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 11, 12, 15, 25 and 45 of the morning section and questions 26 and 27 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 67. On August 2, 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.

Petitioner has been awarded an additional two (2) points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional two (2) points on the Examination. No credit has been awarded for morning questions 15, 25, and 45, and afternoon questions 26 and 27. Petitioner's arguments for these questions are addressed individually below.

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 both (B) and (C) are equally true. Petitioner argues that (B) is not false merely because it does not require the power of attorney to be executed since, other than executing a power of attorney, Ben can simply instruct Chris or any other appropriate intended representative to file a response

based upon representational authority under 37 C.F.R. 1.34(a). Petitioner also argues that (B) does not suggest that Ben may appoint a non-practitioner to prosecute the application, and that it is incorrect to assume that Ben is going to appoint a registered practitioner since he did not appoint a registered practitioner the first time. Petitioner also argues that (C) is incorrect since "any registered practitioner" would include practitioners who have a conflict of interest or practitioners who are suspended or excluded from practice before the Office.

Petitioner's arguments have been fully considered but are not persuasive. The burden is on the petitioner to show that his chosen answer is the most correct answer. Contrary to petitioner's argument that (B) is not false since, rather than executing a power of attorney, Ben can simply instruct Chris or any other registered practitioner to file a response based upon representational authority under 37 C.F.R. 1.34(a), (B) is false since (B) *specifies* that a power of attorney should be sent in by Ben, but does not require the power of attorney to be executed. Petitioner's argument is based on facts not given in answer (B). Contrary to petitioner's argument, (B) does not allow for the option of filing of a response based upon representational authority under 37 C.F.R. 1.34(a) *in lieu of* sending in a power of attorney. (B) requires that Ben send in a power of attorney. The issue in (B), therefore, is not whether a power of attorney should be sent. The issue is whether (C), which requires that the power of attorney be executed, is more correct than (B), which does not have this requirement. Furthermore, since "anyone" could include someone that is a non-registered practitioner, and is not limited to Chris or to any other registered practitioner, petitioner cannot make the assumption that Ben would appoint Chris or any other registered practitioner. Petitioner's assumption that the person Ben selected in his power of attorney would be a registered practitioner, since the first attorney was registered, is also inappropriate, as neither selection (B) nor the fact pattern specifically identifies whom Ben intends. Instead, selection (B) indicates that Ben may send in a power of attorney for anyone, as distinguished from selection (C) that indicates that Ben may send in a power of attorney for only a registered practitioner. Additionally, contrary to petitioner's argument, the term "any registered practitioner" does not include practitioners who are suspended or excluded from practice before the Office. A practitioner who has been excluded from practice before the Office, by definition, is no longer registered to practice before the Office. Similarly, a suspended practitioner is not registered since his registration to practice before the Office has been suspended. Finally, petitioner's argument that "any registered practitioner" can be construed to include practitioners who have a conflict of interest is based on facts not provided in answer (C). (C) makes no mention of conflicts of interest, and the fact pattern provides no reason for such construction. As stated in the directions for both the morning and the afternoon sessions, do not assume any additional facts not presented in the questions. 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 25 reads as follows:
25. John filed a utility patent application for a high strength steel composition on June 9, 1997. During prosecution of the application, an interference under 35 U.S.C. § 135(a) was declared on June 9, 1998 between John's application and an un-expired patent. Subsequently, the interference was terminated in John's favor on June 9, 2000. The year 2000 was a leap year having 366 days. Ultimately, John's application was allowed and issued as a patent on June 12, 2001. Based on proper USPTO practice and procedure, and absent any other events necessitating adjustment of the patent term, when should John's patent expire?

(A) Twenty (20) years from issue date.

(B) Twenty (20) years and one day from filing date.

(C) Twenty (20) years plus three years inasmuch as granting of the patent was delayed by the interference.

(D) Twenty (20) years plus the number of days in the period beginning the date prosecution is suspended in another application that is not in the interference, but is related to the application in interference.

(E) Twenty (20) years plus the period beginning on the date the interference was declared and ending on the date that the interference was terminated with respect to the application.

25. The model answer: (E) is correct. (A), (B), (C), and (D) are wrong because 35 U.S.C. § 154(a)(2), in pertinent part, provides that a patent "grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States... ." An adjustment of the patent term due to examination delay for original patent applications filed on or after June 8, 1995, and before May 29, 2000, is provided by 37 C.F.R. § 1.701. As to (D), the period of adjustment for the application involved in the interference is not adjusted by the period prosecution is suspended in an application related to the application in interference. The period of adjustment for the application in interference is governed by the provisions of 37 C.F.R. § 1.701(c)(1)(i), as opposed to the provisions of 37 C.F.R. § 1.701(c)(1)(ii), which pertain to adjustment of the term of an application wherein prosecution is suspended due to an interference proceeding not involving that application. As to (E), the adjustment involves extending the patent term from the expiration date of the patent by the period of the delay. The manner of calculating the period of the delay is provided in subsection 701(c)(1)(i), which recites: With respect to each interference in which the application was involved, the number of days...in the period beginning on the date the interference was declared...to involve the application in the interference and ending on the date that the interference was terminated with respect to the application... .

Petitioner argues that answer (B) is correct. Petitioner contends that although (B) is wrong inasmuch as it does not appropriately adjust the length of the patent term to include the period during which the application was in interference, (E) is also wrong inasmuch as the filing date is not specified as the starting point for the calculation.

Petitioner's arguments have been fully considered but are not persuasive. As stated in the directions for both the morning and the evening sessions, there is only one most correct answer for each question. The burden is on the petitioner to show that his chosen answer is the most correct answer. (B) is incorrect since it does not appropriately adjust the length of the patent term to include the period during which the application was in interference, as admitted by the petitioner. (B), therefore, does not provide the correct time at which the patent will expire. (E) correctly adjusts the length of the patent term, so that the patent will expire twenty (20) years plus the period beginning on the date the interference was declared and ending on the date that the interference was terminated with respect to the application. The absence of a starting point for the calculation does not cause (E) to be incorrect. (E) is the answer which is most correct. Accordingly, model answer (E) 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 45 reads as follows:
45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art.

(B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).

(D) (A) and (C).

(E) (A), (B) and (C).

45. The model answer: (E). See MPEP § 706.02(b) page 700-23 (8 th ed.), under the heading "Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent." (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

Petitioner argues that answer (D) is correct. Petitioner contends that although (B) provides a practice or procedure that may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e), the procedure may not be properly employed when there is contrary evidence of inventorship.

Petitioner's arguments have been fully considered but are not persuasive. As stated in the directions for both the morning and the evening sessions, there is only one most correct answer for each question. The burden is on the petitioner to show that his chosen answer is the most correct answer. Petitioner's argument is based on facts not given in answer (B). (B) does not indicate that there is contrary evidence of inventorship. As stated in the directions to both the morning and evening sessions, do not assume any additional facts not presented in the questions. (B) provides a practice or procedure that may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e). (D) is not correct because it is not the most inclusive, since it does not include (B). 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.

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 nonprovisonal 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. (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 (D) is correct. Petitioner contends that the question is unanswerable. For an unanswerable question, answer (D) is as acceptable as answer (B). Petitioner provides no further showing that his chosen answer (D) is the most correct answer. Petitioner contends, rather, that the question is not clear as to whether a reexamination is in Flash's best interests and even whether it is possible to do so. Reexamination requires a substantial new question of patentability and the facts of the question do not indicate whether the question of patentability is substantial or new. Petitioner further contends that the reference makes the invention look nonobvious. Flash will spend a great deal of time and money by filing a reexamination without the appearance of any chance of success. Finally, the reexamination will probably trigger a

lawsuit. None of the answers are acceptable and the question should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the fact pattern fails to show a substantial new question of patentability, 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. As to the substantiality of the patentability issue, whether the issue of patentability is substantial is determined by the Office, not the party filing the reexamination request. 35 USC 303, 304. The reexamination would probably strengthen the patent since the question of patentability would probably be overcome, due to the negative comments in the Wicks and Sticks article. The provisions of 35 USC 302 clearly allow for a reexamination request to be filed in this fact pattern. (D) is clearly wrong since the video was not published until after Jack's first application was filed, negating the video, no matter how pertinent. Finally, a request for reexamination cannot be based on a video tape. A request for reexamination can only be based on prior patents and printed publications. See MPEP 2214 and 37 CFR § 1.510(b)(1). A video tape may be a publication, but it is not printed. Accordingly, model answer (B) 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.

Afternoon question 27 reads as follows:
27. Judy Practitioner is preparing the declaration form (PTO/SB/01) for her clients, inventors A and B, to sign prior to filing their utility patent application. Inventor A lives in California, and inventor B lives in Germany. Prior to sending declaration forms to the inventors, only inventor A had reviewed the final version of the application. Which of the following situations below would result in the declaration form(s) being compliant with 37 CFR 1.63(a) and (b)?

(A) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A with the instruction to return to her after he signs the declaration form. After inventor A returned the form, Judy then proceeded to mail out the declaration form to inventor B. After inventor B signed the declaration, Judy then attached the declaration, signed by both inventors, to the application and filed it with the USPTO.

(B) Judy mailed to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and only inventor A's full name and citizenship. At the same time, Judy sent by facsimile to inventor B only a copy of the declaration form, which identified the application and only inventor B's full name and citizenship. Judy then

attached both signed declaration forms to the patent application and filed it with the USPTO.

(C) Judy sent by facsimile (e.g. fax) to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and both inventors by their full names and citizenships. At the same time, Judy mailed to inventor B a copy of the application and a copy of the declaration form, which identified the application and both inventors by their full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.

(D) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A. Judy then attached the declaration, signed only by inventor A, to the application and filed it with the USPTO.

(E) Judy files a petition under 37 CFR 1.48 just stating that inventor B's signature could not be obtained at this time, and files a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, signed by only inventor A.

27. The model answer: The correct answer is (C) because (1) the declaration identified the application and the full name and citizenship of both inventors and (2) a copy of the application was sent to inventor B to review and understand. Answer (A) is incorrect because inventor B never reviewed and understood the application prior to signing the declaration form. Answer (B) is incorrect because (1) each declaration form failed to identify all the inventors (e.g. both inventors A and B) and (2) a copy of the application was not sent to inventor B to review and understand. Answer (D) is incorrect because inventor B never signed the declaration. Answer (E) is incorrect because petitions for nonsigning inventors must be filed under 37 C.F.R. § 1.47, not § 1.48. Even if the petition is treated under § 1.47 a statement, that B's signature could not be obtained at this time, is insufficient.

Petitioner argues that answer (A) is correct. Petitioner contends that (A) is equally correct as (C). Petitioner provides no further showing that his chosen answer (A) is the most correct answer. Petitioner argues that experienced practitioners know that inventors often fail to read or understand declarations, specifications, or claims without necessary intervention by the practitioner, and that answer (C) does not indicate whether inventor (A) understood the application, or whether (B) reviewed or understood the application. Petitioner argues that an assumption that the inventors reviewed and understood the declarations and application in answer (C) is just as reasonable as an assumption under answer (A) that Judy mailed a copy of the application with the declaration form to inventor B.

Petitioner's arguments have been fully considered but are not persuasive. As stated in the directions for both the morning and the evening sessions, <u>there is only one</u>

most correct answer for each question. The burden is on the petitioner to show that his chosen answer is the most correct answer. (A) is clearly wrong since inventor B never reviewed and understood the application prior to signing the declaration form, and Judy did not send inventor B a copy of the application for review. Answer (A), therefore, provides no possibility that the declaration form(s) would be compliant with 37 CFR 1.63(a) and (b), since (A) provides no possibility that inventor B would review and understand the application prior to signing the declaration form. Answer (C) states that the declaration form identified the application and the full name and citizenship of both inventors, specifies that a copy of the declaration form was mailed to both inventor A and inventor B, and states that at the same time, Judy mailed a copy of the application to inventor B. Answer (C), therefore, is the most correct answer since only answer (C) provides the possibility that inventor B would review and understand the application prior to signing the declaration form, and that the declaration form would therefore be compliant with 37 CFR 1.63(a) and (b). 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.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. 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