



UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-87

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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FEB 10 2003

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his-her answers to questions 2, 15 and 28 of the morning section and no questions of the afternoon section of the Registration Examination held on April 17, 2002. Each question in the Registration Examination is worth one (1) point. A petition fee of \$230 has been submitted.

No credit has been awarded for any of the petitioned questions.

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 questions 2, 15, and 28 of the morning session, petitioner requested regrading, arguing that the model answers were either not the best answers or 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.

Petitioner has not been awarded any additional points for any questions, either in the morning section or the afternoon section. Accordingly, petitioner has been granted no additional points on the Examination. Petitioner's arguments for petitioned questions are addressed individually below.

Morning question 2 reads as follows:

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very

desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

- (A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.
- (B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.
- (C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.
- (D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.
- (E) (B) and (D).

The model answer is selection (C).

37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30 days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the

end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

Petitioner selected (B).

Petitioner contends that (B) is correct answer because, under the Administrative Procedure Act, which applies to all USPTO proceedings, the USPTO would not be able to take away patent term from a patentee without setting forth standards and procedures for how much of the patent term would be taken away, and under what circumstances. The Petitioner further contends that the reference would be considered and the USPTO cannot take away any patent term because the USPTO cannot arbitrarily decide how much patent term to take away.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the reference would be considered and the USPTO cannot take away any patent term because the USPTO cannot arbitrarily decide how much patent term to take away, complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Accordingly, model answer (C) 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.

The model answer is (C).

See 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 selected (D).

Petitioner contends that a person always has the right to have a lawyer represent him in any proceeding and that it may very well be that the lawyer may be required to engage a registered practitioner as well, but the lawyer is who represents the individual. Selection (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application. A non-practitioner may not prosecute a patent application. Furthermore, selection (B) is not correct because it does not require the power of attorney to be executed. Since, selection (D) includes incorrect selection (B), selection (D) is not the correct answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a person always has the right to have a lawyer represent him in any proceeding and that it may very well be that the lawyer may be required to engage a registered practitioner as well, but the lawyer is who represents the

individual, a non-practitioner may not prosecute a patent application and a power of attorney is required to be executed. 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 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 28 reads as follows:

28. Claim 6 of the application reads: "A composition for reducing the pregnancy rate among wild deer population, said composition comprising salt and a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer." Claim 7 reads: "The composition of claim 6, wherein said non-hormonal substance is XYZ." Claim 8 reads, "The composition of claim 6, wherein said composition is formed in a block and wherein said non-hormonal substance is interspersed substantially evenly throughout said block." Each of these claims is fully supported by the specification. An Office action is mailed March 15, 2002. Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the Deere patent. Which of the

following arguments, if presented in a timely reply to the March 15 Office action, is most likely to persuade the examiner to remove the § 103 rejection without presenting unpersuasive arguments?

(A) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”

(B) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”

(C) “In contrast to the present invention, the Deere patent calls for the use of a hormonal substance that suppresses ovulation in female deer. Deere neither discloses nor suggests the use of a non- hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer, as set forth in claim 6.”

(D) “The present invention relates to a technique for reducing deer overpopulation by causing male deer to ingest a novel substance (XYZ) that is operable to suppress sexual function in the male deer. The Deere patent neither discloses nor suggests such a technique and, therefore, claim 6 is neither anticipated nor rendered obvious by the Deere patent.”

(E) “Applicant was aware of the Deere patent prior to filing of the present application, and the claims were carefully drafted to distinguish the present invention over the Deere patent. Accordingly, reconsideration and withdrawal of the § 103 rejection of claim 6 is respectfully requested.”

The model answer is (C).

Answers (A) and (B) are incorrect because they attempt to distinguish the claim on the basis of a feature that is not recited in claim 6, *i.e.*, the substance is interspersed throughout the salt lick. *Cf.* claim 8. Answer D similarly relies on a feature that is not set forth in claim 6, *i.e.*, presence of substance XYZ. With regard to Answer (E), a mere conclusory statement that the claim was carefully drafted to distinguish over the prior art is unlikely to be persuasive without reference to distinguishing features set forth in the claim.

Petitioner selected (D).

Petitioner contends that it is very unlikely that the Examiner would withdraw a section 103 rejection and allow a claim for any “non-hormonal” substance. Petitioner further contends that arguing the more limited XYZ claim is most likely to result in withdrawal of the 103 rejection when the Examiner suggests limiting the claim to that substance. Answer (D) is incorrect because it attempts to distinguish the claim on the basis of a feature that is not recited in claim 6, *i.e.*, presence of substance XYZ.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that it is very unlikely that the Examiner would withdraw a section 103 rejection and allow a claim for any “non-hormonal” substance and that the more limited XYZ claim is most likely to result in withdrawal of the 103 rejection when the Examiner suggests limiting the claim to that substance, it is simply incorrect to distinguish a claim on the basis of a feature that is not recited in the independent claim on which the dependent claim depends, *i.e.*, presence of substance XYZ. 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.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score remains at 68. This score is insufficient to pass the Examination, which requires a grade of 70.

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