

5/31/88

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

R-1988-1

In re _____,)
Petitioner)
Decision on Petition
for Review under
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 six 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 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 questions 4 and 5 was timely filed on February 29, 1988. In his decision on the request, the Director added no points for question 4 and 5 points for question 5, which resulted in a total score of 64 points. On April 29, 1988, this petition was filed seeking partial credit on question 4 and additional points for question 5.

FACTUAL REVIEW

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 claims. 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 initial grader gave the petitioner no credit for his answer to this question, which was worth 15 points. The grader noted that the "CIP gives best protection & can easily be filed before 11-11-87 sale bar date." On review, the Director awarded no additional points because the issues discussed by petitioner were considered to be immaterial in view of his answer that a CIP should not be filed.

The model answer, as does the question, allows for both a "yes" and "no" answer with respect to the filing of a CIP. However, the explanation for "no" is that there are no problems with the CIP if filed before the response period has expired and before the statutory bar arises. The model answer assigns 7 points to this part of the question and 8 points for providing a prosecution strategy.

Petitioner argues that he should receive partial credit for mentioning that the Office Action must be responded to within the three month period and that the CIP would have to be filed prior to November 11, 1986.

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 awarded no points because petitioner's claim was not drawn to a species but rather was subgeneric and because petitioner's answer contained no discussion of the claim's basis in the specification. The Director added 5 points on his review but noted that there was no support for the actual language of this claim.

Petitioner argues that he should receive additional credit because there is in fact support for his claim language.

DECISION

Question 4

A thorough and detailed review of the entire record indicates that some partial credit should have been awarded for petitioner's answer to this question. When considered as a whole, the answer shows that petitioner was aware of the need to file a response within the statutory time period and the need to consider potential statutory bars. These issues are relevant because the question asked for a discussion of the problems of filing a CIP if one was not recommended. However, full credit of 7 points is not considered appropriate because of the petitioner's discussion of "new matter" which contains faulty reasoning and is therefore subject to a deduction of 2 points. Five points will be added to petitioner's score for this question.

Question 5

A thorough and detailed review of the entire record indicates that additional credit should have been awarded for petitioner's species claim. Petitioner's claim deserves more credit although not the full amount of 10 points because it is not the preferred answer. Further, it is arguable whether there is actual support in the specification for the language of petitioner's species claim. Three points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of March 31, 1988 is reversed to the extent of restoring eight points deducted by the Director from petitioner's score in the afternoon section of the examination on October 6, 1987. Petitioner, accordingly, has achieved a passing score of 72 points in the afternoon section.

The petition is granted.

Dated: 5/31/88



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs