



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 15, 29, and 35 of the morning section and questions 8, 12, and 39 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 68. On August 5, 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 15, 29, and 35 and afternoon questions 8, 12, and 39. 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 also correct. Petitioner contends that both answers (B) and (C) are correct. Petitioner argues answer (B) is correct because "answer (B) does not address who is qualified, but simply recommends officially designating a power of attorney so there is no question as to who is qualified to represent your interest

before the USPTO.” Petitioner further argues that since only an attorney who is registered can represent Ben before the Office, the person in answer (B) must have been registered in order to be given the power of attorney.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that answer (B) implicitly implied that the person Ben selected in his power of attorney is a registered practitioner, 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. The directions for the examination state, “Do not assume any additional facts not presented in the questions.” Petitioner’s argument is based on additional facts not given in answer (B). Since “anyone” could include someone that is a non-registered practitioner, and is not limited to a registered practitioner, petitioner cannot make the assumption that Ben would appoint a registered practitioner. Ben may not appoint a non-practitioner, as suggested by selection (B). Accordingly, answer (D) is not correct because answer (B) is not correct and answer (C) is the most correct choice.

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

Morning question 29 reads as follows:

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.

29. Claim 15 of the application reads: "A method for reducing pregnancy rate in wild deer population comprising the step of placing at least one salt lick containing an effective amount of XYZ in a location accessible to wild male deer so that XYZ is ingested by said male deer." The specification provides adequate disclosure as to what constitutes an "effective amount" of XYZ. In addition to the Deere patent, the examiner locates a prior art patent to John Doe that discloses the non- hormonal substance XYZ for use as a softening agent in skin cream. There is no disclosure or suggestion in the Doe patent of any other potential use for XYZ. Which of the following statements is most consistent with proper USPTO practice and procedure?

(A) The Examiner may properly reject claim 15 under 35 U.S.C. § 103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.

(B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.

(C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. § 103 only if the Doe patent is in the field of Salt's endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.

(D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. § 112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.

(E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of "an effective amount of XYZ" renders the claim indefinite.

29. The model answer: The best answer is (C). MPEP § 2141.01(a). Answer A is incorrect because under the facts of the question there is no teaching or suggestion to combine the teachings of Deere and Doe. Moreover, what is inherent is not necessarily obvious. Answer B is incorrect because the test under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. The test is not whether it would have been obvious to the inventor. Answer (D) is incorrect at least because the background facts specifically state that the specification is fully enabling. Similarly, Answer (E) is incorrect because the question specifically states that the specification provides adequate disclosure as to what constitutes an "effective amount" of XYZ.

Petitioner argues that answer (A) is correct. Petitioner contends that MPEP § 2112 states that a reference can be relied upon for its express, implied or inherent disclosures. Petitioner argues that because the compound XYZ has the inherent characteristics of suppressing the sexual activity in a deer that the claimed invention would have been obvious considering the teachings of Deere in view of Doe.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the claimed invention would have been obvious considering the teachings of Deere in view of Doe, the fact that XYZ may have the inherent characteristic to suppress a deer's sexual activity does not by itself make it combinable with Deere to render the claimed invention obvious. As the model answer stated, what is inherent is not necessarily obvious. In order for Doe to be combined with the teachings of Deere, Doe would have to be analogous art and there would have to be some reason for the combination. None of these facts are shown in the question. 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 35 reads as follows:

35. Joe Inventor received a patent in July 1999, containing claims to both an article and an apparatus. When filed in the USPTO, the application contained disclosure of a method, but the method was not claimed. The patent contained the same disclosure of the method, but the method had never been claimed in the application. In May 2001, Joe asks Pete Practitioner to file a reissue application to add claims to the method disclosed in the specification. Once filed, which of the following will most likely occur during the prosecution of the reissue application in accordance with published USPTO practice and procedure?

(A) The examiner should reject the added method claims on the basis of not being for the invention claimed in the original patent, under 35 U.S.C. § 251, citing *In re Rowand*, 187 USPQ 487, and allow the original unamended article and apparatus patent claims in the reissue application.

(B) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be constructively elected, examined, and, if found allowable, passed to issue, while the non-elected method claims should be filed in a divisional application.

(C) Following a restriction requirement in the reissue application and the filing of a divisional application to claim the method, the applicant should request a duplicate copy of the original patent so that a copy of said patent can be surrendered in each reissue application.

(D) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be considered constructively elected; if after examination they become allowable in unamended form, they will be held in abeyance in a withdrawn status inasmuch as no “error” under 35 U.S.C. § 251 exists, while Joe prosecutes the claims to the method in a divisional application.

(E) A three-way restriction requirement among the article, apparatus and method claims should be made by the examiner in the reissue application, and an election made by applicant. Each invention should issue in a separate reissue patent.

35. The model answer: The correct answer is (D). The practice is set out in MPEP § 1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP § 1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously unclaimed subject matter.

Petitioner argues that answer (B) is correct. Petitioner contends that failure to claim the method claims is the error required by 35 U.S.C. 251 so that there is no need to hold the original apparatus claims in abeyance while the method claims are being examined.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that there is no need to hold the application only containing the unamended original apparatus claims in abeyance, 35 U.S.C. 251 does require it. While it is true that the failure to claim the method claims is a permissible “error” under 35 U.S.C. 251, the application that only contains the apparatus claims cannot state that failure to claim the method is its error because that reissue application still does not claim the method (i.e., the method claims were cancelled as being nonelected claims). Therefore, in order to be a proper error, the application containing only the apparatus claims must be held in abeyance until such time that the method claims prosecuted in the divisional reissue are found allowable and rejoined. 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.

Afternoon question 8 reads as follows:

8. A grant of small entity status entitles an applicant to which of the following?

(A) Applicant can pay a fee to file an information disclosure statement pursuant to 37 CFR 1.97(c) that is less than the fee required to be paid by other than a small entity.

(B) Applicant can file a Continued Prosecution Application (“CPA”) using a certificate of mailing under 37 CFR 1.8 to obtain a U.S. filing date that is earlier than the actual USPTO receipt date of the CPA.

(C) Applicant can pay a fee to file a petition for revival of an unavoidably abandoned application under 35 U.S.C. § 111 that is less than the fee required to be paid by other than a small entity.

(D) After issuance of a non- final first action, but before the close of the prosecution in a patent application, applicant may properly file a Request for Continued Examination and pay a fee that is less than the fee required to be paid by other than a small entity.

(E) None of the above.

8. The model answer: (C) is the correct answer. 35 U.S.C. § 41(h), 37 C.F.R. §§ 1.17(l) and 1.27(b). (A) is incorrect because 37 C.F.R. § 1.17(p) provides for only one fee for filing an IDS all parties must pay that fee. There is no support in 37 C.F.R. § 1.17(p) for a small entity paying a reduced fee for filing an IDS. (B) is incorrect because it is inconsistent with 37 C.F.R. § 1.8(a)(2)(i)(A). (D) is incorrect because it is inconsistent with 37 C.F.R. § 1.114(a), inasmuch as prosecution is not closed. (E) is incorrect because (C) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that because answer (D) stated that the Request for Continued Examination (RCE) was “properly filed,” then the RCE was proper and therefore, the applicant can pay the smaller fee amount.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the RCE must have been properly filed because answer (D) stated it was so, the RCE was not properly filed. 37 CFR 1.114(a) requires that prosecution must be closed prior to the filing of an RCE. Clearly, this is not the case in answer (D). The petitioner should have read the question as “which one of the following statements are true.” The first part of the statement in answer (D) is not true. 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.

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 (D) is correct. Petitioner contends that answer (D) could be correct because the applicant could overcome the rejection by showing that 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.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) could be the correct answer, applicant cannot show that the combination of Lance in view of Barry does not teach the claimed invention by only showing that one of the references (Barry) does not teach all the claimed elements arranged in the same manner. See MPEP 2145, subsection IV. Accordingly, model answer C is the most correct answer, and petitioner's answer B is incorrect.

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

Afternoon question 39 reads as follows:

39. A nonprovisional application under 37 CFR 1.53(b) is filed with a check for the exact amount of a small entity basic filing fee. A registered practitioner's well trained legal assistant when filing the application forgot to also submit a written assertion of entitlement to small entity status that had been executed by the sole assignee who is a small entity. Which of the following is/are in accordance with proper USPTO practice and procedure?

(A) Applicant need not supplement the initial filing with the omitted written assertion of small entity status as the payment of the small entity filing fee will suffice to accord small entity status.

(B) If the application is allowed, applicant cannot pay the issue fee in the small entity amount unless the fee is accompanied by a written assertion of small entity status.

(C) If after filing of the application small entity status becomes no longer appropriate, applicant may continue to pay small entity fees for newly added claims in a response to a first Office action rejection.

(D) If the application is allowed, a registered practitioner could pay a small entity issue fee solely based on the assignee's written assertion of small entity status that was not originally submitted if the practitioner now submits it with the issue fee.

(E) (A) and (C).

39. The model answer: (E) is the correct answer as both answers (A) and (C) are in accordance with Office practice. Answer (A) is a correct answer as the payment of the small entity filing fee will be treated as a written assertion of entitlement to small entity status pursuant to 37 C.F.R. § 1.27(c)(3). Answer (C) is a correct answer as once small entity status is properly established on filing of the application small entity fees may continue to be paid without regard to a change in status, such as for a claim fee, until the issue fee is due pursuant to 37 C.F.R. § 1.27(g)(1). Answer (B) is not a correct answer.

Although a new determination of entitlement to small entity status is made upon payment of the issue fee, a written assertion of entitlement to small entity status is not required at this time. Once established, small entity status remains in effect unless the facts change. Answer (D) is not a correct answer. At the time of payment of the issue fee the registered practitioner cannot rely upon the previous written assertion of small entity status completed at the time of filing the application. Applicant must conduct a new investigation as to entitlement to small entity status at the time of payment of the issue fee pursuant to 37 C.F.R. § 1.27(g)(1). If small entity status is determined to continue to be appropriate at the time of payment of the issue fee, a small entity issue fee can be paid based on such determination and a written assertion need not be presented at that time pursuant to 37 C.F.R. § 1.27(e)(1).

Petitioner argues that answer (A) is correct. Petitioner contends that answer (C) is not correct because if the “additional fees” were maintenance fees, then the USPTO should have been noticed.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that notification should have been made, answer (C) only asks about the payment of “additional claim” fees. Additional claim fees are charged prior to the allowance of the application, and therefore, prior to any payment of the issue fee or maintenance fees. Therefore, according to proper Office policy and procedure, the applicant may continue to pay small entity fees for newly added claims in a response to a first Office action rejection. Accordingly, model answer (E) 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 68. 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.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is written above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy