

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 6, 1992, denying relief in-part on request for regrade of both the morning and afternoon sections of the registration examination held on August 21, 1991. To the extent the petition complies with 37 CFR § 10.2(c), the Director's decision has been reviewed. The relief requested is, in the entirety, denied.

II

Petitioner requests reconsideration of the deduction of two points for each of her answers to Questions 11 and 41 of the morning section of the exam. Petitioner also requests reconsideration of the following point deductions for her answers to Part I, Option A, and Part II, Question 3, of the afternoon section of the exam:

Part I, Option A:	"A Power Source"	-1 point
	"Power Source/Battery"	-1 point
	"The Magnification Lens"	-8 points
Part II, Question 3		-3 points

III

In the morning section of the exam, petitioner was directed to provide the "most correct answer" to all questions.

Question 11 reads:

11. A personal interview with an examiner to discuss the merits of the claims may not be properly conducted by;

The Director indicated that answer e) was most correct:

e) An unregistered attorney who has been given the associate power of attorney in the particular application.

Petitioner selected answer d):

d) A registered practitioner who does not have a power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.

Answer e) is most correct. Petitioner argues, however, that, given certain assumptions, answer e) is not most correct and is, at the very least, ambiguous.

An applicant for a patent may be represented in the Patent and Trademark Office (PTO) only by an attorney or agent registered to practice before the PTO or an "other individual authorized to practice before the PTO". 37 CFR § 1.31. Petitioner should not have presumed that the unregistered attorney of answer e) had shown circumstances which necessarily and justifiably caused the Director to authorize limited recognition of the unregistered attorney under 37 CFR § 10.9 to prosecute an application before the PTO. The directions for

the morning section of the exam stated, "Do not assume any additional facts not presented in the questions." Therefore, on the facts in Question 11, the unregistered attorney may not conduct an interview with the examiner.

Also, in accordance with 37 CFR § 1.34(a), under the facts in Question 11, when a registered practitioner appears in person, as would be the case under answer d), he represents that he is authorized to act on behalf of the patent applicant and to prosecute applicant's patent application. The examiner need not require further proof.

Question 41 reads:

41. The claims in an application filed on behalf of Jones were rejected as being unpatentable under 35 U.S.C. § 103 over Wilson in view of Frank. Jones gave you, a registered practitioner, power of attorney to prosecute his application. Which one of the following items of information available to you would be relevant to overcoming the rejection of the claims without modifying or amending the claims?

The Director indicated that answer c) was most correct:

c) Jones' invention can be shown to possess unexpected superior properties over the relevant subject matter disclosed by Frank.

Petitioner argues that answer b) would also be correct:

b) Wilson and Frank do not disclose or suggest feature B of Jones' invention which is set forth in the drawings and each working example in Jones' application and which is within the broad scope of each of the rejected claims, but not specifically set forth as a limitation in any of the claims.

Contrary to petitioner's urging, the Director did not state that answer b) may be misinterpreted. Petitioner misconstrues the Director's response. Answer b) to Question 41 is clear and clearly states that feature B lies within the broad scope of the subject matter to which the rejected claims are drawn and that no claim is limited to feature B. Therefore, the fact that Wilson and Frank do not disclose or suggest feature B is irrelevant to the examiner's rejection of all claims under 35 U.S.C. § 103 over other features disclosed in Wilson and Frank. As the question explicitly instructs, the claims cannot be modified or amended. Therefore, Jones' claims cannot be limited to feature B by amendment. On the other hand, unexpected results shown by comparing the relevant subject matter disclosed in Frank to that claimed subject matter Jones regards as his invention as per answer c) would provide relevant evidence of unobviousness commensurate in scope with the teaching of the cited prior art.

IV

The phrase "a handle having power source" appearing in the claim petitioner drafted in responding to Part I, Option A, of the afternoon section of the exam is grammatically "poor," is numerically "indistinct," and lacks "antecedent basis" in the specification. The claims of a patent application must be in the English language. 37 CFR § 1.52(a). The claims must particularly point out and distinctly claim "the subject matter

which applicant regards as his invention." 35 U.S.C. § 112, second paragraph. In conjunction, however, the axiom that a patent applicant may be his own lexicographer applies.

Therefore, to emphasize and be consistent with patent law and practice, the directions for answering Part I of the afternoon section indicated that points would be deducted for "poor grammar," for "language which is indefinite," and for language "which does not have antecedent basis" in the specification. One point was appropriately deducted for the phrase included in the claim petitioner drafted.

One point was also properly deducted for the phrase "said power source having a battery" appearing in petitioner's claim. The grader suggested that the broad phrase "power source may 'comprise' a battery" is supported by the specification. A power source which may comprise a battery reads on the battery itself, but the power source is not limited to one which is battery-energized. However, a power source "having a battery" is limited to a battery-energized power source. Petitioner states, "It was Applicant's intention to broaden the claim to include any source that may energize the light-producing means." However, the phrase petitioner utilized in the claim she drafted does not cover the full scope of subject matter which applicant is said to have regarded as his invention.

Petitioner states that a magnification lens is not required to define the novelty of the invention. Whether or not petitioner is correct in her general assessment is

irrelevant. Eight 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, not the subject matter petitioner regards as novel. The specification instructs:

[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.

The claim petitioner drafted totally disregards applicant's objective; i.e., disregards "subject matter which applicant regards as his invention."

V

Applicant disagrees with the Director's decision on reconsideration and disagrees with the deduction of three points for petitioner's answer to Part II, Question 3, of the

afternoon section. However, any petition under 37 C.F.R. § 10.2(c) shall contain "a statement of the facts involved and the points to be reviewed," i.e., why applicant disagrees with the Director's decision. The petition to review the Director's decision dated March 6, 1992, is insufficient to the extent it asks for review of petitioner's answer to Part II, Question 3, without providing any basis for review. The three point deduction stands.

VI

The relief requested on petition is denied.

Date:

13 April 1992


EDWARD R. KAZENSKE
Director of
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cc: