drum mechanically coupled to a motor; a mechanically spinning random data generator electrically coupled to the motor; and a push button coupled to the random data generator. The examiner further stated, "The examiner takes official notice that it was well known by those of ordinary skill in the art of slot machines, prior to applicant's invention, to use interchangeably either a mechanically spinning, or an electronic random data generator." The examiner did not provide any references to support the official notice. Which of the following timely filed replies to the Office action (compared to each other) is best?

(A) Traverse the rejection arguing that the examiner's use of official notice was improper because the examiner did not provide any references to support the official notice.

(B) Traverse the rejection arguing that Bud's invention was patented after Pete's effective filing date.

(C) Amend Pete's claim to further include a flat screen video monitor display and point out that the newly added feature distinguishes Pete's invention over Bud.

(D) Traverse the rejection arguing that the examiner did not create a prima facie case of obviousness because the examiner did not show why one of ordinary skill in the art of

slot machines would be motivated to modify the patent to Bud.

(E) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(e) was improper because Pete's claim is not anticipated by the patent to Bud.

The model answer is selection E.

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (D) are each incorrect because each reply does not address the lack of anticipation by Bud. (A) is further incorrect. It is proper to take official notice without citing a reference until the practitioner challenges the examiner to provide support. Until seasonably challenged, the examiner would not have to provide support for the official notice. MPEP § 2144.03. (B) is further incorrect because a § 102(e) reference can properly have a patent date after the filing date of an application. (C) is further incorrect because no amendment is necessary. (D) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (C) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (C) is correct, the paragraph above explains why answer (C) is incorrect. Accordingly, model answer (E) 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 6 reads as follows:

6. Evidence that a claim may not comply with the second paragraph of 35 U.S.C. § 112 occurs in accordance with proper USPTO practice and procedure where:

(A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.

(B) There is a lack of agreement between the language in the claims and the language set forth in the specification.

(C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.

(D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.

(E) All of the above.

The model answer is selection A.

In accordance with MPEP § 2172, part II, evidence that shows a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, part II, states, "As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section." (C) is incorrect. MPEP § 2172, part III indicates that the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, part III indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 U.S.C. 120. *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (A) 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 11 reads as follows:

11. An Office action issued with a three month shortened statutory period for reply. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37

C.F.R. § 1.17 to applicant's deposit account. The applicant knew at the time the amendment was filed that a two-month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

(A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.

(B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.

(C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.

(D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.

(E) None of the above.

The model answer is selection C.

37 C.F.R. § 1.136; MPEP § 710.02(e), p. 700-77. (A) and (B) are not true because the amendment is treated as timely. There is no authority for (D). (E) is untrue because (C) is true.

Petitioner argues that answer (B) is correct. Petitioner contends that the applicant did not state he was making an authorization to charge all required fees as required under 37 CFR § 1.136(a). Petitioner's arguments have been fully considered but are not persuasive. MPEP § 710.02(e) states in part:

If a petition for an extension of time under 37 CFR 1.136(a)(with or without a reply) requests an insufficient period of extension such that the petition would be filed outside the so-extended period for reply, but the period for reply could be further extended under 37 CFR 1.136(a) such that the petition would be filed within the further extended period for reply, it is Office practice to simply treat the petition for extension of time as requesting the period of extension necessary to make the petition filed within the further extended period for reply if the petition or application contains an authorization to charge extension fees or fees

under 37 CFR 1.17 to a deposit account. That is, in such situations a petition for an extension of time under 37 CFR 1.136(a) is simply construed as requesting the appropriate period of extension.

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 31 reads as follows:

31. Which of the following do not represent prior art?

(A) The preamble of a Jepson claim.

(B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.

(C) A doctoral thesis indexed, cataloged and shelved in a university library.

(D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.

(E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

The model answer is selection D.

See MPEP § 2128 under the subheading "Date of Availability," of the heading "Electronic Publications As Prior Art." (A) is wrong. See MPEP § 2129 under the heading "A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art." (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public." (E) is wrong. See In re Nomiya, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading "Admissions By Applicant Constitute Prior Art."

Petitioner argues that answer (B) is correct. Petitioner contends that the technical journal in choice B would not be a prior art not until when at least one member of the public receives it. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that no member of the public has mentioned in statement (B) constitutes no prior art rejection, MPEP § 2128.02 states that

“a magazine or technical journal is effective as of its date of publication (date when first person receives it) not the date it was mailed or sent to the publisher.” MPEP treats the date of publication as a constructive public receiving date. 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 1 reads as follows:

1. Which of the following is not required in order for a foreign application that has matured into a foreign patent will qualify as a reference under 35 U.S.C. § 102(d)?

(A) The foreign application must be filed more than 12 months before the effective filing date of the United States application.

(B) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.

(C) The foreign application must have actually issued as a patent or inventor’s certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.

(D) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.

(E) The same invention must be involved.

The model answer is selection D.

35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (A), (B), (C), and (E) are required by 35 U.S.C. § 102(d).

Petitioner argues that answer (A) is correct. Petitioner contends that the question is confusing in that the question does not specify whether it concerns a utility or design application. The directions to the morning and afternoon sections state in part:

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

Contrary to petitioner’s arguments that answer (A) is correct, the exam instructions

explain why petitioner's arguments are unfounded, and the paragraph above explains why petitioner's answer (A) is incorrect. Accordingly, model answer (D) 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 2 reads as follows:

2. Which of the following is not a proper incorporation by reference in an application prior to allowance according to USPTO rules and procedures?

(A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.

(B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.

(C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.

(D) Incorporating non-essential material by reference to a hyperlink.

(E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

The model answer is selection D.

MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (D) 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.

Please answer questions 19 and 20 based on the following facts:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling.

Afternoon question 19 reads as follows:

19. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

(A) Claim 1

- (B) Claim 2
- (C) Claim 3
- (D) Claims 2 and 3
- (E) None of the above.

The model answer is selection C.

Patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 3 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (B) and (D) are incorrect because claim 2 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (C) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that claim 2 is also a correct answer because it is a method of use claim, and as such, it should not be rejected under 35 USC § 101. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that claim 2 is drawn to a method of use, claim 2 is drawn to a composition that is naturally occurring. Accordingly, model answer (C) 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 20 reads as follows:

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and

adding an effective amount of D.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 2.
- (E) None of the above.

The model answer is selection D.

Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that claim 3 is in compliance with 35 U.S.C. § 112 second paragraph because the factual patten in this question states that the disclosed information of the application included an explanation of the “effective amount of D” in functions of brightening colors and decreasing viscosity. Therefore, Petitioner concludes, answer (E) should be the best answer.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claim 3 meets the requirement of 35 U.S.C. § 112 second paragraph, the intended functions, i.e. brightening colors or decreasing viscosity, is not specified. Therefore, it would be confusing for an ordinary skilled person in the art to determine which function the applicant intends to convey in claim 3. Most important, if Petitioner chose answer (E), it is not consistent with Petitioner’s argument because answer (E) means every claim would be properly rejected under 35 USC § 112 second paragraph. 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.

Afternoon question 30 reads as follows:

30. You prepare and file a patent application directed to an invention for improving the safety of research in the field of recombinant DNA. Your client, Inventor Joe, informs you he has licensed exclusive rights to his invention to a major pharmaceutical company. Inventor Joe also informs you that he is aware that another pharmaceutical company,

Titan Pharmaceuticals, learned of the invention from a paper he presented at a technical conference, and is preparing to use the technology in its commercial research labs in the United States. Inventor Joe demonstrates that Titan is about to begin practicing the invention by showing you a rigid comparison of Titan's intended activities and the claims of the application. He also informs you that although he is currently in very good health, he is 67 years old and fears he will not be in good health when the invention reaches its peak commercial value. Accordingly, if possible he would like for you to expedite prosecution in the simplest, most inexpensive way. Given the foregoing circumstances, which of the following statements is most correct?

- (A) Since the invention relates to improving the safety of research in the field of recombinant DNA, you should recommend filing a petition to make special on that basis.
- (B) Since Titan is actually practicing the invention set forth in the pending claims, you should recommend filing a petition to make special on that basis.
- (C) You should recommend filing a petition to make special on the basis of Inventor Joe's age.
- (D) Statements (A), (B) and (C) are equally correct.
- (E) Statements (A), (B) and (C) are each incorrect.

The model answer is selection C.

A petition to make special may be made simply by filing a petition including any evidence showing that the applicant is 65 years of age or more, such as a birth certificate or a statement from the applicant. No fee is required. MPEP § 708.02. Although a petition to make special as indicated in statement (A) is likely available, it would require a petition fee. *Id.* A petition to make special as indicated in statement (B) is likely not available because such a petition may not be based on prospective infringement. *Id.* Also, even if a petition as indicated in statement (B) were available, it would require a petition fee. Thus, neither of these options would be the most inexpensive. (A) also requires a statement explaining the relationship of the invention to safety of research in the field of recombinant DNA research.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. 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.

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. 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