



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 her answers to questions 3 and 7 of the morning section, and questions 1, 6, 10, 16 and 17 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 19, 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.

No credit has been awarded for morning questions 3 and 7, and afternoon questions 1, 6, 10, 16 and 17. 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 argues that answer (B) is incorrect because it contains an ambiguity. Petitioner contends that answer (B) is ambiguous since it is not clear from the answer whether additional fees were due, or whether fees already paid cover the cost of the amended claims.

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 contain an ambiguity. Choice (B) 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 acknowledges in his arguments, and as stated 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. There is no ambiguity in answer (B). 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 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge

for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"

(E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and"

The model answer is choice (B). Answer (B) provides proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2, and "said connector" in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for "said connector" in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not "most broadly" complete claim 1. Answer (D) is incorrect

because it does not provide proper antecedent basis for "said mid-point" in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for "said connector" in Claim 3.

Petitioner argues that answer (D) is the most correct answer. Petitioner contends that the question asks for an answer that most broadly completes the missing paragraph (iii) of claim 1 and that answer (D) does this and also provides antecedent basis for the "connector". Petitioner argues that answer (D)'s lack of support for "said midpoint" should not matter since there is confusion of the two mid-points referenced in paragraph (iv) of claim 1. Petitioner also contends that answer (B) is incorrect because it only includes support for "a mid-point" and does not distinguish the term for the first and second cutting members.

Petitioner's argument has been fully considered but is not persuasive. The examination instructions specifically provide that "[t]he 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*." Answer (D) is incorrect because claims 1 and 2 would be rejected under 37 U.S.C. 112, second paragraph for lack of antecedent basis for the phrase "said mid-point". Also see MPEP 706.03(d). As acknowledged by petitioner, answer (D) does not provide proper antecedent basis for "said mid-point" in paragraph (iv) of Claim 1 and in Claim 2.

In regard to answer (B), support is provided in answer (B) for the mid-points of both the first and second cutting member. Contrary to petitioner's statement that answer (B) does not

distinguish between the mid-points of the first and second cutting members, answer (B) specifically states that “said first cutting member **having a mid-point** between its ends and said second cutting member **having a mid-point** between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other **at their respective mid-points** by a connector; and”. The phrase “said mid-point” in paragraph (iv) of claim 1 is specifically the mid-point of “the second cutting member”, as set forth in answer (B). Therefore, answer (B) provides proper antecedent basis for “said mid-point” in paragraph (iv) of claim 1. Further, the phrase “said mid-point” in claim 2 is specifically the mid-point of “the first cutting member”, as set forth in answer (B). Therefore, answer (B) provides proper antecedent basis for “said mid-point” in claim 2. Answer choice (B) is correct. No error in grading has been shown.

Petitioner’s request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?
 - (A) In a utility case, gross sales figures accompanied by evidence as to market share.
 - (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
 - (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
 - (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
 - (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice is (D). In a utility case, gross sales figures accompanied by evidence of brand name recognition does not constitute probative evidence of commercial success to support a contention of non-obviousness.

Petitioner selected answer (B). Petitioner argues that due to the defective nature of the question, credit should be given to answers (A), (B), (C) and (D). Petitioner argues that except for choice (E), none of the answer choices are truly probative as recited. Petitioner argues that answers (A), (B), (C) and (D) each lack the requisite showing of a "nexus" between the evidence of commercial success and the claimed invention.

Petitioner's arguments have been fully considered but they are not persuasive. In regard to petitioner's contention that each answer lacks the requisite showing of a "nexus" between the evidence of commercial success and the claimed invention, it is noted that the question does not require such a showing. The question asks which choice does not constitute "probative evidence" of commercial success to support a contention of non-obviousness, **not** whether the requisite "nexus" between such evidence and the claimed invention can be shown in any given case. The issue is which types of evidence described in the choices are, or are not, "probative evidence" of commercial success.

In regard to choice (D), MPEP 716.01(c) states "[i]n considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such **success is not the result of heavy promotion or advertising, shift in advertising . . .**" (Emphasis added.) These factors are directly related to brand name recognition, thus choice (D) is not probative evidence of commercial success.

In regard to choice (B), gross sales figures accompanied by evidence as to the time period during which the product was sold does constitute probative evidence of commercial success to support a contention of non-obviousness. As explained in MPEP § 716.03(b), gross sales figures

do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market. *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). Accordingly, sales figures accompanied by evidence as to the time period during which the product was sold does constitute probative evidence of commercial success, rendering answer (B) an incorrect response. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.
- (B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.
- (C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.
- (D) All of the above.
- (E) None of the above.

The model answer is choice is (C). To properly revive an abandoned application that went abandoned because the practitioner did not receive a mailing from the office, practitioner should timely file a petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

Petitioner selected answer (E). Petitioner argues that none of the answers (A), (B), (C) or (D) is correct, and therefore choice (E) is correct. Petitioner argues that choice (C) is incorrect because it does not include a reference to the copy of the docket record in practitioner's statement.

Petitioners' arguments have been fully considered but they are not persuasive. Choice (C) is correct because it sets forth the modified showing discussed in **MPEP § 711.03(c), item subsection II**, and complies with the fact noted in MPEP § 711.03(c), subsection I, that a petition to withdraw holding of abandonment does not require a fee. Further, contrary to petitioner's contention, choice (C) is viewed as including the "reference to the copy of the docket record in practitioner's statement", which petitioner claims is lacking. Specifically, choice (C) includes a "statement . . . that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received" and "a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed."

The statement that the docket records have been searched is a clear reference to the attached copy

of the docket record where the nonreceived Office communication would have been entered.

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 choice (A) is correct and choice (B) is incorrect. Petitioner contends that a responsible attorney should call the examiner to inform him of the bankruptcy proceeding.

Further, petitioner contends that the attorney should request that nothing should be done in the reexamination proceeding in order to represent the client zealously under 37 CFR 10.83.

Petitioner concludes that choice (B) is incorrect because it does not represent "zealous representation".

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to give the examiner a call to inform him of the bankruptcy proceeding, answer (A) specifically states that the attorney should 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. As explained in 35 U.S.C. § 305, reexamination proceedings are conducted with special dispatch. Accordingly, a registered practitioner is charged with knowing that there is no mechanism for suspending a reexamination proceeding until a bankruptcy is settled. Thus answer (A) is incorrect because it asserts an action contrary to PTO rules and practices. The issue of bankruptcy is not relevant to the reexamination proceeding. Such a call would go beyond zealous representation by suggesting an action contrary to PTO rules and practices.

Further, zealous representation of the client does not require any action by the practitioner under the given facts. If the practitioner does nothing, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since the practitioner agrees with the propriety of the rejection of claim 1, the client is not prejudiced, nor is it adversely affected. The facts state that the practitioner received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client. Thus, the client is aware of the office action and the practitioner's agreement with the

Examiner. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to request suspension of a reexamination proceeding, the statement in answer (B) is correct and the statement in answer (A) 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:

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.”). Also see *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 17 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.

17. With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) To encourage prompt disclosure of inventions to the public, the PTO always awards priority to the first to file an application, in this case Billie.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 1999 and actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (D) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 1999 and her patent filing in December 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

The most correct answer is choice (B). Debbie will be awarded priority only if she can

establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.

Petitioner argues that the most correct answer is choice (D). Petitioner appears to argue that since "the entire time between May 14, 1999 and her patent filing date in December 1999" (as recited in choice (D)) includes "the entire time between May 14, 1999 and her actual reduction to practice in June 1999" (recited in choice (B)), choice (D) is also a true statement. Petitioner further appears to argue that choice (B) is incorrect because it does not state the "only" way in which Debbie will be awarded priority.

Petitioner's arguments have been fully considered but they are not persuasive. The **only** way in which Debbie will be awarded priority is if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention. Petitioner appears to acknowledge as much, but contends that Debbie could go further and establish diligence up to her patent filing date in December 1999. However, such proof of diligence up to the filing date is not required. See MPEP 2138.01 and *Manhurkar v. C.R. Bard, Inc.*, 38 USPQ2nd 1288 (Fed. Cir. 1996). Choice (D) is not the most correct answer because it includes establishing diligence for this additional, unnecessary time period. Further, it is illogical to state that choice (B) does not recite the **only** way in which Debbie will be awarded priority because additional, unnecessary steps could also be done. The steps recited in choice (B) are the minimum requirements (i.e. the only way) for Debbie to be awarded priority. That additional, unrequired steps could be performed is irrelevant. Choice (B) is the most correct answer.

No error in grading has been shown as to morning questions 3 and 7, and afternoon questions 1, 6, 10, 16 and 17. 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 Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.).

ORDER

For the reasons given above, no points 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.



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