

R-1999-74

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

In re _____)
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Decision on
Petition for Regrade
Under 37 C.F.R. § 10.101(b)(2) 3 1999.

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MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 1, 7, 20, and 43 of the morning session and questions 25 and 28 of the afternoon session of the Registration Examination held on April 21, 1999. The petition is denied to the extent Petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64. On August 9, 1999, Petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioner to show that his chosen answers are the most correct answers.

The directions to the afternoon section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered. Each question is worth one point.

Petitioner has argued that petitioner should be awarded points for morning questions 20 and 43 and afternoon question 28, and has been awarded points for these questions because these questions have been eliminated from the examination. In addition, petitioner was not awarded credit for morning question 27. Since this question has also been eliminated from the examination, petitioner has been accorded a total of four additional points on the examination, resulting in a regraded score of 68.

Morning question 1:

Question 1 reads as follows:

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and have attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of those remarks. Please charge my deposit account number 99-1234 to cover the costs of any required fees.

P should not be surprised when the amendment is not entered because:

(A) The reply was not signed.

- (B) An amendatory paper determined to contain objectionable remarks will be returned to sender
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A), (B) and (C) are correct.

Choice (D) is correct because both (A) and (B) are correct.

A reply that is not signed is not entered, but applicant is given an opportunity to ratify the reply. See Manual of Patent Examining Procedure (MPEP) § 714.01(a). A reply determined to contain objectionable marks will be returned. See 37 CFR 1.3. (C) is not correct because a general authorization to charge a deposit account is a request for an extension of time, albeit an unsigned one in this instance. See 37 CFR 1.136(a).

Petitioner argues that (E) is the correct response because there is no indication that the registered patent practitioner was authorized to act on behalf of the applicant. The Office normally enters papers filed by a registered patent practitioner, regardless of whether the practitioner is an attorney of record. See 37 CFR 1.34(a). Only in an unusual situation where the record suggests that the attorney does not have authority to act on behalf of the applicant does the Office question the attorney's authority to act. Accordingly, petitioner's argument that the paper would not be treated as a constructive petition for an extension of time because it was not signed by an attorney of record is without merit.

Morning question 7:

Morning question 7 reads as follows:

A patent application claims a chemical composition and discloses in the application that the composition has a cleansing property in addition to being able to remove ink stains. The examiner rejected the claims in the application under 35 U.S.C. § 103 as being obvious over Parker in view of Cross. Each reference discloses chemical compositions which can be used to remove ink stains. The proposed combination of references includes all of the limitations of the composition claimed in the application. However, neither reference shows or suggests the cleansing property newly discovered by applicant. Does the combination of Parker and Cross support a *prima facie* case of obviousness?

(A) Yes, even though neither reference shows or suggests the newly discovered property of the claimed composition.

(B) Yes, because after reading applicant's specification, it would be obvious that both references can be combined to achieve the cleansing property claimed by applicant.

(C) No, unless in addition to structural similarity between the claimed and prior art compositions, the references contain a suggestion that the compositions will have the newly discovered cleansing property.

(D) No, because the discovery of a new property of a previously known composition imparts patentability to the known composition.

(E) No, because the burden of proof cannot be shifted to the applicant to show that the prior art compositions lacked the newly discovered property asserted for claimed composition unless one of the references discloses the property.

(A) is the correct answer because it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. MPEP § 2144, page 2100-115, right hand column.

Petitioner's argument that (C) is the correct response and that (A) is incorrect is not persuasive. Petitioner argues that answer (C) is contrary to MPEP § 2143 which addresses the requirements of a *prima facie* case of obviousness. Petitioner quotes from section 2143 of the MPEP stating "there must be some

suggestion or motivation...to modify the reference or to combine reference teachings" and "the...suggestion to make the claimed combination...must...be found in the prior art." Petitioner concludes that a prima facie case for obviousness requires that the combined references contain a suggestion that the prior art compositions will have all of the limitations of the claimed combination, and that (A) is incorrect because the prior art must suggest "making the claimed combination with all the claim limitations."

Petitioner's paraphrasing of the MPEP omits an important part of the MPEP text. The suggestion or motivation must be either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. It is not whether the teaching was in the reference or the general knowledge that is important to the question and answer, however. Instead, it is understanding whether the cleansing property is a limitation to the claim. The question specifically states that the combination meets all of the limitations of the composition claimed. The question also states that neither reference shows or suggests the cleansing property newly discovered by applicant. Implicitly, the cleansing property is not a limitation of the claim. Answer (C) is incorrect because the references do not have to suggest all of the properties discovered by applicant. It is sufficient that the prior art disclose one reason for combining the references. See In re Baxter Travenol Labs, 952 F.2d 388, 21

USPQ 1281 (Fed. Cir. 1991) (mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention).

Afternoon question 25.

Afternoon question 25 reads as follows.

25. A multiple dependent claim _____.

(A) may indirectly serve as a basis for another multiple dependent claim.

(B) may directly serve as a basis for a multiple dependent claim.

(C) shall be construed to incorporate by reference all the limitations of each of the particular claims to which it refers.

(D) added by amendment should not be entered until the proper fee has been received by the PTO.

(E) (C) and (D).

Answer (E) is the correct answer because both (C) and (D) are correct. A multiple dependent claim (MDC) is construed to incorporate by reference all the limitations of each claim to which it refers. In addition, a multiple dependent claim added by amendment should not be entered until the proper fee has been received by the PTO. Both (A) and (B) are incorrect because one MDC may not depend upon another, either directly or indirectly.

Petitioner argues that (C) not (E) is the correct response because (D) is not a correct response. Petitioner argues that (D) is not correct because MPEP § 608.01(n) states that "If a multiple dependent claim is added in an amendment without the proper fee...the amendment should not be entered until the fee has been received." Petitioner argues that an assumption as to

whether or not the number of claims included with the amendment were in excess of the basic fee and that the amendment was submitted without the proper fee.

No assumption was required as to whether or not there were an excess number of claims or whether the amendment was submitted without the proper fee. Answer (D) states that a MDC will not be entered until the proper fee is paid. Regardless of the number of claims filed, filing a MDC requires a MDC claim fee of \$260 (\$130 for a small entity). See 37 CFR 1.16(d). If the MDC claim fee is not paid, then the amendment should not be entered until the fee is paid. See also 37 CFR 1.75(c) and MPEP 608.01(n), page 600-68.

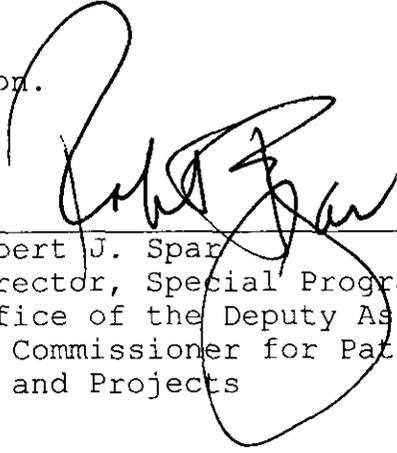
No error in grading has been shown as to questions 1 and 7 of the morning session and 25 of the afternoon session. Petitioner's request for credit on questions 1 and 7 of the morning session and 25 of the afternoon session is denied.

ORDER

For the reasons given above, four points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Special Program Law Office
Office of the Deputy Assistant
Commissioner for Patent Policy
and Projects