



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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AUG 12 2002

In re :

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 2, 18, 29, 35 and 49 of the morning section and questions 5, 7, 12, 33 and 44 of the afternoon section 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 sections of the Registration Examination. Petitioner scored 64. On February 6, 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 point for afternoon questions 5 and 12. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning questions 2, 18, 29, 35 and 49 and afternoon questions 7, 33 and 44. *Petitioner's arguments for these questions are addressed individually below.*

Morning question 2 reads as follows:

2. You are a registered practitioner. Earl, your new associate, has been assigned the task of filing information disclosure statements for patents and publications submitted by a client Tony, who is the named inventor on several patent applications, all of which were filed on or after January 1, 2001. Earl wants to know what information must be included on the information disclosure statements. Which of the following is not accurate with respect to proper USPTO procedure?

(A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English- language translation of a non-English- language document, or portion thereof, if it is within the possession, custody, or control of, or is readily available to any individual designated in 37 CFR 1.56(c).

(B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.

(C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. § 120; and (2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

The model answer is selection (B).

The application number of each U.S. patent is not required to be listed by 37 CFR 1.98(b)(1), which provides “(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.” The elements of (A) are found in 37 CFR 1.98 (a)(3)(ii). The elements of (C) are found in 37 CFR 1.98 (b)(5). The elements of (D) are found in 37 CFR 1.98(c). The elements of (E) are found in 37 CFR 1.98(d).

Petitioner argues that answer (E) is correct. Petitioner contends that 37 CFR 1.98 does not relate to whether an IDS in an earlier application was compliant and that the phrase "appropriate regulations" could mean anything.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 37 CFR 1.98 does not relate to whether an IDS in an earlier application was compliant and that the phrase "appropriate regulations" could mean anything, 37 CFR 1.98, a regulation appropriate to USPTO procedure, does, in fact, state "(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) **The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.**" Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

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

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?

(A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112.

(B) A claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.

(C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.

(D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are statutory natural phenomena.

(E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), *cert. denied*, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner argues that answer (C) is correct. Petitioner contends that selection (C) fails to refer to the single machine as a single device, that only one invention is allowed per patent, and that a computer would contain many devices.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (C) fails to refer to the single machine as a single device, that only one invention is allowed per patent, and that a computer would contain many devices, MPEP 2106 (IV)(B)(2)(a) states "The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture.", contrary to selection (C)'s assertion that only a single machine may be encompassed in a claim. The requirement for restriction against multiple inventions in a patent goes to the singularity of invention, not to that of the underlying embodiment. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

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

The following facts apply to Questions 29 through 32.

Kat Forrest has been a famous golf prodigy since childhood and currently enjoys phenomenal success on the professional golf tour, having won four straight major titles. Kat conceived, constructed and successfully tested a golfer's aid to help less-skilled players. Briefly, the aid includes a distance-finder that determines the precise distance from the golfer's ball to a target such as a fairway landing area or the hole. The aid obtains data concerning playing conditions (e.g., wind speed and direction, soil moisture,

etc.) from a series of sensors distributed throughout a golf course. A global positioning system provides accurate positional coordinates for the ball location and the target location. A user interface allows manual input of situational data (e.g., ball in divot) and permits the user to override system settings and sensor data. The golfer's aid also includes computer memory that stores performance data calibrated to a specific golfer. In use, a digital processor determines a suggested play based on playing conditions and golfer skill level, and automatically displays information concerning the suggested play (e.g., recommended golf club and preferred line of flight for the ball). Other information can be displayed in reply to user requests. Kat comes to you in September 2001 and asks you to prepare and file a patent application on her behalf. She informs you that she has shown the golfer's aid only to her caddie and only under terms of strict confidentiality, and that she finalized the design on June 5, 2001. Her golfer's aid has not been sold or offered for sale. She also informs you that she derived the general idea for the golfer's aid, in part, from (1) an article appearing in the July 2000 edition of a golf magazine concerning a commercial distance finder and (2) a customized personal digital assistant (PDA) she saw on a store shelf while traveling in Thailand in April 2001. The distance finder has been available for sale in the United States since August 2000. The customized PDA was first offered for sale in the United States on June 8, 2001, but has not been disclosed in any publication or patent document. You prepare a patent application with claims that you believe are likely to be found patentably distinct over the commercially available distance finder and the golf magazine article, either alone or in combination. The application is filed with the USPTO on September 17, 2001.

29. Which of the following statements is most true?

(A) Kat should disclose the golf magazine article to the USPTO for consideration by the examiner, but need not disclose information concerning the customized PDA.

(B) Kat need not disclose either the golf magazine article or information concerning the customized PDA to the USPTO for consideration by the examiner.

(C) Kat should disclose both the golf magazine article and information concerning the customized PDA to the USPTO for consideration by the examiner.

(D) Kat's observation of the customized PDA is not material to patentability because the observation took place in Thailand and the PDA was not offered for sale in the United States until June 2001, the PDA has not been described in a publication, and the PDA has not been patented.

(E) Kat's observation of the customized PDA cannot be material to patentability because golfer's aids are nonanalogous art.

The model answer is selection (C).

Regardless of whether the customized PDA or the golf magazine article qualifies as prior art under 35 U.S.C. § 102(a) and/or § 102(b), and despite the belief that the claims are patentably distinct, Kat's derivation of the idea for the golfer's aid from those sources raises a possible obviousness rejection under 35 U.S.C. § 103/102(f). See 37 CFR 1.56. Moreover, the go lf magazine article published more than a year before Kat's filing date and is therefore available as prior art under at least 35 U.S.C. § 102(b).

Petitioner argues that answer (B) is correct. Petitioner contends that neither the article nor the customized PDA are material to patentability.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that neither the article nor the customized PDA are material to patentability, Kat's derivation of the idea for the golfer's aid from those sources raises a possible obviousness rejection under 35 U.S.C. § 103/102(f) and the golf magazine article published more than a year before Kat's filing date and is therefore available as prior art under at least 35 U.S.C. § 102(b). Both (B) and (C) can be argued, but the question asks which is most true. 37 CFR 1.56 instructs the applicant as to the duty of candor and good faith, and although patents are presumed valid, that is a rebuttable presumption. Selection (C) responds to the duty of candor and good faith where selection (B) does not, and placing pertinent prior art in front of an examiner strengthens the presumption of validity against such art. 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 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).

(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 argues that answer (B) is correct. Petitioner contends that as a recalcitrant inventor, Pierre cannot be compelled to sign anything, so the selection in which Amy signs by herself is correct.

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 rescinding the nonpublication request after the forty-five day time period will not change the fact that the application is abandoned. Therefore, following the action in answer (B) will not alter the status of Amy's application. In addition, by following the action in answer (B), 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.

Morning question 49 reads as follows:

49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

- (A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.
- (B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.
- (C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.
- (D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.
- (E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

The model answer is selection (D).

(D) is correct and (A), (B), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application. ... (d)... If... the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation number for the application. This procedure does not obtain in the circumstance described in (B) inasmuch as the EFS copy of the application was not filed within one month of the mailing date of the first Filing Receipt including a confirmation number for the application.

Petitioner argues that answer (C) is correct. Petitioner contends that there is no evidence the applicant wanted the amended application to be published.

Petitioner’s arguments have been fully considered but are not persuasive. In the question, Joe did chose to have the amended application published through his act of filing the amended application via EFS. If applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. See 1241 O.G. 97 (Dec. 26, 2000). Currently, pre-grant publication is the only reason to file an amended application via EFS. Since Joe did timely exercise his option under 37 CFR 1.215(c), answer (C) is not a correct answer.

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

Afternoon question 7 reads as follows:

7. Izzy decides one day that the hydrogen fuel cell research in which he is engaged shows great potential and retains the services of a patent law firm. A patent application is promptly prepared and filed in the USPTO disclosing and claiming a hydrogen fuel cell wherein the electrodes employed to catalyze the hydrogen gas into positive ions and negative ions consist of a platinum catalyst. The original claims are fully supported by the application as filed. Two preliminary amendments are submitted after the original filing, but prior to initial examination. In the first preliminary amendment, the

specification, but not the claims, is amended to recite that the electrodes may consist of a niobium catalyst. In the second preliminary amendment, the specification and the claims are amended to recite that the electrodes may consist of an iridium catalyst. In the first Office action, the examiner determined that both amendments involve new matter and required their cancellation. In addition, the examiner rejected all the claims under 35 U.S.C. § 112, first paragraph on the ground that they recited elements without support in the original disclosure. Ultimately, the examiner issued a Final Rejection on the same basis. Based upon proper USPTO practice and procedure, which of the following is correct?

(A) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by appeal.

(B) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by petition.

(C) Review of the determination that the first preliminary amendment contains new matter is by appeal, and review of the determination that the second preliminary amendment contains new matter is by petition.

(D) Review of the determination that the first preliminary amendment contains new matter is by petition, and review of the determination that the second preliminary amendment contains new matter is by appeal.

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

The model answer is selection (D).

MPEP § 608.04(c) (“Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.”); see, also, MPEP § 706.03(o) (“In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.”). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that the claims could have contained means plus function language that could have been substantively altered by the first amendment, necessitating appeal.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that could have contained means plus function

language that could have been substantively altered by the first amendment, necessitating appeal, the fact pattern explicitly indicates that the claims were not amended and selection (A) would preclude review by petition, which is counter to MPEP § 608.04(c). There is no reason to assume that the claims are drafted in means plus function language, and, in any event, review of the first amendment is clearly by way of petition, because the amendment was to the specification, irrespective of whether the amendment also provides appealable matter. However, there generally would not be review of the first petition by appeal, particularly given that the review by petition would be dispositive of whether any claim ran afoul of 35 USC 112, first paragraph, by virtue of means plus function language. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

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

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

(A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

(B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

(C) Traverse the rejection arguing that the examiner does not create a prima facie case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

(D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.

(E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (C) is correct. Petitioner contends that it is more efficient to argue 35 U.S.C. § 103 which would implicitly argue 35 U.S.C. § 102, as an effort to reduce prosecution time.

Petitioner's arguments have been fully considered but are not persuasive. Afternoon question 33 states that "the examiner rejects claim 1 under 35 U.S.C. § 35 U.S.C. § 102(d) as anticipated by [the Foreign patent]." It does not indicate that the rejection was made under § 103(a). A reply to a rejection under 35 U.S.C. § 103(a) is not required under 37 CFR 1.111(b), because the examiner did not make a rejection under 35 U.S.C. § 103(a). A reply to the rejection the examiner did make under 35 U.S.C. § 102(d) is required. Answer (C) is not the best answer because it does not address the rejection under 35 U.S.C. § 102(d) set forth by the examiner. Answer (D) is the best answer because it does address the grounds of rejection set forth by the examiner in the Office action. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

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

Afternoon question 44 reads as follows:

44. A condition for patentability is that an inventor is entitled to a patent unless he has abandoned the invention. Your client has engaged in conduct or omissions that may or may not be construed as abandonment of her invention. In which of the following situations would it be proper for a patent examiner to conclude, in an *ex parte* proceeding, that an inventor has abandoned the invention?

(A) From the inventor's inaction, following conception, to do anything over a period of time to develop or patent his or her invention, the inventor's ridicule of another person's attempts to develop that invention, and the inventor's active show of interest in promoting and developing the invention only after successful marketing by another of a device embodying that invention.

(B) When acts of another can be imputed to the inventor as an intent to abandon the invention.

(C) From the inventor's delay alone in filing a first patent application for the invention.

(D) From an inventor's delay in reapplying for patent after abandonment of a previous patent application.

(E) From the inventor's act of disclosing but not claiming the subject matter in a previously issued patent, even though the inventor claims the subject matter in an another patent application that is filed within one year after the patent issued.

The model answer is selection (A).

35 U.S.C. § 102(c); MPEP § 2134, and see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 149 USPQ 420, 435 - 436 (E.D. N.C. 1966). (B) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991). (C) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Moore v. U.S.*, 194 USPQ 423, 428 (Ct. Cl. 1977). (D) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *Petersen v. Fee Int'l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974). (E) is not correct. 35 U.S.C. § 102(c); MPEP § 2134, and see *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

Petitioner argues that answer (B) is correct. Petitioner contends that it is possible that acts of another could be imputed to show intent of abandonment, given a hypothetical fact situation.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that it is possible that acts of another could be imputed to show intent of abandonment, given a hypothetical fact situation, selection (B) refers to imputing, not inferring, abandonment. As held in *Ex parte Dunne*, 20 USPQ2d 1479

(Bd. Pat. App. & Inter. 1991), " intent to abandon will not be imputed." Accordingly, model answer (A) 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.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. 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