

6/20/88

R-1988-5

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

In re	,)	Decision on Petition
Petitioner)	for Review under
<hr/>			Rule 10.2(c)

, hereinafter petitioner, requests review under 37 CFR 10.2(c) of the Decision on Request for Regrade on the Afternoon Section of the Examination Held on October 6, 1987, which was rendered on March 31, 1988 by the Director of the Office of Enrollment and Discipline (OED), hereinafter Director. Petitioner seeks an award of at least fourteen points to his score to give him a passing grade.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 6, 1987. He previously passed the morning section but received less than the minimum 70 points (out of 100) on the afternoon part necessary to be registered. A request for regrading on all of the afternoon questions was received on February 25, 1988. In his decision on the request, the Director added 4 points for question 1, 2 points for question 2, no points for question 3, 1 point for question 4, 3 points for question 5 and no points for question 6, which resulted in a total score of 56 points. On April 29, 1988, this petition was filed by express mail seeking 3 points on question 1, 7 points on question 3, 11 points on question 5 and 3 points on question 6.

FACTUAL REVIEW

Question 1

This question asked the examinees to prepare a single claim on either a folding tooth brush or an electrical device. Petitioner chose the former. The instructions for the tooth brush required that the claim must interrelate at least all of the following elements: tooth brush (1), handle (2), bristles (4), shank (5), slot (6), pivot pin (9), hinged cover (12), locking projections (15), locking depressions (16), locking flange (26), and notch (27).

The initial grader deducted 8 points (out of 20). On review, the Director added 4 points in view of petitioner's arguments. Petitioner argues that the deduction of 3 points for failing to recite specifically the spatial relationship between a number of the elements was improper because his claim fully satisfied 35 USC 112.

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 deducted 11 points (out of 20) because petitioner did not discuss a number of issues raised by the facts. This was not changed by the Director who explained why petitioner's answer was incomplete.

Petitioner argues that too many points were taken off for his failing to discuss the common assignment issue. Although the model answer indicated that this issue was worth only 4 points, the grader deducted 5 points. Further, petitioner questions whether any points should be deducted because the examiner has sufficient information to determine whether Smith's invention is prior art to Wisdom without knowing about the common assignment. Petitioner also urges that the 2 points deducted for his failing to disclose Smith's activity in Canada is improper because acts in a foreign country are not material.

Question 5

This question asked the examinees to draft a species claim which would provide for literal infringement of a particular device and explain why the claim is permissible. The model answer assigned 10 points for a claim drawn to a specific embodiment and 5 points for showing its basis in the specification.

The grader deducted 10 points because petitioner's claim was not drawn to a species limiting the thickness to 0.5 mm but gave 1 point credit for explaining why a preliminary amendment was permissible although no basis in the specification for the particular claim was given. The Director increased the partial credit for this part to 4 points on the basis of petitioner's comments. Petitioner seeks full credit of 5 points because he explained accurately why the preliminary amendment could be presented. Also, petitioner argues for partial credit of 7 points for his species claim which he asserts would be literally infringed by the Bremerton widget. In the alternative, he requests full credit of 10 points because this question, which related to infringement, is beyond the proper scope of the examination.

Question 6

This question focused on obtaining an early application filing date in the PTO when not all the required parts including a filing fee are available.

The grader deducted 3 points (out of 15) because petitioner did not mention specifically filing the express mail certificate, to which the model answer assigned a value of 3 points. No change was made by the Director. Petitioner seeks full credit for this question because he referred generally to 37 CFR 1.10, which includes the requirement for a mail certificate.

DECISION

Question 1

A thorough and detailed review of the entire record indicates that the Director was correct in identifying various deficiencies of petitioner's claims. Although there is a certain amount of subjectivity involved in determining what constitutes a well drafted claim, it is noted that the directions specifically require that the claim must interrelate a number of specified elements. Petitioner did not follow these directions because his claim failed to set forth the specific relationship of these elements. Accordingly, no points will be added to petitioner's score for this question.

Question 3

A thorough and detailed review of the entire record indicates that too many points were deducted for this question. As correctly noted by petitioner, the model answer did assign 4 points to providing information to the PTO on common assignment. Accordingly, the deduction of 5 points by the grader, as affirmed by the Director, was improper.

According to petitioner, information about common ownership of the two inventions described in the patent application is not relevant to the PTO's decision to issue the patent if the examiner has sufficient information to consider Smith's reduction to practice in the United States as prior art with respect to claim 2. Petitioner suggests that if applicants do not rely on common ownership, there would be no need for the examiner to have this information.

We disagree because this information is relevant whether or not applicants rely on common ownership to avoid a prior art rejection. Otherwise, the examiner is in no position to evaluate the circumstances especially since an assumption may be made that the inventions are commonly owned in view of the fact that the assignments were submitted to the PTO with the patent application which listed Smith and Wisdom as coinventors.

Although petitioner is correct in his statement that foreign acts cannot be used to establish a reduction to practice (35 USC 104), this does not necessarily mean that Wisdom's reduction to practice in Canada is not material in this question. As explained by the Director, disclosure of the foreign acts would make it clear to the examiner that Wisdom's reduction to practice would be limited to the filing date of the application. However, because it is accepted practice for examiners to assume that the filing date of an application is the date of the invention, this information is not material to the use of the Smith invention as prior art or prior invention against the Wisdom invention under both 35 USC 102(a) and (g), respectively.

Accordingly, three points will be added to petitioner's score for this question.

Question 5

This question, although it mentions the word infringement, relates to the drafting of a claim of particular scope. Since practitioners are expected to know how to vary the scope of the claims to cover their clients' inventions, the particular question is considered appropriate for this examination.

Because it is arguable whether the species claim in the model answer is more accurately classified as a subgeneric claim, the particular label assigned to the claim will not be used to evaluate petitioner's answer. As explained by the Director, petitioner's claim was not sufficiently narrow in scope to avoid potential prior art but read directly on the competitor's device.

Further, petitioner's claim adds limitations to original claim 1 which would make it a substantial duplicate of original claim 2 and would therefore be improper. The fact that petitioner chose to focus attention on the composition of the inner coating does not seem particularly relevant because according to the facts of this question, the Bremerton widget is said to be identical in every respect to the Midwidco "second generation" widget except

for the thickness of the outer resin film. Therefore, the Director did not err in refusing to award petitioner any partial credit for his claim even though it may be considered to be "subgeneric."

With respect to the permissibility of the preliminary amendment, it is noted that petitioner has received 4 out of a possible 5 points even though his answer varies from the model answer. The Director observed that petitioner's answer assumed that the subject matter of the new claim was disclosed in the specification although its location was not identified. Accordingly, the Director did not err in refusing to give full credit for this part of the question.

In view of the foregoing, no points will be added to petitioner's score for this question.

Question 6

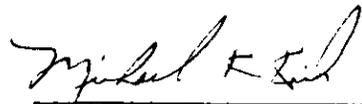
The issue in dispute is whether the general reference by petitioner in his answer to 37 CFR 1.10 is evidence of recognition that a mailing certificate is required as set forth in the model answer. Upon a thorough and complete review of the entire record, it is concluded that the Director did not err in refusing to accept petitioner's interpretation of his answer. Although petitioner's argument has some merit, the Director's conclusion is supportable because petitioner's answer does not clearly indicate an intent to comply with all the requirements of 37 CFR 1.10. It seems well within the Director's discretion to emphasize the use of a mailing certificate. Accordingly, no points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of March 31, 1988 is modified to the extent of restoring three points deducted by the Director from petitioner's score in the afternoon section of the examination on October 6, 1987. Petitioner, however, has not achieved a passing score of 70 points or more in the afternoon section.

The petition is denied.

Dated: 6/20/88



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs