

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

|            |   |                      |
|------------|---|----------------------|
| In re      | ) | Decision on Petition |
|            | ) | for Review under     |
| Petitioner | ) | Rule 10.2(c)         |
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(hereafter "petitioner") petitions under 37 CFR 10.2(c) for review of the Decision on Request For Regrade on the Afternoon Section of the Examination Held on April 8, 1986 rendered by the Director of the Office of Enrollment and Discipline (OED) on September 19, 1986. Petitioner seeks an award of at least seven points to his score to give him a passing grade.

BACKGROUND

Petitioner took the examination for registration before the Patent and Trademark Office on April 8, 1986; he passed the morning section but was awarded less than the minimum of 70 points (out of 100) in the afternoon section, which he needed in order to be registered to practice. A Request For Regrading of the Examination For Registration was timely filed on August 13, 1986 wherein petitioner sought an award of additional points in each of questions 1, 2, 3, and 5. In the Decision on Request For Regrade on the Afternoon Section of the Examination Held on April 8, 1986, the Director of OED took the following action: As to question 1, six points were added to petitioner's score but eight points were deducted from petitioner's score; as to question 2, two points were added to petitioner's score; as to questions 3 and 5, no points were added to petitioner's score. Thus, eight points were added to petitioner's score and eight points were deducted from petitioner's score resulting in the same total score for petitioner (63 points) as when he filed his request for regrade.

On October 14, 1986, petitioner filed A Petition For Review Under Rule 10.2(c) seeking reinstatement of the eight points deducted from question 1 and award of "at least a passing grade" on question 5.

## FACTUAL REVIEW

### Question 1

Question I called upon the examinees to complete a "proper response" to the rejection of a claim under 35 USC 102(b) over a patent to Ullrich after the claim had been amended in a certain way and displayed in its entirety in the question. The examinees were told to assume that the claim as amended is "the broadest claim to which your client is entitled" and that no affidavits under 37 CFR 1.131 or 37 CFR 1.132 "would be appropriate in your response."

Upon the first grading, four points were deducted for the reason, "All novel features not discussed vis-a-vis Ullrich." (Original emphasis.) Two points were deducted with the comment, "Atomized spray not claimed."

In response to the request for regrade, the Director of OED agreed with petitioner's arguments regarding the six-point deduction and restored six points to petitioner's score. However, and this forms the first part of petitioner's request for review under 37 CFR § 10.2, the Director of OED, upon regrade of petitioner's answer, deducted eight points from the score because (1) petitioner's answer "did not point out the novelty of the invention as required by 37 CFR 1.111(c), namely, the simultaneous misting and watering functions of the invention" and (2) petitioner's argument "that Ullrich does not form a fine spray is against the clear teachings of the reference." As to (2), the petitioner had argued in his answer that the "[p]roduction of an atomized spray of mist is not contemplated nor could it be accomplished [sic] according to the Ullrich patent."

The 37 CFR 10.2(c) petition points out that petitioner's answer included the phrase, "Claim 1 as amended recites a substantially closed reservoir and includes an internally formed handle, curved spout and a spray pump mounted on top of the container. The use of a spray pump to provide mist is neither taught nor suggested by Ullrich."

### Question 5

This was an ethics question and petitioner received 10 out of a possible 20 points for his answer. The question called upon the examiner to "[e]xplain all appropriate courses of action which you can take under the facts given above." Upon the first grading of the answer, petitioner had one point deducted from his score because there was "ample time to obtain permission to withdraw" from the case in the period from April 8, 1986 to July 2, 1986. Nine

points were deducted from petitioner's score because he had not fully discussed the steps set forth in 37 CFR 10.40(a) to protect the rights of the client.

In the Request for Regrading, petitioner pointed out that the question specifically stated that the agent did "not wish to incur further expenses or have further dealings with" the client (petitioner's emphasis). Petitioner acknowledged that the answer given by him differed substantially from the model answer but argued that his answer followed "a reasonable course which complies with my ethical obligations."

The Director of OED gave petitioner no additional points for his answer to question 5 because, in the Director's view, one option of paying the issue fee would necessarily incur additional expenses, which would not be an appropriate answer, and the answer appeared "to be what ifs [sic] rather than setting forth definite courses of action."

The 37 CFR 10.2(c) petition states that the Director of OED has ignored the ethical issues raised by the question, and he should have understood that "ethical considerations often take precedence over the 'wishes' of an attorney or agent." Petitioner acknowledges that he took a "conservative position" but points out that he listed courses of action (deemed "what ifs" by the Director) as that was "plainly what the question required." The petitioner believes that he should not have points deducted from the answer because it did not clearly define what course(s) of action he would have taken under the given facts.

#### DECISION

##### Question 1

A thorough and detailed review of the entire record indicates that eight points should not have been deducted for petitioner's answer to Question 1. When considered as a whole, the answer to question 1 shows that petitioner was aware of the differences between the amended claim and the device in Ullrich. Eight points will be added to petitioner's score for question 1.

##### QUESTION 5

A thorough and detailed review of the entire record reveals no error in the Director's refusal to change the scoring of petitioner's answer to question 5.

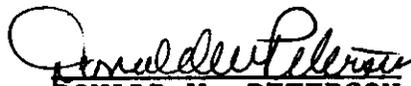
CONCLUSION

The Director's decision of September 19, 1986, accordingly, is reversed in part to the extent of restoring 8 points deducted by the Director from petitioner's score in the afternoon section of the April 8, 1986, examination. Petitioner has, accordingly, achieved a passing score of 71 points for the afternoon section.

The petition is granted.

Dated:

Jan 16, 1987



DONALD W. PETERSON  
Deputy Commissioner of  
Patents and Trademarks