

6/20/88

R-1988-4

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

In re	,)	Decision on Petition
Petitioner)	for Review under
<hr/>			Rule 10.2(c)

, hereinafter petitioner, requests review under 37 CFR 10.2(c) of the Decision on Request for Regrade on the Afternoon Section of the Examination Held on October 6, 1987, which was rendered on March 31, 1988 by the Director of the Office of Enrollment and Discipline (OED), hereinafter Director. Petitioner seeks an award of nine points to his score to give him a passing grade.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 6, 1987. He passed the morning section but received less than the minimum 70 points (out of 100) on the afternoon part necessary to be registered. A request for regrading on questions 2, 3, 4, and 5 was received on March 14, 1988. In his decision on the request, the Director added 5 points for question 2, 8 points for question 3, no points for question 4, and 3 points for question 5, which resulted in a total score of 64 points. On April 29, 1988, this petition was filed by express mail seeking 4 points on question 2, 3 points on question 3, and at least 2 points on question 4.

FACTUAL REVIEW

Question 2

This question asked for the preparation of an information disclosure statement. A number of patents and various activities of the coinventors were to be considered for inclusion in this statement.

The initial grader deducted 9 points (out of 15). On review, the Director added 5 points in view of petitioner's arguments. Petitioner argues that the deduction of 2 points for misrepresenting the facts in his answer and of 2 points for including immaterial information was not proper.

Question 3

This question also related to preparing an information disclosure statement. It added to the fact situation of the previous question a coinventor's prior use and reduction to practice of the invention in the United States. The examinees were asked if they would modify the disclosure statement and explain either a "yes" or "no" answer.

The grader deducted 15 points (out of 20) because petitioner did not discuss a number of issues raised by the facts. The Director added 8 points in view of petitioner's comments and his answer to question 2.

Petitioner argues that he is entitled to 3 additional points for the reasons expressed in his request for regrade noting that no explanation was given by the Director for refusing to award all of the 11 points requested.

Question 4

This question sought an analysis of filing a continuation-in-part (CIP) patent application to cover an embodiment outside the scope of the original claims. If the option of filing the CIP was considered acceptable, the examinees were asked to explain why filing a CIP would be better than continuing prosecution of the original application. However, if this option was not considered desirable, the examinees were asked to explain the problems of filing a CIP and provide a strategy for prosecuting the original application.

The grader gave no credit for petitioner's answer to this 15 point question because of incorrect reasoning. This was not changed by the Director who found the answer to be confusing and inconsistent. Petitioner seeks partial credit of at least 2 points because his answer recognized that a claim in a CIP to an article or widget having an outer film thickness of 2 mm would provide the desirable coverage.

DECISION

Question 2

A thorough and detailed review of the entire record indicates that the Director was correct in concluding that the facts, as stated in this question, do not clearly indicate that the assignments were executed on the filing date of the patent application. Petitioner's assumption that the assignments must have been re-executed is not warranted by the stated facts.

Petitioner's answer, in addition to mentioning the assignments, identified the inventors' statements about the making of the invention and some test results as being material and so should be included in the information disclosure statement. Since none of these three items are considered material under the fact situation in question 2, 2 points were appropriately deducted.

Petitioner's argument that there may be a duplicate claiming problem has been considered but it is not convincing because under the given facts, there is no likelihood that such a problem exists. Further, it is not understood how such a problem would make all of the items in petitioner's disclosure statement material.

On the other hand, if the activities of one inventor becomes prior art against the other as in question 3, this would be an entirely different matter. Thus, the Director gave petitioner's answer to question 2 considerable partial credit for question 3.

Accordingly, no points will be added to petitioner's score for this question.

Question 3

Although the Director in restoring most but not all of the points for this question gave no reason for any deduction, a review of the entire record supports the conclusion that full credit was not considered appropriate for petitioner's discussion of the Smith invention. The discussion analyzed this invention as creating a possible interference, which only indirectly suggests a prior art problem under 35 USC 102(g) and is completely silent on the 35 USC 102(a) issue. Therefore, the partial credit of 2 points awarded by the Director out of 5 points assigned in the model answer is appropriate. Accordingly, no more points will be added to petitioner's score for this question.

Question 4

As acknowledged by petitioner, his answer to this question focused erroneously on what he believed to be an improper dependent claim issue. It was for this reason, he found the proposed CIP to be unacceptable although his answer did recommend responding to the rejection and filing a CIP with the dependency of the claims changed.

Because his answer generally recognized the advantage of filing a CIP to provide protection, some partial credit is appropriate. The model answer designated 5 points for indicating that the proposed CIP strategy in the question was adequate. Full credit under this part is not warranted because not only does petitioner's answer have a different CIP strategy but also there is no need to tie the filing of the CIP to the response to the rejection.

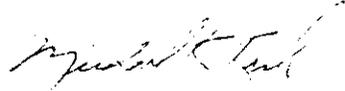
Additional partial credit under other parts of this question is not justified because the timing of the CIP is critical as explained by the model answer. Accordingly, only 2 points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of March 31, 1988 is modified to the extent of restoring two points deducted by the Director from petitioner's score in the afternoon section of the examination on October 6, 1987. Petitioner, however, has not achieved a passing score of 70 points or more in the afternoon section.

The petition is denied.

Dated: 6/20/88



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs