



OCT 1 2001

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

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 3, 6, 14, and 31 of the morning section and questions 16, 20, and 25 of the afternoon section of the Registration Examination held on October 18, 2000. 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 66. On January 29, 2001, 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 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. Any reference to a practitioner is a reference to 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 subsequent court decision or a notice in the Official Gazette. 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 which 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 morning question 6. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 3, 14, and 31 and afternoon questions 16, 20, and 25. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing,

and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

I. The fee set forth in 37 C.F.R. § 1.17(i).

II. John's birth certificate showing his date of birth.

III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

(A) I

(B) II

(C) III

(D) II and III

(E) None of the above.

The model answer is selection (E).

MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that (A) is correct because (A) is the best answer amongst varying degrees of incorrectness, with the answer requiring a fee instead of a non-fee being highly preferred to save client's money. Petitioner alleges that he interprets the question to ask whether (A), (B), or (C) were sufficient without the petition.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the question is ambiguous, the question is not ambiguous. The question asks which of the following, singularly **or** in combination, submitted with the petition is **not** sufficient to result in the petition being granted. The question cannot be construed to exclude the submission of a petition. As enumerated supra, options (A), (B), and (C) are all singularly sufficient to allow for the granting of the petition. Accordingly, (D) must be sufficient as well. Because all of the choices A-D are sufficient to grant the petition, then the only correct answer must be (E). Accordingly, model answer (E) is correct and Petitioner's answer (A) is incorrect.

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

Morning question 14 reads as follows:

14. Jack, a registered patent agent, received a final rejection of all of the claims in an application directed to an article of manufacture. Jack is about to file a timely Notice of Appeal to the Board of Patent Appeals and Interferences. Before filing his notice of appeal, Jack would like to tie up some loose ends by amendment. Which of the following reply (replies) may he file without triggering the requirements of 37 C.F.R. § 1.116(b)?

- (A) A reply that presents his argument in a more defensible light and adds additional claims.
- (B) A reply amending the claims into process claims.
- (C) A reply amending all of the independent claims, accompanied by a declaration from the inventor.
- (D) A reply complying with a requirement of form expressly set forth in the previous Office action.
- (E) (A) and (D).

The model answer is selection (D).

37 C.F.R. § 1.116; MPEP § 714.13, Entry Not Matter of Right [p. 700- 118]. The reply in (D) is directed to a reply permitted to be made under 37 C.F.R. § 1.116(a). (A), (B), and (C) are directed to the merits of the application, and are not in accord with 37 C.F.R. § 1.116(a).

Petitioner argues that answer (E) is correct. Petitioner contends that there does appear room in 37 CFR § 1.116(a) to enter claims that do not constitute new matter (and touch on the merits which trigger the showing required by part (b)), if they were added as amended claims in order to get the issue in the record for later argument.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to Petitioner's statement that (E) is the most correct answer, the correct answer is (D). Answer (E) requires that both (A) and (D) not trigger the requirements of 37 CFR § 1.116(b). However, (A) would trigger the requirements of 37 CFR § 1.116(b) because (A) adds additional claims. Note that MPEP § 714.13 states that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR § 1.116) or reinstate previously canceled claims. Therefore, the addition of new claims triggers the requirements of 37 CFR § 1.116(b). Accordingly, model answer (D) 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 31 reads as follows:

31. Which of the following do not represent prior art?

(A) The preamble of a Jepson claim.

(B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.

(C) A doctoral thesis indexed, cataloged and shelved in a university library.

(D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.

(E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

The model answer is selection (D).

See MPEP § 2128 under the subheading "Date of Availability," of the heading "Electronic Publications As Prior Art." (A) is wrong. See MPEP § 2129 under the heading "A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art." (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public." (E) is wrong. See *In re Nomiya*, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading "Admissions By Applicant Constitute Prior Art."

Petitioner argues that answer (E) is correct. Petitioner contends that (E) is a worse choice than (D) because the figures could be prior art but not the "labeling" as such. Moreover, Petitioner argues that internet material can be used to support the state of the art with respect to time actually accessed/downloaded shown by time stamped ( or via server record trails).

Petitioner's arguments have been fully considered but are not persuasive. Petitioner is correct in his assertion that the internet material can be used to show state of the art. However, prior art is distinct from state of the art. Prior art disclosures on the Internet are considered to be publically available as of the date the item was publically posted. See MPEP § 2128. If the publication does not include a publication date (or retrieval date), it cannot be prior art. See MPEP § 2128. Internet disclosure without a publication date or retrieval date is not prior art under 35 USC §§ 102(a) or (b). Answer (D) is clearly a wrong answer. Petitioner argues that (E) is a worse answer because the label on the figure would not be prior art. The Office respectfully disagrees with Petitioner's assertion that the label on the figure would not be prior art because answer (D) expressly states that one of the figures were labeled as prior art. According to *Nomiya*, by filing an application containing figures labeled prior art, "appellants have conceded what is to be considered prior art." *In re Nomiya*, 184 USPQ 607 at 611-612. Accordingly, the figure labeled as prior art represent prior art and therefore (E) is not a correct answer. Accordingly, model answer (D) 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.

Afternoon question 16 reads as follows:

16. In June 1995 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 1997, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 1997. During the prosecution of the patent for the circuit board device, the practitioner files the following claims

11 and 12:

11. An electronic device comprising:  
circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:

- a) adapting a television remote control device to emit signals to open a garage door;
- b) pointing said television remote control device at said garage door; and
- c) actuating said television remote control to cause said garage door to open.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner is correct in his assertion that the internet material can be used to show state of the art. However, prior art is distinct from state of the art. Prior art disclosures on the Internet are considered to be publically available as of the date the item was publically posted. See MPEP § 2128. If the publication does not include a publication date (or retrieval date), it cannot be prior art. See MPEP § 2128. Internet disclosure without a publication date or retrieval date is not prior art under 35 USC §§ 102(a) or (b). Answer (D) is clearly a wrong answer. Petitioner argues that (E) is a worse answer because the label on the figure would not be prior art. The Office respectfully disagrees with Petitioner's assertion that the label on the figure would not be prior art because answer (D) expressly states that one of the figures were labeled as prior art. According to *Nomiya*, by filing an application containing figures labeled prior art, "appellants have conceded what is to be considered prior art." *In re Nomiya*, 184 USPQ 607 at 611-612. Accordingly, the figure labeled as prior art represent prior art and therefore (E) is not a correct answer. Accordingly, model answer (D) 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.

Afternoon question 16 reads as follows:

16. In June 1995 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 1997, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 1997. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising:  
circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:  
a) adapting a television remote control device to emit signals to open a garage door;  
b) pointing said television remote control device at said garage door; and  
c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

- (A) Since the television and remote control were sold in June 1995, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.
- (B) Although the device was bought in June 1995, Michael did not use it to open a garage door until 1997. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1995, and 35 U.S.C. § 102(b) does not apply.
- (C) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.
- (D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.
- (E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

The model answer is selection (C).

When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. Cf. *Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), *aff'd*, 456 F.2d 592, 172 USPQ 324 (CA 3), *cert. denied*, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (B), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (B) is correct. Petitioner contends that the term circuitry is defined in terms that further limit the claim to include uses for garage and for TV. Petitioner argues that claim 11 is not barred by 35 USC 102(b) because of the limitation that the program invention signals both a TV and a garage.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the correct answer is (B), the correct answer is (C). Claim 11 is directed to an article of manufacture, not a method claim. Claim 11 includes intended use recitations. However, in apparatus, article, and composition claims, intended use must result in a structural difference in order to patentably distinguish the claimed invention from the prior art. See MPEP § 2111.02. If the prior art structure is capable of performing the intended use, then it meets the claim. In the present question, the circuitry was preexisting. There are no structural differences. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

Please answer questions 19 and 20 based on the following facts:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling.

Afternoon question 20 reads as follows:

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 2.
- (E) None of the above.

The model answer is selection D.

Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that claim 2 is indefinite and therefore the correct answer is (E). Petitioner argues that claim 2 is indefinite because the claim does not say whether the “%” is related to mass, volume mole, or weight?

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claim 2 is indefinite, both claims 1 and 2 are definite. Specifically, claim limitations are read in light of the specification. The specification suggest that the unit of measure is parts by weight. Accordingly, claim 2, read in light of the specification would suggest that the percentage is in parts by weight percentage and therefore be definite. Claim 1 is definite. Because claims 1 and 2 could not be rejected as being indefinite, Answer (E) is not a proper answer. Accordingly, model answer (D) 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.

Afternoon question 25 reads as follows:

25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.

II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.

III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

- (A) I
- (B) II
- (C) III
- (D) I and II
- (E) None of the above.

The model answer is selection B.

MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that (D) is the correct answer because both I and II are correct statements. Petitioner contends that situations may arise where a traversal of the "well known" prior art may be seasonable and yet not be in the next Office action.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments, an applicant who does not seasonably traverse the well known statement during examination will have the object of the well known statement taken to be prior art. A seasonable challenge constitutes a demand for evidence made as soon as practical during prosecution. See MPEP § 2144.03. In order to be a seasonal response, Applicants are charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. See MPEP § 2144.03. Rebutting the well known statement in the next Office action is necessary because the examiner must be given the opportunity to provide the evidence required in the next Office action in which the well known statement was made. See MPEP § 2144.03. Therefore, I is not a correct statement. Because I is not a correct statement, the answer D is incorrect. Accordingly, model answer (B) is correct and

Petitioner's answer (D) is incorrect.

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

**ORDER**

For the reasons given above, 1 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.



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