



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 her answers to questions 8, 19 and 25 of the morning section and questions 7, 16, 21 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 67. 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, 19 and 25 and afternoon questions 7, 16, 21 and 25. 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 also correct. Petitioner contends that a dependent claim may only be broadened after two years where an expressed intent is made within the first two years, which is not in the fact situation.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a dependent claim may only be broadened after two years where an expressed intent is made within the first two years, which is not in the fact situation, a dependent claim, when broadened, will retain all the limitations of its parent claim and thus will not be more broad than the original patent, and can therefore be performed after two years, even absent expressed intent to broaden a patent within two years. MPEP § 1412.03, p.1400-13. 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 19 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

(A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.

(B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.

(C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.

(D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.

(E) (C) and (D) are each an appropriate way to correct the named inventive entity.

The model answer is selection C.

Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that both (C) and (D) are appropriate, resulting in (E) being the best answer because it may be assumed ManCo gave its written consent.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that both (C) and (D) are appropriate, resulting in (E) being the best answer because it may be assumed ManCo gave its written consent, the instructions specifically state "Do not assume any additional facts not presented in the questions." Contrary to petitioner's assertion that even answer (C) requires an assumption that a new oath or declaration is required, such an oath or declaration is inherent in the filing of a continuation in answer (C), requiring no assumption. Accordingly, model answer (C) 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 25 reads as follows:

25. In June 1997, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1997, when Jack returns to the United States he begins to make and sell a identical knife to the one seen in Vietnam. In July 1998, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife, and Jack is awarded a patent in December 1999. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack had a duty under 37 C.F.R. § 1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (B) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

The model answer is selection B.

Answer (B) is not true since Jack was not the first to invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f) ; MPEP § 2137. Answer (A) is correct in that Jack should have disclosed "all information material to patentability," including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the

inventor's own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

Petitioner argues that answer (A) is also correct. Petitioner contends that the absence of complete identity between knives absolves Jack of any duty to disclose his discovery.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the absence of complete identity between knives absolves Jack of any duty to disclose his discovery, the duty is predicated on materiality toward patentability and good faith. Near identity of prior art to a claimed invention presents a prima facie case of unpatentability, at least under 35 USC 103. There is no reason to assume the differences are substantial enough to avoid a good faith test in bringing the art to the examiner's attention. 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 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 (D) is also correct. Petitioner contends that it is reasonable to assume that there is a desire to claim priority, under which (D) is true in order to perfect such priority. Petitioner also argues that answer (B) is not correct because the issue fee may be accepted if the delay in payment is shown to have been unavoidable. Petitioner concludes that 35 U.S.C. 151 explicitly provides for an extension.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that it is reasonable to assume that there is a desire to claim priority, under which (D) is true in order to perfect such priority, the instructions specifically state "Do not assume any additional facts not presented in the questions."

Contrary to petitioner's assertion that even answer (B) is not true because 35 U.S.C. 151 allows an issue fee to be accepted late where unavoidably delayed, this does not constitute an extension of time. The application will be abandoned if the payment of issue fee is not timely made. A petition to revive the application abandoned for failure to timely pay the issue fee under 37 CFR 1.137 and appropriate petition are required to accept late payment. Extensions of time require no showing of unavoidability. 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.

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 also correct. Petitioner contends that claim 11 is for the use of the claimed apparatus and because the use as an opener was not preexisting, 35 USC 102(b) is inapplicable.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that claim 11 is for the use of the claimed apparatus and because the use as an opener was not preexisting, 35 USC 102(b) is inapplicable, claim 11 is a claim for an apparatus, not a method of use. As stated in *Monsanto Co. v. Rohm & Haas Co*, an old product with a new use cannot be patented but rather the new use must be patented. The product in claim 11 was clearly preexisting according to the facts specified. As to petitioner's assertion that *Monsanto* did not make a holding as to 35 USC 102(b), *Monsanto* later states "We have decided that the chemical compound 3,4-DCPA was described in printed publications before May 27, 1956 within the meaning of sections 102(a) and (b) and therefore was anticipated. It is clear that a specific description of a chemical compound or of its formula in the prior art is an anticipation of any claim to that compound even if the prior reference contains no method at all for its production." 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 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make an amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (E) is correct. Petitioner contends that (B) is equally likely to lead to the most favorable result because the fact situation suggests the case is otherwise ready for issue and MPEP § 608.02(r) says that the case cannot be corrected unless the case is otherwise ready for issue unless the changes are on a separate letter.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (B) is equally likely to lead to the most favorable result because the fact situation suggests the case is otherwise ready for issue and MPEP § 608.02(r) says that the case cannot be corrected unless the case is otherwise ready for issue unless the changes are on a separate letter, MPEP § 608.02(r) first says "Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a separate letter." No exception is listed. Even if the application is otherwise ready for issue, failing to follow the MPEP instructions cannot be as likely to lead to the most favorable result as following the instructions. The question asks about likelihood. Accordingly, model answer (C) 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 (I) is also correct because it is reasonable to interpret "at any time during the prosecution" as meaning at the next response to the current Office action.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (I) is also correct because it is reasonable to interpret "at any time during the prosecution" as meaning at the next response to the current Office action, the phrase "any time" is unrestricted and therefore cannot be interpreted as being restricted to the next reply. Any time not seasonable will render (I) false. 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, no 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