UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

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| In re | ) | Decision on Petition for Review Under 37 C.F.R. § 10.2(c) |

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) dated July 30, 1996, denying Petitioner's request for a higher score on the morning and afternoon sections of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on May 3, 1995 (1995 Examination). The petition is denied-in-part and dismissed-in-part.

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 examination. Petitioner originally received a score of 60 on the morning section of the 1995 Examination and a score of 56 on the afternoon section of the 1995 Examination.

As indicated in a Notice to Petitioner dated September 27, 1995, two points were added to Petitioner's score on the morning section because of an error in programming the answer key. Thus,

the original score on the morning section was raised from 60 to 62.

On October 4, 1995, Petitioner sent a Request for Regrading of questions 1, 15-18, 21, 22, 38, and 46 from the morning section of the 1995 Examination and questions 1-4 from the afternoon section of the 1995 Examination. A decision from OED was mailed to Petitioner on December 12, 1995. This decision did not add any points to Petitioner's score for the morning section, but the score for the afternoon section was changed from 56 to 64.

By petition to the Director of OED dated December 21, 1995, Petitioner requested reconsideration of the December 12, 1995 decision. In a decision mailed July 30, 1996, the Director determined that no additional points should be awarded to Petitioner's score for the morning section, which remained at 62. The Director determined that Petitioner's score for the afternoon section should be raised from 64 to 66.

By petition received August 4, 1996, Petitioner requests that the Commissioner reverse the Director's denial of credit for questions 1, 15-18, 22, 38, and 46 from the morning section of the 1995 Examination. Petitioner also took exception to certain points made in the July 30, 1996, decision with regard to Petitioner's score on the afternoon section of the 1995 Examination.

On August 28, 1996, Petitioner once again sat for the Examination to practice in Patent Cases Before the U.S. Patent and Trademark Office (1996 Examination). Petitioner successfully passed the afternoon section of the 1996 Examination.

## Opinion

### 1. Morning Section

Pursuant to 37 C.F.R. § 10.7(c), Petitioner must particularly point out any errors that occurred in the grading of the 1995 Examination. The directions to the morning section state: "No points will be awarded for incorrect answers or unanswered questions." The burden is upon the Petitioner to show that his chosen answer is the most correct answer. Petitioner has failed to meet this burden.

Furthermore, Petitioner's arguments are replete with assumptions that are not supported by the facts presented in the questions. The directions to the morning section state:

> 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 agent. The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with U.S. patent statutes, the PTO rules of practice or 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.

For the following reasons, no points will be added to Petitioner's score for the morning section of the 1995 Examination.

**QUESTION 1**

Question 1 reads as follows:

1. You represented Hale before the PTO in conjunction with a patent application filed January 8, 1992, which issued May 4, 1993. That application had a divisional patent application filed December 22, 1992, which issued July 27, 1993. Both applications (parent and divisional) were based upon a foreign application filed December 23, 1991, in France. In the parent application, a claim for benefit of foreign priority was made and the requirements of 35 U.S.C. 119 were met before issuance of the patent. However, a claim for benefit of foreign priority was not made in the divisional application prior to its issuance as a patent. What, if any, is the *most appropriate procedure* for perfecting this benefit of foreign priority after the divisional has issued as a patent?

(A) File a substitute patent application.

(B) File a petition and proper fee to have the benefit of foreign priority of the parent application entered in the record of the divisional application.

(C) The omission of the benefit of foreign priority may not be corrected in any manner.

(D) File a request for Certificate of Correction and Fee.

(E) File a request and proper fee for reexamination of the divisional application.

In the model answer, choice (D) is identified as the correct answer on the basis of 35 U.S.C. § 255; 37 C.F.R. § 1.323; and MPEP § 201.16[1]. Petitioner chose choice (C).

A certificate of correction may be used to correct clerical, typographical or minor errors in a patent, which are not the

[1] All references to the MPEP are addressed to the Original Sixth Edition of the MPEP, dated January 1995.

fault of the PTO. 35 U.S.C. § 255. The omission of a claim for priority under 35 U.S.C. § 119 in a continuing application, where the parent application included the claim for priority, is such an error. Cf. In re Van Esdonk, 187 USPQ 671 (Comm. Pat. 1975) (holding that the omission of a claim for priority in a continuation application can be corrected with a certificate of correction where the parent application made the claim for priority). See also MPEP § 201.16 (stating that the holding of Van Esdonk is applicable to all applications having benefits under 35 U.S.C. § 120). Therefore, choice (D) is correct.

Petitioner argues that choice (C) is correct. Choice (C) states that there is no manner to correct the omission of a claim for foreign priority. However, as noted above, the claim for priority may be added via a certificate of correction. Therefore, choice (C) is incorrect.

Petitioner also argues that Van Esdonk refers to a continuation application, not a divisional application. Both continuation and divisional applications are "continuing" applications entitled to the benefits of 35 U.S.C. § 120. 37 C.F.R. § 1.53(b)(1). Therefore, a certificate of correction may be used to add a claim for foreign priority in the present situation.

Petitioner further argues that the relative timing of the perfecting of the foreign priority in the parent and the filing

of the divisional are unknown. Van Esdonk holds only that a certificate of correction may be used to add a claim for priority under 35 U.S.C. § 119 in a continuing application, where the claim for priority was perfected in the parent application. It does not state that the claim for priority must be perfected in the parent application prior to filing the continuing application.

Petitioner's request for credit on question 1 is denied.

**QUESTION 15**

Question 15 read as follows:

15. Jones received a Notice of Allowance and Issue Fee Due on January 4, 1994, for a traffic warning sign that may be placed on the surface of a roadway to warn passing motorists of the presence of a disabled vehicle ahead. Sadly, however, on the day Jones received the Notice, a motor vehicle accident left Jones in a coma for many months and in the hospital until April 4, 1995. In the pile of doctor and hospital bills in his home, Jones found a Notice of Abandonment for failure to pay the issue fee. The notice was dated April 18, 1994. Jones, in a panic at the thought of losing his patent, has sought you out today to act on his behalf before the office to save his patent. Which of the following would be the most appropriate response for you to make on Jones behalf?

    (A) File a petition to the Commissioner to accept a late fee accompanied by the proper petition fee, late payment fee, and issue fee. Also, include a verified statement that the delay was unintentional and a description of the circumstances surrounding the abandonment to make the record clear.

    (B) File a petition to the Commissioner to waive the statutory requirement for paying the application issue fee, and a verified showing that the delay was unavoidable.

(C) File an affidavit or declaration explaining the circumstances regarding why the payment of the issue fee was late, together with a terminal disclaimer and the issue and late payment fees.

(D) File a new application because a petition to revive his application and to accept unintentionally late payment of the issue fee must be filed within one year of the date of the Notice of Allowance and Issue Fee Due.

(E) File a petition to the Commissioner to revive his application accompanied by the proper issue fee, late payment fee and petition fee. Also, include a verified statement showing that the delay was unavoidable and a terminal disclaimer and fee to cover the period of abandonment.

In the model answer, choice (E) was identified as the correct answer.

When an application is abandoned for failure to pay the issue fee, the Commissioner may accept the issue fee under the provisions of 37 C.F.R. § 1.316(b) and (c). See MPEP § 203.07.

When the delay in payment is unavoidable, the Commissioner may accept late payment of the issue fee upon the submission of a petition including: (1) the issue fee, if not already paid, (2) the fee for late payment under 37 C.F.R. § 1.17(l), and (3) a showing that the delay was unavoidable. 37 C.F.R. § 1.316(c). In addition, a terminal disclaimer is required dedicating the term of abandonment to the public. 37 C.F.R. § 1.316(d).

When the delay in payment is unintentional, the Commissioner may accept late payment of the issue fee upon the submission of a petition including: (1) the issue fee, if not already paid, (2) the fee for unintentionally delayed payment under

37 C.F.R. § 1.17(m) and 3) a statement that the delay was unintentional. 37 C.F.R. § 1.316(c). In addition, the petition must be filed either: (1) within one year of the date on which the application became abandoned or (2) within three months of the date of a first decision of a petition for acceptance of a late payment of a fee, where the delay was unavoidable under section 1.316(b). 37 C.F.R. § 1.316(c)(4).

Petitioner has failed to show that choice (A) is more correct than choice (E). The facts provide that the Notice of Issue Fee Due was dated January 4, 1994. Therefore, the date of abandonment was April 4, 1994. See 37 C.F.R. § 1.316(a). No petition under 37 C.F.R. § 1.316(b) was filed. Therefore, choice (A) is clearly incorrect, as more than a year has elapsed since the date of abandonment. See 37 C.F.R. § 1.316(c)(4).

Petitioner's argument that choice (E) is missing the requirement of 37 C.F.R. § 1.137(a)(1) of a proposed response to continue prosecution is not convincing. Section 1.137(a) deals with abandonment for failure to prosecute. The facts state that the application was abandoned for failure to pay the issue fee, which is governed by 37 C.F.R. § 1.316. Therefore, 37 C.F.R. § 1.137(a) does not apply. Choice (E) is clearly more correct than choice (A).

Petitioner also argues that precedent indicates that a car accident is "unintentional" and not "unavoidable." Petitioner has not cited any precedent. Petitioner bears the burden of

showing that his answer is correct. Hence, Petitioner has not carried his burden.

Petitioner's request for credit on question 15 is denied.

**QUESTION 16**

Question 16 read as follows:

16. Which one of the following statements is *false* regarding practice before the PTO?

    (A) A computer program listing which is less than 10 printed pages may be submitted as drawings in a patent application.

    (B) A preliminary amendment to the specification filed after the filing date of the application, but before the first Office action, becomes part of the original disclosure of the application.

    (C) A personal interview after a final Office action is permissible provided the examiner is advised of the intended purpose and content of the interview, either orally or in writing, prior to the interview.

    (D) After a non-final second action where the claims were twice rejected, an appeal may be taken to the Board of Patent Appeals and Interferences.

    (E) A request for reexamination of a patent can be made anonymously through an attorney.

In the model answer, choice (B) was identified as the best answer, citing MPEP § 714.09. Petitioner chose choice (C).

An amendment filed after the filing date cannot add new matter to the disclosure. 35 U.S.C. § 132; 37 C.F.R. §§ 1.53(b), 1.118. Therefore, any matter added by amendment after the filing date is not entitled to the original filing date and is not part of the original disclosure. See MPEP § 714.09 (stating that an

amendment, filed before the first action, but not filed along with the original application, is not part of the original disclosure). Therefore, as admitted by Petitioner, choice (B) is clearly a false statement.

Petitioner asserts that choice (C) is also an false statement, citing MPEP § 713.09. In order for an interview after a final Office action to be proper the examiner must be: 1) advised, orally or in writing, of the purpose and content of the interview, and 2) be convinced that disposal or clarification of the issue for appeal may be accomplished with only nominal further consideration. MPEP § 713.09. Petitioner argues that choice (C) only states the first requirement. Therefore, according to Petitioner, it is "clearly false to state that an interview may be granted based solely on the request itself, when the MPEP states that an interview may be granted based on the examiner's evaluation of the substance of the request and the extent of reconsideration required to disposition [sic] the request." Petition at page 2.

Choice (C) states that an interview is permissible when the listed conditions are met. The term permissible is defined as: "that [which] may be permitted: allowable; admissible." Webster's Third New International Dictionary Of The English Language Unabridged 1683 (1993). Choice (C), therefore, does not state that an examiner must grant an interview when the examiner is advised of the intended purpose and content of the interview,

but rather that the examiner may grant an interview when advised of the intended purpose and content of the interview. As such, choice (C) is clearly in accordance with MPEP § 713.09, and is a true statement.

