

5/15/87

R-1987-3

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

In re : DECISION ON REQUEST FOR
: RECONSIDERATION OF
: APRIL 16, 1987, O.E.D. DECISION

Pursuant to your May 8, 1987, petition from the Office of Enrollment and Discipline decision of April 16, 1987, your examination of October 14, 1986, has been further reviewed. This review did not change your score for the morning section, but your grade for the afternoon section has been raised to passing. The following comments are intended to supplement the comments made in the decision of April 16, 1987.

MORNING SECTION

SECTION 1, QUESTION 10: 37 CFR § 1.331 is entitled "Recording of assignments" and deals with the conditions for recording of assignments. Of necessity, these assignments must have been submitted to the PTO. Your argument that the "rule neither states nor implies that the assignment can be submitted to the PTO [after execution]" requires that the rule state the obvious, that assignments must be submitted to be considered, and is not persuasive. It is noted that the main reason for requiring adequate identification of the application is to put others on notice that the patent has been assigned, 35 U.S.C. § 261. The correct answer is "true."

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REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

SECTION 1, QUESTION 37: Under 37 CFR § 1.64(a), the oath or declaration must be signed by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47. The exception for the joint inventorship fact situation of this question is expressly found in 37 CFR § 1.47(a). See MPEP 409.03(a). The provisions of 37 CFR § 1.47(b) apply to the situation where the inventor(s) is (are) not available. See MPEP 409.03(b). Nothing in § 1.47(b) can be construed to permit an assignee to execute application papers on behalf of joint inventors who are available and willing to execute the application papers. The correct answer is "false."

SECTION 1, QUESTION 46: The term "printed publication" in 35 U.S.C. § 102 is a term of art in patent law. A "publication" does not necessarily require wide circulation as you assume from Tampax, Inc. v. The Personal Products Corp. See Potter Instrument Co. v. Odec Computer Sys., 499 F.2d 209, 210 n. 2, 182 USPQ 386, 387 n. 2 (1st Cir. 1974) ("limited circulation alone does not disqualify a publication from contributing to the prior art"). Tampax was cited because the similarity in the fact situation, i.e., a pamphlet is sent accompanying a sample of the claimed device to more than one member of the public. The correct answer is "false." The

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

topic of "publication" is covered in detail in patent treatises such as 1 Chisum, Patents § 3.04[2] (1987).

SECTION 2, QUESTION 1: Patent practitioners are responsible for current orders, notices, changes in rules, etc., published in the weekly Official Gazette. See, e.g., Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985). A compilation of important notices and rule changes currently in effect is published every January under the title Consolidated Listing of Official Gazette Notices -- Re Patent and Trademark Office Practices and Procedures, for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. In addition, practitioners should keep up with weekly changes after that date. The time period of five months from the publication of the O.G. notice until the date of the examination is considered sufficient time to become acquainted with the terms of the O.G. notice. The question is proper and will not be withdrawn.

SECTION 2, QUESTION 4: The question states that the evidence available supports an "on sale" rejection, then asks the proper PTO procedure to raise this issue. Since the "on sale" issue cannot be raised in a reexamination proceeding, choice (b) is incorrect. Your response assumes that the evidence for an "on

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

sale" rejection is of the type that will support a different rejection, i.e., one based on prior art printed publications. This not only assumes material facts not stated in the question, but does not answer the question of the proper PTO procedure to raise the "on sale" issue.

SECTION 2, QUESTION 10: Prior to 1952, the language of the patent statute stated that the patent grant was "of the exclusive right to make, use and vend the invention or discovery . . . throughout the United States and the Territories thereof." Under the Patent Act of 1952, this was changed in wording to the grant "of the right to exclude others from making, using, or selling the invention throughout the United States," following the language of court decisions explaining the nature of the right conferred by a patent. See, Crown Dye and Tool Co. v. Nye Tool and Machine Works, 261 U.S. 24 (1923). The exact rights conferred by a patent were difficult to understand and explain under the old language. For example, a patent B to an improvement of patent A does not confer the right to make, use and sell devices covered by the improvement patent B because the device will infringe patent A. Patent B only gives the right to exclude others from making, using or selling the invention covered by the claims of patent B. Therefore, both choices (b) and (e) are incorrect. Choice

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

(d) is a more correct statement of the patent grant than choice (b), but choice (c) is the most correct because it states the language of the statute, 35 U.S.C. § 154.

SECTION 2, QUESTION 13: The claims as they would have been amended if the amendment after final rejection had been entered, have not been rejected and, therefore, cannot be properly argued on appeal. Your argument that "[t]he rule [37 CFR § 1.191] does not state that what is not mandatory is improper," is unpersuasive since you are being tested on your knowledge of correct practice under the rules. Only choice (d) is correct.

SECTION 2, QUESTION 34: Information which would render the claims unpatentable, including failure to disclose the "best mode," is "material" information within the meaning of 37 CFR § 1.56. Information known to be material to the examination of the application must be disclosed to the PTO under Rule 56; its disclosure is not "discretionary" with the patent attorney or agent. Accordingly, choice (a) is incorrect. See MPEP 2004, numbered paragraph 3, regarding the duty to disclose the "best mode."

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

SECTION 2, QUESTION 43: The provisions of 37 CFR § 1.63(a)(3) require that a proper oath or declaration must identify (1) each inventor, and (2) the residence and citizenship of each inventor. The rule requires that an inventor be identified, but not that he or she be identified by his or her full given name. The rule requires that the oath or declaration identify the citizenship of each inventor and, therefore, a failure to identify the citizenship is not a defect which can be corrected without the filing of a new oath or declaration. Accordingly, choice (c) is incorrect.

SUMMARY: Your grade of 67 remains the same, and is insufficient to pass the morning section of the examination.

AFTERNOON SECTION

QUESTION 2: Your arguments regarding the original two points deducted for not discussing the difference between the prior art and the "means on the bottom surface of the base plate to prevent movement of base with respect to the tie" are unpersuasive. Your response, as written, can only be interpreted to refer to the means which secures the base plate to the tie (i.e., screw spikes 14 in Qureshi or bolts 14 in Moorhead) and not to the "means on the bottom surface of the base plate to prevent movement of the base with respect to the

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

tie" (the serrated edges 34 in the application and lugs 4 in Moorhead). The reviewer's use of the word "securing" refers to securing the base against movement with respect to the tie and does not state, as does your answer, that the base is secured to the tie. Accordingly, the deduction of points was proper.

Your arguments concerning the eight points deducted during regrading are persuasive. Eight (8) points have been added to your score.

QUESTION 3: The facts of this question do not support a showing of "unavoidable" delay (as opposed to "unintentional delay"). Delay due to inadvertence or mistake does not constitute "unavoidable delay" under 35 U.S.C. § 133, Smith v. Diamond, 209 USPQ 1091, 1093 (D.D.C. 1981), aff'd, 671 F.2d 533, 213 USPQ 977 (D.C. Cir. 1982), Potter v. Dann, 201 USPQ 574, 575 (D.D.C. 1978). The points deducted by the grader were proper.

QUESTION 5: Upon reconsideration of the question as a whole, five (5) points will be added to your score for this question.

SUMMARY: Eight (8) points have been added to your score for Question 2, and five (5) points have been added to your score for Question 5 for a total of thirteen (13) points. Your final

REQUEST FOR RECONSIDERATION OF
APRIL 16, 1987, O.E.D. DECISION

score for the afternoon section is 72, which is a passing grade.

The petition is granted to the extent indicated.

