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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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AUG 12 2002

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 17, 30 and 35 of the morning session and questions 4, 12, 32 and 43 of the afternoon session of the Registration Examination held on October 17, 2001. 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 sessions of the Registration Examination. Petitioner scored 66.

On February 4, 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 sessions 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 point for afternoon question 12. Accordingly, petitioner has been granted one additional point on the Examination. No credit has been awarded for morning question 17, 30 or 35, and no credit has been awarded for afternoon question 4, 32 or 43. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.

- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

The model answer is selection (C).

17. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the Japanese patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner has argued that answer (B) is the best answer because if John's application was filed before Ted's date of invention, there would be a statutory bar under 35 U.S.C. § 102(e). Petitioner's arguments have been fully considered but are not persuasive. As provided in MPEP § 715, a reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a "statutory bar." While it would be proper for the examiner to make a rejection under 35 U.S.C. 102(e) based on the patent to John, it is not a statutory bar because Ted could prove an earlier date of invention.

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

Morning question 30 reads as follows:

30. Which of the following is most likely to be considered in a proper obviousness determination?

- (A) Evidence demonstrating the manner in which the invention was made.
- (B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.
- (C) Evidence demonstrating the level of ordinary skill in the art.

- (D) Evidence that one of ordinary skill in the art, after reading Kat's application, would readily be able to make and use Kat's invention without undue experimentation.
- (E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

The model answer is selection (C).

30. ANSWER: The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). (A) is not the best answer because 35 U.S.C. § 103 specifically states that patentability shall not be negated by the manner in which the invention was made. (B) is not the best answer because economic unfeasibility is not a basis for a determination of nonobviousness. See MPEP § 2145 VII. (D) is directed to the issue of enablement, not obviousness. (E) is wrong because the commercial success of the prior art distance finder is not relevant (although commercial success of Kat's invention would be relevant).

Petitioner has argued that (A) is the best answer because evidence demonstrating the manner in which the invention was made is not precluded from being used to show unobviousness, even though it is evident from the statute that the manner in which the invention was made cannot negate patentability for obviousness reasons. Petitioner's arguments have been fully considered but are not persuasive. The statute (35 U.S.C. § 103) makes it clear that the manner in which the invention was made is not something that should be taken into account when making an obviousness (or unobviousness) determination. Rather, the determination is made based upon the Graham factual inquiries set forth in MPEP § 2141. Answer (C), "Evidence demonstrating the level of ordinary skill in the art" is the best answer because the third Graham factual inquiry set forth in MPEP § 2141 is "Resolving the level of ordinary skill in the pertinent art."

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

Morning question 35 reads as follows:

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as *pro se* joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

- (A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office.
- (B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.
- (C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is not an inventor of the invention claimed.
- (D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.
- (E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

The model answer is selection (D).

35. ANSWER: (D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with 37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to

35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy's application has not issued as a patent, and reissue relates only to applications that have issued as patents.

Petitioner has argued that the question asks what Amy can do in her best interest, not what both Amy and Pierre should do to help both their interests. Since Amy cannot force a signature from Pierre, petitioner argues that choice (A) is the best course of action offered by the answer choices for Amy to undertake on her own.

Petitioner's arguments have been fully considered, but are not persuasive.

Petitioner is reminded that the instructions for the examination stated to not assume facts not stated. The facts in the question do not state that Pierre will refuse to sign the required petition. In addition, merely notifying the USPTO after the forty-five day time period will not change the fact that the application is abandoned. Therefore, following the action in answer (A) will not alter the status of Amy's application. In addition, by following the action in answer (A), Amy may not be able to file a petition and state that the entire delay was "unintentional." A requirement for such a petition is that the entire delay from the date the notification was due under 35 U.S.C. § 122(b)(2)(B)(iii) to the date a grantable petition was filed was unintentional. See 37 CFR 1.137(b) and (f).

Therefore, if Amy intentionally delays filing the petition, as suggested by petitioner, she might not be able to properly file the petition at a later time. Answer (D) is the only answer that will result in the revival of Amy's application. Accordingly, answer (D) is the most correct answer.

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

Afternoon question 4 reads as follows:

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

- A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.
- D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

The model answer is selection (B).

4. ANSWER: (B). Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner argues that B) is an incorrect answer because Charlie did not invent the fishing

device himself, and Petitioner argues that C) is the best of the remaining answers.

Answer C) is an incorrect answer because it improperly states that Sydney can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.

The affidavit or declaration would need to be made under 37 CFR 1.132 rather than under 37 CFR 1.131, because 37 CFR 1.131 clearly provides that “Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country.” Answer B) is the best answer because it states that Sydney “is precluded from antedating the date of the first public use in the United States.” An affidavit or declaration “antedating the date of the first public use” could not be filed under 37 CFR 1.131 because “prior invention” may not be established under 37 CFR 1.131 in any country other than the United States, a NAFTA country, or a WTO member country.

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

Afternoon question 32 reads as follows:

32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

The model answer is selection (E).

32. ANSWER: (E). As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner has argued that answers (C) and (D) are true, but answer (B) is not true because it did not include a petition under Rule 1.137. Therefore, Petitioner concluded that his answer choose (C) is the most correct answer.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that (D) is true because priority may be claimed under 35 U.S.C. § 119 rather than § 120. Petitioner is correct that a priority claim under 35 U.S.C. § 120 is not the only way to obtain benefit of priority based on an earlier filed patent application. For example, benefit may be obtained under 35 U.S.C. § 119(a)-(d) if the earlier application is a foreign application, benefit may be obtained under 35 U.S.C. 365(a) if the earlier application is an international application designating at least one country other than the United States, and benefit may be obtained under 35 U.S.C. § 119(e) if the earlier application is a provisional application. However, the DIRECTIONS provide: "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.” Accordingly, the reference to “an earlier filed patent application” and the reference to “an earlier filed application” in answer (D) refer to a regular (non-provisional) utility application, and not to an earlier filed provisional, earlier filed international, or earlier filed foreign application.

In response to Petitioner’s argument that answer (B) did not include a petition under Rule 1.137, the facts presented in the answer (B) show that the petition is made by the statement “the delay in making the payment is **shown** to be unavoidable” (emphasis added). The only method consistent with USPTO practice and procedure to make a showing is to file a written statement of facts to support the assertion that the delay was unavoidable. In addition, the petition fee was supplied by the statement “upon payment of a fee for delayed payment.” Therefore, since all the necessary requirements of 37 CFR 1.137(a) were met in answer (B), the answer is correct. Answer (E) is the best answer because both (B) and (C) are correct, and as provided in the DIRECTIONS, “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.”

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

Afternoon question 43 reads as follows:

43. A claim in your client’s patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

(A) The prior art is a U.S. patent issued five years before the effective date of your client’s application. In your client’s application, the claim is a generic claim. The

prior art clearly discloses a species falling within the claimed genus in your client's application.

- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

The model answer is selection (D).

43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With "Sufficient Specificity"). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific examples falling within the claimed, a case by case determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner argues that a composition "comprising copper oxygen and 15 mg of sulfur" is not necessarily the same as a composition "comprising copper, oxygen, and 15 mg. of sulfur." The persuasiveness of this argument turns on how "copper oxygen" has been defined in the client's application. Unless "copper oxygen" has been defined by the client to be something that does not include both copper and oxygen, (C) is an incorrect answer because the claimed composition is anticipated by the composition disclosed in the prior art. Because "copper oxygen" does not have any recognized meaning as a term of art, because the facts did not specify how "copper oxygen" was defined in the application, and because the "DIRECTIONS" included the instruction "Do not assume any additional facts not presented in the questions," answer (C) is an incorrect answer.

Answer (D) is a better answer because MPEP § 2131.03 specifically provides that "If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims." Petitioner has also argued that time management is one of the most important elements of success, and that because answer (C) comes before choice (D) in the order of answers, it is more likely that a test-taker will choose (C) instead of (D). The examinee has the burden of choosing the "most correct answer" from the choices given in the time allotted. There is no reason why an examinee should believe that any answer is more likely to be correct on the basis of the letter that precedes that answer.

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

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. 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