

of the morning section was mailed to Petitioner on August 7, 1998. A decision from the Director on request for regrade of the afternoon section was mailed to Petitioner on August 28, 1998. Neither decision added any points to Petitioner's score.

By petition received September 9, 1998, Petitioner requests that the Commissioner reverse the Director's denial of credit for question 40 of the morning section of the Examination. By petition received September 30, 1998, Petitioner requests that the Commissioner reverse the Director's denial of credit for questions 18 and 27 of the afternoon section of the Examination.

Opinion

Pursuant to 37 CFR § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The burden is upon the Petitioner to show that his chosen answer is the most correct answer. The directions to the exam state: "Do not assume any additional facts not presented in the questions." In addition, the directions also state:

The most correct answer is the policy, practice and procedure which must, shall, or should be followed in accordance with U.S. patent statutes, the PTO rules of practice or 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.

Petitioner has presented numerous arguments attacking the validity of the Director's decision. All of Petitioner's arguments have been considered. For the following reasons, no

points will be added to Petitioner's score for the morning section and two points will be added to the Petitioner's score for the afternoon section.

Morning Section

QUESTION 40

Question 40 reads as follows:

40. Kent, an inventor, filed a patent application in the PTO and received a filing date of June 14, 1995, on a supersonic krypton diffuser. On October 17, 1995, Mr. Kent filed an Information Disclosure Statement (IDS). On October 28, 1995, Mr. Kent received an Office action from the examiner dated October 19, 1995, allowing Claims 1-5, the only claims in the application. What action must Mr. Kent take to have the IDS considered by the examiner?

- (A) Submit a certification under 37 CFR § 1.97 and a fee.
- (B) Submit a certification under 37 CFR § 1.97 only.
- (C) Submit a certification under 37 CFR § 1.97, petition, and petition fee.
- (D) Submit a petition and petition fee.
- (E) None of the above.

In the model answer, choice (E) is identified as the correct answer on the basis of 37 CFR § 1.97(b)(3) and Manual of Patent Examining Procedure (MPEP) § 609. Section 1.97(b)(3) states that "[a]n information disclosure statement shall be considered by the Office if filed by the applicant: . . . (3) Before the mailing date of a first Office action on the merits." MPEP § 609 explicitly states that an IDS "filed within this period [i.e., before the mailing date of a first Office action on the merits] requires neither a fee nor a statement under 37 CFR 1.97(e)." MPEP § 609(B)(1), at 600-106.

Petitioner selected choice (B). This choice is incorrect. Under § 1.97, a certification under 37 CFR § 1.97 is not needed where the IDS was filed before the first Office action.

Petitioner argues that the model answer is not correct because it is based on the assumption of additional facts not presented in the question. In particular, the Petitioner argues that the question is silent as to whether the October 19, 1995 Office action was the first Office action.

Petitioner's argument lacks merit. The model answer properly classifies the October 19, 1995 Office action as the first Office action. It is the only Office action referred to in the question; there is nothing in the question which would lead one to believe that any other Office actions had issued. The statement regarding the October 19, 1995 Office action should be read in the context of the question, which describes a series of events that took place during the prosecution of the application. It is Petitioner's answer, choice B, that assumes "additional facts not presented in the questions." That is, choice B would only be correct if it is assumed that the October 19, 1995 Office action was not the first Office action. Since the question does not present any facts which suggest that the October 19, 1995 Office action was not the first Office action, choice (B) is not correct.

Afternoon Section

QUESTION 18

Question 18 is ambiguous, making it unclear which answer is most correct. Therefore, no points will be deducted for this question. Two points will be added to Petitioner's score for question 18.

QUESTION 27

Question 27 reads as follows:

27. Applicant filed a patent application relating to adhesive compositions having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer. The specification states, "The compositions of this invention must contain, as essential ingredients, at least one monomer of a class of alpha-cyanoacrylic acid esters and at least one filler." The compositions are characterized as being capable of being applied to a substrate submerged in water. Claim 1 reads as follows:

1. An adhesive composition having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer, the composition being capable of being applied to a substrate submerged in water.

The examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, by virtue of the functional statement regarding application to a substrate submerged in water therein, and under 35 U.S.C. § 112, first paragraph, as unduly broad. You decide to amend the application by canceling claim 1 and adding a new claim or claims. Assuming proper claim numbering, which of the following claims and arguments

accords with proper PTO practice and procedure and would overcome the rejections?

. . . .
(B) Claim - An adhesive composition having a paste-like consistency and comprising filler admixed with at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer, the composition being capable of being applied to a substrate submerged in water.

Argument - The 35 U.S.C. § 112, second paragraph, rejection is traversed on the ground that functional language in patent claims is permissible so long as it sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The 35 U.S.C. § 112, first paragraph, rejection is obviated because the breadth of the language "liquid monomer" has been narrowed to an essential ingredient, i.e., at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters.

. . . .
(D) Claim - An adhesive composition having a paste-like consistency and comprising filler admixed with at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.

Argument - The 35 U.S.C. § 112, second paragraph, rejection is obviated because the functional statement is no longer recited in the claim. The 35 U.S.C. § 112, first paragraph, rejection is obviated because the breadth of the language "liquid monomer" has been narrowed to an essential ingredient, i.e., at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters.

(E) (B) and (D).

In the model answer, choice (E) is identified as the best answer. The reason given is that the claims set forth in (B) and (D) do not violate 35 U.S.C. § 112, first and second paragraph.

Petitioner asserts that choice (D) is the most correct answer because the claim set forth in choice (B) contains

functional language. Petitioner argues that choice (B) is not the most correct answer because it requires an interpretation of whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. Petitioner believes that choice (D) is more correct because it avoids functional issues and related opinions.

The question asks "which of the following claims and arguments accords with proper PTO practice and procedure and would overcome the rejections." Choice (E) is the best answer because the options given in (B) and (D) would both accord with proper PTO practice and procedure and would both overcome the rejections. See MPEP 2173.05(g) ("There is nothing inherently wrong with defining some part of an invention in functional terms."). While it is true that choice (B) requires the person taking the exam to determine whether the limitation "capable of being applied to a substrate submerged in water" circumscribes a particular area with a reasonable degree of particularity, this does not make choice (B) any less correct than choice (D). Rather, because this limitation does circumscribe a particular area with a reasonable degree of particularity, the correct answer takes into account that both (B) and (D) accord with proper PTO practice and procedure and would overcome the rejections. Because (E) contemplates that both (B) and (D) satisfy this condition, (E) is the best answer.

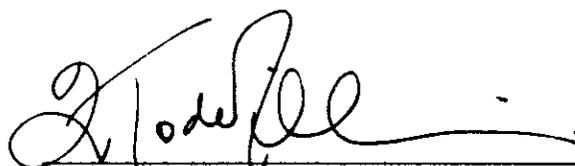
CONCLUSION

Petitioner's grade for the morning section will not be changed. The final grade for the morning section is 68 points. Two points will be added to Petitioner's grade for the afternoon section. The final grade for the afternoon section is 69 points. Petitioner has not achieved a passing grade of 70 in either the morning or afternoon sections of the Examination.

ORDER

Upon consideration of the Petition to the Commissioner under 37 CFR § 10.2(c), it is

ORDERED that the petition is denied.



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