Petitioner's request for credit on question 16 is denied.

**QUESTION 17**

Question 17 read as follows:

17. X and Y are joint inventors of the subject matter claimed in an application pending before the PTO. However, only X through error and without deceptive intent of the part of X and Y, was named as the sole inventor at the time the application was filed. Assuming payment of any fees involved, can the inventorship be corrected and if so, how?

    (A) No, because an inventorship error of this type cannot be corrected.

    (B) Yes by filing an amendment naming Y as a joint inventor and a new oath signed by both X and Y.

    (C) Yes, by filing a request for certificate of correction.

    (D) Yes, by filing a continuing application with a declaration signed by both X and Y.

    (E) Yes, by filing a reissue application with an oath naming both X and Y as the inventors along with a new oath signed by X and Y setting forth how the error arose without deceptive intent.

In the model answer, choice (D) is identified as the correct answer, citing 35 U.S.C. § 116, 37 C.F.R. §§ 1.48(a) and 1.324, and MPEP §§ 201.03, 1402, and 1481.

When, through error and without deceptive intent, a person is not named as an inventor in an application, the application

may be amended to include that person as an inventor, under such terms as provided by the Commissioner. 35 U.S.C. § 116. If at least one of the correct inventors has been named in an application, but it is discovered that correction of inventorship is necessary, applicant may correct the inventorship by abandoning the application and filing a continuing application under 37 C.F.R. § 1.53, naming the correct inventive entity. MPEP § 201.03. Thus, a person may correct inventorship by filing a "continuation" application. Therefore, choice (D) is the correct answer.

Petitioner selected choice (B).

Inventorship may also be changed by filing an amendment accompanied by a petition, according to 37 C.F.R. § 1.48(a) (entitled "Correction of Inventorship"), which states:

> If the correct inventor or inventors are not named in a application for patent through error without any deceptive intentions on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must diligently be made and <u>must be accompanied by</u>:
>
> (1) <u>A petition including a statement of facts verified by the original inventor or inventors establishing when the error without deceptive intention was discovered</u>
>
> (2) An oath or declaration by each actual inventor or inventors as required by § 1.63
>
> (3) The fee set forth in § 1.17

(Emphasis added). Therefore, choice (B) is incorrect since it does not include the filing of a petition along with the amendment as required by 37 C.F.R. § 1.48(a).

Petitioner contends that choice (D) fails to indicate that the prior application is abandoned. An application will become abandoned if no action is taken with respect thereto. See 37 C.F.R. § 1.135(a) ("If an applicant of a patent application takes no action within the time period provided under §§ 1.134 and 1.136, the application will become abandoned . . . ."). Moreover, since abandonment has no effect on change of inventorship, whereas a petition is required to change inventorship by amendment, choice (D) is more correct than choice (B).

Finally, Petitioner argues that choice (D) is missing 1 of 2 requirements advised by the MPEP while choice (B) is missing 1 of 3 requirements of the C.F.R. and, therefore, choice (B) is more correct than choice (D). As noted above, under choice (D), the original application will go abandoned by inaction, providing the "missing" requirement.

Petitioner's request for credit on question 17 is denied.

**QUESTION 18**

Question 18 read as follows:

> 18. On April 14, 1995, you filed a patent application in the PTO together with a check to cover the filing fees. However, due to unforeseen circumstances, measures were not taken to cover the amount of your check written

against your bank account. Consequently, you received a notice from the PTO dated April 30, 1995, that your check has been returned for insufficient funds. In order to avoid abandonment of your recently filed application, what steps do you need to take in addition to depositing ample funds in your bank account?

(A) You need only pay the difference in funds for the filing fee, within the period set in the notice.

(B) You must timely open a deposit account, and ask that the remaining portion of the fee due for filing the application be charged against your deposit account.

(C) Make payment to encompass the filing fee including a return check charge in a timely fashion.

(D) Make payment to encompass the filing fee, a returned check charge, and a surcharge fee in a timely fashion.

(E) Do (A) or (B)

The model answer identified choice (D) as correct, citing MPEP § 509.01. Petitioner chose choice (E).

The facts state that the initial check for the filing fee was returned for insufficient funds. Therefore, the filing fee is still due. In addition, 37 C.F.R. § 1.16(e) requires a surcharge for paying the filing fee at a date later than the filing date and 37 C.F.R. § 1.21(m) requires a charge for a returned check. Hence, choice (D) includes all of the fees necessary under the rules and is therefore the correct choice.

Petitioner argues that choice (D) is incorrect in that the model answer refers to MPEP § 509.01, which covers deposit accounts. The citation provided to support the correct answer,

choice (D), in the model answer booklet references MPEP § 509.01. This explains why choice (B) is incorrect.

Petitioner also argues that choice (E) is correct in that the language of choices (A) and (B) are ambiguous enough to cover the fees required by 37 C.F.R. § 1.21(m). Choice (A) however, does not include all of the fees necessary under the rules. In addition, choice (B) does not include a specific request to charge the fee for a returned check under 37 C.F.R. § 1.21(m). See MPEP § 509.01 (stating that fees under 37 C.F.R. §§ 1.19, 1.20, and 1.21 will not be charged as a result of a general authorization under 37 C.F.R. § 1.25).

Petitioner's request for credit on question 18 is denied.

**QUESTION 22**

Question 22 read as follows:

22. Your office is located in close proximity to the PTO. A client comes to you this morning and wants a design patent application filed on a coffee pot. After a brief discussion with your client, you determine that the application must be filed today in order to avoid a statutory bar. Your client hands you several very clear black and white photographs of the pot which show all sides and a good perspective view of the pot. You know that there is no way that ink drawings can be prepared by the end of the day. Can you file a design application today and be accorded a May 3, 1995 filing date?

    (A) No, because a novelty search must be completed before a design application can be filed.

    (B) No, because photographs are not acceptable (other than for plant patents) and ink drawings are required for a complete application.

(C) Yes, by filing a proper specification and claim today, and filing formal drawings and an executed oath at a later date along with the appropriate fee.

(D) Yes, by filing a proper specification and claim today, together with the photographs, petition, and appropriate fee.

(E) Yes, by filing a proper specification and claim today, together with an oath and filing fee, and later submitting the drawings by amendment.

In the model answer, the correct answer was identified as choice (D), citing 37 C.F.R. §§ 1.53(b) and 1.84(b) and MPEP §§ 608.02 and 1503.02. Petitioner selected choice (B).

Photographs are not ordinarily permitted in design or utility applications, but may be accepted upon petition under 37 C.F.R. § 1.84(b). Choice (B), therefore, is clearly incorrect because ink drawings are not required in all instances for design or utility applications.

Choice (D), however, correctly includes all of the necessary procedural steps of 37 C.F.R. § 1.84(b) for getting photographs approved in place of ink drawings. Choice (D) is, therefore, the correct answer.

Petitioner's request for credit on question 22 is denied.

**QUESTION 38**

Question 38 read as follows:

38. Which of the following is not required in a request for reexamination?

(A) A form PTO-1465 (Request for Reexamination Transmittal Form).

(B) A copy of the original patent.

(C) A copy of every patent or printed publication relied upon.

(D) An identification of every claim for which reexamination is requested.

(E) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

In the model answer, the correct answer was identified as choice (A), citing 37 C.F.R. §§ 1.510 and 1.560 and MPEP § 2214. Petitioner chose choice (B).

Form PTO-1465, is helpful to persons filing a reexamination request, but is not required in a request for reexamination. See MPEP § 2214. Therefore, as admitted by Petitioner, choice (A), stating that form PTO-1465 is not required in a reexamination request is a correct choice.

Petitioner asserts that Choice (B) is also a correct choice. Choice (B) provides that a copy of the original patent is not required in a reexamination request. A request for reexamination must include the entire specification (including claims) of the original patent in the form of cut up copies of the original patent with only a single column on each page and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. 37 C.F.R. § 1.510(b)(4). Therefore, a copy of the patent is clearly required. The copy is a modified version of the original publication from the PTO. However, it is still a copy of the original patent, as it has all

of the original subject matter. Hence, a copy of the original patent is required in a reexamination request and, therefore, choice (B) is a wrong answer.

Petitioner argues that a mere copy of the original patent does not meet the requirements of the rule, as the rule requires any disclaimers, certificates of correction, or reexamination certificates. This argument fails, as the fact that more than a copy of the patent may be required does not detract from the fact that a copy is required.

Petitioner's request for credit on question 38 is denied.

**QUESTION 46**

Question 46 read as follows:

46. Inventors A and B originally gave attorney Z a power of attorney to prosecute their application before the PTO. At this time, inventor B has decided that she no longer wants attorney Z to represent her. Instead, inventor B wants you to represent her. Thus, inventor B wants the power of attorney to attorney Z revoked. Inventor A does not agree and wants attorney Z to continue. How, if at all, should the revocation and appointment of a new power of attorney be properly handled.

    (A) Papers revoking the power of attorney/appointing a new power of attorney signed only by inventor A should be accompanied by a petition giving good and sufficient reasons for acceptance should be filed together with an appropriate fee.

    (B) Papers revoking the power of attorney/appointing a new power of attorney cannot be accepted without the concurrence of inventor A.

    (C) Papers revoking the power of attorney/appointing a new power of attorney cannot be accepted without concurrence of attorney Z.

(D) Papers revoking the power of attorney/appointing a new power of attorney need to be signed by inventor B and must include a statement from inventor A indicating that A wishes to retain his current attorney.

(E) Papers revoking the power of attorney/appointing a new power of attorney signed only by you should be accompanied by a petition giving good and sufficient reasons as to why such papers should be accepted should be filed together with an appropriate fee.

In the model answer, the correct answer was identified as choice (A), citing MPEP § 402.10. Petitioner chose choice (B).

Petitioner argues that both inventors A and B must sign the revocation of power of attorney in order for it to be effective. This is incorrect. One joint inventor may change attorneys in a patent application without the consent of the other(s) by filing a revocation of power attorney and a new power of attorney, signed only by that inventor, along with a petition and fee under 37 C.F.R. § 1.182, setting forth good and sufficient reasons for the change. See MPEP § 402.10 (setting forth the procedure for one inventor to change attorneys without the consent of the other(s)). This is the procedure set forth in choice (A).

The absolute language in choice (B) that a revocation of power of attorney and appointment of a new power of attorney from B can never be accepted without concurrence from A is clearly contrary to MPEP § 402.10. Therefore, choice (B) is incorrect.

Petitioner argues that a mere disagreement is not enough to show good and sufficient reasons for B filing a revocation and

appointment without A's concurrence. However, choice (A) clearly sets forth the proper procedure for petitioning for a change of inventorship without approval of all inventors, as set forth in MPEP § 402.10.

Petitioner's request for credit on question 46 is denied.

2. Afternoon Section

In considering Petitioner's request, the Commissioner notes that Petitioner passed the afternoon section of the 1996 Examination. Thus, a decision on Petitioner's pending petition on the afternoon section of the 1995 Examination has been rendered moot.

CONCLUSION

Petitioner's grade for the morning section of the 1995 Examination will not be changed. The final grade for the morning section is 62 points. Also, since Petitioner has passed the afternoon section of the 1996 Examination, a decision on Petitioner's petition on the afternoon section of the 1995 Examination is dismissed.

ORDER

Upon consideration of the Petition to the Commissioner under 37 C.F.R. § 10.2(c), it is

ORDERED that the petition is denied-in-part and dismissed-in-part.

3/27/97

Date

Lawrence J. Goffney, Jr.
Acting Deputy Assistant Secretary of Commerce
and Deputy Commissioner of Patents
and Trademarks