

The Morning Section of the May 1995 Registration Examination consisted of fifty multiple-choice questions testing the applicant's knowledge of practice and procedure in patent cases before the PTO. Each question was worth two points. Thus, to pass the morning section, : must show that he correctly answered one question that the Director adjudged him to have answered incorrectly.

The Directions for the Morning Section provided:

Do not assume any additional facts not presented in the questions. . . . 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 There is only one most correct answer for each question.

petition is directed to Question 10 of the Morning Section. With respect to Question 10, the Examination provided:

Questions 9-13 below are based on the following factual scenario. Unless otherwise indicated, answer each question independently of the other questions.

On June 25, 1992, in Brussels, Belgium, inventor Sprout reduced to practice a vegetable processor device. He instructed a Belgian patent attorney, Phideux, to obtain patent protection in Belgium. Phideux prepared the patent application on the inventive vegetable processor device and filed the application in the Belgian Patent Office on January 4, 1993. The Belgian Patent was granted on February 1, 1993, but the invention disclosure was not laid open for public inspection, via a publication of the abstract, until May 3, 1993. The certified copy of the patent decree, along with an attached copy of the specification, was sent by the Belgian Patent Office to Sprout on June 10, 1993. The complete specification was not published until December 23, 1993.

On January 5, 1994, Sprout realized that it was no longer possible for his Belgian application to act as a priority document because the anniversary for filing a patent application in the United States had passed. Thus, he was not entitled to foreign priority for his Belgian application. The invention had been first sold to a Belgian company, which does vegetable processing, on October 7, 1993, and was slowly gaining favor among other vegetable processors in Europe. Based on this limited commercial success, Sprout decided that it would be prudent to obtain patent protection in the United States. He hired you to act as his U.S. agent. On January 14, 1994, you filed the U.S. application, containing claims 1-10.

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For Questions 10-12, assume Sprout did not file an application in Belgium nor obtain a [Belgian] patent.

10. In the first Office action, the examiner rejected claims 1-10 as being anticipated by the disclosure in a U.S. patent to Carrot. The Carrot patent discloses, but does not claim, a vegetable processor. The Carrot patent issued on August 16, 1994, and is based on a patent application filed on June 26, 1992. Under which of the following sections of Title 35 U.S.C., if any, would Sprout 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.

selected answer (E), "None of the above," to Question

10. However, the Director adjudged that answer (D), "[35 U.S.C. §] 102(e)," was the correct answer. The Morning Section Model

Answers explained:

The invention was described in Carrot which was patented on August 16, 1994, which is prior to, but less than 12 months from when the patent application was filed in the U.S. on January 14, 1994. Since Sprout filed on 1/14/95 (sic, 1/14/94), Sprout could

not rely on his acts abroad to establish reduction-to-practice under 35 U.S.C. § 104

asserts that both (D) and (E) may be correct answers to Question 10, depending on which provision in 35 U.S.C. § 104 applies. Section 104 has been amended since the May 1995 Registration Examination. However, the version of section 104 which applied to Sprout's U.S. application provided, in relevant part:

(a) *In General.*--In proceedings before the Patent and Trademark Office . . . , an applicant for a patent . . . may not establish a date of invention by reference to knowledge or use thereof, or any other activity with respect thereto, in a foreign country other than a NAFTA country Where an invention was made by a person . . . while domiciled in the United States or a NAFTA country and serving in any other country in connection with operations by or on behalf of the United States or a NAFTA country, the person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States or a NAFTA country. . . .

"NAFTA" refers to the North American Free Trade Agreement.

Belgium is not a NAFTA country.

According to . . . , the correct answer to Question 10 depends on whether Sprout, at the time of his making the invention on June 25, 1992, satisfied the exception of the second sentence of section 104(a) for persons "domiciled in the United States or a NAFTA country and serving in any other country in connection with operations by or on behalf of the United States or a NAFTA country." If so, then Sprout can rely on his Belgian

activities to establish a date of invention of June 25, 1992, which is prior to Carrot's June 26, 1992 filing date; section 102(e) therefore does not apply; and (E), "None of the above," is the correct answer. But if Sprout did not meet the exception of the second sentence, then the general rule of the first sentence of section 104(a) applies; Sprout cannot rely on his Belgian activities to avoid section 102(e); and (D), "\$ 102(e)," is the correct answer.

contends that since Question 10 has two possibly correct answers, and he selected one of those answers, he deserves credit for a correct answer to Question 10. If so, then score should be increased to 70, giving him a passing score for the Morning Section.

The Director issued a Regrade Decision on March 11, 1996 which, among other things, did not award credit for a correct answer on Question 10 of the Morning Section. then requested that the Director reconsider her Regrade Decision. The Director issued Reconsideration Decisions on August 20, 1996 and September 12, 1997 which again did not award credit for a correct answer to Question 10.

The Director asserts that the only correct answer to Question 10 is (D), "\$ 102(e)"; that did not choose this answer; and thus that deserves no credit for a correct answer to Question 10. The Director's reconsideration decision of September .12, 1997 agrees with that the correct answer

would instead be (E), "None of the above," if Sprout met the exception of the second sentence of section 104(a). However, the Director's reconsideration decision relies on the Directions for the Morning Section, which forbade examinees from assuming any additional facts not presented in the questions. Since Question 10 did not state that Sprout met the exception of the second sentence of section 104(a), the Director's reconsideration concludes that [redacted] had no basis for assuming that the exception was met, and [redacted] answer was incorrect.

OPINION

The Commissioner has carefully considered arguments. However, for the reasons stated below, the Commissioner concludes that [redacted] is not entitled to any additional points.

[redacted] is correct that the answer to Question 10 of the Morning Section of the May 1995 Registration Examination depends on 35 U.S.C. § 104(a). The general rule of section 104(a), stated in the first sentence, is that inventors may not rely upon acts in a non-NAFTA country to establish a date of invention. If the general rule applies, Sprout may not rely upon his June 25, 1992 invention in Belgium to avoid the preclusive effect of Carrot's U.S. patent application filing on June 26, 1992. Thus, if the general rule applies, Carrot's patent is prior art under 35 U.S.C. § 102(e), and answer (D) is correct.

proposed answer relies upon the second sentence of section 104(a), which states a narrow exception to the general rule of the first sentence. Sprout may rely upon his June 25, 1992 invention in Belgium to avoid Carrot under section 102(e) if Sprout was "domiciled in the United States or a NAFTA country and serving in any other country in connection with operations by or on behalf of the United States or a NAFTA country." Thus, if the exception of the second sentence of section 104(a) applies, Carrot's patent is not prior art and answer (E) is correct.

is also correct that Question 10 does not specify whether or not Sprout met the exception of the second sentence of section 104(a). Thus, while the Director is correct that

reasoning for answer (E) rests on an assumption, the Director's reasoning in support of answer (D) also rests on an assumption. Answer (E) assumes that Sprout met the exception of the second sentence of section 104(a); answer (D) assumes that Sprout did not meet the exception.

However, argument overlooks the more fundamental reason why his answer to Question 10 does not deserve credit. The Directions for the Morning Section required Wright to provide the most correct answer to each question to receive credit. And answer (D) is the most correct answer to Question 10.

The most correct answer is the answer which accords with the general rule of section 104(a), not the narrow exception. Applicants for registration to practice in patent cases before

the PTO are expected to understand and apply the patent statutes, including section 104. An applicant who correctly understood the structure of section 104 would have recognized that the general rule is that applied in all but exceptional circumstances, and thus would have selected the answer to Question 10 corresponding to the general rule--answer (D)--absent any indication in Question 10 that the exception would apply.

Thus, answer (D), "§ 102(e)," is the most correct answer to Question 10. Answer (E), "None of the above," while potentially correct, is less correct than answer (D) because Question 10 does not give any indication that exceptional circumstances apply. The Director correctly refused to award credit for the most correct answer to Question 10.

CONCLUSION

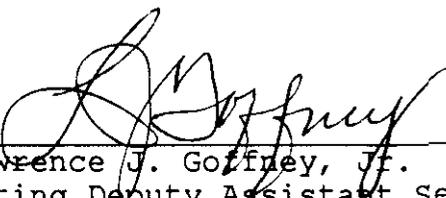
Having carefully considered Wright's arguments, the Commissioner concludes that [redacted] is not entitled to any additional points, and [redacted] petition is denied.

ORDER

On consideration of _____ : Petition to the
Commissioner for Review of the Regraded May 1995 Examination, it
is

ORDERED that the petition is denied, the Director's
reconsideration decision of September 12, 1997 is affirmed, and
petitioner's score for the Morning Section of the May 3, 1995
Registration Examination for Patent Attorneys and Agents remains
at 68.

3/27/98
Date



Lawrence J. Goffney, Jr.
Acting Deputy Assistant Secretary
of Commerce and Deputy Commissioner
of Patents and Trademarks

cc: