

APR 18 1994

R1994-2

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

In re _____)
) Decision on Petition
) for Review under
) 37 CFR § 10.2(c)
)

MEMORANDUM OPINION AND ORDER

(petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED), dated March 22, 1994, which denied the petitioner's request for higher scores on both Part I and Part II of the afternoon section of the Registration Examination for Patent Attorneys and Agents held on October 13, 1993.

The Director's decision of March 22, 1994, is affirmed. The petitioner is not entitled to any additional points on the score achieved for the afternoon section of the examination.

Background

The afternoon section of the examination consist of two parts. Part I consists of a claim drafting question worth 60 points. Part II consists of Multiple Choice Question Nos. 1-8 worth 5 points each. To pass the afternoon section of the examination, 70 points had to be achieved.

The petitioner had 15 points deducted from his score for answering three multiple choice questions incorrectly. On the claim drafting question, 24 points were deducted. Accordingly, the petitioner achieved a combined score of 61 points for the afternoon section of the examination, 9 points short of a passing grade.

On January 4, 1994, the petitioner requested a regrade of the Claim Drafting Question and of Multiple Choice Question No. 2. On January 31, 1994, the OED issued a regrade decision which determined that the petitioner was not entitled to any additional points for either the Claims Drafting Question or for Multiple Choice Question No. 2.

On February 14, 1994, the petitioner requested reconsideration by the Director of OED. The Director's decision was issued on March 22, 1994. The Director determined that the petitioner was not entitled to any additional points on either the Claim Drafting Question or on Multiple Choice Question No. 2.

Opinion

A. The Claim Drafting Question

In answering the claim drafting question, the petitioner had an option to work with any one of three different disclosed inventions -- a mechanical invention, a chemical invention, and an electrical invention. The petitioner chose the mechanical invention which is directed to a shaving implement.

A specification of the invention was provided by the question, including a paragraph entitled Objects of the Invention, figures showing two embodiments of the invention, and detailed written description of the two embodiments.

The question contained these instructions:

Draft THREE (3) CLAIMS: a single independent claim and two dependent claims to a shaving

implement. The generic claim (claim 1) must be the broadest claim for the shaving implement which defines the invention as set forth in the OBJECTS OF THE INVENTION, which includes any critical limitations, and which is not anticipated by the prior art. One dependent claim (claim 2) must cover the specific embodiment shown in FIGS. 1 through 3 and further include the relatively rotatable first and second closure parts with the cooperating interior chamber, passages, and angled conduit. The other dependent claim (claim 3) must cover the specific embodiment shown in FIGS. 4 through 6, including handle openings, the plug, and the threaded closure cap. The generic claim is worth 40 points and each dependent claim is worth 10 points. Your claims must be drawn to a shaving implement, and you must adhere to the following requirements. You may not be your own lexicographer to name the elements or components of the disclosed invention or to rename elements or components of the shaving implement. You must use the terminology of the described invention. Any method claim or Jepson claim will receive no credit. Points will be deducted for (1) claiming subject matter not within the scope of the invention disclosed above; (2) using claim language which is vague or indefinite,

(3) using claim language which does not have antecedent basis or which does not positively set forth each element or component; (4) failing to interrelate or incorrectly interrelating the elements or components set forth in your claims, (5) claiming unnecessary limitations in generic claim 1; (6) presenting a claim that defines an inoperative invention or that is anticipated by the prior art; (7) using poor grammar and misspelled words, and (8) failing to follow these directions.

Thus, generic claim 1 has to be the broadest claim:

- A. Which defines the invention as set forth in the Objects of the Invention paragraph;
- B. Which includes any critical limitations; and
- C. Which is not anticipated by prior art.

The Objects of the Invention paragraph reads as follows:

OBJECTS OF THE INVENTION

The present invention provides an improved shaving implement by overcoming the disadvantages mentioned above relative to the prior art shaving implement. The main object of the invention is to provide a shaving implement which can dispense shaving cream for the lifetime of the razor. A further object of the invention is to provide a handle having a channel with longitudinal sides and a chamber for holding a collapsible tube of shaving cream so that when a tube

closure is in its open position, a tube squeezing slide, positioned in the channel and chamber of the handle, can be moved by a user to cause opposed slots of the slide to ride on the longitudinal sides of the channel such that shaving cream from the tube can be selectively dispensed from a dispensing opening in a neck of the collapsible tube. [Emphasis added.]

Five points were deducted from the petitioner's score because petitioner's claim 1 did not include the limitation that the handle of the shaving implement has "longitudinal sides." Five points were deducted from the petitioner's score because petitioner's claim 1 did not include the limitation that the tube squeezing slide has "opposed slots."

The petitioner argues that the instructions to this question require neither the "longitudinal sides" feature of the channel in the handle nor the "opposed slots" feature of the tube squeezing slide to be included in claim 1. In support of that argument, the petitioner states:

[T]he test instructions clearly only require the Applicant to draft the BROADEST claim which defines the invention as set forth in the Objects of the Invention, and include only those limitations that are either critical to the invention or necessary in order to distinguish over the prior art.

The petitioner's position is that not every structure described in the Objects of the Invention necessarily has to be

included in generic claim 1. The petitioner states that including every feature described in the Objects of the Invention would be "inconsistent with drafting the broadest claim" and also "inconsistent with good patent prosecution practice, i.e. by including limitations not required by the prior art." The petitioner further states: "As a result, my claim covers a wide variety of means for connecting the slide to the handle, and therefore, affords the client broader protection by protecting my client from potential infringers."

The petitioner's arguments are without merit. Drafting the broadest claim which defines over the prior art is not the only consideration required by the question asked. It is evident that examinees also must identify the features described in plain English within the Objects of the Invention paragraph and present them in the form of a patent claim. The question directs examinees not simply to draft the broadest claim which defines over the prior art, but the broadest claim:

- (a) which defines the invention as set forth in the Objects of the Invention paragraph;
- (b) which includes any critical limitations; and
- (c) which is not anticipated by prior art.

The petitioner must answer the question asked. In that regard, defining the invention as set forth in the Objects of the Invention paragraph is an explicit requirement of the Claim Drafting Question.

On the basis of the instructions given, it would be unreasonable for an examinee to interpret the Claim Drafting Question as merely asking for claim 1 to be the broadest claim directed to an operative shaving implement not anticipated by the prior art. That interpretation would read the specific requirement of defining the invention as set forth in the Objects of the Invention paragraph out of the instructions.

While it is true that the instructions do state that points will be deducted for claiming unnecessary features, the features described in the Objects of the Invention paragraph are not unnecessary. The instructions specifically direct examinees to draft a claim which defines the invention as set forth in the Objects of the Invention paragraph. Petitioner has erroneously focused only on drafting the broadest claim which defines over the prior art without considering the other examination instructions.

Additionally, even if we assume that the petitioner's interpretation is reasonable, the petitioner had to draft the broadest claim possible having the fewest features of the disclosed invention, which is not anticipated by prior art. The petitioner has failed in that regard as well.

Anticipation requires that each element of a claim be found in a single prior art reference. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, if more than one element in petitioner's claim 1 is not found in a single prior art reference, the petitioner has claimed

unnecessary features. Even under petitioner's interpretation, his claim 1 contains limitations beyond what is necessary to avoid anticipation by prior art. The instructions state that points will be deducted for claiming unnecessary limitations. So even under the petitioner's interpretation of the question asked, he has not demonstrated that ten points would not otherwise have been deducted for claiming unnecessary limitations.

The petitioner does not dispute that the "longitudinal sides" feature of the channel in the shaving implement and the "opposed slots" feature of the slide in the shaving implement are described within the Objects of the Invention paragraph. It is also undisputed that those limitations are not included, either expressly or implicitly, within petitioner's claim 1. The petitioner's reciting that the slide is movably mounted within the channel does not incorporate either one of the two required features in the claim. Thus, for each deficiency, five points were properly deducted from the petitioner's score.

B. Multiple Choice Question No. 2

This question relates to an appeal to the Board of Patent Appeals and Interferences. Claims 1-4 and 6 have been finally rejected by the examiner and are appealed. Claim 5 was allowed by the examiner.

Question No. 2 states:

2. Claim 5 has been indicated by the examiner as being allowable. The claim is not an original claim, but was added by amendment in response to the examiner's first Office action. The claim specifies that the "tubular body portion is flexible". In accordance with established PTO practice and procedure, the Board would

(A) introduce in its decision a statement setting forth a new rejection of claim 5 under 35 U.S.C. 112, first paragraph, as having no descriptive basis in the specification as filed.

(B) introduce in its decision a statement setting forth a new rejection of claim 5 under 35 U.S.C. 103 as being obvious over the Miller patent.

(C) recommend in its decision a new rejection of claim 5 under 35 U.S.C. 102(b) as being anticipated by the disclosure of the Miller patent.

(D) recommend in its decision rejections of claim 5 under 35 U.S.C. 112, first paragraph, as having no descriptive basis in the original specification and under 35 U.S.C. 102(b), as being anticipated by Miller, and remand the application to the examiner.

(E) take no action relative to allowed claim 5 because the claim is fully supported in the specification.

The Model Answer to this question is Choice C. The petitioner's answer was Choice (B).

In the petitioner's request of February 14, 1994, for the Director of OED to reconsider the grader's regrade decision, it was stated: "I agree with the staff attorney that the correct answer corresponds to 37 CFR § 1.196(d)." In pertinent part, 37 CFR § 1.196(d) reads:

(d) Although the Board of Patent Appeals and Interferences normally will confine its decision to a review of rejections made by the examiner, should it have knowledge of any grounds for rejecting any allowed claim it may include in its decision a recommended rejection of the claim and remand the case to the examiner. . . .

The petitioner argued to the Director that both answer Choice B and answer Choice C correspond to 37 CFR § 1.196(d), because the ordinary meaning of "introduce" means the same thing as "recommend." The petitioner pointed to the Director two dictionary definitions of the word "introduce," which indicate that the word can be used to mean "recommend" or the making known of a "recommendation." See page 5 of petitioner's paper dated February 14, 1994.

In response, the Director's decision did not discuss the alleged similarity of meaning between "introduce" and "recommend," but discussed why Choice (B) would nonetheless still be wrong because the Miller patent anticipates claim 5

under 35 U.S.C. § 102(b) rather than just rendering claim 5 unpatentable for obviousness under 35 U.S.C. § 103.

Here, the petitioner explains that in the initial regrade decision it was held that whether the rejection to be raised should be based on § 103 or § 102(b) is a non-issue because the focus of the question was on whether the Board should introduce a statement setting forth the rejection or just recommend the rejection. The petitioner argues that the Director's decision concluding that claim 5 is indeed anticipated by the Miller reference resurrected what the regrade decision had already determined to be a non-issue. The petitioner further states:

Therefore, there is at least some confusion or ambiguity in this question and an applicant should receive full credit for this question.

I am unpersuaded that there is any ambiguity in this question or that this question would confuse a reasonable examinee familiar with the pertinent regulations.

The regrade decision properly regarded the point made by the petitioner about making a § 103 or a § 102(b) rejection as a non-issue. Even assuming the petitioner is correct on this point, Choice (B) is still wrong because, under 37 CFR § 1.196(d), the Board would recommend the rejection and remand the case and not make the rejection directly in its decision. Also, because the petitioner continued to make the point about a § 103 rejection versus a § 102(b) rejection to the Director,

the Director's decision properly discussed why the correct rejection is under § 102(b) and not § 103.

In order to prevail, the petitioner has to successfully establish both: (1) that introducing a statement setting forth a rejection is the same as recommending a rejection; and (2) that claim 5 is not anticipated by the Miller reference under 35 U.S.C. § 102. The petitioner has done neither.

The Director's decision explained in detail why claim 5 is anticipated by the Miller reference. The petitioner has not explained where there is any error in the Director's analysis. The Director's conclusion is correct that claim 5 is sufficiently broad so as to allow the length of the tubular portion to be either short, as in Miller, or long, as in Jones. The Director is also correct in stating: "The skirt 24 in Miller is tubular and includes an outside surface 28 which engages the inner annular surface 18 of the neck 12 of the bottle."

The petitioner's argument to the Director that ordinarily, "introduce" means the same as "recommend" is misplaced. Examinees cannot reasonably interpret those two terms in a vacuum. Rather, the context is that of established PTO practice and procedure, e.g., 37 CFR § 1.196(b) and 37 CFR § 1.196(d). Moreover, what is at issue is not simply the word "introduce" versus the word "recommend," but the entire phrase "introduce in its decision a statement setting forth a new rejection of claim 5 under 35 U.S.C. 103 as being obvious over

the Miller patent" versus "recommend in its decision a new rejection of claim 5 under 35 U.S.C. 102(b) as being anticipated by the disclosure of the Miller patent."

In pertinent part, 37 CFR § 1.196(b) states:

[S]hould the Board of Patent Appeals and Interferences have knowledge of any grounds of rejection not involved in the appeal for rejecting any appealed claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new rejection of the claims.

In pertinent part, 37 CFR § 1.196(d) states:

[S]hould the Board have knowledge of any grounds for rejecting any allowed claim it may include in its decision a recommended rejection of the claim and remand the case to the examiner. . . . The examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

An examinee familiar with 37 CFR §§ 1.196(b) and 1.196(d) would not reasonably confuse introducing in the Board's decision a statement setting forth a new ground of rejection with recommending in the Board's decision a new ground of rejection. While the former is covered by 37 CFR § 1.196(b)

and is applicable to rejected claims already on appeal to the Board, the latter is covered by 37 CFR § 1.196(d) and is applicable to claims which have been allowed.

CONCLUSION

For the foregoing reasons, the petitioner is not entitled to any additional points on his score of 61 achieved on the afternoon section of the registration examination held on October 13, 1993. Accordingly, upon consideration of the petition to the Commissioner, filed under 37 CFR § 10.2(c), it is herein ORDERED that the petition is denied.

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EDWARD R. KAZEMSKIE
Director of Interdisciplinary
Programs

cc: