



FEB 19 2002

In re	: : : DECISION ON : PETITION FOR REGRADE : UNDER 37 C.F.R. § 10.7(c) : :
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MEMORANDUM AND ORDER

(petitioner) received a grade of 65 on the April 18, 2001

Registration Examination, and petitions for regrading his answers to seven (7) questions consisting of: questions 17, 30, 35, 41, and 43 of the morning section and questions 41, and 49 of the afternoon section. Each question in the Registration Examination is worth one point. A petition fee of \$230 has been submitted.

Credit has been given for afternoon question 49 thereby producing a corrected score of 66.

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 from both the morning and afternoon sections of the Registration Examination. Petitioner's initial

combined score was 65. On July 16, 2001 petitioner requested regrading, arguing that the model answers to certain questions 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 C.F.R. § 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 PTO 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 certain of the model answers. All of petitioner's arguments have been fully considered.

Petitioner has been awarded an additional one (1) point for afternoon question 49. Accordingly, petitioner has been granted an additional one (1) point on the Registration Examination. No credit has been awarded for morning questions 17, 30, 35, 41, and 43 and afternoon question 41. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

17. Which of the following statements involving an examiner's statement of reasons for allowance in a Notice of Allowance dated February 8, 2001, is in accordance with USPTO rules and procedure?

(A) Failure by applicant or patent owner to file a statement commenting on the reasons for allowance cannot give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

(B) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement gives rise to the implication that the examiner agrees with applicant's statement.

(C) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement does not give rise to any implication.

(D) (A) and (C)

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.104(e) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54633 (September 8, 2000). As stated in 65 FR at 54633, middle column, "In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons..." Thus, (A) is incorrect. 65 FR at 54633, middle column, also provides, "That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement." Thus (B) is incorrect. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

Petitioner has not indicated what answer petitioner selected. A review of the examination booklet reveals that petitioner selected answer (B).

Petitioner believes that confusion occurred in regard to the expression "rise to implication." Petitioner admits that under the rules an examiner is not required to comment if the applicant files a statement responding to an examiner's reasons for

allowance, but that acquiescence on behalf of applicant to a reasons for allowance from the examiner does have implications under the rules. Petitioner, however, argues that there is nothing in the rules that amounts to a definition or ramification related to the phrase “implication” resulting from an action from the examiner (or lack thereof such as the failure to respond to comments from applicant regarding an examiner’s reason for allowance). Moreover, the wording in the model answer from 65 FR 54633 does not show the word “implication” or what legal ramifications would or could apply as a result of filing by the applicant comments on an examiner’s reasons for allowance where the examiner does not respond to applicant’s comments.

The basis for answer (C) is that there is no implication where an examiner does not comment on a response by applicant to an examiner’s reasons for allowance. This is exactly what Petitioner recognizes to be an absence in the rules (or otherwise) of any statement that would result in giving effect to a lack of response by an examiner. As the rules do not provide for any effect for the lack of response by an examiner to comments by applicant on the examiner’s reason for allowance, answer (B) cannot be the correct answer as answer (B) requires an effect, namely that an implication results that the examiner by her lack of response agrees with the comments made by applicant.

Petitioner takes issue with the appearance of the term “implication” in answer (C) of the question and the lack of the term “implication” in that part of the model answer and in the Federal Register to justify answer (C). The concept represented by answer (C) is clearly stated in the Federal Register that the fact that an examiner does not respond to an applicant commenting on a reasons for allowance does not mean that the examiner agrees with or acquiesces to applicant’s reasoning in applicant’s comments. That Petitioner did not comprehend that the use of the term “implication” in answer (C) represented a shorthand way of expressing the concept of the examiner not agreeing with or acquiescing to an applicant’s comments is not sufficient basis to give credit to Petitioner for selecting incorrect answer (B).

Answer (B) is not a correct answer.

Accordingly, no credit can be given for answer (B).

