

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 considered. Each question in the examination is worth one point.

Petitioner has presented the argument that insufficient time was allotted for the examination. This argument does not address regrading and is therefore outside the scope of a petition for regrading of an examination under 37 C.F.R. § 10.7(c).

Petitioner has been awarded points for afternoon questions 6, 11 and 29. Accordingly, petitioner has been granted an additional two points on the examination, resulting in a regraded score of 69. However, no credit has been awarded for morning questions 28 and 41 and afternoon questions 5, 18 and 46.

Morning question 28 reads as follows:

28. A patent application filed in the PTO contains the following three claims, including product by process Claim 3:

- Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.
- Claim 2. The method of claim 1, further characterized by the step of D.
- Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper PTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."
- (B) Cancel Claim 3.
- (C) Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."
- (D) Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."
- (E) (B), (C), and (D).

Choice (E) is correct because choices (B), (C) and (D) are correct. The cancellation of Claim 3 overcomes the examiners objection. The addition of Claim 4 and 5 provide the client

with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 5; 37 CFR § 1.75(c); MPEP § 608.01(n)(I)(B)(1) ("Claim Does Not Refer Back in the Alternative Only"). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either claim 1 or claim 2.

Petitioner contends that choice (A) is the correct response because (B), (C), (D) and (E) are each incorrect according to MPEP § 608.01(n) which indicates that claims must use "or" wording as opposed to "and" wording. Petitioner argues that (A) is the best response because it is merely ambiguous. Petitioner's argument is not persuasive. The question asks which reply best overcomes the examiner's objection and provides the client with the broadest patent protection. Answer (A) is incorrect because it is an improper multiple dependent claim, which is more in error than being merely ambiguous. Petitioner relies on MPEP § 608.01(n) to prove that (B), (C) and (D) and therefore (E) are incorrect because each uses the connector "and" instead of "or". The only portion of MPEP § 608.01(n) which speaks to this distinction between the use of "and" and "or" is MPEP § 608.01(n)(I), Multiple Dependent Claims, which states that multiple dependent claims must refer to precedent claims in the alternative only. None of the claims in choices (B), (C), (D) nor (E) are multiple dependent claims and thus MPEP § 608.01(n)(I) and its requirement for reference to precedent claims in the alternative only is not applicable to any of these claims. Thus, choice (A) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 41 reads as follows:

41. A claim limitation reads "a pH range between 7 and 12, preferably between 9 and 10." Which of the following is correct?

- (A) Since the limitation properly sets forth outer limits, it is definite.
- (B) As long as the limitation is supported in the written description, it is proper.
- (C) The limitation is indefinite.
- (D) Since the limitation sets forth a preferred range, it is definite.
- (E) An applicant is precluded from expanding the claim coverage beyond a pH range of 7-12 under the doctrine of equivalents.

The correct answer is choice (C) because MPEP § 2173.05(c), part (I) indicates that a preferred narrower range set forth within a broader range may be an indefinite claim limitation when the boundaries of the claim are not discernible. (A), (B), and (D) state the contrary and are therefore incorrect. Furthermore, choice (B) is incorrect because a claim can be supported by the written description, but still be indefinite, as in the problem where it is unclear whether a pH of 7 would meet the claim, or whether it would not since it is not within the preferred range. (E) is wrong because the doctrine of equivalents operates to expand claim coverage beyond the literal scope of the claim language.

Petitioner contends that choice (A) is as correct as choice (C). According to petitioner, MPEP § 2173.05(c) states that the use of a narrow numerical range within a broader range in the same claim may render the claim indefinite, when the boundaries of the claim are not discernible and therefore there is insufficient information on the face of question 41 to conclusively determine that the claim is indefinite.

Petitioner does not argue that the model answer (C) is incorrect, but that petitioner's answer (A) is equally correct. Petitioner's argument that there is insufficient information on the face of question 41 to conclusively determine that the claim is indefinite is not persuasive. The

MPEP section cited by petitioner, MPEP § 2173.05(c), also says “Description of examples and preferences is properly set forth in the specification rather than in the claims. If stated in the claims, examples and preferences lead to confusion over the intended scope of a claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. 112, second paragraph should be made. The Examiner should analyze whether the metes and bounds of the claim are clearly set forth. **Examples of claim language which have been held to be indefinite are (A) ‘a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius’; and (B) ‘a predetermined quantity, for example, the maximum capacity’.**” (emphasis added). Example (A) from MPEP § 2173.05(c) uses the same preference limitation as the claim in question 41 and conclusively determines that the claim is indefinite. Therefore answer (A) to question 41 is incorrect. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 5 reads as follows:

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members

could be substantially parallel and including guidelines for determining what would be considered "substantially parallel." Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

(A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.

(B) If applicant amends claim 1 to replace "a circular shaped member" with "an elliptical shaped member," then the amendment should be considered untimely since the amendment would broaden the scope of the claim.

(C) If applicant amends claim 1 to delete "wherein the leg members are parallel to each other," then the amended claim should be allowed.

(D) If applicant amends claim 1 to replace "parallel" with "substantially parallel," then the amended claim will likely be allowed.

(E) None of the above.

Choice (E) is the most correct answer because none of the statements (A), (B), (C) nor (D) are true. (A) and (B) are incorrect because a broadened claim can be presented within two years from the grant of the original patent in a reissue application. MPEP § 1412.03. (C) is incorrect because it would involve an attempt to recapture claimed subject matter deliberately canceled in a patent application. MPEP § 1412.02. (D) is incorrect because it improperly relies on new matter. MPEP § 1411.02.

Petitioner contends that choice (D) is incorrect, but because the question asks which statement is correct, this appears to be a typographic error on petitioner's part. If this is not a typographic error, then petitioner is in agreement with the model answer and the argument is

moot. If Petitioner is in fact arguing that choice (D) is correct, consistent with the remainder of the argument, petitioner so argues because the prior amendment clearly states that leg members could be substantially parallel.

Petitioner's arguments are not persuasive. Choice (D) is not the correct answer because the prior amendment itself introduced new matter. The disclosure as originally filed stated that all leg members must be parallel to each other. The only claim with the original filing did not include any further characterization of the legs being parallel. Therefore, the original disclosure stated that the legs must be parallel. The amendment recharacterized the legs' alignment as substantially parallel, which differs materially from the original disclosure of the legs being parallel. This recharacterization was impermissible new matter. The examiner should have objected to the amendment and required the cancellation of the amendment. No rejection of the claim as amended for the initial allowance was needed because the claim of the allowed application specified parallel legs and thus did not rely on the new matter. The fact that the examiner failed to object to the amendment and require its cancellation did not change the fact that the amendment introduced new matter.

The claim proposed in the reissue application specifies substantially parallel legs and thus does depend on the new matter introduced in the amendment. Therefore the claim would not be allowed because it was based on new matter and would be rejected under 35 USC § 112, first paragraph. Thus, (D) is incorrect and choice (E) is therefore correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 18 reads as follows:

18. Bill wishes to amend the sole, original Claim 1 of the patent granted to him and obtain the following amended Claim 1. The amended Claim 1 set forth below is fully supported by the original disclosure in the application:

1. A computer processor comprising:
 - a. a plurality of registers divided into a global port subset and a local pool subset;
 - b. means for distinguishing a successful [unconditional] interruptible jump operation;
 - c. means for receiving interrupts or exceptions; and
 - d. an interrupt or exception handler for handling the interrupts or exceptions in response to distinguishing the [unconditional] interruptable jump operation [from the local pool subset].

In the absence of questions of recapture, novelty, obviousness, and utility, which of the following statements, if any, is true?

- (A) A claim so amended is properly presented during a reexamination proceeding where a request for reexamination was filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on July 15, 1997.
- (B) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on July 15, 1997.
- (C) A claim so amended is properly presented in a reissue application filed on September 9, 1999, and a reissue patent is grantable where reissuance is sought of a patent granted on November 18, 1997.
- (D) A claim so amended is properly presented in a request for reexamination filed on September 9, 1999, and a certificate of reexamination may be issued where reexamination is sought of a patent granted on November 18, 1997.
- (E) A claim so amended is properly presented in a reissue application filed any time before expiration of the term of the patent inasmuch as the scope of Claim 1 in the original patent is narrowed by replacing the word "unconditional" with the word "interruptable."

Choice (C) is the most correct answer because the scope of Claim 1 is enlarged, or broadened by the deletion of "from the local pool subset" from the claim. As presented in (C), the reissue application is filed less than two years after the original patent was granted and the

application seeks to enlarge the scope of Claim 1. As such, a reissue application may be properly granted containing the claim. 35 U.S.C. § 251. (A) and (D) are incorrect. The scope of Claim 1 is enlarged by the proposed amendment. Claims cannot be enlarged or broadened in a reexamination application regardless of when the application is filed. 35 U.S.C. § 305; 37 CFR § 1.552(b). (B) and (E) are also incorrect given that the scope of Claim 1 is broadened by the proposed amendment. As such, the reissue application cannot be filed more than two years from the grant of the original patent. 35 U.S.C. § 251.

Petitioner contends that choice (D) is correct because the change in claim language from “unconditional” to “interruptible” is a narrowing and not a broadening of claim language and therefore permissible for inclusion in the amendment where the time period is less than two years. Petitioner does not indicate which time period which is less than two years his response refers to.

Petitioner’s arguments are not persuasive. Choice (D) is not the correct answer because the scope of Claim 1 is broadened by the proposed amendment in a reexamination proceeding. Claims may never be broadened in a reexamination. The time period is not an issue. 35 U.S.C. § 305; 37 CFR § 1.552(b). Petitioner argues that the claim is not broadened. The claim originally contained a limitation that the jump was unconditional. The unconditional limitation was removed. The claim originally contained a limitation that the jump operation was distinguished from the local pool subset. The local pool subset as an object of distinction was removed from the claim. Each of these removals constituted removals of limitations from the original claim and thus broadened the scope of the claim.

The insertion of the limitation that the jump operation was interruptible did not negate the broadening caused by the removal of the limitation that the jump operation was unconditional. MPEP § 1412.03 states “ A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the patent. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects. A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable apparatus or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for direct infringement who previously could not have been sued for direct infringement.” The removal of the modifier “unconditional” enlarged the scope of the claim to include both conditional and unconditional interrupts. Because the patent did not cover claims with conditional interrupts, this amendment enlarged the patent’s scope.

Petitioner did not argue that the removal of the local pool subset as an object of distinction broadened the scope of the claim. This removal enlarged the scope to include any object of distinction.

A claim in reexamination may never be broadened in scope. Thus, (D) is incorrect for the situation presented in the question. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 46 reads as follows:

46. On June 22, 1999, you receive a final Office action, dated June 17, 1999, rejecting numerous claims in a patent application that you filed in the PTO. The Office action did not set a shortened statutory period for reply. Following proper PTO practices and procedures, under which circumstances is it most likely your submission of new evidence under 37 CFR § 1.129(a) in support of patentability, along with the appropriate fee, will result in the automatic withdrawal of the finality of the final rejection?

- (A) The application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file a Notice of Appeal to the Board of Patent Appeals and Interferences.
- (B) The application is filed on June 7, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file an appeal brief to the Board of Patent Appeals and Interferences.
- (C) The application is filed on June 8, 1995, it has an effective filing date of June 7, 1993, and you file the submission on December 20, 1999.
- (D) The application is filed on June 7, 1995, it has an effective filing date of June 7, 1993, and you file the submission on the same day you file an appeal brief to the Board of Patent Appeals and Interferences.
- (E) (A) and (C).

Choice (A) is the most correct answer because an applicant in a patent application filed on or before June 8, 1995, and which has an effective filing date of June 8, 1993 or earlier, is entitled to have new evidence in support of patentability entered and considered (and the finality of the final rejection withdrawn), provided the submission (along with the appropriate fee) is filed prior to the filing of an appeal brief to the Board of Patent Appeals and Interferences or abandonment of the application. 37 CFR § 1.129(a); MPEP § 706.07(g). Here, the application is

filed on June 8, 1995, it has an effective filing date of June 8, 1993, and the submission (along with the appropriate fee) is filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences or the abandonment of the application. Answers (B) and (D) are incorrect because the submission was not filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences. 37 CFR § 1.129(a); MPEP § 706.07(g). Answer (C) is incorrect because the submission was not filed prior to the abandonment of the application on December 18, 1999. 37 CFR § 1.129(a); MPEP § 706.07(g). Answer (E) is incorrect because Answer (C) is incorrect.

Petitioner contends that choice (D) is as correct as (A) because answer (A) does not indicate when an appeal brief is actually filed and an assumption has to be made. Assuming that an appeal brief is filed in both answers (A) and (D), both answers may have additional facts under which a response is filed prior to the appeal brief and so both answers are equally correct.

Petitioner's arguments are not persuasive. Choice (D) is not the correct answer because the submission was not filed prior to the filing of the appeal brief to the Board of Patent Appeals and Interferences. 37 CFR § 1.129(a); MPEP § 706.07(g). The instructions to the examination specifically state "Do not assume any additional facts not presented in the questions". There is no fact in answer (A) showing that any appeal brief has been or will be filed. The filing of a Notice of Appeal does not necessitate a subsequent filing of an appeal brief. Without an appeal brief, the fact pattern of answer (A) will trigger an automatic withdrawal of finality. Therefore no assumption regarding the timing of an appeal brief relative to the submission is required. Thus, there is no issue of timing relative to an appeal brief in (A). (D) is incorrect for the

situation presented in the question. No error in grading has been shown. Petitioner's request for credit on this question is denied.

No error in grading has been shown as to questions 28 and 41 of the morning session and questions 5, 6, 18, and 46 of the afternoon session of the Registration Examination held on November 3, 1999. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, three points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 69. 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