



SEP 5 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 8 and 46 of the morning section and questions 5, 7, 18 and 20 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 65. On February 2, 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.

No credit has been awarded for morning questions 8 and 46 and afternoon questions 5, 7, 18 and 20. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.
- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

The model answer is selection C.

See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that if a dependent product claim is redrafted as a product by process claim then it would be considered a broadening claim.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that if a dependent product claim is redrafted as a product by process claim then it would be considered a broadening claim, the instructions state "Do not assume any additional facts not presented in the questions." There is no reason to assume that the dependent claim mentioned in selection (D) is a product by process claim. Selection (D) states that a dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent, i.e., may not be broadened in a reissue application after the first two years of the enforceable life of the patent. This is not true as MPEP § 1412.03, p.1400-13 makes clear. A broadened dependent claim will generally incorporate all the limitations of its parent claim, in which case, such broadening may be made over two years from patent issue. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 46 reads as follows:

46. Which of the following statements regarding an applicant's duty to submit a drawing in a U.S. patent application is true?

I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.

II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.

III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

- (A) I
- (B) II
- (C) III
- (D) II and III
- (E) I, II, and III

The model answer is selection D.

35 U.S.C. § 113; MPEP § 608.02(a), under heading "Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113," p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

Petitioner argues that answer (E) is correct. Petitioner contends that selection (I) is also true because 35 USC 113 and MPEP 601.01(f) require a drawing where necessary for understanding of the invention.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (I) is also true because 35 USC 113 and MPEP 601.01(f) require a drawing where necessary for understanding of the invention, selection (I) states that the examiner may only require a drawing where the drawing is necessary for the understanding of the invention, i.e. the examiner may not require a drawing where a drawing is not necessary. This is not true, the examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). This may be

the case where a drawing is not actually necessary, which renders selection (I) incorrect. 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 5 reads as follows:

5. Which of the following is a proper basis for establishing a substantial new question of patentability to obtain reexamination in accordance with proper USPTO practice and procedure?

(A) An admission per se by the patent owner of record that the claimed invention was on sale, or in public use more than one year before any patent application was filed in the USPTO.

(B) A prior art patent that is solely used as evidence of an alleged prior public use.

(C) A prior art patent that is solely used as evidence of an alleged insufficiency of disclosure.

(D) A printed publication that is solely used as evidence of an alleged prior offer for sale.

(E) None of the above.

The model answer is selection E.

35 U.S.C. § 302; MPEP § 2217. The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon 35 U.S.C. § 102(a), (b), (d) and (e), new questions of patentability under 35 U.S.C. § 103 that are based on the foregoing indicated portions of 35 U.S.C. § 102, and substantial new questions of patentability may be found under 35 U.S.C. §§ 102(f)/103 or 102(g)/103 based on the prior invention of another disclosed in a patent or printed publication. (A) is incorrect. MPEP § 2217. An admission, per se, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication. (B), (C), and (D) are incorrect. A prior art patent cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, or insufficiency of disclosure.

The prior art patent must be applied directly to claims under 35 U.S.C. § 103 and/or an appropriate portion of 35 U.S.C. § 102 or relate to the application of other prior art

patents or printed publications to claims on such grounds.

Petitioner argues that answer (C) is correct. Petitioner contends that (C) would be correct if during the course of prosecution the examiner raises the question of enablement of the disclosure under 35 U.S.C. 112, first paragraph.

Petitioner's arguments have been fully considered but are not persuasive. MPEP § 2217 states "[o]ther matters, such as public use or sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, fraud, etc., will not be considered when making the determination on the request and should not be presented in the request. Further, a prior art patent or printed publication cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or sale, insufficiency of disclosure, etc. The prior art patent or printed publication must be applied directly to claims under 35 U.S.C. 103 and/or an appropriate portion of 35 U.S.C. 102 or relate to the application of other prior art patents or printed publications to claims on such grounds." Prior art patent may not be properly applied as a ground for reexamination if it is merely used as evidence of insufficiency of disclosure. Accordingly, model answer (E) 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 7 reads as follows:

7. Which of the following is true?

(A) Once an application is ready to be issued, there is a public policy that the patent will issue in regular course once the issue fee is timely paid. In accordance with the foregoing, issuance of a patent may not be deferred.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended.

(C) While anyone may file a request for ex parte reexamination, a patent practitioner filing a request for ex parte reexamination must disclose the client's name.

(D) It is necessary to claim priority under 35 U.S.C. § 120 to earlier filed applications for which a corresponding claim of priority has been made in the corresponding foreign filed applications of the same applicant.

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

The model answer is selection B.

See 35 U.S.C. § 151; MPEP § 1306. As to (A) see MPEP § 1306.01. As to (C) see MPEP § 2212. As to (D), the claim for priority is not required as a person may not wish to do so in order to increase the term of his or her patent. Since (A) and (C) are incorrect, (E) is incorrect.

Petitioner argues that answer (A) is also correct. Petitioner contends that the use of “may not be deferred” in (A) is permissive rather than exclusionary.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the use of “may not be deferred” in (A) is permissive rather than exclusionary, MPEP § 1306.01 states that issuance of a patent cannot be deferred after an allowed application receives a patent number and issue date unless the application is withdrawn from issue under 37 CFR 1.313(b). This language is permissive in the case of a petition. Accordingly, model answer (B) 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 18 reads as follows:

18. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1997. Sally’s spot remover was made from water, chlorine, and lemon juice. On June 2, 1997, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally’s assignment was not recorded in the USPTO, but was referred to in her application. On June 12, 1998, Jane, also an employee of Ted, having no knowledge of Sally’s spot remover, conceived of and reduced to practice a spot remover for Ted. Jane’s spot remover was made from carbonated water, chlorine, and lemon juice. On May 26, 1998, the USPTO granted Sally a patent. On November 6, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane’s application, Jane assigned the entire rights in her application to Ted. Jane’s assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in October 2000, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally’s patent?

I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.

II. A copy of Sally’s assignment to Ted, clearly indicating that common ownership of

Jane's and Sally's inventions existed at the time Jane's invention was made.

III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.

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

The model answer is selection E.

Sally's patent is prior art under 35 U.S.C. § 102(a) and cannot be disqualified by a showing of common ownership, which can be used to disqualify prior art under 35 U.S.C. 102(f) and (g). 37 C.F.R. § 1.104(a)(5); MPEP §§ 706.02(l) ("If the subject method qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a) . . .) it will not be disqualified as prior art under 35 U.S.C. 103."), and 706.02(l)(2).

Petitioner argues that answer (D) is correct. Petitioner contends that the distinction between water and carbonated water in the two applications makes the rejection a 35 U.S.C. 103 rather than 35 U.S.C. 102 rejection, and therefore the common ownership properly evidenced in answer (D) would overcome the rejection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the distinction between water and carbonated water in the two applications makes the rejection a 35 U.S.C. 103 rather than 35 U.S.C. 102 rejection, and therefore the common ownership properly evidenced in answer (D) would overcome the rejection, Sally's patent is prior art under 35 U.S.C. 102(a) and cannot be disqualified under 35 U.S.C. 103(c). The petitioner is raising an irrelevant issue. The fact pattern admits the distinction asserted by the petitioner and correctly indicates that a 35 U.S.C. 103 rather than 35 U.S.C. 102 rejection is made. The issue is whether Sally's patent can be disqualified under 35 U.S.C. 103(c) by a showing of common ownership. Jane did not conceive and reduce the invention to practice until after Sally's patent issued. Therefore, Sally's patent, as a part of a rejection under 35 U.S.C. 103, was a reference that qualifies as a prior art under 35 U.S.C. 102(a). Accordingly, model answer (E) 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.

Afternoon question 20 reads as follows:

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.

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 (B) is correct. Petitioner contends that claim 1 would be properly rejected pursuant to 35 U.S.C. 112, second paragraph because the phrase “six parts C by weight” is indefinite.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claim 1 would be properly rejected pursuant to 35 U.S.C. 112, second paragraph because the phrase “six parts C by weight” is indefinite, the phrase “by weight” modifies C on its face, and not A and B as argued by petitioner. Accordingly, model answer (D) 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, no point have been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. 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