



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 8, 31, 48 and 50 of the morning section and questions 11 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 68. On December 27, 2000, 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 1 point for morning question 50. Accordingly, petitioner has been granted an additional 1 point on the Examination. No credit has been awarded for morning questions 8, 31, and 48 and afternoon question 11. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Which of the following is true?

(A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.

(B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.

(C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).

(D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.

(E) (A), (B), and (C).

The model answer is selection (C).

See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that 35 U.S.C. 251 and MPEP § 1412.03 require that a broadened claim or intent to broaden a claim must be made within two years of the issue date of the patent.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner's argument ignores the wording of answer (D): "A **dependent claim . . .**" A dependant claim must be at least as narrow as the claim upon which it depends because "a dependent claim is construed to contain all the limitations of the claim upon which it depends." See MPEP § 1412.03 Scope of Dependent Claim Enlarged - Not Broadening. Therefore such a claim is not broader than the patent and the two-year limitation is inapplicable. 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.

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 no answer should be correct because all answers represent prior art. Petitioner contends that the Internet disclosure is prior art under MPEP § 2128. Petitioner contends that a disclosure publicly posted on the Internet with no publication or retrieval date may be used to provide evidence of regarding the "state of the art."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that undated Internet publications are prior art, MPEP § 2128.02 clearly states that undated Internet publications may be used to provide **evidence** of the state of the art. Petitioner improperly equates the terms "prior art" and "evidence regarding state of the art." Prior art must be prior to the date of the invention. 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.

Morning question 48 reads as follows:

48. A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

The model answer is selection (A).

Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application “may be converted to a provisional application and be accorded the original filing date of the” nonprovisional patent application. MPEP § 601.01(c). (B), (C), and (D) are wrong because they recite dates other than the original filing date of the nonprovisional patent application. (E) is wrong because (A) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that the provisional application would expire on June 3, 2000, and that converting the nonprovisional to provisional would accomplish nothing but the abandonment of the application.

Petitioner's arguments have been fully considered but are not persuasive. Regardless of whether the conversion resulted in abandonment, the question asked which of the answers were true. As stated above, under 37 C.F.R. § 1.53(c)(2) when a nonprovisional application is converted to a provisional application, the provisional application is accorded the original filing date of the nonprovisional. Thus, it is true that “[t]he provisional application is entitled to a filing date of June 3, 1999.” In fact, Petitioner admits this in his argument. 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.

Please answer questions 10 and 11 based on the following information.

A patent issued to Joe Inventor on July 25, 2000 based on an application filed in January 1999. Larry Practitioner was the registered practitioner of record in the application, and all correspondence from the USPTO during prosecution was directed to Larry at his then-current address. At the time he paid the issue fee, Larry designated a "fee address" for payment of maintenance fees. Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Larry did not, however, file a change of correspondence address in the patent file. An assignment of all rights in the patent from Joe Inventor to Big Corporation was made September 5, 2000 and was recorded in the USPTO on September 14, 2000.

Afternoon question 11 reads as follows:

11. Under standard USPTO practice and procedure, where will the USPTO send a communication for Big Corporation concerning a request for reexamination involving the patent?

- (A) Joe Inventor's address as indicated on the inventor's declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry's address prior to September 2000.
- (C) Larry's address subsequent to September 1, 2000.
- (D) The fee address designated by Larry at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

The model answer is selection (C).

See, e.g., 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

Petitioner argues that answer (B) is correct. Petitioner contends that since a correspondence address had been designated, correspondence regarding the reexamination would have gone to that address according to 37 C.F.R. § 1.33.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that reexamination correspondence be sent to the correspondence address, 37 CFR 1.33(c) states that "[a]ll . . . communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record . . . in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to 10.5 and 10.11." As the question stated, Larry changed his address in accordance with 10.11. Thus, Larry's address subsequent to September 1, 2000 would receive correspondence concerning the reexamination according to 37 CFR 1.33(c). 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.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

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

This is a final agency action.



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