Morning question 30 reads as follows:

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

(A) A utility application was filed in October 1999. Following a restriction requirement, the applicant elected claims 1-5, and the examiner withdrew non-elected claims 6-10. After a final rejection of claims 1-5 in January 2001, the applicant may submit an

amendment canceling previously examined claims and present claims to the previously non-elected invention of claims 6-10 when filing a request for continued examination under 37 CFR § 1.114.

(B) Claims in an allowed application may be amended as a matter of right after payment of the issue fee inasmuch as the Office may not rule on amendment filed after a notice of allowance until after the period for payment of the issue fee has expired.

(C) If, at the time an application is allowed in January 2001, a corrected drawing is required or formal drawing is needed, the applicant is given a three month period in the notice of allowability to file the same, and is permitted to file corrected or formal drawings after payment of the issue fee upon filing a request of an extension of time and payment of the requisite fee.

(D) Where, after a final rejection, a request for continued examination complying with 37 CFR § 1.114, is filed in April 2001 accompanied by a request to suspend action by the Office for a period not exceeding three months to provide time to submit an information disclosure statement, and the requisite fees, the Office may grant the requested suspension.

(E) Where an examiner has finally rejected all the claims in a utility application in January 2001, and sets a three month shortened statutory period for reply, the Office may grant a request to suspend action by the applicant for a period not exceeding six months to provide time to gather and submit evidence, if the request and requisite fees are filed within the three month reply period.

The model answer is selection (D).

37 C.F.R. § 1.103(c). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50100, right column, Comment 11 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114. "An applicant may not obtain examination of a different or non-elected invention (e.g., a divisional) in a request for continued examination under § 1.114." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50102, left column, Comment 21 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.312. Amendments are not entered as a matter of right. Section 1.312 is not intended to be used for continued examination of applications. See MPEP 714.16. April 18, 2001 Examination Morning Session Model Answers 9 Any amendments considered necessary by the applicant should be completed before the notice of allowance is issued." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65

F.R. 50092, 50102, middle column, Comment 24 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 37 C.F.R. §§ 1.85(c) and 1.136(c)(2). The three-month period set in the notice of allowability for submission of any outstanding corrected or formal drawing is not extendable under 37 C.F.R. § 1.136(a) or (b). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50102, middle column, Comment 23 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.103(a). The Office will not suspend action if a reply by the applicant is due. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50101, left column, Comment 12 and response (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner selected answer (C). Petitioner argues that since the prohibition against extensions of time to submit a corrected or formal drawing more than three months from the period set in the notice of allowability can be waived by the Office if it deems fit, the answer is flawed.

The question required Petitioner to select the answer that is in accord with proper Office practice. Answer (D) is in accord with proper Office practice. The rules of practice prohibit the procedure set forth in answer (C). The facts set forth in answer (C) do not provide a basis for waiver of the three month requirement, which waiver standard is not that the Office sees fit to permit something not normally permitted, but that an extraordinary situation is presented where justice requires the relief requested. 37 CFR 1.183.

Answer (C) is not a correct answer.

Accordingly, no credit can be given for answer (C) .

Morning question 35 reads as follows:

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions. Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 USC § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The

Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001. Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26, 2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied. A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

35. In addition to the facts set forth in connection with the previous question, Joseph's application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Joseph submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) By requesting nonpublication of the application, Joseph "opted out" of the statutory framework for patent term extension and, therefore, no patent term extension is available.
- (B) Submission of the nonpublication request does not affect any patent term extension that might be available to Joseph.

(C) Joseph may rescind his nonpublication request at any time.

(D) Statements (A) and (C) are true.

(E) Statements (B) and (C) are true.

The model answer is selection (E).

Nonpublication of the application does not affect the patent term extension provisions of the Patent Term Guarantee Act of 1999. Thus, statement (B) is true. The patent term extension provisions of 37 CFR §§ 1.702 et seq. are separate and independent of the eighteen-month publication provisions. There is no support for statement (A). An applicant may rescind a nonpublication request at any time. See "37 CFR Parts 1 and 5 -- Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule," Federal Register Vol. 65, No. 183 (9/20/2000) at 57024, middle column. Thus, statement (C) is also true. Accordingly, the best answer is (E).

