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R1991-3

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

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

(petitioner) requests review under 37 CFR § 10.2(c) of a decision of the Director of the Office of Enrollment and Discipline, entered May 23, 1991, refusing to give petitioner a passing grade on the morning section of the examination for registration held on October 10, 1990.

BACKGROUND

The Director's decision was on a petition, which was treated as a request for reconsideration of a decision, entered April 5, 1991, on a request for regrade of four questions of the morning section. Petitioner scored 46 points on the morning section.

The decision on request for regrade denied petitioner's request for regrade of his answers to three of the questions -- Questions 44, 52 and 55 -- while adding one point to petitioner's score on the fourth question, thus raising his score to 47 points.

The decision on request for reconsideration granted no further credit to petitioner's score.

Petitioner's ground for challenging the Director's decision is that his answers to Questions 44, 52 and 55 are correct and thus, his score should have been 50 points. A minimum of two more points, however, would be sufficient to give petitioner a passing score of 49 (out of 70).

FACTUAL REVIEW

Question 44

Question 44 reads as follows:

Although a drawing is not necessary for the understanding of Paul's claimed invention, the disclosed invention admits of illustration by a drawing. Which of the following sets forth only the essential parts of the patent application that Paul must file in the PTO to obtain a filing date?

- a) A specification including a claim and Paul's full name, a drawing and a filing fee.
- b) A specification including a claim and Paul's full name, and a filing fee.
- c) A specification including a claim and Paul's full name.
- d) A specification including a claim and Paul's full name, and a drawing.
- e) A specification including a claim and Paul's full name, a drawing, an oath, and a filing fee.

The model answer for Question 44 is c), citing 35 U.S.C. 111 and 113, and 37 CFR 1.53(b). Petitioner answered d).

Question 52

Question 52 reads as follows:

Which of the following statements with respect to Markush language in a claim is true?

- a) The members of the Markush group must be recited in the alternative only.
- b) The Markush language may only be properly used in chemical cases.
- c) Markush language must be used even though alternative generic language is available.
- d) The Markush group may not be properly used when reciting functionally equivalent members.
- e) None of the above is true.

The model answer for Question 52 is e), citing MPEP 706.03(y). Petitioner answered a).

Question 55

Question 55 reads as follows:

Which of the following statements about the 35 U.S.C. 102(b) "on sale" and "public use" bars is false?

a) The "on sale" bar does not necessarily turn on whether there was or was not a reduction to practice claimed of the invention.

b) An inventor's secret commercial use of a process before the critical date can constitute a "public use" bar to the inventor obtaining a patent.

c) Secret commercial use of a process before the critical date by a person not connected to the inventor does not constitute a "public use" bar to the inventor obtaining a patent.

d) For an assertion of experimental use to have merit, it must be clear that testing of the invention was conducted under the supervision and control of the inventor.

e) A written proposal to sell a product does not constitute an "on sale" bar to obtaining a patent on an invention if the proposal gives no details as to the invention.

The model answer for Question 55 is e), citing RCA Corp. v. Data General Corp., 887 F.2d 1056, 12 USPQ2d 1449 (Fed. Cir. 1989); UMC Electronics Co. v. United States, 816 F.2d 647, 2 USPQ2d 1465 (Fed. Cir. 1987); D.L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144, 219 USPQ 13 (Fed. Cir. 1983), cert. denied, 474 U.S. 825 (1985); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Hamilton, 882 F.2d 1576, 11 USPQ2d 1890 (Fed. Cir. 1989).
Petitioner answered c).

DECISION

Question 44

I find no error in the decision refusing to award petitioner credit for his answer to Question 44.

The statute (35 U.S.C. 111 and 113) and regulations (37 CFR § 1.53(b) and 37 CFR § 1.81(a)) make clear that a drawing is required to be furnished in order to receive a filing date only where necessary for understanding of the subject matter sought to be patented. While 35 U.S.C. 113 provides that a requirement to furnish a drawing may, and 37 CFR § 1.81(c) provides that such a requirement will, be made when the nature of the subject matter sought to be patented admits of illustration by a drawing, it does not follow that a filing date already received is lost in cases where such a requirement is made, as petitioner seems to imply. In other words, where a drawing is not necessary for understanding subject matter sought to be patented but that subject matter admits of illustration by a drawing, submission of a drawing may ultimately be required but not for purposes of obtaining a filing date. 37 CFR § 1.81(c) does not render the question ambiguous, as petitioner argues.

Question 52

I find petitioner's argument persuasive regarding his answer to Question 52. Therefore, one point will be added to petitioner's score.

Question 55

I find no error in the decision refusing to award petitioner credit for his answer to Question 55.

Petitioner's answer to Question 55 -- "Secret commercial use of a process before the critical date by a person not connected to the inventor does not constitute a 'public use' bar to the inventor obtaining a patent" -- is not false. The case -- J.A. LaPorte, Inc. v. Norfolk Dredging Co., 787 F.2d 1577, 229 USPQ 435 (Fed. Cir. 1985) -- cited by petitioner, does not support petitioner's proposition that his answer is false.

In LaPorte, the Federal Circuit held a patent invalid on the ground that the claimed invention was "on sale" more than one year before the filing date. Specifically, a consulting engineer, of whom the inventor was a client, photographed the claimed invention with the inventor's permission and with no directions concerning confidentiality. More than a year before the filing date, the consulting engineer accepted a purchase order for the claimed invention by LaPorte. The inventor all the time knew of the consulting engineer's activities and acquiesced in them. LaPorte ultimately received rights in the patent. The Federal Circuit held that the consulting engineer's activities amounted to an "on sale" bar.

LaPorte, as decided by the Federal Circuit, involved the "on sale" bar, not the "public use" bar. Moreover, the sale or offer for sale in LaPorte was by a person "connected with the

inventor." In LaPorte, there was one invention, not two as implied by answer c) to Question 55. Thus, LaPorte is inapposite for these reasons, not because the invention in LaPorte was an apparatus as opposed to a process.

As a general proposition, answer c) is true. There may be exceptions to the proposition, such as where the product of the secret process is in public use and the process of making it becomes obvious once the product is known. However, the instructions for the morning section state not to assume any additional facts not presented in the questions. Based on the facts given in answer c) alone, that statement is not false. The statement given in answer e), the answer given as correct in the model answer, without the assumption of additional facts, is, on the other hand, always false.

The instructions for the morning section also ask for the most correct answer to each question. As between answer c) and answer e), there can be no question that answer e) is the most correct.

CONCLUSION

One point has been added to petitioner's regraded score of 47, thus giving petitioner a score of 48. As a score of 48 is insufficient to pass the morning section, the decision of the Director of May 23, 1991, is affirmed. Therefore, this petition is denied.


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Commissioner of Patents
and Trademarks