June 15, 1987
Date

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

cc:

9/23/87

R-1987-3(R)

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

In re : DECISION ON REQUEST FOR
: RECONSIDERATION OF THE DEPUTY
: COMMISSIONER'S DECISION OF
: JUNE 16, 1987

You have petitioned the Commissioner for review of the Deputy Commissioner's decision of June 16, 1987. The Commissioner may delegate the determination of petitions, 37 CFR § 1.181(g). The Deputy Commissioner is authorized to decide petitions under 37 CFR § 10.2(c) for review of decisions by the Director of Enrollment and Discipline. Accordingly, this petition is before the Deputy Commissioner and will be treated as a request for reconsideration. See, In re Staeger, 189 USPQ 284 (Comm'r Pat. 1974); In re Intine, 162 USPQ 192 (Comm'r Pat. 1969); In re Ackerman, 156 USPQ 572 (Comm'r Pat. 1967); In re Schuyler, 117 USPQ 229 (Comm'r Pat. 1957).

The record as a whole has been thoroughly reviewed. We find no reasons persuasive of error in the decision of June 16, 1987. Accordingly, your score remains unchanged. It is not the function of this decision to provide a tutorial on patent law or to point out the errors in each of your arguments. The following comments are intended to provide guidance for your own further study.

COMMENTS

SECTION 1, QUESTION 10: You argue that 37 CFR § 1.331(c) states that an assignment can be executed prior to the

REQUEST FOR RECONSIDERATION

application being given a serial number but does not state that the assignment can be submitted before being given a serial number. You have interpreted the question as a "trick" question which was intended to test whether you were observant enough to see that the rule said "execute" rather than "submit." The question is not a trick question but a straightforward question on procedure. Among the top half of those taking the exam, 97% got the correct answer and, overall, the figure was 90.5%. This is a good indication that this was a fair question.

You state that "[o]ne could no doubt submit the assignment after the serial number is given." You have given no reason for the conclusion that the assignment can be submitted after the serial number is given but not before. The purpose of 37 CFR § 1.331 is to state the conditions for recording submitted assignments. The rule states that an assignment which is executed before its serial number is ascertained, can be recorded if it adequately identifies the application. It should be apparent that it is proper to submit an assignment if it is capable of being recorded.

Your interpretation is that an assignment can be executed before receiving a serial number, but that you must wait for the serial number before actually submitting the assignment. This is not stated in the rule and a serial number is not a

REQUEST FOR RECONSIDERATION

condition for recording of the assignment. This interpretation is also inconsistent with the three month recordation requirement of 35 U.S.C. § 261. Since an assignment may be void as against a subsequent purchaser if not filed within three months of its date, it is not wise to delay submitting an assignment for the time necessary to receive a serial number.

SECTION 1, QUESTION 46: A work does not require wide distribution or large numbers to be considered a "publication." An often used example is that a single copy in a library constitutes a publication if it is available to the public. See, In re Hall, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986); 1 Robinson, The Law of Patents for Useful Inventions § 327 (1890). Two (not twelve) thousand leaflets were distributed in Tampax, but even one would have been enough. Your proposed alternative test based on a percentage of companies receiving the brochures is not a legal test. Publication under 35 U.S.C. § 102 is a legal determination based on underlying fact issues and must be approached on a case-by-case basis. In re Hall, supra, 781 F.2d at 899, 228 USPQ at 455.

The "intent" factor is the intent for the work to be a publication, i.e., the work is intended for general public use as compared to being held confidential. This intent is plainly evidenced in both the problem and in Tampax, by the fact that the recipients were not enjoined to secrecy. Compare, General

REQUEST FOR RECONSIDERATION

Tire & Rubber Co. v. Firestone Tire & Rubber Co., 349 F. Supp. 333, 174 USPQ 427 (N.D. Ohio 1972), aff'd in part, rev'd in part and vacated in part, 489 F.2d 1105, 180 USPQ 98 (6th Cir. 1973), cert. denied, 417 U.S. 932 (1974), reh'g denied, 419 U.S. 886.

For a discussion of policy reasons behind the publication bar, see, Pickering v. Holman, 459 F.2d 403, 406, 173 USPQ 583, 585 (9th Cir. 1972). Where a publication is by the inventor there is generally no dispute that he or she was aware of it and, therefore, no policy or fairness reason to require publication of more than a single copy.

SECTION 2, QUESTION 4: The problem states that the evidence establishes that the competitor's claimed device was "on sale in this country more than one year prior to the filing date of the application." No other ground of rejection is relevant to the problem or supported by the given facts. Since the "on sale" issue will not be considered in a reexamination proceeding, choice (b) is incorrect.

You argue that evidence of a sale "virtually implies that account books, receipts, advertisements, etc., are available" and from your argument of May 8, 1987, you submit that "some of these may well be 'printed publications'" which "can indeed be considered in a reexamination proceeding." This reasoning is

REQUEST FOR RECONSIDERATION

contrary to the test instructions to answer the questions based on the facts in the given paragraph and to "not assume additional facts or employ irrelevant or incorrect reasoning." The only definite ground of rejection given in the problem is the "on sale" bar of 35 U.S.C. § 102(b). The ground of rejection you propose, presumably one based on the "described in a printed publication . . ." provision of § 102(b), is a different ground of rejection which is not suggested by the facts and is, therefore, irrelevant to the question.

Your reasoning assumes facts not stated in the problem, specifically, that the evidence establishing the "on sale" bar consists of "printed publications." A "printed publication" requires a showing of special circumstances which are neither suggested nor supported by the facts of the problem. It is natural for a layman to think of evidence in terms of matter with which he or she is familiar, however, a patent attorney or agent should recognize that the nature of evidence is widely varied and must be characterized on a case-by-case basis.

To summarize, reexamination is an incorrect answer because the facts do not suggest that the evidence consists of "printed publications" and, regardless of the type of evidence, the reexamination proceeding does not permit consideration of the only definite ground of rejection in the problem, the "on sale" bar.

REQUEST FOR RECONSIDERATION

SECTION 2, QUESTION 34: An application which does not disclose the best mode does not comply with the statutory requirements of 35 U.S.C. § 112, first paragraph, and is not entitled to a patent under the law. It is a patent examiner's duty (acting for the Commissioner) to ensure that applications are entitled to a patent under all provisions of the patent law, 35 U.S.C. § 131. A reasonable examiner must consider failure to comply with any statutory provision, including the absence of the best mode disclosure, important in deciding whether to allow the application to issue as a patent and, therefore, "material" in the sense of requiring disclosure under the test of 37 CFR § 1.56(a) (Rule 56).

The PTO does not usually inquire into whether the mode disclosed is or is not the best, absent information to the contrary. However, one cannot conclude that the PTO would consider information regarding the failure to disclose the best mode to be immaterial if brought to its attention. If an examiner is aware that a best mode has not been disclosed, he or she must make an objection to the specification and a rejection of the claims under 35 U.S.C. § 112, first paragraph. See, MPEP §§ 706.03, 608.01(h).

Concealment of the best mode known to an applicant at the time of filing of the invention is inequitable conduct. Steierman v. Connelly, 192 USPQ 433 (Bd. Pat. Int. 1975),

REQUEST FOR RECONSIDERATION

modified, 192 USPQ 446 (Bd. Pat. Int. 1976); Flick-Reedy Corp. v. Hydro-Line Mfg. Co., 241 F. Supp. 127, 140-141, 144 USPQ 566, 576 (N.D. Ill. 1964), aff'd in part and rev'd in part, 351 F.2d 546, 146 USPQ 694 (7th Cir. 1965), cert. denied, 383 U.S. 958 (1966); In re Nelson, 280 F.2d 172, 126 USPQ 242 (1960). Since you recognize that Rule 56 (as amended in 1977) "codifies the existing Office policy on fraud and inequitable conduct," you should agree that concealment of the best mode is a violation of Rule 56.

DECISION

The petition is denied. This decision is final for the purpose of seeking judicial review.

Sept 23, 1987
Date

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

cc: