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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 1, 4, 8, 15, 21, 24, 27 and 42 of the morning section and questions 12, 22 and 26 of the afternoon section of the Registration Examination held on April 17, 2002. 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 65. On August 7, 2002, 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 CFR 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. 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 USPTO 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 court decision, a notice in the Official Gazette, or a notice in the Federal Register. 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 that 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.

No credit has been awarded for morning questions 1, 4, 8, 15, 21, 24, 27 and 42 and afternoon questions 12, 22 and 26. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

1. The model answer: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

Petitioner argues that answer (E) is correct. Petitioner contends that all of the responses are subject to proper interpretation under 35 U.S.C. § 112, paragraph 6.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that all of the responses are subject to proper interpretation under 35 U.S.C. § 112, paragraph 6, the question asks which is the best way so that it will be so interpreted. Selections (A), (B) and (D) contain limitations that direct the examiner to construe the claim according to its specific language without regard to the sixth paragraph. Whether the examiner may construe the claim under the sixth paragraph after an argument is not within the scope of the question. Only selection (C) meets the requirements of MPEP § 2181. Accordingly, model answer (C) 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 4 reads as follows:

4. The specification in your client’s patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation- in-part application that has an enabling specification.
- (D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.
- (E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

4. The model answer: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

Petitioner argues that answer (C) is correct. Petitioner contends that MPEP 608.01(p) precludes completing an enabling specification teaching by reference to a subsequently filed application, making selection (C) improper and therefore a correct response. Petitioner does not argue that model answer (B) is incorrect.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that MPEP 608.01(p) precludes completing an enabling specification teaching by reference to a subsequently filed application, making selection (C) improper and therefore a correct response, selection (C) does not suggest that the original application refer to a continuation-in-part. Selection (C) only states that a continuation-in-part be filed, in which it would certainly be the case that the enablement objection would be overcome. Accordingly, model answer (B) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000,

Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(1)(3). ~~Also, evidence of common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (B) is also correct. Petitioner contends that selection (B) would put the application in condition for allowance.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (B) would put the application in condition for allowance, such a result would make selection (B) not the best answer,

because the question asks “[w]hich of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?” Petitioner’s argument agrees with the model answer’s assertion that selection (B) is in accord, which would make (b) not a correct answer. Contrary to petitioner’s assertion that the Jones reference is a 102(e) reference, the Jones reference is a 102(a) reference because it was issued prior to the filing of the Clark application. Accordingly, model answer (D) 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.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben’s consent, sends a proper associate power of attorney to the Office for Ben’s application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben’s comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the

power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is correct. Petitioner contends that (B) is also correct making (D) the best answer because the applicant can appoint anyone to represent him.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that that (B) is also correct making (D) the best answer because the applicant can appoint anyone to represent him, the applicant cannot appoint anyone unless they are a registered practitioner. Petitioner's argument that all answers may be correct where an applicant sends in a power of attorney to prosecute pro se is moot because no power of attorney is sent to prosecute pro se. Petitioner's argument that (C) can be construed so as to make it incorrect is moot because the fact pattern provides no reason for such construction. 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 21 reads as follows:

21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

- (A) must issue a certificate of correction.
- (B) must reprint the patent to correct the printing error.
- (C) need not respond to Company X.
- (D) should include Company X's notification in the patent file.
- (E) must notify Company X of any USPTO decision not to correct the printing error.

21. The model answer: (C) is the most correct answer. *See* 37 C.F.R. § 1.322(a)(2)(i) ("There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section"). *See* MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification,

while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. See 37 C.F.R. § 1.322(a)(2)(ii) ("Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office").

Petitioner argues that answer (D) is correct. Petitioner contends that MPEP 1480 states that third party certificate of correction submissions may be place in the file.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that MPEP 1480 states that third party certificate of correction submissions may be place in the file, this is not the case.

MPEP 1480 states:

"While third parties are permitted to submit information about mistakes in patents which information will be reviewed, the Office need not act on that information nor deny any accompanying request for issuance of a Certificate of Correction. Accordingly, a fee for submission of the information by a third party has not been imposed. The Office may, however, choose to issue a Certificate of Correction on its own initiative based on the information supplied by a third party, if it desires to do so. Regardless of whether the third party information is acted upon, **the information will not be made of record in the file that it relates to, nor be retained by the Office.**" (emphasis added)

Also note 37 CFR 1.322(a)(2)(ii):

"Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office."

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 24 reads as follows:

24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "Y". Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick's application. The examiner rejected Brick's claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called "Q," and that although "Y" and "Q" are not the same, it would have been obvious to one of ordinary skill to make changes to the "Q" ball in order to obtain a ball just like Brick's "Y" ball. On August 2, 2001, Brick responds by stating that his new "Y" ball bounces unexpectedly higher than the "Q" ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the "Y" and "Q" balls and showing that the "Y" ball bounces unexpectedly higher than the "Q" ball. Brick argues

that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the “Y” ball as compared to the “Q” ball, it would not have been obvious to one of ordinary skill in the art to make changes to the “Q” ball to obtain Brick’s “Y” ball. On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: “The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action.” Brick believes he is entitled to a patent to his new bouncing ball “Y.” How should Brick proceed?

- (A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick’s invention.
- (B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.
- (C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his “Y” ball.
- (E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the “Q” ball and the “Y” are not identical.

24. The model answer: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Brick should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Brick’s invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the “Q” ball relied upon by the examiner, not applicant’s “Y” ball. (D) is wrong because whether or not Reference X provides a written description for Brick’s invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. §

103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the “Q” and “Y” balls are not the same.

Petitioner argues that answer (E) is correct. Petitioner contends that the bounce height is the only conceivable difference between the claimed subject matter and the art, and therefore the argument in (E) that the two are not identical is sufficient to overcome the 103 rejection.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the bounce height is the only conceivable difference between the claimed subject matter and the art, and therefore the argument in (E) that the two are not identical is sufficient to overcome the 103 rejection, the examiner admitted that the two are not identical, and absent an argument as to why the one is not also obvious in view of the other, in spite of being different, such an argument cannot overcome the 103 rejection. The bounce height is not part of the claimed subject matter, and there are no claimed ranges as suggested by the petitioner, and therefore bounce height is only a secondary consideration. Accordingly, model answer (B) 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 questions 27 through 29 are based on the following factual background. Consider morning questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non- hormonal substance XYZ (“Antiagra”) that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non- hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal

substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

Morning question 27 reads as follows:

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates (claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

(A) You contact the examiner on the telephone on December 27, 2001 and make an oral election of the subject matter of claims 6-14 without traverse, and request cancellation of claims 1-5 and 15-20 without prejudice to resubmission of those claims in a continuation application. You do not, however, subsequently confirm the substance of the telephone conversation in writing and the examiner does not complete an Interview Summary Record.

(B) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the requirement would force the small entity applicant to file multiple patent applications and is therefore unduly burdensome. The Reply to Office Action requests reconsideration of the restriction without making an election.

(C) On February 12, 2002, you file a Reply to Office Action, a Petition for Two Month Extension of Time and all necessary fees. The Reply to Office Action does not make an election. Instead, the Reply to Office Action traverses the restriction requirement and requests reconsideration of the restriction without specifically pointing out the supposed errors in the examiner's action.

(D) On February 14, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the claims as originally presented in a single application do not pose a serious burden on the examiner, and therefore requests reconsideration of the election requirement. The Reply to Office Action provisionally

elects the subject matter of claims 6-14. There is no authorization to charge a deposit account.

(E) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action elects claims 6-14 without traverse.

27. The model answer: The best answer is (E). The original deadline for responding to the Office action was one month from December 12, 2001, *i.e.* January 12, 2002. A one-month extension of time would be required for a response filed from January 12, 2002 to February 12, 2002. Answer (D) is incorrect because the responses are not timely. Answer (B) is incorrect because a proper reply must include an election even if the restriction requirement is traversed (MPEP § 818.03(b)). Furthermore, although small entity status entitles an applicant to pay reduced fees, small entity status does not change the manner in which restriction requirements are considered. Answer (A) is incorrect because the reply must be in writing. See, *e.g.*, MPEP § 818.03(a). Answer (C) is incorrect because the Reply to Office Action does not make an election and because it does not specifically point out the supposed errors in the Examiner's action. See MPEP § 818.03(a).

Petitioner argues that answer (D) is correct. Petitioner contends that all necessary fees in (D) would include the fee for a two month extension.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that all necessary fees in (D) would include the fee for a two month extension; selection (D) specifically recites that "you file a Reply to Office Action, a Petition for **One Month Extension of Time** and all necessary fees." The one month extension is insufficient to make the response timely. Accordingly, model answer (E) 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 42 reads as follows:

42. Applicant Homer filed a non-provisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

(A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.

(B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.

(C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.

(D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.

(E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

42. The model answer: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a *bona fide* attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a *bona fide* attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

Petitioner argues no answer is correct, and therefore all answers should receive credit. Petitioner contends that (D) is not correct because the examiner may still induce abandonment by sending out a notice of non-responsive reply.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer is correct, and therefore all answers should receive credit because in (D) the examiner may still induce abandonment by sending out a notice of non-responsive reply, such an event is outside the scope of the question. Clearly an application may be abandoned later depending on the events subsequent to the fact pattern of the question, but such are irrelevant because they are outside the scope of the question. The reply in (D) will avoid abandonment, as opposed to leading to abandonment, because a notice of non-responsive reply will be sent instead of the application going abandoned. Every one of the remaining selections would result in abandonment. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

(A) Barry's device is too large to combine with Lance's device.

(B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor than the applicant's invention.

(C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.

(D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.

(E) All of the above.

12. The model answer: (C) is correct. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance's device unsatisfactory for its intended purpose. (A) is incorrect. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry's art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

Petitioner argues that answer (A) is also correct. Petitioner contends that the argument as to size indicates that the combination would not have worked as intended.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the argument as to size indicates that the combination would not have worked as intended, selection (A) contains no mention of an argument that the combination of the teachings would not have worked as intended, only that the size of the specific embodiment would have been too large to combine. As the model answer indicates, it is the teachings, not the specific size, that is indicative of what one of ordinary skill would understand from a piece of art. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 22 reads as follows:

22. Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USPTO practice and procedure?

(A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.

(B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.

(C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.

(D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.

(E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

22. The model answer: (E) is the correct answer. 35 U.S.C. § 251. The reissue permits Smarter to broaden the claimed subject. (A) is incorrect. There must be copendency between the divisional application and the original application. 35 U.S.C. § 120. (B) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (C) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*, including a divisional reissue application. MPEP § 1402. (D) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*

Petitioner argues that answer (C) is correct. Petitioner contends that there is no error upon which selection (E)'s reissue could be brought and selection (C) provides another method to get broader rights.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that there is no error upon which selection (E)'s reissue could be brought and selection (C) provides another method to get broader rights, selection (C) is also for a reissue, which the petitioner has argued against, and therefore is counter to petitioner's argument. Further, (C) fails to restrict the time period in which a broadening reissue should be brought, which selection (E) correctly does. As to the lack of an error in selection (E), failing to claim broadly is one of the errors upon which a reissue can be brought. 35 U.S.C. § 251. Accordingly, model answer (E) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 26 reads as follows:

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent ("P1"), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles ("P2"), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision. On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you've never heard of, and he wants to "revive his patents." He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption "It's just a dream: it can't be made we've tried a thousand times, don't bother." He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. "But it's such a stupid way to do things - it's expensive and it doesn't work very well- it doesn't even make a safety candle," Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing Annie's proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash's patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

- (A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.
- (B) File a request for reexamination of P1 based on the Wicks and Sticks article.
- (C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.
- (D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.
- (E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

26. The model answer: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article “shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*” (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because a request for reexamination cannot be based on a video tape ~~broadened claims may not be filed in a reexamination~~. (E) is not the best answer because it is not clear there is an “error” under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

Petitioner argues that answer (C) is correct. Petitioner contends that no answer is correct because the facts fail to indicate that the question of patentability is substantial.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that no answer is correct because the facts fail to indicate that the question of patentability is substantial, whether the issue of patentability is substantial is determined by the **Office**, not the party filing the reexamination request. 35 USC 303, 304. The provisions of 35 USC 302 clearly allow for a reexamination request to be filed in this fact pattern. Accordingly, model answer (B) is correct and petitioner’s answer (C) 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 65. 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