Petitioner selected answer (B), rather than the best answer, answer (E), which answer (E) recognizes that answer (C) as well as answer (B) is a correct statement of Office practice and procedure. Petitioner argues that answer (C) is an over generalization in that it permits rescinding of the nonpublication request at "any time." This is in opposition with the facts shown whereby the request is submitted at 18 months. Moreover, even if this is meant to imply that the request is submitted at the 18 month point, it may not be granted if the application has already published.

Preliminarily, the facts of morning question 35 clearly state that the nonpublication request was submitted at the time the application was filed, which is a statutory requirement and the only point in time that a nonpublication request may be filed. The reference in answer (C) to 18 months is a reference to when an application is to be published should it be subject to the statutory publication requirement and a timely nonpublication request is not submitted. In contrast to when a nonpublication request may be filed, a nonpublication request can be rescinded at any time. Obviously, there is potential that a request to rescind a nonpublication request may be made at a time too late for the rescision request to be acted upon. Nonetheless, the import of answer (C) is a recognition that rescision of a nonpublication request, unlike the nonpublication request itself, may be submitted at any time.

Answer (B) is not the best answer as answer (E) incorporates answers (B) and (C), which are both correct answers.

Accordingly, no credit can be given for answer (B).

Morning question 41 reads as follows:

41. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

(A) The expedited treatment available for design applications under 37 CFR § 1.155 expedites design application processing by, among other things, decreasing clerical processing time as well as the time spent routing the application between processing steps.

(B) The "petition to make special" procedure is also available for designs and the petition fee is less than the fee for expedited examination.

(C) To qualify for expedited examination: (1) the application must include drawings in compliance with 37 CFR § 1.84; (2) the applicant must have conducted a preexamination search; and (3) the applicant must file a request for expedited examination including: (i) The appropriate fee; and (ii) a statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with 37 CFR § 1.98.

(D) If the design application is not effectively expedited by the Office, the fee for expediting the application will be refunded.

(E) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.

The model answer is selection (D).

There is no such refund permitted since 35 U.S.C. 42(d) only permits a refund of any fee "paid by mistake or any amount paid in excess of that required." According to the statute, any refund of an "amount paid in excess" must be based upon an overpayment of a fee that was, in fact, required when the fee was paid. See "Changes to Implement the Patent Business Goals; Final Rule," 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000). As to (A) and (B), see "Changes to Implement the Patent Business Goals; Final Rule," 65 F.R. 54604, 54642 (center column) (September 8, 2000), 1238 Official Gazette 77 (September 19, 2000), which states: "[t]his procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps... . Further, the 'Petition to Make Special' procedure will continue to be made available without any anticipated increase in the required petition fee." As to (C), it contains all of the elements of 37 CFR § 1.155(a), which provides "(a) The applicant may request that the Office expedite the examination of a design application. To qualify for

expedited examination: (1) The application must include drawings in compliance with § 1.84; (2) The applicant must have conducted a preexamination search; and (3) The applicant must file a request for expedited examination including: (i) The fee set forth in § 1.17(k); and (ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98." As to (E), it contains all of the elements of 37 CFR § 1.155(b), which provides "(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section."

Petitioner selected answer (B). Petitioner argues that answer (B) is not in accord with proper Office practice in view of the presence of the conjunctive "and," since a petition to make special for designs is a false statement and therefore the entire sentence is false.

Petitioner appears to confuse the ability (availability) of a design applicant to choose either expedited treatment of the design application, or making the design application special, the gravamen of answer (B), with the need to choose one or the other (expedited or special treatment) as both would not be performed at once. Answer (B) is in accordance with proper Office practice as notwithstanding the newly available expedited treatment, a design applicant may alternatively continue to elect special treatment, an option that was not deleted upon providing expedited treatment.

Answer (B) is not a correct answer.

Accordingly, no credit can be given for answer (B).

Morning question 43 reads as follows:

43. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

The model answer is selection (C).

MPEP § 608.04(c) includes the following recitation: 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), which includes the following recitation: 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. [Note re Question 43, third line of factual background : Examination proctors were instructed to direct examination candidates to delete from the third line of the factual background the word -- in--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.]

Petitioner selected answer (A). Petitioner argues that rejections under law, as is taught in the regulations, are appealable, and therefore, answer (A) is the most proper answer.

Rejections are appealable, however, the examiner's treatment of amendment #1, an amendment of only the specification (and not the claims), would be an objection under 35 U.S.C. 132 rather than a rejection. MPEP 706.03(o). Accordingly, review of the treatment (objection) of amendment #1 (confined to the specification) would be by way

of a petition, while review of the treatment (rejection) of amendment #2 (of both the specification and the claims) would be by way of appeal, MPEP 608.04(c).

Answer (A) is not a correct answer.

Accordingly, no credit can be given for answer (A).

Afternoon question 41 reads as follows:

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

(A) Applicant's mailing address.

(B) Applicant's citizenship.

(C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.

(D) (B) and (C).

(E) All of the above.

(C) or (D) are accepted as correct answers.

37 CFR § 1.76(d) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant's mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant's citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if "applicant" in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

Petitioner selected answer (E). Answer (E) includes answer (A) regarding the

additional appearance of the mailing address in a declaration when it is supplied in an application data sheet. Petitioner argues that inclusion of the mailing address in the declaration would not be improper or questionable. As a matter of form it is desirable to provide such information in the declaration for completeness and accuracy.

The question asks must applicant's mailing address also be provided in the declaration if it is set forth in an application data sheet. As provided by 37 CFR 1.63(c)(1), the mailing address must be supplied in the declaration only if it has not been supplied in an application data sheet. Where a mailing address has been supplied in an application data sheet that information need not be repeated in the declaration. That the mailing address may be supplied in the declaration even though it has been supplied in an application data sheet is irrelevant to what the question has asked.

Answer (E) is not a correct answer.

Accordingly, no credit can be given for answer (E).

Afternoon question 49 reads as follows:

49. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

- (A) Status information is available for Application B, that is a continuation of an application A, when application A has been published under 35 U.S.C. § 122(b).
- (B) A person requesting status information may be provided the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier is available.
- (C) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).
- (D) A coinventor in a pending application may gain access to the application if his name appears as an inventor in the application, even if he did not sign the oath or declaration.
- (E) Notwithstanding the fact that only a redacted copy of an application has been published, a member of the public is entitled to see the entire application upon written request.

The model answer is selection (E).

Since a redacted copy of the application was used for publication purposes, 37 C.F.R. § 1.14 (c)(2) provides that "(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy." As to (A), (A) contains the elements of 37 C.F.R. § 1.14(b)(2), which reads "When status information may be supplied. Status information of an application may be supplied by the Office to the public if any of the following apply: ... (2) The application is referred to by its numerical identifier in a published patent document (e.g., a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section)." As to (B), (B) is within the purview of 37 C.F.R. § 1.14(a)(1)(iii) which states: "(a)(1) Status information is: ... (iii) The application "numerical identifier" which may be: (A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or (B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage." As to (C), (C) contains the elements of 37 C.F.R. § 1.14(c)(1)(i), which states "(c) When copies may be supplied. A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply: (1) Application-as-filed. (i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1)." As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 C.F.R. § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

Petitioner selected answer (B).

It has been determined that credit will be given for afternoon question 49 where a petitioner argues for answer (B).

Accordingly, credit is given to Petitioner for afternoon question 49 resulting in one (1) additional point.

ORDER

For the reasons given above, one (1) point has been added to petitioner's initial score of 65 on the Examination. Therefore, petitioner's corrected 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