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R-1987-4

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

In re)
) Decision on Petition to
) Review Decision of Director
) of Enrollment and Discipline
)

This is a decision on petitioner Hintz's Petition To Invoke The Supervisory Authority Of The Commissioner Under 37 CFR 1.182 [sic] To Overturn The Grading Of Examination, filed September 1, 1987. Petitioner asks the Commissioner to review and reverse the decision of the Director of Enrollment and Discipline, entered July 31, 1987, which granted the addition of only two of the requested thirty points to petitioner's grade in the Afternoon Section of the PTO Registration Examination For Patent Attorneys And Agents of April 7, 1987. Review of the decision of the Director is specifically authorized under 37 CFR 10.2(c). The petition is construed as seeking relief under this rule.

In the petition, petitioner repeats and incorporates by reference the arguments made before the Director in his Request For Regrading Of Examination In Accordance With 37 CFR 10.7(c), filed July 8, 1987, and additionally argues that the decision of the Director on regrade ignored and disregarded the applicable case law on language in claim preambles as limitations in claims.

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The decision of the Director has been reviewed in light of the petition and petitioner's answers to Questions 2 and 3 of the Afternoon Section of the Examination. No reversible error is found in the Director's decision. The following is added for emphasis.

Petitioner's claim for relief is based on the contention that the coating thickness recitation in claim 1 of the application filed January 14, 1987 is in the preamble to the claim and thus, is not a limitation on the claim. In support of his argument, petitioner cites "MPEP 1.77(e)" and various cases. Claim 1 reads as follows:

1. A widget having a resin coating of up to 0.1 mm thickness, said resin coating comprising a mixture of polyhexathisnthat and platonic acid.

Neither the cited cases nor 37 CFR 1.75(e) (the rule petitioner presumably intended since it contains the quoted language and there is no section 1.77(e) in the MPEP) support petitioner's contention that matter in the preamble to a claim is not a limitation of that claim, nor is this true as a rule of law. At any rate, there is no doubt that the thickness recital in the above claim 1 is, in fact, a limitation on the claim.

Even if the petitioner's contention were correct, it was not made in any of petitioner's answers in the Examination. Indeed, it is inconsistent with the answer

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which petitioner wrote for Question 2, which shows clearly that petitioner at that time believed the thickness recitation to be a limitation on the claim.

The \$140 received with the petition was in excess of the \$92 fee required under 37 CFR 10.2(c). See 37 CFR 1.21(a)(5). The Office of Enrollment and Discipline will process a refund in the amount of \$48.

The petition is denied.

Date: Dec. 3, 1987

Donald W. Peterson
DONALD W. PETERSON
Deputy Commissioner of
Patents and Trademarks