

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

JUL 23 1999

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

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 5, 16, 22 and 37 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 64 on the afternoon section. On December 29, 1998, Petitioner requested regrading of four 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 directions to the afternoon section 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,” “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 5:

Two points are awarded for question 5.

Question 16 reads as follows:

16. An original claim in a patent application to a mechanical arts invention recites the limitation of “a screw” which is shown in an original application drawing. However, “a screw” does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include “a screw.”
- (B) The claim is indefinite with respect to “a screw.”
- (C) The application lacks an enabling disclosure as to “a screw.”
- (D) The claim is definite with respect to “a screw.”
- (E) The application fails to set forth the best mode for “a screw.”

Choice (D) is correct because MPEP § 2173.05(e) indicates that as long as a claim phrase has a reasonable degree of clarity, such as reciting something well known in the mechanical arts, e.g., “a screw,” the claim phrase is definite despite the lack of antecedent basis in the written description. Choice (B) is not correct because MPEP § 2173.05(e) shows that a claim phrase, which has no antecedent basis in the written description, is not necessarily indefinite because it may have a reasonable degree of clarity to those skilled in the art.

Petitioner argues that either of choices (B) and (D) should be given credit because “either answer choice is reasonable as to whether ‘a screw’ is so well known to be definite despite the lack of antecedent basis.” In the alternative, Petitioner argues that the entire question should be deleted. Petitioner disagrees that “a screw” is so well known in the mechanical arts because “I for one have no idea of what ‘may’ or ‘may not’ have a reasonable degree of clarity to those skilled in the mechanical arts since I am not skilled in that art since my personal background is in electronics and not the mechanical arts.” Petitioner maintains that “either answer B or C are the most correct answers” because more information is needed “as to what someone skilled in the art would know or not know.”

Petitioner’s arguments are not persuasive. MPEP § 2173.05(e) states that “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.” The facts show that while the limitation “a screw” lacks antecedent basis in the words of the description, the limitation is provided with antecedent basis in an original application drawing. While no words provide explicit antecedent basis, the claim is supported by the disclosure of the screw in the original drawing. Thus, the scope of a claim reciting “a screw” would be reasonably ascertainable by those skilled in the mechanical arts and does not render the claim indefinite. Petitioner’s personal knowledge of the art is not relevant to the issue because the standard is the knowledge of “those skilled in the art.” MPEP § 2173.05(e). Petitioner has also argued for crediting choice (C), lack of an enabling disclosure. However, Petitioner has not provided any reasoning to show that the disclosure of a screw in the drawing is insufficient to inform one skilled in the art how to make and/or use the invention having the limitation “a screw.” No error in grading has been shown. Petitioner’s request for credit on question 16 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 the claims in choices (A) – (C) are in proper format.

Petitioner selected choice (C). Petitioner contends that “[t]his question is vague and ambiguous because more than one answer is correct – and either answer could be the ‘most correct answer.’” Petitioner contends that “none of the answers are very good” and choice (C) “is the most correct definite answer.” According to Petitioner, choices (A) and (B) are indefinite because they recite “within conventional covered outdoor barbecue grills.” Petitioner asks “[w]hat is this and what size is it?” In Petitioner’s view, “it would seem that it is indefinite and over the term of the patent it would change rendering the claim even more indefinite.”

Petitioner’s arguments are not persuasive. Petitioner’s contention that choices (A) and (B) are indefinite is not germane because the question concerns “proper format.” Petitioner’s argument that choice (C) is most correct is not responsive to the call of the question concerning which claim is not proper. Rather than identifying any format defect in choice (C), Petitioner urges the propriety of the claim in choice (C). Petitioner’s argument that the claims in choices (A) and (B) are indefinite lacks foundation. Merely raising a question about the meaning of a claim limitation does not establish indefiniteness. To establish that a claim is indefinite, it is necessary to establish that the

claims do not reasonably apprise those skilled in the art both of the utilization and scope of the invention. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). Petitioner's mere observation, "it would seem that it is indefinite," fails to establish by evidence or reasoning that one of skill in the art cannot reasonably ascertain the meaning. This argument is also not germane to the "proper format" call of the question. Petitioner's argument appears to suggest that the choice (D), including "(A) and (B)," should be the answer, rather than choice (C) selected by Petitioner. However, choice (D) is not correct because choices (A) and (B) are in proper format. No error in grading has been shown. Petitioner's request for credit on question 22 is denied.

Question 37 reads as follows:

37. Which of the following expressions, when found in a claim, comply with the provisions of the second paragraph of 35 U.S.C. § 112?

- (A) containing A, B, and optionally C
- (B) material such as rock, wool or asbestos
- (C) lighter hydrocarbons, such, for example, as the vapors or gas produced
- (D) normal operating conditions such as while in the container of a proportioner
- (E) such material as wood and the like

The most correct answer is choice (A) and Petitioner selected choice (B). The word "optionally" may be used when there is no ambiguity as to which alternatives are covered by the claim. See MPEP § 2173.05(h)III. Each of choices (B), (C), (D) and (E) are prima facie indefinite because they set forth a broad term but mention a narrower range with the exemplary language "such as," "such, for example, as" or "such . . . as."

The stated examples and preferences lead to confusion over the intended scope of the claim. It is not clear if the narrower range is a limitation of the broader term.

See MPEP § 2173.05(d). Accordingly, choices (B), (C), (D) and (E) fail to comply with 35 U.S.C. § 112, second paragraph.

Petitioner contends that “my answer choice B is as good as A, C, D or E since they are all wrong.” Petitioner argues that if analysis of choice (A) is required under MPEP § 2173.05 “one can conclude that this answer like all the others is indefinite.” Petitioner points out that the answer choices contain ellipses, unlike the examples in the MPEP. According to Petitioner, “I don’t know what ‘. . .’ means, certainly this choice has more to it than what the MPEP infers is okay.” Petitioner argues that this is a “poor question and it is testing which expression is the least offensive of the group.” Petitioner maintains that “[f]or a test question to be fair, the answers should be black and white,” and objects that “this question is definitely in the gray area.”

Petitioner’s arguments are not persuasive. For the reasons stated above, choice (A) is the correct answer. A need for some analysis does not justify Petitioner’s conclusion that a claim requiring any analysis must be indefinite. As explained above, the correct answer is reached by reasoning with the prima facie information given. Petitioner’s desire to know the omitted material represented by ellipses is misplaced. The “. . .” in the answer choices indicates the omission of irrelevant words and does not imply any pertinent meaning. No assumptions regarding the ellipses are needed to answer the question and the examination instructions state that additional facts should not be assumed. Petitioner’s argument that fairness demands only “black and white” issues be tested is wrong. The ability to assess “shade[s] of gray” is a necessary skill for patent

practitioners, particularly in claim construction as tested here. No error in grading has been shown. Petitioner's request for credit on question 37 is denied.

Examination Conditions:

Petitioner contends that "[t]he Petitioners for the afternoon exam offered in Los Angeles were subject to the equivalent of psychological torture for two and one half hours before the exam was finally administered." According to Petitioner, "[t]he PTO should change the minimum passing level for the Petitioners of the Los Angeles exam to 60 points or pass all people who complained that the events effected [sic] them, based on this I should be awarded a passing grade."

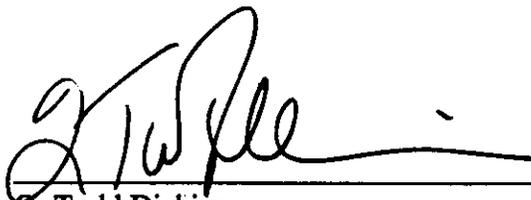
The nature of the Los Angeles testing conditions have been duly noted. The Office of Personnel Management is taking steps to address the situation and to ensure that the situation is not repeated. Pursuant to 37 CFR § 10.7(c), "[a]ny Petitioner requesting regrade shall particularly point out the errors which the Petitioner believed occurred in the grading of his or her examination." The testing conditions do not provide any basis for awarding Petitioner a passing score.

ORDER

For the reasons given above, two 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