

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections 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 fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded points for afternoon questions 11, 19, and 29. Accordingly, petitioner has been granted additional three points on the Examination. However, no credit has been awarded for morning questions 18, 19, and 28 and afternoon questions 5, 34, and 45.

Petitioner’s arguments for these questions are addressed individually below.

Morning question 18 reads as follows:

18. A patent application filed in the PTO contains the following dependent claim:
 2. The method of Claim 1, further consisting of the step of cooling the mixture to a temperature of 32° F.

Following proper PTO practices and procedures, from which of the following claims does the dependent claim not properly depend?

- (A) 1. A method of making liquid compound A consisting of the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (B) 1. A method of making liquid compound A comprising the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (C) 1. A method of making liquid compound A including the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (D) 1. A method of making liquid compound A characterized by the steps of mixing equal quantities of material C and material D in a beaker and heating the mixture to a temperature of 212° F.
- (E) (C) and (D).

The model answer is choice (A).

Petitioner contends that there is no correct answer. According to the petitioner, “dependent claim 2 uses ‘consisting’ - such a claim cannot depend from any claim properly because it then excludes the steps of the parent claim.”

Petitioner’s argument has been fully considered but they are not persuasive. A dependent claim incorporates all the limitations recited in the previous claim. Furthermore, the phrase “consisting of” in claim 2 appears in a clause of the body of the claim, rather than immediately following the preamble. Hence, it limits only the elements set forth in that clause; other elements are not excluded from the claim as a whole. See MPEP 2111.03 and *Mannesmann Demag Corp.*

v. Engineered Metal Products Co., 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). Accordingly, the phrase “consisting of” in claim 2 does not exclude the steps recited in claim 1. Answer (A) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 19 reads as follows:

19. If a claim has been properly rejected under 35 U.S.C. § 103 as being rendered obvious over a combination of prior art references, then in accordance with proper PTO practice and procedure:

- (A) it is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by the applicant, if the combination provides motivation to make the claimed invention.
- (B) the rationale to modify or combine the prior art must be found expressly set forth in the prior art.
- (C) in considering the disclosure of prior art it is proper to take into account the specific teachings of the reference. It is not proper to take into account the inferences that one skilled in the art could reasonably draw from the specific teachings.
- (D) it is improper for a patent examiner to take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being “well known.”
- (E) it is proper to rely on equivalence in support of the rejection, the equivalence may be recognized in the prior art or in the applicant’s disclosure.

The model answer is choice (A).

Petitioner argues that there is no correct answer to the question. Petitioner contends that the PTO rule indicates that the reference may directly or impliedly state a rationale to modify.

Petitioner further states that “the quality ‘impliedly’ does not allow the statement of a rationale to modify to be absent - it must be present. ‘To suggest’ is very different from ‘to imply.’”

Petitioner concludes that question 28 has no correct answer.

Petitioner’s arguments have been fully considered but they are not persuasive. As explained in MPEP 2144, “[i]t is not necessary that the prior art suggest the combination to achieve the

same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).” The MPEP further states “while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.” Accordingly, answer (A) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 28 reads as follows:

28. A patent application filed in the PTO contains the following three claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper PTO practices and procedures, which of the following replies best overcomes the examiner’s objection and provides the client with the broadest patent protection?

- (A) Amend Claim 3 to read: “The Ethernet cable as made by the process set forth in claims 1-2.”
- (B) Cancel Claim 3.
- (C) Add Claim 4, which reads: “An Ethernet cable made by a process comprising the steps of A, B and C.”
- (D) Add Claim 5, which reads: “An Ethernet cable made by a process comprising the steps of A, B, C and D.”
- (E) (B), (C), and (D).

The model answer is choice (E).

Petitioner argues that there is no correct answer. Petitioner contends that “[t]he Examiner objected to claim 3 as “improper” because claim 3: (a) refers to more than one preceding claim, and (b) it includes a trademark.”

Petitioner’s arguments have been fully considered but they are not persuasive. Contrary to the petitioner’s (b) contention, the question only states that “the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim.” Neither “Ethernet” nor “Ethernet cable” are trademarks (“Ethernet Relay” and “Ethernet Everywhere” are trademarks.) The use of a trademark may be permitted, however, if the product to which the trademark refers is set forth in such language that its identity is clear. See MPEP 608.01(v). Here, the examiner did not object to the use of the term, Ethernet.

Answer (E) is correct because the cancellation of Claim 3 overcomes the examiner’s objection and the addition of Claim 4 and 5 provides the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 CFR § 1.75(c); MPEP § 608.01(n) (“1. Claim Does Not Refer Back in the Alternative Only”). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either claim 1 or claim 2. Therefore, answer (E) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 5 reads as follows:

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered "substantially parallel." Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace "a circular shaped member" with "an elliptical shaped member," then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete "wherein the leg members are parallel to each other," then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace "parallel" with "substantially parallel," then the amended claim will likely be allowed.
- (E) None of the above.

The model answer is choice (E).

Petitioner argues that there is no correct answer to the question. Petitioner alleges that “[a]n ‘amendment’ can only occur during pendency of the application - not the reissue- and is improper in a reissue, making A and B correct.” Petitioner further maintains that “geometrically, lines/elements either are parallel or they are not and the question itself provides no information that demonstrates that a change from ‘substantially parallel’ to ‘parallel’ means insertion of new matter - making D correct.”

Petitioner’s arguments have been fully considered but they are not persuasive. Contrary to the petitioner’s statement, amendments may be presented in a reissue application. See MPEP 1411.02 through 1412.03. Answers (A) and (B) are incorrect because a broadened claim can be presented within two years from the grant of the original patent in a reissue application.

MPEP § 1412.03.

The original disclosure filed March 1, 1995, stated that “all leg members must be parallel to each other.” The applicant amended the specification to “the leg members could be substantially parallel.” In response to petitioner’s argument, “substantially parallel” is not indefinite since the amendment includes guidelines for determining what would be considered “substantially parallel.” See MPEP 2173.05(b). Furthermore, “substantially parallel” is a broader term than “parallel” because “substantially parallel” allows deviations from “parallel.” Thus, the amendment introduced new matter. According to the MPEP 1411.02, the claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Here, the applicant does not have the right to claim the subject matter “substantially parallel.” Answer (D) is incorrect because the reissue claim improperly relies on new matter.

Therefore, answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 34 reads as follows:

34. Your client, Vada, disclosed the following information to you. While vacationing on a desert island, she discovered a salt lake where the water was a solution saturated with NaCl. Vada experimented with the solution and determined that it could be used to cure skin rashes if applied directly to the skin. By further experimentation, Vada determined that the best results could be obtained if the solution were first heated to an ideal temperature (T_i) equal to skin temperature (T_s) plus the square of the difference between room temperature (T_r) and skin temperature (T_s). Vada documented her findings in the form of the following equation: $T_i = T_s + (T_r - T_s)^2$. Vada further experimented and found that she could obtain the exact same solution that she discovered while vacationing, by mixing NaCl with water followed by heating the mixture to 212°F and cooling it to 80°F. You draft a patent application with a specification including all the information disclosed to you by Vada. Which, if any, of the following claims, included in the application, would provide the proper basis for a rejection pursuant to 35 U.S.C. § 101?

- (A) A composition comprising: water saturated with NaCl.
- (B) A composition for restoring youth.
- (C) A composition and method for treating skin rashes, comprising: a solution of water saturated with NaCl; heating said solution to a temperature defined by skin temperature plus the square of the difference between room temperature and skin temperature; and applying said solution to skin rashes.
- (D) An expression comprising: $T_i = T_s + (T_r - T_s)^2$.
- (E) All of the above.

The model answer is choice (E).

Petitioner argues that there is no correct answer to the question. Petitioner contends that “[a]s a matter of law, claims are not the basis for rejection, laws are the basis for rejection.”

Petitioner's arguments have been fully considered but they are not persuasive. The question provides 35 U.S.C. § 101 as the basis for the rejection, and asks which claim or claims would be properly rejected under this statute. Answer (E) is correct because the claims set forth in answer (A) through (D) may be properly rejected under 35 U.S.C. § 101. The claim in answer

(A) includes a naturally occurring composition. See MPEP 2106. The claim in answer (B) may be properly rejected because it does not have any limitation, but an intended use. See MPEP 2106. The claim in answer (C) is drawn to more than one statutory class of invention, i.e., a product and a process, in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. § 101. The claim in answer (D) is a mathematical equation which alone is not a patentable subject matter. See MPEP 2106. Therefore, answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 45 reads as follows:

45. You have been asked to draft a patent application based on Figures 1 and 2 provided below. The inventor has provided you with a written disclosure which states that the invention is directed to a toy building element which may be mounted as a dump body on a toy vehicle. According to the inventor's description, the toy building element comprises an open container part and a bottom, said container part and bottom being hingedly interconnected, said bottom being moreover provided with coupling means for coupling with other toy elements. Referring to Figure 1, the inventor's description states that the toy building element (1), which is just called a dump body, consists of two parts which are interconnected via a hinge (2) viz a container part (3) and a bottom (4). The written description further provides that the container part (3) is formed by an upwardly open, box-like unit having a substantially square bottom and four side walls, one of which is considerably lower than the others. In the embodiment shown, the bottom of the container is provided with coupling studs (5) on which toy building elements may be coupled. As described by the inventor, the bottom (4), which is square in its base face, has a plane surface on which the container part (3) rests along its entire circumference when it is tilted down. The surface of the bottom (4) may be provided with well-known means for detachably retaining (not shown) the container part (3) so that "it just takes a small force to tilt the container part." Referring to Figure 2, the inventor's description states "Figure 2 shows the dump body (1) mounted to tilt rearwardly on a toy truck (6), which comprises a bottom (7), wheels (8), and a driver's cab (9)." It is further provided that "on the chassis at the rear end of the truck (6), the truck bottom (7) is equipped with a square, plane face provided with well-known coupling means (not shown) which meet with the well-known coupling means (not shown) positioned on the underside of the bottom (4) of the dump body (1).

Based on the drawings and description provided above, which of the following claims, if any, are in accordance with proper PTO practice and procedure?

- (A) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4).
- (B) A toy building element for use as a dump body (1) for a toy vehicle, said toy building element comprising an open container part (3) and a bottom (4), said container part (3) and bottom (4) being hingedly interconnected by a hinge (2).
- (C) A toy building element comprising an open container part and a bottom, said open container part and bottom being hingedly interconnected, said bottom being provided with coupling means for coupling with other toy building elements.
- (D) (A), and (B).
- (E) (A), (B), and (C).

The mode answer is choice (E).

Petitioner argues that there is no correct answer to the question. Petitioner alleges that “[a]nswer/claim A is not a claim, but a “kit” (parts without connexity), and further exceeds - on a § 112, 1st paragraph basis - the scope of the specification.”

Petitioner’s arguments have been fully considered but they are not persuasive. In response to the petitioner’s argument, the claim in answer (A) is a proper claim because it is claiming a device, a toy building element, that comprising an open container part and a bottom. Furthermore, interconnection of the elements as described in the written description provided by the inventor and as disclosed in the drawings is not required. The claim is an originally presented claim, which is part of the disclosure. Accordingly, answer (E) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

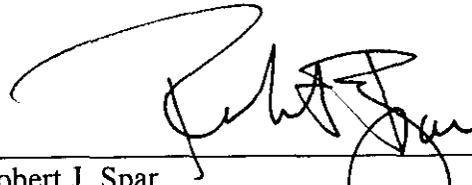
No error in grading has been shown as to morning questions 18, 19, and 28 and afternoon questions 5, 34, and 45. Petitioner’s request for credit on these questions is denied.

ORDER

For the reasons given above, three points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 67. This score is insufficient to pass the Examination.

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

This is a final agency action.



Robert J. Spar
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Office of the Deputy Commissioner
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