

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

JUL 23 1999

) Decision on
) Petition for Regrade
) Under 37 C.F.R. § 10.7(c)

In re _____)

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 3, 5, 9, 13, 22, 35 and 45 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

BACKGROUND

An Applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 62 on the afternoon section. On December 28, 1998, Petitioner requested regrading of seven two-point questions on the afternoon section, 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, all regrade requests have been considered in the first instance by the Commissioner.

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 Registration Examination Directions include the following statements:

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,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner’s arguments have been considered.

Question 3:

Two points are awarded for question 3.

Question 5:

Two points are awarded for question 5.

Question 9 reads as follows:

9. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case.

Claim 1 reads as follows:

1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

The most correct answer is choice (E) because none of choices (A) – (D) would accord with proper PTO practice and procedure. Choice (A) is defective because it is misdirected to “a copper base alloy” while the claim it depends upon is directed to “a ship propeller.” Choice (B) is defective for two reasons. First, it purports to add a process step to a product claim. A claim directed to more than one statutory class of invention violates 35 U.S.C. § 112, second paragraph. Second, choice (B) purports to add aluminum to the copper base alloy of Claim 1. This is impermissible because Claim 1

recites “copper base alloy consisting of” (Emphasis added). The transitional phrase “consisting of” excludes any element, step or ingredient not specified in Claim 1.

See MPEP § 2111.03 (“A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.”). Choice (C) is wrong because it purports to add “2 to 10 percent aluminum” to the propeller of Claim 1. Since the specification teaches the addition of aluminum to the copper base alloy, not to the propeller, choice (C) introduces new matter. Thus, choice (C) is subject to rejection under 35 U.S.C. § 112, first paragraph. See MPEP § 608.04. Choice (D) is wrong because it purports to include “2 to 10 percent aluminum” in the alloy in Claim 1.

However, the alloy in Claim 1 is defined by the term “consisting of.” The transitional phrase “consisting of” excludes any element, step or ingredient not specified in Claim 1.

The most correct answer is choice (E) and Petitioner selected choice (D).

According to Petitioner, “[t]he claimed ship propeller in question 9 consists *essentially of* the recited alloy.” Petitioner maintains that “[t]herefore, other materials that do not materially affect the basic and novel characteristics of the claimed invention may be recited in dependent claims.”

Petitioner’s arguments are not persuasive. Petitioner’s focus on adding elements to the ship propeller is misplaced because choice (D) purports to add an element to “said alloy.” While the phrase “consisting essentially of” limits the ship propeller, it is not the pertinent limitation on the alloy. Instead, the alloy is limited by the phrase “consisting of.” Choice (D) fails to observe the “consisting of” limitation in the clause directed to the alloy. See Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc., 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986) (the phrase “consisting of” appearing in a clause

limits the element set forth in the clause); see also, MPEP 2111.03 (“When the phrase ‘consists of’ appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole”). The transitional phrase “consisting of” excludes any element, step or ingredient not specified in the alloy of Claim 1. Thus, aluminum is excluded from the alloy. No error in grading has been shown. Petitioner’s request for credit on Question 9 is denied.

Question 13 reads as follows:

13. A’s patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure on the specification of a minimum amount of storage for the random access memory. In the preferred embodiment the microprocessor has a clock speed of 100-200 megahertz. The application originally included the following Claims 11 and 12 (among others), and Claim 13 was added by amendment after an office action:

11. A personal computer comprising a microprocessor and a random access memory including at least ½ gigabyte of storage.

12. The personal computer of Claim 11, in which the microprocessor has a clock speed of 170-200 megahertz.

13. The personal computer of Claim 12, in which the random access memory is greater than 1 gigabyte of storage.

Which of the following statements is or are true about the claims with respect to 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 11 is a proper independent claim.
- (B) Claim 12 is a proper dependent claim.
- (C) Claim 13 is a proper dependent claim.
- (D) Claim 13 is an improper dependent claim.
- (E) (A), (B), and (C).

The most correct answer is choice (E) because choices (A), (B), and (C) are true with respect to 35 U.S.C. § 112, fourth paragraph. Section 112, fourth paragraph,

requires that “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” Choice (A) is true because independent Claim 11 is part of the original disclosure as an original claim. Choice (B) is true because Claim 12 refers to and further restricts the scope of the preceding Claim 11. Choice (C) is true because Claim 13 refers to and further restricts the scope of the preceding Claim 12. Choice (D) is not true because, as noted above, Claim 13 is a proper dependent claim with respect to Section 112, fourth paragraph.

Petitioner contends that “the issue in this question is whether claim 13 is a proper dependent claim.” According to Petitioner, choice (D) is the most correct answer “[b]ecause the amount of gigabyte storage was nowhere disclosed within the specification.” As such, Petitioner maintains that “claim 13 is properly rejected for violating the written description requirement under 35 U.S.C. § 112.”

Petitioner’s arguments are not persuasive. The question is directed to which statement is true about the claims with respect to 35 U.S.C. § 112, fourth paragraph. (Emphasis in original.) Section 112, fourth paragraph requires that “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” Claim 13 complies with this particular requirement. Petitioner’s argument concerning the written description requirement is not pertinent to the question asked because the written description requirement is a first paragraph issue, not a fourth paragraph issue, under 35 U.S.C. § 112. No error in grading has been shown. Petitioner’s request for credit on Question 13 is denied.

Question 22 reads as follows:

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.
- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.
- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because each of claims (A) – (C) is in proper format.

The correct answer is choice (E) and Petitioner selected choice (D). Petitioner contends that claims (A) and (B) are not in proper format because they both “recite the device as fitting completely within conventional outdoor barbecue grills.” According to Petitioner, “this limitation is indefinite because the size of a conventional outdoor barbecue grill is nowhere defined.” Petitioner maintains that “Claim C is distinguished from (A) and (B) because there is no mention of the ‘conventional’ outdoor barbecue grill.”

Petitioner’s arguments are not persuasive. The question is directed to which of the claims are **not** in proper format. The correct answer is choice (E) because all of the

claims in choices (A), (B) and (C) are in proper format. Contrary to Petitioner's position, claims (A) and (B) are not indefinite because the size of a "conventional outdoor barbecue" is "nowhere defined." No error in grading has been shown. Petitioner's request for credit on Question 22 is denied.

Question 35 reads as follows:

35. Given the following information regarding three claims:

- (i) A claim refers to "said lever" where the claim contains no earlier recitation or limitation of a lever;
- (ii) A claim initially refers to "an aluminum lever," and "a plastic lever" and thereafter refers to "said lever"; and
- (iii) A claim initially refers to a "controlled stream of fluid" and thereafter refers to "the controlled fluid,"

which of the following statements is correct?

- (A) The claims (i), (ii) and (iii) are all definite.
- (B) The claims (i) and (ii) are definite; and the claim in (iii) is indefinite.
- (C) The claim (i) is indefinite; and the claims in (ii) and (iii) are definite.
- (D) The claims (i) and (ii) are indefinite; and the claim in (iii) is definite.
- (E) The claims in (i), (ii) and (iii) are all indefinite.

The most correct answer is choice (D) because the scope of (iii) is reasonably ascertainable by those skilled in the art, but neither (i) or (ii) provides clear antecedent basis for "said lever." *See Ex parte Porter*, 25 USPQ2d 1144, 1145 (BPAI 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). The question was constructed using the three examples discussed in MPEP § 2173.05(e) "Lack of Antecedent Basis" for statements (i), (ii) and (iii).

The most correct answer is choice (D) and Petitioner selected choice (E). Petitioner contends that choice "(E) should be recognized as the most correct answer"

because (iii) is indefinite. According to Petitioner, “[t]he claim initially recites a ‘controlled stream of fluid’ and later refers to ‘the controlled fluid.’” Petitioner maintains that “a properly drafted claim would later refer to ‘the controlled stream of fluid’ or ‘the controlled stream.’” Petitioner argues that (iii) is indefinite “[b]ecause no antecedent basis lies within the claim to support ‘the controlled fluid.’”

Petitioner’s arguments are not persuasive. As provided in MPEP § 2173.05(e), “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” (Citation to *Porter* omitted.) Contrary to Petitioner’s position, claim (iii) is definite since it is reasonably ascertainable that the “the controlled fluid” is referring back to the earlier claimed “controlled stream of fluid.” No error in grading has been shown. Petitioner’s request for credit on Question 35 is denied.

Question 45 reads as follows:

45. Presented below are five separate portions of five different claims. Assuming that there are no issues of support or lack of antecedent basis, which portion does not contain a means-or-step-plus function which invokes the sixth paragraph of 35 U.S.C. § 112?

- (A) 1. In a pressure responsive instrument having a pressure responsive chamber including a wall portion movable in reply to change in fluid pressure thereon, the improvement comprising a plate means and a leaf spring; wing means on said plate means
- (B) 1. A process for recovering molybdenum values in usable form from ferruginous, molybdenum - bearing slags comprising raising the pH of the resulting pulp to about 5.0 to precipitate dissolved molybdenum trihydroxide
- (C) 1. A boring device for deep boring an object rotating about an axis, comprising . . force generating means adapted to provide a force acting on the cutting head to cause radial displacement of said cutting head
- (D) 1. In an aircraft having a bladed rotor adapted under at least one translational flight condition to provide both lift and propulsive

thrust, a jet driving device so constructed and located on the rotor as to drive the rotor

- (E) 1. An air filter assembly for filtering air laden with particulate matter, said assembly comprising . . . said portion having means, responsive to pressure increases in said chamber caused by said cleaning means, for moving particulate matter in a downward direction

The most correct answer is choice (A) because the terms “plate” and “wing,” modifying the structureless term “means,” specify no function to be performed. Whatever functions are to be performed by the “plate means” and “wing means” of the instant claim, they have not been specified in the claim, as is required by 35 U.S.C. § 112, sixth paragraph. *See York Products Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996) (“Without an identified function, the term ‘means’ in this claim cannot invoke 35 U.S.C. § 112, paragraph 6.”); *Ex parte Klumb*, 159 USPQ 694, 695 (Bd. App. 1967) (section 112 sanctions claim only where such structureless terms as “plate means” and “wing means” specify a function). *See also* MPEP § 2181 entitled “Identifying a 35 U.S.C. § 112, Sixth Paragraph Limitation.” Thus, choice (A) does not invoke 35 U.S.C. § 112, sixth paragraph.

Petitioner contends that choice (B) does not invoke the sixth paragraph of 35 U.S.C. § 112. According to Petitioner the case cited in the Model Answer, *Ex parte Zimmerley*, “has only limited pertinence to 35 U.S.C. § 112, sixth paragraph.” Petitioner maintains that “[h]ad this case been applicable to 35 U.S.C. § 112, sixth paragraph, the alkali would have been limited to *those disclosed within the specification and equivalents [sic] thereof.*” (Emphasis in original.) Petitioner argues that binding case law supports his contention that choice (B) does not invoke section 112, sixth paragraph. Relying on *O.I. Corp. v. Tekmar Co. Inc.*, 115 F.3d 1576 (Fed. Cir. 1997) Petitioner contends that “a

method claim similar to that in answer (B) was adjudicated” and that “[t]he court found that § 112, P 6 is implicated only when steps plus function without acts are present.”

Petitioner’s arguments are not persuasive. The step of “raising the pH of the resulting pulp to about 5.0 to precipitate” set forth in choice (B) is identical to the step of “raising the pH of the resultant pulp to about 5.0 to precipitate” that was determined to be functional in *Ex parte Zimmerley*, 153 USPQ 367 (Bd. App. 1966). Petitioner’s concern with the scope of “alkali” is misplaced because, according to the Board, the issue was whether “the claims should recite a specific way of raising the pH.” *Zimmerley*, 153 USPQ at 369. The Board specifically determined the language to be proper under 35 U.S.C. § 112, third (now sixth) paragraph. This precise language is identified as Example (F) in the MPEP under the heading “Language Falling Within 35 U.S.C. § 112, Sixth Paragraph.” See MPEP § 2181, entitled “Identifying a 35 U.S.C. § 112, Sixth Paragraph Limitation; see also *Caterpillar Inc. v. Detroit Diesel Corp.*, 961 F.Supp. 1249, 1255, 41 USPQ2d 1876, 1882 (N.D. Ind. 1996) (section 112, sixth paragraph, “applies to functional methods claims where the element at issue sets forth a step for reaching a particular result, but not the specific technique or procedure used to achieve the result.”). Petitioner’s reliance on *O.I. Corp. v. Tekmar Co. Inc.* is misplaced. Nothing in that case conflicts with or overrules the Board’s determination in *Zimmerley*. No error in grading has been shown. Petitioner’s request for credit on Question 45 is denied.

Request For Points Based On Petitioner’s Overall Performance:

Petitioner contends that “[w]hen adding my morning and afternoon scores together [from the August 1998 examination], my total will lie between 160 and 174, depending on the regrade.” Petitioner submits “that my performance, well above the prescribed 140, is

sufficient to warrant my admission to the patent bar.” However, as set forth in the Examination Directions, “YOU MUST SCORE AT LEAST 70 POINTS TO PASS THIS SECTION OF THE REGISTRATION EXAMINATION.” (Emphasis in original). Thus, the Morning and Afternoon Section grades were not cumulative.

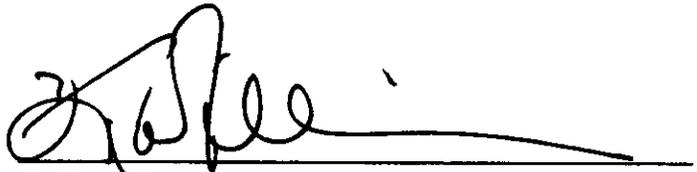
Petitioner’s argument for a passing score is based in part on a further misunderstanding concerning the Morning Section result. Petitioner received a score of 62 on the Afternoon Section and passed the Morning Section. Petitioner was informed that he had passed the morning section of the Registration Examination by the notation “Passed 98.” Although Petitioner interprets that notation to mean his score on the Morning Section was 98, the “98” designation was the particular year of the Morning Section of the Examination was passed, and not the score Petitioner received. The PTO has a policy of not giving a numerical score if an individual passes a section of the examination.

ORDER

For the reasons given above, four points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 66. This score is insufficient to pass the Afternoon Section of the Examination.

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

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Q. Todd Dickinson', written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks