

5/18/89

R-1989-1

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

In re) Reconsideration of
Petitioner) Decision on Petition
_____) Under Rule 10.2(c)

_____, hereinafter petitioner, requests review under 37 CFR 10.2(c) of the Decision on Reconsideration of Request for Regrade of the Examination held on October 12, 1988, which was rendered on April 4, 1989 by the Director of the Office of Discipline and Enrollment (OED), hereinafter Director. Petitioner seeks an award of at least five additional points to his score for the afternoon section.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 12, 1988. He previously passed the morning section but received less than the minimum 70 points (out of 100) on the afternoon section necessary to be registered. A request for regrading was received by OED on January 31, 1989. In his decision on the request, the Director added 1 point for question 1 and 1 point for question 2. This resulted in a total score of 65 points. A request for reconsideration was filed on March 20, 1989, but no additional credit was given by the Director in his decision of April 4, 1989. On April 8, 1989, this petition was filed seeking 7 points for question 3 but withdrawing the challenge to Question 1 and to the deduction of 1 point for citing the incorrect petition fee in Question 3. On April 14, 1989, a supplemental petition was filed.

FACTUAL REVIEW

Question 3 relates to determining what action should be taken on an abandoned application when a practitioner's files were destroyed by fire and he was hospitalized because of the fire. It also concerns the filing of an amendment to distinguish over an anticipatory patent, and the correcting of a defective oath which did not identify the citizenship of the inventor. The examinees were asked to prepare a document to be filed in the PTO if they think that prosecution can be continued. The facts in the question did not specify the time for response to the Office action.

This question has a value of 40 points, of which the Model Answer assigned 20 points for the petition to revive, 5 points for the supplemental oath, 10 points for the amended claim, and 10 points for pointing out the novelty of the invention and for showing how the amended claim distinguishes over the reference.

The initial grader deducted 27 points for deficiencies in the petition to revive, the supplemental oath and the amendment. Of the issues remaining in dispute, 2 points were deducted for the supplemental oath because it failed to include the term "first inventor" (1 point) and to make reference to the amended claim (1 point). Ten points were deducted for the amended claim because the "removably attached" feature relied on by petitioner did not distinguish the amended claim over the reference. Five points were deducted because petitioner did not clearly point out the novelty of the invention. Four

points were deducted because petitioner's remarks did not accurately characterize the examiner's rejection (2 points) and the discussion of his amended claim did not distinguish over the reference (2 points).

On reconsideration, the Director refused to award any additional credit. The Director found that petitioner's supplemental declaration was not in accordance with 37 CFR §§ 1.63 and 1.67(a). The Director advised that the amendment and the argument in support of the amendment were separately graded so that petitioner's failure to correctly identify the novelty of his client's invention affected his answer in more than one area.

DECISION

Petitioner disputes the Director's determination that his supplemental declaration is deficient and has presented sample forms to support his position. As the Director indicated, such forms do not establish compliance with PTO rules. However, if the two declarations are considered together, the requirements of 37 CFR §§ 1.63 and 1.67(a) have been fulfilled. See MPEP 602.02. With respect to the § 1.67(b) deficiency noted by the grader, a supplemental declaration is not required to make reference to the amended claim because the particular amendment does not appear to introduce subject matter not substantially embraced in the statement of the invention. Therefore, 2 points have been restored although the preferred approach, as mentioned in the Model Answer, is to request that the

requirement for a new declaration be deferred until the examiner indicates that there is allowable subject matter.

Petitioner asserts that he should have received partial credit for pointing out the support in the specification for the amendment he made to the claim. Although it is good practice to point out the basis in the specification for any limitation added to the claims to avoid a "new matter" rejection, no points were allocated (added or subtracted) for this feature of the response. Accordingly, the Director's refusal to give partial credit is appropriate.

The principal problem with petitioner's amended claim and argument in support of it is that it completely failed to identify the novelty of the invention and to distinguish the claim over the reference, which is the crux of this part of the question. No amount of argument or description of support for a limitation in the application disclosure can be persuasive of patentability if the limitation does not, as here, distinguish the claimed subject matter from the teaching of the prior art. Therefore, the Director's conclusion that petitioner is entitled to only 1 out of 20 possible points is reasonable especially since petitioner also inaccurately characterized the examiner's position on the reference patent.

CONCLUSION

The Director's decision of April 4, 1989 is modified to the extent of restoring two points deducted by the Director

from petitioner's score on the afternoon section of the examination on October 12, 1988. However, petitioner has not received a passing score of 70 points on the afternoon section.

Therefore, this petition is denied.

Dated: May 18, 1989



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs

MAILED

AUG 8 1989

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS U.S. PATENT & TRADEMARK OFFICE

In re)
Petitioner) Review of Decision
) On Petition Under
) 37 CFR 1.181 R 1989-1 (RI)

, hereinafter petitioner, requests review by the Commissioner of a Decision by the Assistant Commissioner for External Affairs. Petitioner seeks an award of four additional points to his score for the afternoon section of an examination he took on October 12, 1988.

BACKGROUND

On May 18, 1989, the Assistant Commissioner for External Affairs, acting under a delegation from the Commissioner, rendered a decision which modified the Director's decision of April 4, 1989. The Assistant Commissioner restored three points to petitioner's score on the afternoon section. The additional points, however, did not give petitioner a passing score of 70 points.

DECISION

Although the Commissioner may review in person a decision rendered by an official of the PTO pursuant to a delegated authority, such a review is not a matter of right and is done only in unusual or exceptional circumstances. In re Staeger, 189 USPQ 284 (Comm'r Pat. 1974) and Corrigan v. Alexeevsky, 200 USPQ 368 (Comm'r Pat. 1978).

There does not appear to be any unusual or exceptional circumstances in the case which would justify review by the Commissioner in person. The request for such a review is denied and the matter is referred to the Assistant Commissioner to be treated as a request for reconsideration.

Fred Maxwell Jr

DONALD J. QUIGG
Commissioner of Patents
and Trademarks

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

In re	,)	Request for
Petitioner)	Reconsideration

Pursuant to the order mailed August 8, 1989, the Petition under 37 CFR 1.181 has been treated as a request for reconsideration of the decision by the Assistant Commissioner for External Affairs on a petition under 37 CFR 10.2(c) to review the regrading of the afternoon section of the Examination held on October 12, 1988. Curtis C. Panzer (petitioner) seeks an award of four additional points to his score.

BACKGROUND

On May 18, 1989, a decision was rendered which modified the Director's decision of April 4, 1989. Three points were added to petitioner's score on the afternoon section. The additional points, however, did not give petitioner a passing score of 70 points.

Petitioner now asserts that 10 points were improperly allocated to part of the answer to Question 3, in which the examinees were to point out the novelty over a particular reference and show how their amended claim would distinguish over this reference. According to petitioner, this part should have been given only 5 points and the other 5 points were for summarizing the amended claim and making a "no new matter" assertion.

DECISION

In rendering a decision on the petition, only the record was relied upon, which includes the Model Answers. 37 CFR 10.2(c). The Model Answer for preparing a response to the Office Action rejecting a claim as being anticipated by a reference was assigned a total of 25 points: 10 points for a satisfactory claim, 5 points for dealing with a deficient oath, 5 points for correctly pointing out the novel feature and 5 points for correctly explaining how the amended claim distinguishes over the reference. The fact that the decision added the 5 points for pointing out the novelty of the invention and the 5 points for showing how the amended claim distinguishes over the art is not inconsistent with the Model Answer.

It may be that petitioner does not appreciate that 37 CFR 1.111(c) has two distinct requirements for a reply by an applicant to an Office action. In particular, an applicant in amending the claims "must clearly point out the patentable novelty . . . which the claims present in view of the . . . references cited" (designated Item 2A by petitioner in the

Model Answer to Question 3) and "must also show how the amendments avoid such references" (designated Item 3A by petitioner). Although the Model Answer graded the two requirements separately, the Director advises that it was acceptable to discuss the requirements together.

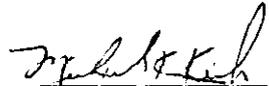
Petitioner persists in maintaining that there is a "new matter" issue in this question. The record has been reviewed and the evidence supports the Director's conclusion that the facts in this question do not raise that issue, notwithstanding that petitioner believes the regrader agreed with him. The part of the Model Answer designated Item 3A by petitioner is clearly a discussion of the requirement in § 1.111(c) to show how the amended claim distinguishes over the reference and has nothing to do with "new matter." There is no mention in the Model Answer of providing support in the specification for the particular amendment. Accordingly, the Director's refusal to give partial credit for petitioner's answer which shows support in the disclosure for a feature, which does not distinguish over the cited reference, is appropriate.

CONCLUSION

Reconsideration of my decision of May 18, 1989 is granted but the petition for additional points on the afternoon section of the Examination on October 12, 1988 is denied.

Petitioner's check has been returned by separate correspondence.

Dated: September 7, 1989



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs