



SEP 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 3, 18, 36, 43 and 50 of the morning section and questions 10, 14 and 33 of the afternoon section of the Registration Examination held on October 18, 2000. 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 United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On January 31, 2001, 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, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and

10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

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 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" or "Office" are used in this examination, they mean the United States 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 additional 2 points for morning question 43 and 50. Accordingly, petitioner has been granted an additional 2 points on the Examination. No credit has been awarded for morning questions 3, 18 and 36 and afternoon questions 10, 14 and 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

I. The fee set forth in 37 C.F.R. § 1.17(i).

II. John's birth certificate showing his date of birth.

III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

(A) I

(B) II

(C) III

(D) II and III

(E) None of the above.

The model answer is selection E.

MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that the question could be read another way in that the other facts presented are not considered and one only considered the answer choices alone or in combination with the petition. Then, the fee alone would not be sufficient to result in the petition being granted.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (A) is the correct answer, the question asks which of the following in combination with the petition is not sufficient to result in a grantable petition. All of the additional facts presented to the Office would have been

considered as part of the petition. All of the additional elements would result in a grantable petition. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

18. How do you best advise ManCo?

(A) Recommend promptly filing a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time.

(B) Recommend promptly filing a petition and associated fees for a three month extension of time along with a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action.

(C) Recommend proceeding with prosecution by promptly filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time; and allowing the patent to issue in Putin's name alone with the understanding that, if the investigation shows the possible joint inventor should have been named, correcting the inventorship after issuance of the patent in accordance with 37 C.F.R. § 1.48.

(D) Recommend promptly filing an appropriate reply to the outstanding Office action along with a petition and fees for a three-month extension of time and concurrently submitting a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

(E) Recommend promptly filing a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

The model answer is selection D.

(A), (B) and (E) are each wrong at least because action cannot be suspended in an application that contains an outstanding Office action or requirement awaiting reply by the applicant. 37 C.F.R. § 1.103; MPEP § 709. These recommendations, if followed, would likely lead to abandonment of the application. (C) is wrong at least because inventorship in an issued patent is properly corrected through 37 C.F.R. § 1.324, not § 1.48. Also, (C) is contrary to ManCo's instructions that the matter is to be straightened out before the application is allowed to issue as a patent, and may raise questions concerning compliance with the duty of candor before the USPTO.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (C) is correct because one can correct inventorship after a patent issues, thus both (C) and (D) are correct answers.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement (C) is incorrect because inventorship in a patent is corrected through 37 C.F.R. § 1.324, not § 1.48. Additionally, (C) is contrary to ManCo's instructions that the matter is to be straightened out before the application is allowed to issue as a patent, and may raise questions concerning compliance with the duty of candor before the USPTO. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 36 reads as follows:

36. In July 1999, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 5, 1997. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

(A) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims

(B) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.

(C) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.

(D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.

(E) Since the new invention was disclosed but not claimed in the original application, Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

The model answer is selection C.

It is essential that Sam file broader claims and indicate his intention to broaden within the two year time limit of 35 U.S.C. § 251. See MPEP § 1412.03, p.1400-13, and

In re Graf, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). As to answer (D), according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived sua sponte. As to a continuation application, they may also issue at different times as explained at MPEP § 1451, p.1400-38. Since (C) is true, (A), (B) and (E) are false. Further as to (E), claims reading on subject matter not covered by the original claims are broader.

Petitioner argues that answer (B) is correct. Petitioner contends that as long as applicant indicates an intention to file broader claims before the two year time limit, that he may file broader claims later. Petitioner also contends that the facts do not state whether the dependent claims were broader or narrower, thus the claims could have been broader and applicant would have a right to file broader claims.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that it is not clear if the new claims would broaden the scope of the claimed invention, the facts state that the claims are "to an entirely different invention, which was disclosed in the patent but not claimed." Secondly, broadening dependent claims does not enlarge the scope of the invention, because the dependent claim includes all the limitations of the independent claim. See MPEP 1412.03. Additionally, the instructions indicate not to presume facts not presented in answering the questions. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Please answer questions 10 and 11 based on the following information.

A patent issued to Joe Inventor on July 25, 2000 based on an application filed in January 1999. Larry Practitioner was the registered practitioner of record in the application, and all correspondence from the USPTO during prosecution was directed to Larry at his then-current address. At the time he paid the issue fee, Larry designated a "fee address" for payment of maintenance fees. Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Larry did not, however, file a change of correspondence address in the patent file. An assignment of all rights in the patent from Joe Inventor to Big Corporation was made September 5, 2000 and was recorded in the USPTO on September 14, 2000.

Afternoon question 10 reads as follows:

10. Under standard USPTO practice and procedure, where will the USPTO send any Maintenance Fee Reminder?

- (A) Joe Inventor's address as indicated on the inventor's declaration, unless a change of address had been filed for Mr. Inventor.
- (B) Larry's address prior to September 2000.
- (C) Larry's address subsequent to September 1, 2000.
- (D) The fee address designated by Larry at the time he paid the issue fee.
- (E) The address of the assignee as indicated on the assignment recorded in the USPTO.

The model answer is selection D.

The Maintenance Fee Reminder is sent to the correspondence address used during prosecution unless a fee address has been designated. 37 C.F.R. § 1.363; MPEP § 2540.

Petitioner argues that answer (C) is correct. Petitioner contends that (C) is correct because the conditions of both 1.363(a)(1) and 1.363(a)(2) are met. Petitioner contends that Larry's change of address in compliance with 37 CFR 10.11 is also a change of address for his applications.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Larry complied with the conditions of both 1.363(a)(1) and 1.363(a)(2), Larry only designated a fee address. Larry did not make a change of address in the application. See 37 CFR 10.11(a). Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 14 reads as follows:

14. The right of priority under 35 U.S.C. § 119(a)-(d) may be obtained where, if all other requirements are met:

- (A) A is the inventor of the U.S. nonprovisional application, and B is the inventor of the foreign application, and the two applications are owned by the same party.
- (B) The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, was filed 18 months from the earliest, and only foreign filing.
- (C) The right is premised upon the second foreign filed application disclosing and claiming the same invention as is claimed in the earliest United States nonprovisional application, the first foreign application having been filed twenty-four months before said

United States nonprovisional application.

(D) The U.S. application contains only process claims, and the foreign application does not enable the disclosed process.

(E) The claim for foreign priority includes the application number, and filing date of the foreign application, as well as the name of the treaty under which the application was filed, if appropriate, and the name and location of the national or intergovernmental authority which received such application.

The model answer is selection E.

MPEP § 201.13 “The Priority Claim.” (A) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. A right of priority does not exist in the case of an application of inventor B in the foreign country and inventor A in the United States, even though the two applications may be owned by the same party. The name of the treaty is appropriate if it is a bilateral treaty, as opposed to the Paris Convention, whereas naming the treaty is not appropriate if it is the Paris Convention. (B) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. § 120, must have been filed within twelve months of the earliest foreign filing. (C) is incorrect. 35 U.S.C. § 119; MPEP § 201.13. The twelve months is from earliest foreign filing except as provided in 35 U.S.C. § 119(c), which exception does not obtain in the given facts. (D) is incorrect. 35 U.S.C. § 119(a); MPEP § 201.13. The foreign application must be for the same invention as the application in the United States.

Petitioner argues that answer (A) is correct. Petitioner contends that since both inventions are owned by the same party that § 119 permits priority to be claimed. Petitioner also contends that the model answer is wrong because the type of treaty has nothing to do with the correct answer.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that as long as the inventions are owned by the same party, one can claim priority to the earlier application. A right of priority does not exist in the case of an application of inventor B in a foreign country and inventor A in the United States, even though the two applications may be owned by the same party. See MPEP § 201.13. Accordingly, model answer (E) is correct and petitioner’s answer (A) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. Mike and Jill are members of the Virginia Bar with a general law practice. Jill is registered to practice before the USPTO and is constantly poking fun at Mike for not being registered. Jake, one of Mike's former clients, owns a small tool shop and while attempting to remove a broken drill bit from a workpiece, invented a tool that easily extracts a broken bit. The tool is simple to make. Jake asked Mike if he could patent his invention, and Mike, desiring to impress Jill with his patent skills, said, "No problem." Using a "how to" book that he obtained from the INTERNET, Mike prepared an application on Jake's invention and filed it in the USPTO together with a power of attorney which Jake executed naming Jack as attorney of record. Shortly thereafter, the Mike and Jill firm hired Jim, a registered patent attorney, and Mike physically filed a document with the USPTO naming Jim as an associate attorney in Jake's application. Upon reviewing Jake's application, Jim discovered that the original claims omitted the recitation of a critical element which was disclosed in the specification. Assuming a preliminary amendment is filed with the USPTO adding the critical element to the claims, and explaining in the REMARKS that the critical element was inadvertently omitted at the time of filing the application, which of the following is the most comprehensive answer in identifying the individual(s), if any, who by signing the amendment will be recognized by the USPTO for representation?

- (A) Jake
- (B) Jim
- (C) Jill
- (D) All of the above
- (E) None of the above

The model answer is selection D.

Jake is the applicant, and Jim and Jill are registered practitioners. "An applicant for patent may file and prosecute his or her own application..." MPEP § 401. The applicant, Jake, is not required to revoke Mike's power of attorney because Jack is unregistered, and therefore his appointment is void ab initio. MPEP § 402, Form Paragraph 4.09 (first paragraph). Jim and Jill's signature constitutes "a representation to the Patent and Trademark Office that...he or she is authorized to represent the particular party in whose behalf he or she acts." 37 C.F.R. § 1.34. This privilege applies whether or not the registered attorney is of record. 37 C.F.R. § 1.31; MPEP § 402. (A), (B), and (C) are wrong because they do not represent the "most comprehensive" answer. (E) is wrong because it is inconsistent with (D), which is correct.

Petitioner argues that answer (C) is correct. Petitioner contends that the question is confusing and that all answers should be given credit because Jack was introduced midway through the question. Petitioner contends that Jill will probably be recognized

and that Jim would not be recognized because he is an associate of Mike. Mike could not give Jim power to act since he was never of record. Additionally, the rules cited in the model answer would not give Jim power to act for Jake

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Jim would not be recognized by the PTO, 37 CFR 1.34 states that a practitioners signature constitutes he or she is authorized to represent the party. Additionally, an applicant for patent may file and prosecute his or her own application... ." MPEP § 401. Accordingly, model answer D is correct and petitioner's answer C is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, 2 points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 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
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy