

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

In re Examination of)
) DECISION ON PETITION
) FOR REVIEW OF DIRECTOR'S
) FINAL DECISION UNDER
) 37 CFR § 10.2(c)
)

I

Petitioner asks the Commissioner to review a decision of the Director of the Office of Enrollment & Discipline (OED) dated March 10, 1992, denying relief on request for regrade of the afternoon section of the registration examination held on August 21, 1991. The Director's decision has been reviewed. The relief requested is, in the entirety, denied.

II

In Part I, Option A, of the afternoon section of the exam, petitioner was instructed:

Present a . . . complete response to the Office action . . . and present a new single independent claim which defines the novelty of the invention as set forth in the object of the invention and which distinguishes your client's invention over the teachings of the Dude patent and the admitted prior art.

Your claims must . . . include and interrelate at least the following elements: the head, the handle, the light source, the power source, the metal strip, the reflector, and the switch.

Points will be deducted for claiming subject matter which is not within the scope of the invention shown in the Figure of or described in Dude's application, for using language which is indefinite or which does not have antecedent basis, [and] for

failing to interrelate the elements or components in your claim

The general DIRECTIONS for the exam instructed:

The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with the patent statutes, PTO rules, and the Manual of Patent Examining Procedure (MPEP).

III

The claim petitioner drafted reads as follows:

4. An illuminated brush device comprising:
 - a) a handle having a cylindrical void therein;
 - b) a head containing bristles joined to said handle and being in the same longitudinal plane as said handle;
 - c) a light source positioned in said cylindrical void in said handle, said light source comprising a metal strip having two ends connectably in contact with a battery at one of its ends and in contact with a light bulb at its other end;
 - d) a reflector, having a concave reflective surface, being in electrically conductive contact with a collar of said light bulb;
 - e) a switch having a contact plate thereon, located on the handle rotationally in contact with said battery providing for the flow of electricity when said contact plate contacts said collar;
 - f) a plurality of optical fibers transporting light from said light bulb, when said electrically conductive connections are made, to said head, illuminating said bristles.

IV

The grader deducted points as indicated below:

- 6 points: "claiming bristles separate from the optical fibers"
- 2 points: "incorrect expression of the invention not supported by the disclosure. The optical fibers are the bristles"

- 8 points: "omits lens"
- 2 points: MPEP 512 -- A separate certificate of mailing is required for the petition and for the amendment.
- 4 points: "the metal strap [sic, strip] is not disclosed as being in contact either with the battery or with the bulb".

V

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

35 U.S.C. § 112, second paragraph. The Director agreed with the grader that the claim petitioner drafted did not comply with the second paragraph of § 112.

Petitioner was instructed to present a claim which defines the novelty of the invention as set forth in the object of the invention and distinguishes your client's invention over the teachings of the Dude patent and the admitted prior art. Petitioner urges that the claim need not recite that the fiber optic filaments form the bristles protruding from the head or specify a magnification lens to define an invention which is novel over the prior art. Whether or not petitioner is correct in an assessment of novelty outside the scope of the instructions is irrelevant. Points were deducted because petitioner did not draw a claim "particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention" as required under 35 U.S.C. § 112, second paragraph. Petitioner's view of the novel aspects of the

invention described is irrelevant. In the specification
applicant discloses:

[I]t is the object of the present invention to provide a brush device having plastic fiber optic filaments which act as bristles and which transmit light having greater intensity than the original light source to the tips of the bristles The magnification means is essential to the operation of the brush device because of the necessity to concentrate and intensify the light into the optic fiber filaments to intensify the light emitted from the tips of the bristles.

It is the applicant's intent to "illuminate the area in close proximity to the bristles." The claim petitioner drafted is not considerate of applicant's objectives; i.e., petitioner disregarded the "subject matter which applicant regards as his invention."

Given the broadest reasonable interpretation of the claim language, the claim petitioner drafted need not and likely would not fulfill the objectives applicant had for his invention for the full scope of the subject matter claimed. In accordance with the claim petitioner drafted, light does not emanate from the tips of fiber optic "filaments forming the bristles" as applicant intended. Additionally, without a lens for concentrating light into the optic fiber filaments, the light transmitted to and emanating from the bristle tips cannot have "greater intensity than the original light source" as applicant intended. Furthermore, a complete response to the Office action, as was required by the directions for the exam, would have discussed the limitations in the claims by which

applicant's claimed invention is thought to be distinguished over the prior art teachings. The grader deducted an appropriate number of points.

VI

The general DIRECTIONS to the afternoon section of the exam instruct:

The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with the patent statutes, PTO rules, and the Manual of Patent Examining Procedure (MPEP). (Emphasis added.)

MPEP 512(E) advises:

(E) In situations wherein the correspondence includes several papers directed to the same application . . . each paper should have its own certification as a part thereof or attached thereto.

However, 37 CFR § 1.8(a)(2) directs:

(a) . . . [P]apers and fees required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely if:

(2) They also include a certificate for each paper or fee stating the date of deposit [with the U.S. Postal Service]. . . .

MPEP 512(E) is to be considered in conjunction with the intent of MPEP 512 as a whole. MPEP 512(C) advises:

(C) When the certification is presented on a separate sheet, the sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. . . .

Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the connection between the sheet and the paper filed.

Given the facts that petitioner's Response and request For Extension Of Time are presented on separate sheets, display separate headings and signatures, and do not reference each other, the papers would appear to be separate, and their connection would likely be questioned. Therefore, the dates of deposit of the papers with the U.S. Postal Service should be independently certified to assure acceptance by the Patent Office. Certification attached to one paper which does not identify and is not attached to a second separate paper likely will not be sufficient to establish that the second paper was timely filed. The grader deducted an appropriate amount of points.

VII

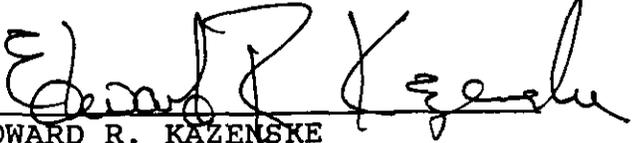
The grader deducted four points because there is no support in the specification for direct contact between the metal strip in the invention defined by the claim petitioner drafted and either the battery or the light bulb. Petitioner was informed in the directions for the exam that points would be deducted for claiming subject matter which is not within the scope of the invention shown in the Figure of or described in Dude's application. In the specification and Figure, applicant described and depicted a metal strip contacting a reflector at one end and an electrical contact plate at the other end. The primary function of a claim is to apprise one skilled in the art of the scope of the invention for which applicant seeks

protection. The claim petitioner drafted does not adequately perform that function. The grader's deduction was appropriate.

VIII

The relief requested on petition is denied.

Date: 22 April 1992


EDWARD R. KAZENSKE
Director of
Interdisciplinary Programs

cc: