

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 certain examination questions. 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 and Petitioner only argues for disqualification of the question "for ambiguity" since it has two correct answers. 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.

Petitioner’s sole argument is that question 2 should be disqualified for ambiguity because it has two correct answer choices. However, the question is not rendered ambiguous by the fact that there are two correct answers. The fact that two correct answers were provided which covered the alternative meanings of “very similar” gave Petitioner the opportunity to correctly answer the question regardless of which meaning he 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 4 reads as follows:

4. As patent counsel for the Apex Biotechnology Corporation, you filed a patent application in the PTO on January 2, 1998, naming Smith as inventor, with claims directed to a method for recovering a purified eucaryotic growth hormone or an analog thereof from a bacterial cell. The growth hormone or analog thereof is produced in the bacterial cell via expression of a DNA sequence encoding the hormone or analog. A primary patent examiner initially rejected all the claims as obvious under 35 U.S.C. § 102(e)/103 in view of a commonly assigned application Serial No. 0X/XXX,XXX (the ‘XXX application), filed December 29, 1995 naming Jones as inventor. The rejection was “provisional” in the sense that the ‘XXX application had not yet issued as a patent. After consultations with Smith and Apex management, you filed a terminal disclaimer complying with 37 CFR § 1.321(c) disclaiming that part of the term of the Smith application which would extend beyond the expiration date of the commonly assigned, copending ‘XXX application. Upon the ‘XXX application becoming abandoned, in favor of a Continued Prosecution

Application (CPA), filed June 4, 1998, the examiner withdrew the rejection and substituted the following two rejections in the Smith application:

(1) A rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over commonly-assigned U.S. Patent No. A,AAA,AAA to Able in view of U.S. Patent No. B,BBB,BBB to Baker; and

(2) A “provisional” rejection of all the claims under 35 U.S.C. §§ 102(e)/103 as obvious over the CPA application in view U.S. Patent No. B,BBB,BBB to Baker.

The examiner correctly noted that both the Able patent and the CPA application disclose, but do not claim, the subject matter of the abandoned ‘XXX application, and that the application which matured into the Able patent was assigned to Apex and was filed in the PTO on December 29, 1995. The invention claimed in the Smith application is patentably distinct from the inventions claimed in the Able patent and the CPA application.

Which of the following actions and/or arguments is most likely to overcome the examiner’s rejections?

- (A) File a reply arguing (1) that the terminal disclaimer should be effective to overcome the 35 U.S.C. § 102(e)/103 rejection based on the public policy implicit in 35 U.S.C. § 103(c), which precludes citation as prior art of commonly-owned subject matter developed by another person, and (2) that Smith, Able, and Jones are “other persons.”
- (B) File a declaration under 37 CFR § 1.132 by Smith unequivocally declaring that he conceived or invented the subject matter disclosed but not claimed in the references.
- (C) File a reply arguing that the terminal disclaimer should be effective to overcome the 35 U.S.C. §§ 102(e)/103 rejection based on the analogy of such rejection to a double patenting situation, citing *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), wherein the court characterized an obviousness-type double patenting rejection as “analogous” to a 35 U.S.C. § 103 rejection.
- (D) File an affidavit under 37 CFR § 1.131 by Smith including facts that Smith conceived the claimed invention in a NAFTA member country in August 1993, that Smith moved to Hawaii in 1994 and began working on his conception in earnest during the period December 1994 until December 1, 1995, when he moved to a WTO member country other than a NAFTA country, where he successfully reduced his invention to practice on December 28, 1995. Accompany the affidavit with the argument that the affidavit effectively “swears back” of such references.

- (E) File a declaration under 37 CFR § 1.130 to disqualify the commonly owned references, accompanied by the argument that a prior art reference that renders claimed subject matter obvious under 35 U.S.C. § 103 necessarily creates an obviousness-type double patenting situation, which is obviated by the filing of the terminal disclaimer.

The correct answer is (B) and Petitioner only argues for disqualification of the question “for the need to assume facts.” Choice (B) is the most correct answer because, as the fact pattern states, “both the Able patent and the CPA application disclose, but do not claim, the subject matter of [Smith’s earlier] application.” In such a situation:

it is incumbent upon the inventors named in the application . . . to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the petitioner rather than invented by the . . . patentee notwithstanding . . . the inventorship of the patent.

MPEP § 716.10. Accordingly, since Smith conceived of the same invention disclosed in the references but not claimed, he can submit an affidavit swearing to be the inventor of the subject matter claimed.

Petitioner’s sole argument is that question 4 should be disqualified for the need to assume facts on the basis that answer (B) assumes that Smith unequivocally conceived or invented the subject matter disclosed but not claimed in the references. However, as noted above, the fact pattern expressly states that “both the Able patent and the CPA application disclose, but do not claim, the subject matter of [Smith’s earlier] application.” Accordingly, there is no assumption of facts to lead to the correct answer and Petitioner’s argument for disqualification of the question is without merit. No error in grading has been shown.

Question 11 reads as follows:

11. Jack developed a unique safety valve for use in combination with a standard boiler. The safety valve comprises a piezoelectric element which functions to adjust the opening of the valve in response to pressure build-up. His patent agent prepared and filed a proper patent application in the PTO with the following sole original claim:

The combination of a standard boiler with a safety valve, said safety valve comprising a piezoelectric element which functions to adjust the opening of the valve in reply to pressure build-up.

In the first Office action, the primary examiner properly rejected the claim over a combination of references as being unpatentable under 35 U.S.C. § 103. Thereafter, the patent agent responded by filing an amendment which substituted a new claim for the sole original claim. The new claim is also drawn to the combination of a standard boiler with a safety valve. The examiner finally rejected the new claim on same grounds as the original claim was rejected, and stating that the new claim was a substantial duplicate of all the essential features of the canceled claim. Which of the following accords with PTO practice and procedure for responding to the rejection?

- (A) File a response having an amendment which adds a single claim limited to the safety valve, accompanied by argument clearly demonstrating that the claim to the safety valve has limitations not shown in the prior art references.
- (B) File a response clearly and correctly pointing out that the new claim has limitations to particular structure not disclosed or suggested by the prior art references whether considered individually or in combination.
- (C) File a response accompanied by an affidavit under 37 CFR § 1.132 setting forth test data demonstrating the technical superiority of Jack's safety valve over the safety valves in the prior art when used in conjunction [with] pneumatic tire inflation devices.
- (D) File a petition to the Commissioner under 37 CFR § 1.81 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection as being premature because the new claim presented limitations not disclosed or suggested by the prior art references, and the examiner did not address those limitations in the rejection.

- (E) File a petition to the Commission under 37 CFR § 1.183 and the proper petition fee requesting that the examiner be directed to withdraw the finality of the rejection on the ground that the finality of the rejection was premature inasmuch as the new claim contained limitations not disclosed or suggested by the references, and the examiner did not address those limitations in the rejection.

The correct answer is (B) and Petitioner only argues for disqualification of the question “for the need to assume facts.” Choice (B) is the most correct answer because a final rejection does not preclude consideration of further amendment or argument regarding the rejected claim. MPEP § 714.12.

Petitioner’s sole argument is that question 11 should be disqualified for the need to assume facts on the basis that answer (B) assumes that the new claim of the question statement has limitations to particular structure not disclosed or suggested by the prior art references. However, the fact pattern expressly states that the practitioner filed an amendment which substituted “a new claim for the sole original claim.” Filing an amendment and substituting a new claim means that it differs from the original claim. Thus, the practitioner may respond to the examiner by pointing out the differences in an attempt to overcome the references. Accordingly, there is no need to assume additional facts and 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 correct answers and Petitioner only argues for disqualification of the question “for ambiguity” since it has two correct answers. 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).

Petitioner’s sole argument is that question 26 should be disqualified for ambiguity because it has two correct answer choices. However, the question is not rendered ambiguous by the fact that there are two correct answers. The fact that two correct answers were provided gave Petitioner two opportunities to correctly answer the question. Petitioner does not dispute that answers (C) and (D) comply with PTO practice and procedure. Accordingly, Petitioner’s argument fails to point out any error in the grading of his examination.

Question 32 reads as follows:

32. In connection with an appeal to the Board of Patent Appeals and Interference's, which of the following rejections would be a new ground of rejection?

- (A) In a final Office action, Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B. On appeal, in the examiner's answer, the primary examiner again states that Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B, but the actual argument or rationale supporting the rejection, while having the same basic thrust as the argument or rationale advanced in the final rejection differs therefrom.
- (B) In a final Office action, Claim 6 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 8 is rejected under 35 U.S.C. § 103 over A in view of C. No claim was rejected under 35 U.S.C. § 103 over A in view of B and C. In reply, an amendment proposes to combine the limitations of Claims 6 and 8 together in a new claim, Claim 9, and canceling Claims 6 and 8. In an advisory action, the primary examiner permits entry of the amendment as reducing issues on appeal. On appeal, in the examiner's answer, the primary examiner rejects Claim 9 under 35 U.S.C. § 103 over A in view of B and C, supported by the argument advanced in the rejections of Claims 6 and 8.
- (C) In a final Office action, Claims 1 and 2, where Claim 2 depends on Claim 1, are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to rewrite Claim 2 in independent form and cancel Claim 1. In an advisory action, the primary examiner advises that the proposed amendment will be entered as reducing issues on appeal, and that the final rejection would be used to reject Claim 2 as amended. On appeal, in the examiner's answer, the primary examiner rejects Claim 2 under 35 U.S.C. § 103 over A in view of B, supported not only by the argument advanced in the rejections of Claims 1 and 2, but also by rationale not advanced in the final rejection, though the rationale has the same thrust as the rationale in the final Office action.
- (D) In a final Office action, Claims 2 and 3 are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to cancel Claims 2 and 3, and add Claim 4, which incorporates the limitations of Claims 2 and 3. In an advisory action, the primary examiner advises that the proposed amendment will be entered, and that the final rejection would be used to reject the added Claim 4. On appeal, in the examiner's answer, the primary examiner rejects Claim 4 under 35 U.S.C. § 103 over A in view of B, supported by the argument advanced in the rejections of Claims 2 and 3.

- (E) In a final Office action, Claim 3 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 4 is rejected under 35 U.S.C. § 103 over A in view of C. In reply, an amendment proposes to combine the limitations of Claims 3 and 4 together in a new claim, Claim 5, and canceling Claims 3 and 4. In an advisory action, the primary examiner denies entry of the proposed amendment as not reducing issues on appeal. On appeal, in the examiner's answer, the primary examiner states that Claim 3 has been rejected under 35 U.S.C. § 103 over A in view of B, and claim 4 has been rejected under 35 U.S.C. § 103 over A in view of C, and supports the rejections by expanding upon the arguments advanced in the final Office action.

The correct answer is (B) and Petitioner only argues for disqualification of the question "for ambiguity" on the basis that answer (E) is also a correct answer. The question inquires which of the five rejections would be a new ground of rejection in connection with an appeal to the Board of Patent Appeals and Interferences. Choice (B) is where, in a final Office action, Claim 6 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 8 is rejected under 35 U.S.C. § 103 over A in view of C; no claim was rejected under 35 U.S.C. § 103 over A in view of B and C; in reply, an amendment proposes to combine the limitations of Claims 6 and 8 together in a new claim, Claim 9, and canceling Claims 6 and 8; in an advisory action, the primary examiner permits entry of the amendment as reducing issues on appeal; and on appeal, in the examiner's answer, the primary examiner rejects Claim 9 under 35 U.S.C. § 103 over A in view of B and C, supported by the argument advanced in the rejections of Claims 6 and 8. Choice (B) is the most correct answer because in 37 CFR § 1.193(a)(2), the "individual rejections" in the final rejection were rejections under 35 U.S.C. § 103 over A in view of B, and over A in view of C. There was no individual rejection under 35 U.S.C. § 103 in the final rejection over A in view of B and C.

In choice (E), there is no new ground of rejection. There is no change in the rejections between the final Office action and any on appeal. Answer (E) states that the examiner expands on the argument. There is no mention of a new rejection and there is no mention of a new claim.

Petitioner refers to 37 C.F.R. § 1.196(b) which permits the Board of Patent Appeals and Interferences to make a new ground of rejection. Petitioner contends that this rule could apply to an examiner's answer. Contrary to Petitioner's position, an examiner who issues a new ground of rejection must reopen prosecution of the application. See 37 C.F.R. § 1.193(a)(2). Section 1.196(b) is for decisions by the Board. 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 mislead [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 only argues for disqualification of the question “for inappropriate application of case law to 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 A's attorney may show diligence and that a reasonable interpretation of answer (C) shows unavoidable delay. 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. Petitioner maintains that the question or the answers contain ambiguous information, but fails to particularly point out what language is allegedly ambiguous, as required by 37 C.F.R. § 10.7(c). Accordingly, no error in grading has been shown.

Question 43 reads as follows:

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

- (A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.
- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.

- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.
- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.
- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

The correct answers are (A) and (B) and Petitioner only argues for disqualification of the question “for ambiguity.” The question presents five different situations wherein the attorney of record calls an error to the attention of the examiner and asks for the one that is not in accord with proper PTO practice and procedure. Answers (A) and (B) are the most correct answers. MPEP § 710.06 provides that “[i]f the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period.” Since the errors in both (A) and (B) were called to the examiner’s attention more than one month after the date of the Office action, the Office would set a new period for

reply “to substantially equal the time remaining in the reply period.” Under this practice, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a “three month shortened statutory period” is not in accord with proper PTO practice and procedure. MPEP § 710.06 also provides that the Office will set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. MPEP § 710.06.

Petitioner argues that question 43 should be disqualified for ambiguity because it has two correct answer choices. However, the question is not rendered ambiguous by the fact that there are two correct answers. The fact that two correct answers were provided gave Petitioner two opportunities to correctly answer the question. Petitioner does not dispute that answers (C) and (D) comply with PTO practice and procedure. Accordingly, Petitioner’s argument fails to point out any error in the grading of his examination.

Petitioner also argues that the language in the question which asks which request and reply is not in accordance with proper PTO practice and procedure is subject to different interpretations and therefore renders the questions ambiguous. However, the question is directed to the procedure to follow when an office action is received which is not complete and the appropriate response from the PTO when the error is properly brought to the attention of the PTO. If the request is not in accordance with the procedure set forth in the MPEP, the time period will not be reset or restarted, as set forth in MPEP § 710.06. The MPEP clearly identifies the time periods required for notification to the PTO in order to get a three month time period for response reset and when only two months or one month will be set as the time period for response. As demonstrated

above, choices (A) and (B) are clearly not in accord with proper PTO procedure.

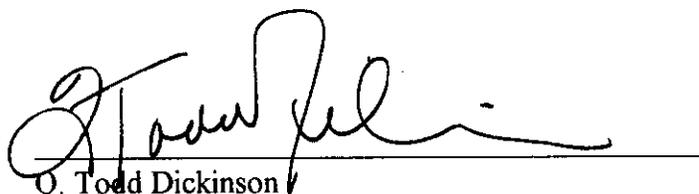
Accordingly, no error in grading has been shown.

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

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied.

AUG 18 1999

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

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