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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JAN 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 3 and 11 of the morning section, and questions 10, 16 and 48 of the afternoon section of the Registration Examination held on April 12, 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 July 18, 2000, 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, all regrade requests have been considered in the first instance by the Director of the USPTO.

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," "PTO," or "Office" are used in this examination, they mean the U.S. 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 credit for morning question 20. Accordingly, petitioner has been granted one additional point on the Examination. However, no credit has been awarded for morning questions 3 and 11, nor afternoon questions 10, 16 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E). Choice (E) is correct because both (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. Choices (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (B) is incorrect and therefore answer (D) alone is correct. Petitioner contends that (B) would be true only in situations in which a fee is required for the additional multiple dependent claim.

Petitioner's argument has been fully considered but is not persuasive. MPEP 608.01 (n) (top of p. 600-65) states:

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not

be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the amended claims.

Contrary to petitioner's characterization of answer (B), it does not state that a fee must be received with the amendment which adds the multiple dependent claim. Answer (B) only states that the multiple dependent claim should not be entered until the proper fee has been received by the PTO. As petitioner states in his arguments, and as acknowledged in the above quoted section of the MPEP, the "proper fee" may be covered by fees which have already been received by the PTO. Such fees may have been paid due to the presence of a prior multiple dependent claim in the application. However, this does not conflict with answer (B), which is a true statement. The multiple dependent claim should not be entered until the proper fee has been received by the PTO, whether such fee is first paid with the amendment, or is covered by fees previously received by the PTO. Accordingly, both answers (B) and (D) are correct, rendering answer (E) correct. The statement in answer (E) is the most correct for including both answers (B) and (D). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United

States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C)

The model answer is choice (E), which includes (A), (B) and (C). Mario can rely on his activities in both (A) Canada (a NAFTA country) and (B) Germany (a WTO member country) in establishing a date of invention in a priority contest against another inventor. Mario can also rely on his activities in Canada (a NAFTA country) in establishing a date of invention prior to publication of the regional Canadian magazine article (choice (C)).

Petitioner argues that choice (B) is the most correct answer. Petitioner appears to argue that choices (A) and (C) are incorrect, and thus choice (E) is incorrect. Petitioner appears to argue that since the invention was not reduced to practice until March 17, 1999, Mario cannot rely on his activities in Canada prior to the February 1, 1999 publishing date of the magazine article to establish a prior date of invention. Petitioner argues that since invention requires both conception and reduction to practice, Mario cannot establish a date of invention prior to the actual reduction to practice without a showing of due diligence. Further, petitioner argues that there is no evidence of due diligence in the statement of facts on which the question is based.

Petitioner's arguments have been fully considered but they are not persuasive. As an initial

matter, it is pointed out that if petitioner's "lack of due diligence" argument for choices (A) and (C) was accepted, then choice (B) (which petitioner selected) would be incorrect also. However, the answers do not address the issue of whether there was "due diligence" or not. The answers only state that Mario **may rely on his activities in Canada and Germany** in establishing a date of invention, **NOT** whether such a date of invention could ultimately be established (which would include evidence of "due diligence"). While the reduction to practice occurred after the date of publication of the article, Mario **may** rely on his activities in Canada in establishing his date of invention. Note that in order to ultimately establish such date of invention, a showing of conception and due diligence prior to the date of publication of the article would be required. See 37 CFR 1.131 and MPEP § 715 and § 715.07. However, the answers only state that he **may** rely on his activities in Canada and Germany, **not whether a date of invention will ultimately be established**. Since, the article is a publication of Mario's own work and not a statutory bar, he may rely on his activities in Canada. See 35 U.S.C. § 104 and MPEP § 715.01(c) and § 715.07(c). Choice (E) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems

and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B). Sam should do nothing, and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2-10 is confirmed.

Petitioner argues that none of the answers are correct. Petitioner appears to argue that choice (B) is not correct because the client should be kept informed and his interests protected. Petitioner cites ABA Model Rule 1.4 and 37 CFR 10.23 in support of this position.

Petitioner's arguments have been fully considered but they are not persuasive. As an initial matter, note that the ABA Model Rules are not applicable to this examination. The rules found in part 10 of 37 CFR address conduct of practitioners registered to practice before the PTO. Contrary to petitioner's contention, Sam (the practitioner) has not failed to keep the client informed. Sam has been told by his client that they do not have funds to continue prosecution. If Sam does nothing, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since Sam agrees with the propriety of the rejection of claim 1, the client is not prejudiced, nor is it adversely affected. The facts state

that Sam received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client. The client then advised Sam that they have no funds available to further prosecute the reexamination proceeding. Thus, the client is aware of the office action and Sam's agreement with the Examiner. No papers need to be filed with the PTO to preserve the client's rights. Therefore, the client is informed, and his interests are protected. Choice (B) is the correct answer.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner argues that the most correct answer is choice (E), because (A), (B), (C) and (D) are each incorrect. Petitioner argues that none of the statements regarding the relevance of “nearly simultaneous invention” by Debbie and Billie are correct. Petitioner asserts that since MPEP 2141.03 does not refer to “nearly simultaneous invention” as being evidence of the level of skill in the art, choice (B) is not correct. Petitioner further argues that since the MPEP, PCT, U.S. patent statutes, patent rules, and case law (listed in the examination instructions) do not refer to or support “nearly simultaneous invention”, choices (A), (B), (C) and (D) are incorrect.

Petitioner’s arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. See *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) (...evidence of contemporaneous invention is probative of “the level of knowledge in the art at the time the invention was made.”). See Also *International Glass Co. v. U.S.*, 159 USPQ 434, 442 (US Cl Ct 1968) (The fact of nearsimultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.). Choice (B) finds clear support in the cited case law. Therefore, choice (B) is correct, and choice (E) is incorrect.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the “gist” of the invention, even where the “gist” does not take into regard an express limitation in the claims.
- (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
- (E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice is (D). With respect 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (B). Petitioner argues that since ascertaining the differences between the prior art and the claims is one of the factual inquiries enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), choice (B) is also correct.

Petitioner’s arguments have been fully considered but they are not persuasive. Choice (D) is the most correct answer. “In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”

In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 (section styled,

“Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”).

In regard to choice (B), the question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Petitioner correctly states that ascertaining the differences between the prior art and the claims is **one of** the factual inquiries in determining obviousness under 35 U.S.C. § 103. Contrary to petitioner's contention, that is not the statement set forth in choice (B). Choice (B) states that the question of obviousness under 35 U.S.C. § 103 is **resolved** by determining whether the differences between the prior art and the claims would have been obvious. However, as petitioner acknowledges, the differences between the prior art and the claims is only **one of** the factual determinations to be made under *Graham v. Deere*. The **resolution** of the issue of obviousness under 35 U.S.C. § 103 is not "whether the differences between the prior art and the claims would have been obvious", but rather "whether the claimed invention as a whole would have been obvious". Choice (B) is not the most correct answer.

No error in grading has been shown as to morning questions 3 and 11, and afternoon questions 10, 16 and 48. Petitioner's request for credit on these questions is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr.

Worley's examination answers as correct when the answers did not conform with the USPTO's

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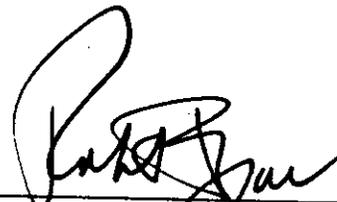
Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.).

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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