



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 11 and 50 of the morning section and questions 2, 36 and 43 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 31, 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 one (1) point for morning question 50. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning question 11 and afternoon questions 2, 36 and 43. Petitioner's arguments for these questions are addressed individually below.

Morning question 11 reads as follows:

11. An Office action issued with a three month shortened statutory period for reply. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 C.F.R. § 1.17 to applicant's deposit account. The applicant knew at the time the amendment was filed that a two-month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

- (A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.
- (D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (E) None of the above.

The model answer is selection C.

37 C.F.R. § 1.136; MPEP § 710.02(e), p. 700-77. (A) and (B) are not true because the amendment is treated as timely. There is no authority for (D). (E) is untrue because (C) is true.

Petitioner argues that answer (B) is correct. Petitioner contends that since the petition does not include the proper request for a two month extension of time and it is not clear from the facts provided that all of the requirements of 37 CFR § 1.136(a)(3) are met that the application should go abandoned. Specifically, petitioner argues that the applicant has not previously submitted a written request to treat a reply requiring an extension of time as incorporating a petition for such extension of time nor has he previously filed an authorization to charge all fees or all required extension fees.

Petitioner's arguments have been fully considered but are not persuasive. If a petition for an extension of time requests an insufficient period of extension such that the petition would be filed outside the so-extended period for reply, but the period for reply could be further extended under 37 CFR 1.136(a) such that the petition would be filed within the further extended period for reply, it is the Office practice to simply treat the petition for extension of time as requesting the period of extension necessary to make the petition filed within the further extended period for reply if the petition or application contains an authorization to charge extension fees or fees under 37 CFR 1.17 to a deposit account. See MPEP § 710.02. 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. 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.

Afternoon question 2 reads as follows:

2. Which of the following is not a proper incorporation by reference in an application prior to allowance according to USPTO rules and procedures?

- (A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.
- (B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.
- (C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.
- (D) Incorporating non-essential material by reference to a hyperlink.
- (E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

The model answer is selection D.

MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications.

(B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

Petitioner argues that answer (E) is correct. Petitioner contends that since the question does not state whether or not the material is essential, it could be essential subject matter and that essential matter may not be incorporated by reference to a publication which itself incorporates essential subject matter by reference. See MPEP §608.01(p)(I)(a).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (E) is a correct answer because the material could be essential material, (E) specifically states that the incorporating material is for indicating the background of the invention, which is non-essential. Furthermore, the instructions state "[d]o not assume any additional facts not presented in the questions." Thus, petitioner should not assume that the material is essential. 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 36 reads as follows:

36. The following statements relate to "multiple dependent claims." Which statement is not in accord with proper USPTO practice and procedure?

(A) A multiple dependent claim contains all the limitations of all the alternative claims to which it refers.

(B) A multiple dependent claim contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration.

(C) A multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.

(D) Restriction may be required between the embodiments of a multiple dependent claim.

(E) The limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately.

The model answer is selection A.

The answer is inconsistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (B), (C), and (E) are wrong answers because they are consistent with 35 U.S.C. § 112 and MPEP § 608.01(n), subpart I.B.4. (D) is wrong because it is consistent with MPEP § 608.01(n), subpart I. C.

Petitioner argues that answer (B) is correct. Petitioner contends that the statement is inconsistent because the dependent claim itself can introduce additional features which do not necessarily limit the features provided in the claim from which it depends. See 37 CFR 1.75(c).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (B) does not allow the addition of a new feature, it states that in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration (i.e., limited to those limitations drawn to the same embodiment). Selection (B) does not state that the dependent claim can not add additional features. See MPEP § 608.01(n)(I)(B)(4). 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.

Afternoon question 43 reads as follows:

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

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

The model answer is selection D.

MPEP § 2173.05(h). *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that both cited cases in the model answer use Markush groups. Petitioner argues that neither claims 1 nor 3 are Markush claims and it is not clear from the MPEP or from the cases cited whether a non-Markush claim using the word “optionally” is definite within 112.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claims 1 and 3 are indefinite, the claims are definite because “optionally” expression is acceptable alternative language since there is no ambiguity as to which alternatives are covered by the claim. See *Ex part Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989) and MPEP 2173.05(h)III. Petitioner misinterprets the MPEP 2173.05(h) entitled “Alternative Limitations.” The MPEP set forth that subsection I entitled “Markush Groups” applies to Markush Groups, subsection II entitled “‘OR’ Terminology” applies to any claim that uses the “or” expression, and subsection III entitled “Optionally” applies to any claim that uses the “optionally” expression. Subsections II and III are not limited to Markush Groups. 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.

ORDER

For the reasons given above, one (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.



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