

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section 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, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question 2 reads as follows:

2. Your client, Mr. Jones, asked you to prepare a patent application for his new pasta maker. The key features of the invention are the different types of dough which can be used and the shapes of the pasta which can be made. The completed application was filed on Monday, May 18, 1998. After filing the application, you conducted a prior art search and found a published article by another which was published on May 16, 1997. The published article discusses a pasta maker very similar to your client's pasta maker. In the course of your search, you also found a few patents, but none as pertinent as the article. You file all of the prior art in an Information Disclosure Statement on June 8, 1998. In your opinion, the article is the best available prior art. Assuming that this is true, under which of the following sections of Title 35 U.S.C., if any, would Mr. Jones not be entitled to a U.S. patent?

- (A) 102(a)
- (B) 102(b)
- (C) 102(d)
- (D) 102(e)
- (E) None of the above.

Choices (A) and (E) are correct answers. Petitioner selected answer (B). Both (A) and (E) are considered correct answers in light of the statement that the "published article discusses a pasta maker very similar to your client's pasta maker." As explained in MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." The phrase "very similar" can be understood to mean that the published article explicitly or impliedly discloses every aspect of the claimed invention. Under this interpretation, (A) is correct because the published article is prior art under 35 U.S.C. § 102(a) (used to reject claims to an invention that "was known . . . by others in this country, or . . . described in a printed publication in this . . . country, before the invention thereof by the applicant for patent").

The phrase “very similar” could also be taken to mean that the published article did not teach every aspect of the claimed invention as required for anticipation under 35 U.S.C. § 102. Based on this interpretation, answers (A), (B), (C), and (D) would be rendered incorrect because they are all based on sections of 35 U.S.C. § 102. Accordingly, answer (E) “[n]one of the above,” is also a correct answer.

Answer (B) is not a correct answer because of when the one year anniversary date occurs for the published article and when the patent application needs to be filed. “When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken or the fee paid, on the next succeeding secular or business day.” 35 U.S.C. § 21(b). This statute modifies the one year or twelve month periods specified in other parts of Title 35 including 35 U.S.C. § 102(b). See MPEP §§ 706.02(a); 2133. Therefore, the article would be a reference under 35 U.S.C. § 102(a) and not under § 102(b), since May 16, 1998, falls on a Saturday. *Ex parte Olah*, 131 USPQ 41, 43 (Bd. App. 1960).

Petitioner argues that since answer (E) states “none of the above,” answers (A) and (E) cannot both be correct at the same time and the question is therefore defective. However, the question is not rendered defective by the fact that there are two correct answers. The fact that two correct answers were provided which covered the above-discussed alternative meanings of “very similar” gave Petitioner the opportunity to correctly answer the question regardless of which meaning she considered. Petitioner does not dispute that answers (A) and (E) comply with PTO practice and procedure.

Accordingly, Petitioner's argument fails to point out any error in the grading of his examination.

Question 9 reads as follows:

9. Able, a researcher with the Royal Fruit Co. (hereinafter "Royal"), discovered a distinct and new variety of peach tree which he successfully succeeded in asexually reproducing. Royal then obtained an assignment from Able, and filed a plant patent application with the PTO claiming the asexually reproduced peach tree. Subsequently, Baker, a researcher with the Georgia Peach Co. (hereinafter "Georgia"), unaware of Able's discovery, discovered a similar though independent and patentably distinct variety of peach tree. Baker succeeded in asexually reproducing his discovery. Georgia then obtained an assignment from Baker and filed a utility patent application with the PTO claiming the fruit and propagating material of the Baker peach tree. Subsequently, Georgia merged with Royal, which acquired title to all of Georgia's assets, including the Baker utility patent application. In the course of prosecution of the Baker patent application, the primary examiner "provisionally" rejected all of the claims in the Baker application on the ground of obviousness-type double patenting with the claims in Able's application. On the basis of the present factual scenario and proper PTO practice and procedure, which of the following statements is true?

- (A) The rejection is improper because while there is a common relationship of ownership, a common relationship of inventorship is lacking.
- (B) The rejection is improper because the Able and Baker inventions are independent and patentably distinct from each other.
- (C) The rejection is improper because there was no common relationship of ownership at the time of Baker's invention.
- (D) The rejection is proper because the issue of double patenting can be addressed without violating the confidential status of the applications as required by 35 U.S.C. § 122.
- (E) The rejection is improper because a provisional double patenting rejection cannot be based on copending utility and plant patent applications.

The correct answer is (B) and Petitioner selected answer (D). The question asks which of five statements relating to the propriety of a provisional rejection of Baker's claims on the ground of obviousness-type double patenting is true on the basis of the

factual scenario presented and proper PTO practice and procedure. Answer (B) is correct because the facts show that the inventions are independent and patentably distinct, and that the double patenting rejection is of the obviousness type. Manual of Patent Examination Procedure (“MPEP”) § 804 reads:

There are . . . two types of double patenting rejections. One is the “same invention” type double patenting rejection The second is the “nonstatutory-type” double patenting rejection . . . which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes rejections based on . . . obviousness.

Petitioner’s selection, choice (D), is incorrect because the statement “[t]he rejection is proper” is not true. As fully discussed above, the facts show that the inventions are independent and patentably distinct and the examiner’s statutory double patenting rejection is therefore improper. Petitioner argues that the facts do not state that the examiner was aware at the time of making the rejection that the inventions were patentably distinct and that the rejection was therefore properly made. This argument is simply without merit. The rejection was made and the facts show that a statutory double patenting rejection should not have been made.

Petitioner also argues that the use of the word “similar” to describe the claimed inventions could be construed by an examiner as constituting a proper basis for an obviousness-type double patenting rejection. However, the question is concerned with double patenting, a condition which by definition results when two or more patents are granted containing conflicting claims, *i.e.*, claims which are not patentably distinct from each other. Since the facts state that the inventions are “independent and patentably

distinct,” the obviousness-type double patenting rejection is improper. The term “similar” is a comparative term, and its use in a phrase proximal to “Able’s discovery” can only mean that Baker’s peach tree is being compared to Able’s peach tree.

Accordingly, no error in grading has been shown.

Question 18 reads as follows:

18. Which of the following statements regarding design patent applications is not correct?
- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
 - (B) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
 - (C) The design application may have only a single claim.
 - (D) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
 - (E) The inventive novelty or unobviousness of a design resides in the shape or configuration, and/or surface ornamentation of the subject matter which is claimed.

Answer (D) is correct and Petitioner selected answer (E). Choice (D) is the most correct answer because “it is permissible to illustrate more than one embodiment of a design invention in a single application.” MPEP § 1504.05(II)(A); *see also In re Rubinfeld*, 270 F.2d 391, 393, 123 USPQ 210, 212 (CCPA 1959) (“we see no reason why . . . 35 U.S.C. § 171 should, per se, preclude the showing of two or more embodiments of a design invention”). Additionally, “[t]he design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.” 37 C.F.R. § 1.152(a). Accordingly, when there are different embodiments of a design, compliance with the rule’s provision that there be a sufficient number of views to constitute a “complete” disclosure of the design requires that each embodiment be set

forth in the drawings. Therefore, different embodiments or modifications of a design need to be shown in the drawings.

Petitioner chose answer (E) which contains, however, a correct statement of how designs are evaluated in design patent applications. See MPEP § 1504 (“[t]he inventive novelty or unobviousness resides in the ornamental shape or configuration of the article in which the design is embodied or to which the surface ornamentation is applied”). Thus, answer (E) is an incorrect selection to the question “[w]hich of the following statements regarding design patent applications is not correct” (emphasis in original).

Petitioner argues that the following MPEP language makes answer (D) a correct statement and therefore an incorrect answer:

[i]n addition to the figure descriptions, the following types of statements are permissible in the specification: (A) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure.

MPEP § 1503, ¶ 15.46. However, the quoted language relates to statements which describe portions of the claimed design, in contrast to statements which describe modifications of the claimed design. Answer (D) is concerned with modifications, not portions, of the claimed design. In this regard, attention is drawn to the following language found in paragraph (B) midway between ¶ 15.47.01 and ¶ 15.60 recited in MPEP § 1503.01:

Statements which describe or suggest modifications of the claimed design which are not illustrated in the drawing disclosure are not permitted in the specification of an issued design patent.

In view of the above, no error in grading has been shown.

Question 26 reads as follows:

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block decoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider having two inputs and one output. The functions of the phase comparator and divider are adequately disclosed in the specification. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phrase [sic, phase] comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.
- (B) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, and that these elements were "routinely built."
- (C) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built," and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university."

- (E) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The professor was involved with the construction of the digital transmission system.

Both (C) and (D) are accepted as correct answers and Petitioner selected answer (E). The question asks which of five declarations would be minimally legally sufficient to overcome the examiner’s rejection in accordance with proper PTO practice and procedure. The declarations in both answer (C) and answer (D) state that the divider and phase comparator were “well-known to those of skill in the art as of June 17, 1997” and that these elements were “routinely built.” Answer (C) also states that the declarant “provides details in the declaration concerning the structure and function of the elements.” Choice (C) contains additional “details” so as to constitute “something more than a conclusory statement” as referred to in MPEP § 2164.05. Providing these details in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. See fact pattern to question (“the claims [stand rejected] under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed”) (emphasis added).

As such, credit has been given for answer (C). As explained in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.” *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)

(“expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement”).

The declaration in (D) states that these elements were “sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. Again, having this statement in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. For these reasons, (D) is a correct answer. A specification need not disclose what is well known to those skilled in the art and may omit that which is well known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Answer (E) is not correct because the question asks “[w]hich of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure” (emphasis in original), and the declaration in (E) includes the additional statement that the professor was involved with the construction of the digital transmission system. This added statement appears in the declaration because the question begins “[w]hich of the following declarations [i.e., answer choices]” Accordingly, all in (E) is in the declaration. As set forth above, since answer (D) is a minimally legally sufficient answer, answer (E) which adds

a fact to answer (D) is more than minimally legally sufficient and is therefore an incorrect answer choice.

Petitioner argues that the professor must have personal knowledge of the facts to which he is averring and the added statement in answer (E) is therefore necessary. However, to be minimally legally sufficient, it is not necessary for the professor to have been “involved with the construction of the digital transmission system.” All that is needed is that he have knowledge in the pertinent field, which does not require his involvement with the construction of the system in question. Accordingly, this argument is unpersuasive.

Petitioner alternatively argues that since the added statement does not appear in quotes, it is not part of the declaration and therefore the declaration in (E) is the same as in (D). However, as discussed above, since the answer choice follows the question “[w]hich of the following declarations [i.e., answer choices] . . .,” all that is in (E) is in the declaration, in some form. That is, the quoted portions in (E) appear exactly as such in the declaration, and the unquoted portions substantively appear in the declaration, given the wording of the question. The declaration simply has more than the quoted portions in answer choice (E). In view of the above, no error in grading has been shown.

Question 29 reads as follows:

29. On September 10, 1997, Smith invented a process for implanting processing chips in human heads. The chips permit the human to control replies when angered. Smith filed a *pro se* patent application in the PTO on the process on November 17, 1997. Shortly afterwards, Smith was hired by EZ Corporation, a processor and distributor of chips. During the pendency of the Smith patent application, on January 3, 1998, Smith invented an improvement to the process, and pursuant to Smith's employment agreement, Smith executed an assignment of the improved process invention to EZ Corporation. You are patent counsel for EZ Corporation. Pursuant to instructions, you prepared a patent application on the improved process invention. On February 3, 1998, you filed a complete patent application together with the executed assignment in the PTO. The application filed on February 3, 1998, in addition to disclosing the process disclosed in the *pro se* application, also disclosed and claimed only the improved process. The first sentence of the specification in the application filed on February 3, 1998, stated that the application was a CIP of the copending *pro se* Smith patent application, which was adequately identified therein. On May 11, 1998, the *pro se* Smith patent application became abandoned. On June 4, 1998, all the claims to the improved process in the application filed on February 3, 1998, were rejected by the primary examiner as unpatentable under 35 U.S.C. § 103 over a U.S. patent that issued on March 3, 1998, on an application that was filed on December 11, 1995. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the examiner's rejection?

- (A) File a reply which argues that the claims of the present application are nonobvious over the U.S. Patent issued on March 3, 1998.
- (B) File a reply which argues that since Smith is the same inventor named in the previously filed *pro se* application, and since the CIP application contains a specific reference to the earlier filed application, the CIP application is entitled to the benefit of the earlier date in accordance with 35 U.S.C. § 120 for purposes of the improvement process claims.
- (C) File an affidavit under 37 CFR § 1.132 presenting test data showing that the process in the CIP application is significantly superior to the process in the *pro se* application.
- (D) File a reply which argues that the reference patent cannot be the basis of a rejection because its issue date postdates the filing date of the CIP application.
- (E) File an affidavit under 37 CFR § 1.131 swearing back of the reference filing date.

Answer (A) is the correct choice and Petitioner selected choice (C). Answer (A) is the most correct answer because the practitioner argues that the claims are patentable over a patent used in the rejection, shows errors in the examiner's action, and replies to the ground of rejection by addressing the relied upon reference. In doing so, the practitioner has met the requirements for replying to an Office action. See 37 C.F.R. § 1.111(b):

“The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and . . . present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

Petitioner's choice, Answer (C), is not an adequate reply to the examiner's Office action rejecting the claims for obviousness over a prior art reference because the submitted affidavit does not compare the test data to the cited prior art. Instead, the affidavit compares the applicant's improved process to his old process. Thus, the affidavit fails to traverse the rejection, as required by 37 C.F.R. § 1.132. Additionally, since no comparison to the prior art has been made, the reply overall does not comply with above discussed 37 C.F.R. § 1.111(b), which requires pointing out alleged errors in the rejection and, in this case, arguing any distinctions from the prior art. See also MPEP § 716.02(e) (“An affidavit or declaration under 37 CFR § 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)”). Accordingly, Petitioner's arguments that the affidavit was a sufficient reply to the obviousness rejection are not persuasive. Thus, no error in grading has been shown.

Question 35 reads as follows:

35. During the pendency of inventor Smith's first patent application, he filed a request for a Continued Prosecution Application (CPA). On February 4, 1998, a primary examiner again rejected Claims 1-4 in the CPA application under 35 U.S.C. § 103 over references X and Y, and again rejected Claim 5 under 35 U.S.C. § 103 over references X, Y, and Z. The examiner did not set a shortened statutory period for reply. On August 4, 1998, the practitioner filed a notice of appeal to the Board of the Patent Appeals and Interferences from the examiner's decision rejecting Claims 1-5. Claims 6-10 in the CPA application stand allowed. Which of the following actions was not in accord with proper PTO practice and procedure regarding the appeal and Smith's CPA application?

- (A) The practitioner timely filed the notice of appeal containing an authorization to charge fees to a deposit account, which is signed by the practitioner.
- (B) The practitioner timely filed the notice of appeal containing an authorization to charge the appeal fee to a deposit account which is signed by the practitioner and does not specify which claims are appealed.
- (C) The practitioner timely filed the notice of appeal containing an unsigned authorization to charge the appeal fee to a deposit account; the notice of appeal specifies which claims are appealed.
- (D) The practitioner timely filed an unsigned notice of appeal; the notice of appeal specifies which claims are appealed; a proper authorization to charge fees to a deposit account accompanied the notice of appeal.
- (E) The practitioner timely filed the notice of appeal which was signed by the practitioner; the notice of appeal specifies which claims are appealed; the appropriate fee accompanies the notice of appeal. An appeal brief was filed with a request for extension of time and the requisite fee seven months after the notice of appeal was filed.

Answer (C) is the most correct answer and Petitioner selected answer (D). In answer (C), the practitioner is filing two items with the PTO: (1) a notice of appeal, and (2) an unsigned authorization to charge the appeal fee to a deposit account. Answer (C) is most correct because an unsigned authorization to charge the appeal fee to a deposit account does not pay the fee that is required by 37 C.F.R. §§ 1.191(a) and 1.17(b).

The general rule is that papers, such as an authorization to charge a deposit account,

filed in an application “must be signed.” 37 C.F.R. § 1.33(b). A notice of appeal is an exception to this general rule and need not be signed. 37 C.F.R. § 1.191(b); see also Changes in the Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53131, 53167 (October 10, 1997). However, 37 C.F.R. § 1.191(b) does not extend to or cover payment of an appeal fee by an unsigned authorization to charge a deposit account. Accordingly, answer (C) is the most correct answer to the question which action is not in accord with proper PTO practice and procedure.

Answer (D) complies with proper practice and procedure because the notice and authorization to charge the appeal fee to a deposit account is signed and claims 1-5 have been twice rejected. There is no requirement in 37 C.F.R. § 1.191 that the claims be twice rejected in the same application. Accordingly, answer (D) is not a correct answer choice to the above question asking which choice was not in accord with proper PTO practice and procedure.

Petitioner asserts that answer (D) was not in accord with proper PTO procedure because the notice of appeal was unsigned, and a certificate of mailing would therefore also have been unsigned contrary to PTO practice. This argument, however, assumes facts not in the question. That is, the notice of appeal could very well have been filed with a proper certificate of mailing or it could have been hand delivered. The examination directions expressly state “[d]o not assume any additional facts not presented in the questions.” By arguing that the certificate of mailing procedure was used and, if so, the certificate was necessarily unsigned, Petitioner is assuming additional facts. Such assuming is directly contrary to the examination directions. Accordingly, no error in grading has been shown.

Question 38 reads as follows:

38. Inventor A, with the assistance of a registered patent practitioner P, filed a patent application. The PTO mailed to P an Office action. P, a sole practitioner, received the Office action. The application became abandoned for failure to respond within the three month shortened statutory period for reply specified in the Office action. A asked P every three months about the status of the application. P always advised A that the application was pending. P did not revive the application. Using letters, and billing A for work not performed in the application, P misled [sic, misled] A into believing that the application was pending. Inventor A first learned of the abandoned status of the application in a telephone conversation with the primary examiner on June 12, 1998. On June 14, 1998, A engaged another practitioner, X, to assist in reviving and prosecuting the application. Since June 12, 1998, P has refused to respond to letters he received from A and X by certified mail, or to telephone calls from A and X, wherein A and X have requested P to provide a factual statement explaining what occurred. Inventor A, with the assistance of practitioner X, filed a petition to revive the application on August 25, 1998. Which of the following complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action?

- (A) Where the application was filed on May 9, 1995, and became abandoned on March 5, 1997, for no reply to an Office action dated December 4, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and a showing, corroborated by supporting documents and affidavits from A and X, demonstrating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.

- (B) Where the application was filed on June 10, 1996, and became abandoned on March 21, 1997, for no reply to an Office action dated December 20, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (C) Where the application was filed on April 10, 1997, and became abandoned on May 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition, accompanied by the petition fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the action, P misled A regarding the status of the application, and P has failed to respond to communications from A and X requesting P's assistance in reviving the application.
- (D) Where the application was filed on April 10, 1997, and became abandoned on February 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition to revive accompanied by a terminal disclaimer for 3 months which is proper in all formal respects, an authorization to charge any required fees to a designated account, the required reply, and an affidavit signed by A stating that P failed to inform A of the action, and that A was damaged by P's conduct at least to the extent that A had incurred additional fees and expenses for the petition, and the entire delay was unavoidable.
- (E) None of the above.

The correct answer is (A) and Petitioner selected answer (C). The question asks which of five answers complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action. Answer (A) is most correct because, in accordance with 37 C.F.R. § 1.137(a) and MPEP § 711.03(c), the petition to revive includes the petition, the appropriate petition fee, a terminal disclaimer, the disclaimer fee, a reply to the last Office action, and a showing that the entire delay in the filing of the reply from the due date to the filing of a grantable petition was unavoidable. In view of evidence that the practitioner, P, concealed the abandonment

from the inventor, A, billed A for work not performed, and gave misleading statements to A with regard to the application, P's lack of diligence cannot be charged to A.

See In re Lonardo, 17 USPQ2d 1455, 1458 (Comm'r Pats. 1990).

Answer (C) is not the most correct answer because it, unlike answer (A), lacks the fact that A had regularly sought status information from P. "Diligence on the part of the applicant is essential to show unavoidable delay." *Douglas v. Manbeck*, 21 USPQ2d 1697, 1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869 (Fed. Cir. 1992). Accordingly, since there is no showing in answer (C) that A was diligent, answer (A), which includes a showing that "A had sought status information from P every three months since November 1996," is a more correct answer choice.

Answer (C) also lacks an affidavit by A which would inform the PTO what steps, if any, A took to act as a "reasonably prudent person." Such a showing is required to demonstrate unavoidable delay. *See, e.g., In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). In sharp contrast, answer (A) includes such an affidavit with the required showing of diligence by the inventor. Accordingly, overall, answer (A) is more correct than answer (C).

Petitioner argues that answer (C) includes an affidavit that shows the delay was unavoidable and therefore meets the requirement for a petition to revive. However, contrary to Petitioner's position, *Douglas* holds that it is the applicant's responsibility to exercise due diligence with respect to his or her application. 21 USPQ2d at 1700. Answer (C) fails to include the fact that A regularly sought status information from P and an affidavit by A showing diligence on A's part. Accordingly, no error in grading has been shown.

Question 44 reads as follows:

44. Your client, the Happy Co., has come to you and requested that you file an international application under the Patent Cooperation Treaty (PCT) which designates Canada, Mexico, and the European Patent Office. Since today, August 26, 1998, is the last day of the Paris Convention priority year, you are rushing to prepare an application which will be granted an international filing date. Given the following elements, which combination is necessary to have an international filing date granted?

- I. The designation of at least one PCT contracting state.
 - II. The payment of the international fee.
 - III. A part of the application which appears to be a claim.
 - IV. The name(s) of the inventor(s).
 - V. An application in a language prescribed by the receiving office.
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- (A) I, II, and III.
 - (B) I, III, and V.
 - (C) I and III.
 - (D) II and V.
 - (E) I, III, IV, and V.

The correct answer is (B) and Petitioner chose answer (E). Answer (B) is the most correct answer. MPEP § 1810; PCT Article 11. As presented, element I is identified in section (1)(iii)(b) of PCT Article 11, element III is found in section (1)(iii)(e) of PCT Article 11, and element V is set forth in section (1)(ii) of PCT Article 11.

Petitioner argues that since the facts do not specify where the application was filed, she assumed that the application was filed in the U.S. Receiving Office which would require the name of the inventor and make her answer choice correct. However, assuming facts is directly contrary to the examination directions and therefore this

argument is without merit. Additionally, PCT Rule 2.1 reads:

“Whenever the word “applicant” is used, it shall be construed as meaning also the agent or other representative of the applicant, except where the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, such as, in particular, where the provision refers to the residence or nationality of the applicant.”

Thus, the name of the inventor(s) is not a necessary requirement to have an international filing date granted since the agent or other representative’s name may suffice. Accordingly, no error in grading has been shown.

ORDER

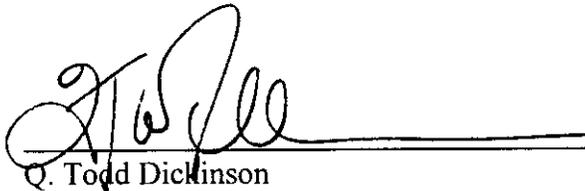
For the reasons given above, no points have been added to Petitioner’s score in the Morning Section of the Examination. Therefore, Petitioner’s score remains at 60.

This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing score on the Morning Section of the Examination is denied.

This is a final agency action.

AUG 18 1009



Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks