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

In re) Decision on Petition
Petitioner) for Review 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 6, 1987, which was rendered on June 3, 1988 by the Director of the Office of Enrollment and Discipline (OED), hereinafter Director. Petitioner seeks an award of six additional points to his score for the morning section and at least nine points for the afternoon section.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 6, 1987. He received less than the minimum 70 points (out of 100) on both the morning and afternoon parts. A request for regrading was filed on February 22, 1988. In his decision on the request, the Director added 1 point to morning multiple choice question 24, and on the afternoon part, 7 points for question 1, 2 points for question 3 and 5 points for question 4, which resulted in total scores of 67 and 61 points on the morning and afternoon parts, respectively. A request for reconsideration was received on May 11, 1988 and denied on June 3, 1988. However, the Director added one point to the morning section for true/false question 15, which resulted in a total score of 68 points on this part. On June 24, 1988, this petition was received which requests additional credit on morning true/false questions 11, 45, 50 and multiple choice questions 7, 35, 44 and afternoon questions 1, 3 and 4.

FACTUAL REVIEW

MORNING SECTION

(TRUE/FALSE)

Question 11

This question addressed the time when an applicant may

petition the Commissioner for a review of a restriction requirement. In the stated facts, applicant Brown petitioned two months after the claims were finally rejected but before the notice of appeal was filed. The petition was stated to be timely.

Petitioner answered this question "false" and received no credit because the model answer was "true". Petitioner argued that since the petition was filed after 2 months but not within 2 months as required by 37 CFR 1.181(f), it was untimely. The Director explained that the "2-month" period of this rule did not apply in this case. Instead, 37 CFR 1.144, which specifically addresses petitions from restriction requirements, was considered pertinent. Since the latter rule permits petitions after a Final Rejection but before appeal, the petition was considered timely filed and therefore the correct answer was "true."

Question 45

The statement in this question was:

"Double patenting cannot exist between a design application and utility patent."

Petitioner answered this question "true" and received no credit because the model answer was "false". Petitioner argued that it was possible to obtain a utility patent without being rejected on double patenting over a design patent on the same article. Although the Director agreed, he explained that since the statement was not true in all situations, i.e. that there were some circumstances when double patenting would exist between a design application and a utility patent, the correct answer was "false."

Question 50

This question related to the scope of reexaminations. It stated that:

"In a reexamination proceeding, an unamended patent claim may be re-examined for compliance with the requirements of 35 USC 112."

Petitioner answered this question "true" and received no credit because the model answer was "false." Petitioner argued that "unamended" claims include "new" claims, which, under 37 CFR 1.552(b), are reviewed for compliance with 35 USC 112. The Director disagreed with this interpretation of "unamended," noting that the question stated that it involved an "unamended patent claim." Accordingly, the correct answer was "false."

(MULTIPLE CHOICE)

Question 7

This question addressed the requirements for filing a continuing application under 37 CFR 1.60. Petitioner selected the answer "a," which mentioned pendency but did not specify that a filing fee must also be paid. He argued that the facts implied that the fee had been paid as a matter of routine when it was stated that "the continuation is filed...." The Director disagreed and held that the correct answer was "d," which identified both requirements: pendency of the two applications and payment of the fee.

Question 35

This question addressed the requirements for a petition to revive. According to the facts, the patent attorney's secretary lost the Final Rejection and the PTO held the application abandoned for the applicant's failure to respond. Examinees were asked how to revive the application.

The petitioner selected "d," which did not mention that a notice of appeal had to be filed. He argued that the facts implied the filing of a notice of appeal, which was a matter of routine. The Director disagreed and held that the correct answer was "e" because none of the other answers recited both requirements for a proper petition.

Question 44

This question addressed the filing requirements in the U.S. after a PCT application was filed in Japan. It was stated that the U.S. attorney was given a copy of the Japanese patent application filed 20 months ago without an English translation or declaration and was asked what to do.

Petitioner chose "d," which indicated that the declaration and translation must be filed by the end of the twenty-second month with the appropriate surcharge for filing the declaration. This answer did not mention including the filing fee, which was covered generally by "b." Petitioner argued that the facts implied that the application was filed with the proper fee. The Director disagreed with petitioner's interpretation of the facts.

AFTERNOON SECTION

Question 1

This question asked the examinees to prepare a single claim on either a folding tooth brush or a method of making an electrical device. Petitioner chose the latter.

The initial grader gave no credit for petitioner's claim (out of 20 points). On review, the Director added 7 points. Petitioner argues that several deficiencies in his claim, noted by the grader and repeated by the Director, were incorrect and that as a result, more partial credit should be awarded.

Question 3

This question related to preparing an information disclosure statement. It added to the fact situation of question 2, a coinventor's prior use and reduction to practice of the invention in the United States. The examinees were asked if they would modify the disclosure statement and explain either a "yes" or "no" answer.

The grader gave no credit because of "incorrect reasoning" for this 20 point question which petitioner answered by indicating that there was no need to change the information disclosure statement. On review, the Director awarded partial credit of 2 points for petitioner's discussion of why there was no material prior art under 35 USC 102(b).

Petitioner argues generally that he is entitled to more partial credit.

Question 4

This question sought an analysis of filing a continuation-in-part (CIP) patent application to cover an embodiment outside the scope of the original claim. If the option of filing the CIP was considered acceptable, the examinees were asked to explain why filing a CIP would be better than continuing prosecution of the original application. However, if this option was not considered desirable, the examinees were asked to explain the problems of filing a CIP and provide a strategy for prosecuting the original application.

The grader deducted 10 points for petitioner's answer to this 15-point question, which recommended the filing of a CIP because the answer did not contain any discussion of the problems with the prior sale and publication and also it did not mention when the CIP should be filed. On review, the Director added 5 points. Petitioner seeks full credit because he discussed all the relevant issues.

DECISION

MORNING SECTION

(TRUE/FALSE)

Question 11

Petitioner suggests that it makes a difference whether the petition was filed "within" or "after" two months. This argument apparently is based on the assumption that "two-month" period of 37 CFR 1.181(f) is controlling. This is not the case as explained by the Director, who invited petitioners' attention to 37 CFR 1.144, which specifically relates to petitions on restriction requirements. Since Brown has three months to respond to the Final Rejection or file a notice of appeal, his petition is timely and the correct answer is "true." Accordingly, no credit is appropriate for this question.

Question 45

Petitioner seeks to create an ambiguity by misinterpreting the word "cannot" in this question. The Director was correct in defining "cannot" as "can never." To make an analogy, if the statement was "man (or woman) cannot swim" and the facts were that some men (or women) can swim, then such a statement would clearly be false. Accordingly, no credit is appropriate for this question.

Question 50

Petitioner has advanced no reason why the Director erred in refusing to accept petitioner's answer of "true." On the other hand, we agree with the Director, who advised that under 37 CFR 1.552(b) only amended claims in reexaminations are considered for compliance with 35 USC 112. See, Patlex Corp. v. Quigg, 680 F. Supp. 33, 6 USPQ 2d 1296 (D.D.C. 1988). On the other hand, if you accept petitioner's interpretation, a redundancy would be introduced into the rule because it would result in both amended and unamended claims being subject to a § 112 rejection. Accordingly, no credit is appropriate for this question.

(MULTIPLE CHOICE)

Question 7

The Director was correct in concluding that there was no reasonable basis for petitioner to assume that the filing

fee was paid. Accordingly, no credit is appropriate for this question.

Question 35

Director was correct in concluding that there was no reasonable basis for petitioner to assume that a notice of appeal had been separately filed. Under 37 CFR 1.137, a petition to revive must include the proposed response unless previously filed. Accordingly, no credit is appropriate for this question.

Question 44

The Director was correct in concluding that the facts, as stated in the question, do not indicate that any fees had been paid prior to filing the declaration and translation. Accordingly, no credit is appropriate for this question.

AFTERNOON SECTION

Question 1

This question calls for claim to a method of making a specific electrical device, as shown in Figure 2, to have three layers including a carbon substrate, a middle layer of silicon, phosphorus and carbon and a top layer of silicon, aluminum and carbon. Accordingly, the examinees were expected to select those steps from the specification which were necessary to make the particular device. To the contrary, petitioner did not follow directions but appears to have merely listed the steps in order as they appeared in the third, fourth and fifth paragraphs on page 5 of the afternoon section. As a result, his claim recited an extra carbon layer and the order of the other layers were reversed from that in Figure 2. In addition, both the Director and the initial grader observed that the claim did not specify that the gas mixture was passed over a heated substrate to decompose the gas and thereby deposit a layer on the substrate. Petitioner now argues that the decomposition was implied in his claim because he recited the correct processing conditions.

We agree to some extent although petitioner's claim does not clearly state that the gas mixture comes in contact with the heated substrate. Accordingly, 2 points will be added out of the 4 points which the initial grader deducted for not mentioning "decomposing."

Question 3

Petitioner has not shown why the Director erred in refusing to award additional partial credit although he

makes a general reference to his request for reconsideration. However, we have reviewed the entire record and observe the following about petitioner's answer:

a) it indicates that the information disclosure statement does not need to be modified because the trip to Lake Washington is not a statutory bar (i.e. it occurred less than a year prior to the filing of the U.S. patent application);

b) it does not contain any discussion of the prior use of one species, i.e., Smith (claim 1), as being prior art against the other species, i.e. Wisdom (claim 2), under 35 USC 102(a) and 102(g)/103 and also does not mention the applicability of 35 USC 104 which limits Wisdom's date of invention to the filing of the patent application and does not mention the impact of the second paragraph of 35 USC 103 if the prior invention under 35 USC 102(g) is commonly owned; and

c) it does not contain any discussion about the need to disclose the different inventorship of the individual species.

Thus, we find that the Director did not err in refusing to give partial credit of more than 2 points and so no points will be added to petitioner's score for this question.

Question 4

Petitioner has not shown why the Director erred in refusing to award additional partial credit although he makes a general reference to his request for reconsideration.

We have reviewed the entire record and agree with the petitioner that the model answer requires more information than was specifically asked for in this question, i.e. an explanation why the CIP would be better for the client than prosecuting the claims in the rejected application if the answer selected is "yes." Although the issue of when the CIP should be filed to avoid the patentability problem created by the offer of sale and the publication should have been included in a complete answer (as suggested by the Director), we note that the question mentions that the CIP is being considered for filing within the originally set 3-month period. This period expires on November 3, 1987 or in advance of any statutory bar and thus there would be no problem with the sale or publication. However, the record does not indicate that petitioner ever made this analysis and so does not deserve full credit for his answer. Thus, only 3 points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of June 3, 1988 is modified to the extent of restoring five points deducted by the Director from petitioner's score on the afternoon section. However, petitioner has not achieved a passing score of 70 points or more on either the morning or afternoon section of the examination on October 6, 1987.

Therefore, this petition is denied.

Dated: Aug 17, 1988

Michael K. Kirk

MICHAEL K. KIRK
Assistant Commissioner
for External Affairs

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

In re _____,)
Petitioner)

Reconsideration of
Decision on Petition
under Rule 10.2(c)

_____, hereinafter petitioner, requests reconsideration of the decision on petition under 37 CFR 10.2(c) of the Decision on Reconsideration of Request for Regrade of the Examination held on October 6, 1987. Petitioner seeks an award of two additional points to his score for the morning section and at least four points for the afternoon section.

As the petitioner no doubt is aware, the Patent and Trademark Office has reviewed his answers to the examination on four separate occasions, including the initial grading. The petitioner now seeks a fifth review.

With respect to multiple choice questions 7, 35 and 44, petitioner argues for additional credit because he used a "different but logical and understandable interpretation of the facts as given." As was explained in the decision on petition, petitioner's interpretation of the facts are not considered reasonable. Thus, the fact that petitioner's answers may be correct if the facts he assumed were present is not at issue.

Petitioner's answers to questions 1 and 3 on the afternoon section are still considered to be deficient. Although it is regrettable that petitioner did not follow the directions for question 1, he must bear the consequences of such action. With respect to question 3, please be assured that the entire record, including the February 22, 1985 letter, was carefully and thoroughly considered when the petition was acted upon, especially since both your scores were close to the passing score of 70.

Therefore, the request for reconsideration is denied.

Dated: October 3, 1988



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs