

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

JUL 28 1999

In re )  
          ) Decision on  
          ) Petition for Regrade  
          ) Under 37 C.F.R. § 10.7(c)  
\_\_\_\_\_)

**MEMORANDUM AND ORDER**

(Petitioner) petitions for regrading answers to questions 5, 8, 25, 29 and 30 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

**BACKGROUND**

An Applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64 on the afternoon section. On January 4, 1999, Petitioner requested regrading of five two-point questions on the afternoon section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

**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 afternoon 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.

Question 5:

Two points are awarded for question 5.

Question 8 reads as follows:

8. A patent application describes an improved cat litter tray, preferably rectangular in shape, and includes drawings depicting such a tray having a major axis and a minor axis and adapted to hold a layer of cat litter. The specification describes and the drawings depict a removable igloo-like cover mated with at least two sides of the tray in a friction fit manner and containing an opening at each end of the cover parallel to the minor axis of

the tray adapted for ingress and egress of a cat. The essential feature described in the specification and depicted in the drawings resided in a screen, pivotally affixed to opposing sides of the tray parallel to the major axis of the tray at points above the cat litter. In operation, as described in the specification, a cat would enter the device through one of the openings in the igloo-like cover stepping upon the screen, preferably wire mesh. The weight of the cat would cause the screen to pivot downward until it contacted the layer of cat litter. Following urination, the cat would egress from the device through a cover opening, the urine having passed through the wire mesh screen to be absorbed by the cat litter, and the cat having egressed without carrying any litter to be tracked into the surrounding area. During the day, ingress and egress from the opposing cover openings would result in the pivotally affixed wire mesh screen being subjected to a see-saw action, essential to break up and disintegrate dried fecal matter, thus permitting the matter to pass through the screen to the litter below. Reference numerals assigned to the elements and shown in the drawings were as follows: tray 10, screen 15, cover 20 . . . .

Which of the following claim phrases accord(s) with PTO practice and procedure regarding the form of claims?

- (A) An improved cat litter tray comprising a tray 10, a screen 15, a cover 20 . . . .
- (B) An improved cat litter tray comprising a tray (10), a screen (15), a cover (20) . . . .
- (C) An improved cat litter tray comprising a tray, a screen, a cover, . . . .
- (D) A and B
- (E) B and C

The correct answer is choice (E) because it is the most comprehensive answer that accords with PTO practice and procedure regarding the form of claims. MPEP § 608.01(m) recites: "Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same elements or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims." Choices (B) and (C) individually are not as comprehensive as choice (E).

The correct answer is choice (E) and Petitioner selected choice (C). Petitioner contends that “since answer (E) does not include parenthesis around ‘B’ and ‘C,’ answer choice (E) includes letters ‘B’ and ‘C’ rather than answers (B) and (C).” To support this contention, Petitioner refers to other questions on the exam that used parentheses when listing a plurality of answer choices. Petitioner further contends that “[s]ince a majority of registered practitioners avoid including reference characters in claims, my answer (C), which does not include reference characters, is preferable over answer (B).”

Petitioner’s arguments are not persuasive. Petitioner argues that choice (E) does not refer to a combination of choices (B) and (C). Apparently it is supposed to be the language of the claim itself. The context of the question does not support his argument. Petitioner also argues that a majority of practitioners would not use reference characters. However, the question does not ask what a majority of practitioners might do. The question asks “[w]hich of the following claim phrases accord(s) with PTO practice and procedure regarding the form of claims?” Both choice (B) and choice (C) are in accord with PTO practice and procedure. No error in grading has been shown. Petitioner’s request for credit on Question 8 is denied.

Question 25 reads as follows:

25. Which of the following is false?

- (A) The meaning of terms in a claim should be ascertainable by reference to the description in the specification.
- (B) While a term used in a claim may be given a special meaning in the description, no term may be given a meaning repugnant to the usual meaning of the term.
- (C) Trademarks may be used in claims only if each letter in the trademark is capitalized.
- (D) Claims may not contain tables or chemical or mathematical formulas.

(E) Figures may be incorporated by reference in the claims.

Both choices (C) and (D) contain false statements and are, therefore, correct answers. Choice (C) is a false statement because capitalization alone is not enough to constitute proper use of a trademark in a claim. Trademarks should be identified by capitalizing each letter of the mark. See MPEP § 608.01(v). However, a claim should be carefully analyzed to determine how a trademark is used in the claim. If the trademark is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See MPEP § 2173.05(u), citing *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). In such a case, the claim scope is uncertain since a trademark is a source identifier, not an identification of a particular material or product. Thus, it is not true that trademarks may be used in the claim **only if** each letter in the trademark is capitalized. Claims may contain chemical or mathematical formulas and, if necessary, may contain tables. 37 CFR § 1.58(a). Thus, choice (D) is a false statement.

Both choices (C) and (D) are correct answers and Petitioner selected choice (E). Petitioner contends that “answer (E) is as correct as answers (C) and (D)” because “[f]igures may be incorporated by reference in the claims only in exceptional circumstances.” According to Petitioner, choice (E) “falsely [indicates] that incorporating figures into claims is generally permitted,” contrary to MPEP § 2173.05(s). Petitioner maintains that the statement in choice (E) that “[f]igures may be incorporated by reference in the claims” is not accurate.

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, choice (E) does not indicate that “incorporating figures into claims is generally permitted.”

Choice (E) is a true statement. Figures are permitted where necessary. See MPEP § 2173.05(s), citing *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Int. 1993). No error in grading has been shown. Petitioner's request for credit on Question 25 is denied.

Question 29 reads as follows:

29. Your client's bowling pin includes both a unique functional structure and unique surface ornamentation. You decide that it would be beneficial to protect the unique structure and the unique surface ornamentation separate and apart from one another. Which of the following would be an appropriate action for separately protecting the unique functional structure of the bowling pin?

- (A) Draft a dependent claim covering the unique functional structure and file it in the same design application as the claim covering the entire design of the bowling pin.
- (B) File a separate utility application claiming only the unique functional structure of the bowling pin.
- (C) File a separate design application claiming only the unique surface ornamentation of the bowling pin.
- (D) File a separate utility application claiming a unique method for making a wooden bowling pin having the unique functional structure.
- (E) None of the above.

The most correct answer is choice (B) because a utility patent would provide separate protection for the unique functional structure of the bowling pin. Choice (A) is incorrect because a design patent may not contain more than one claim and because a design patent may be used to protect "ornamental design" but not functional structure. 35 U.S.C. § 171; 37 C.F.R. § 1.153(a). Choice (C) is incorrect because a design patent may be used to protect "ornamental design" but not functional structure. 35 U.S.C. § 171. Choice (D) is incorrect because the method claim proposed would not protect the functional structure of the bowling pin.

The most correct answer is choice (B) and Petitioner selected choice (C).

Petitioner contends that “[a]nswers (B) and (C) are both correct, because they are actually the same answer, by implication.” According to Petitioner, “[t]he words ‘separate utility application’ in answer (B), when read in the context of the question, imply that a separate design application is also being filed.” Petitioner maintains that “[c]onversely, the words ‘separate design application’ in answer (C) imply that a separate utility application is also being filed.” Petitioner concludes “both answers (B) and (C) indicate that two separate applications, a design application and a utility application, are being filed.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, choices (B) and (C) do not imply that two separate applications are being filed. Choice (C) does not address the problem of protecting a functional structure. There is no basis for Petitioner’s assumption that choice (C) solves the problem by implication. The examination instructions state “[d]o not assume any additional facts not presented in the questions.” No error in grading has been shown. Petitioner’s request for credit on Question 29 is denied.

Question 30 reads as follows:

30. Which of the following requirements of 35 U.S.C. § 112 do NOT apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

Choice (E) is correct. 35 U.S.C. § 171 provides “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided.”

The correct answer is choice (E) and Petitioner selected choice (D). Petitioner contends that choice (D) “is the more preferable answer.” According to Petitioner, “[a]lthough the Patent Act does not explicitly exempt design patent applications from the third paragraph of § 112, it effectively does.” Pointing to 37 C.F.R. § 1.153(a), Petitioner maintains that “design patent applications may have only a single claim, and therefore § 112, third paragraph, which addresses the independence versus dependence of a claim, can not [sic] possibly apply to such applications.” Petitioner argues in the alternative that “this question should be withdrawn for lack of clarity.”

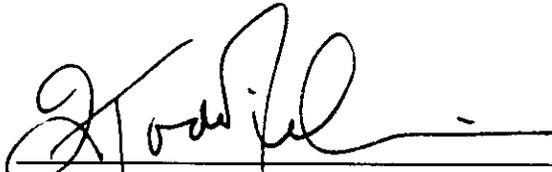
Petitioner’s arguments are not persuasive. Petitioner’s contention that the Patent Act “effectively” exempts design patent applications from the third paragraph of section 112 lacks foundation. The third paragraph of section 112 states that “[a] claim may be written in independent, **or if the nature of the case admits**, in dependent . . . form.” (Emphasis added). The nature of design patents does not admit claims in dependent form because Rule 1.153(a) prohibits more than one claim. Thus, the statutory requirement for an independent claim continues in force for design patents while dependent claims are not admitted. No error in grading has been shown. Petitioner’s request for credit on Question 30 is denied.

**ORDER**

For the reasons given above, two points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 66. This score is insufficient to pass the Afternoon Section of the Examination.

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

This is a final agency action.



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

cc: