



SEP 5 2001

In re

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

MEMORANDUM AND ORDER

petitions for regrading her answers to questions 3, 10, 19, 27, 43, and 46 of the morning section and questions 21, 33, 43, and 49 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 63. On January 27, 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 an additional 1 point for morning question 43. Accordingly, petitioner has been granted an additional 1 points on the Examination. No credit has been awarded for morning questions 3, 10, 19, 27, and 46 and afternoon questions 21, 33, 43 and 49. 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 since a fee is not required for a grantable petition to make an application special on the basis of the applicant's age or poor health. Petitioner's arguments have been fully considered but are not persuasive. Taken alone, any one of items I through III would be a sufficient basis for a grantable petition to make the above-described application special. 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 10 reads as follows:

10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

- (A) Claim 2.
- (B) Claim 3.
- (C) Claim 4.
- (D) Claims 2 and 3.
- (E) Claims 3 and 4.

The model answer is selection A

MPEP § 2173.05(e). Claim 2 is indefinite because “said pipe” lacks antecedent basis. Claim 3 is definite, as “the outer surface” is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), (D), and (E) are incorrect. Claim 4 is definite as there is antecedent basis for “said plastic valve.” Therefore, (C) is incorrect.

Petitioner argues that answer (D) is correct on the basis that claim 3 lacks antecedent basis for “the outer surface.” Petitioner’s arguments have been fully considered but are not persuasive. The paragraph above explains that “the outer surface” is an inherent part of the pipe and would not require antecedent recitation. Accordingly, model answer (A) is correct and petitioner’s answer (D) is incorrect.

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

Morning question 19 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.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

(A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.

(B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be

corrected.

(C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.

(D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.

(E) (C) and (D) are each an appropriate way to correct the named inventive entity.

The model answer is selection C.

Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

Petitioner argues that answer E is correct. Petitioner's argument is predicated on the assertion that model answer C must incorporate the assumption that the continuation application referred to therein included a new oath or declaration. This assertion, however, is incorrect as an oath or declaration may be filed in an application after the filing date thereof under the provisions of 37 CFR 1.53(f). Petitioner's arguments have been fully considered but are not persuasive for the reasons provided above. Accordingly, model answer C is correct and petitioner's answer E is incorrect.

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

Morning question 27 reads as follows:

27. If a prima facie case of obviousness is properly established by a primary examiner, how can an applicant effectively rebut the rejection in accordance with proper USPTO practice and procedure?

(A) Rebuttal may be by way of arguments of counsel used in place of factually supported

objective evidence to rebut the prima facie case.

(B) Rebuttal may be by way of an affidavit or declaration under 37 C.F.R. § 1.132 containing objective evidence arising out of a secondary consideration related to the claimed invention.

(C) No substantive showing is required by applicant. The burden remains on the examiner to maintain a prima facie case.

(D) Rebuttal evidence must be found elsewhere than in the specification.

(E) Rebuttal may be by way of arguing that the prior art did not recognize latent properties.

The model answer is selection B.

MPEP § 716.01(a). Affidavits or declarations containing objective evidence of criticality, unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, is considered by an examiner. (A) is incorrect. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); MPEP § 716.01(c), subsection styled “Attorney Arguments Cannot Take The Place of Evidence”; 2145, part I. Arguments of counsel cannot take the place of factually supported objective evidence. (C) is incorrect. MPEP § 2145. The burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). (D) is incorrect. In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); MPEP § 2144.05, subsections II and III. (E) is incorrect. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (finding that mere recognition of latent properties in the prior art does not render the a known invention unobvious); MPEP § 2145, subsection II.

Petitioner argues that answer (D) is correct. Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s arguments that answer (D) is correct, evidence of unexpected results, for example, must pertain to data contained in the specification. Accordingly, model answer (B) is correct and petitioner’s answer (D) is incorrect.

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

Morning question 43 reads as follows:

43. Which of the following definitions does not accord with proper USPTO practice and

procedure relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped “approved” by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.
- (D) A substitute drawing is usually submitted to replace an original formal drawing.
- (E) A drawing may be declared as informal by the applicant when filed.

The model answer is selection D.

A substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

Petitioner argues that answer (C) is correct. Due to possible ambiguity in model answer (D), petitioner’s request for credit on this question is granted.

Morning question 46 reads as follows:

46. Which of the following statements regarding an applicant’s duty to submit a drawing in a U.S. patent application is true?

- I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.
- II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.
- III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

- (A) I
- (B) II
- (C) III

- (D) II and III
- (E) I, II, and III

The model answer is selection D.

35 U.S.C. § 113; MPEP § 608.02(a), under heading "Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113," p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Further, answer (E) encompasses two contradictory statements (statements I and II). Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

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

Afternoon question 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make an amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

- (A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.
- (B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.
- (C) Submit a reply amending the claims and setting forth your arguments to overcome the

obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (E) 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 (E) is correct. Petitioner points out that the question does not state whether Jack is registered or not. However, as Jack is not listed among the possible answer choices, any confusion as to Jack's status should not result in an incorrect answer. As explained above, 37 CFR 1.34 (a) sets forth that the signature of a registered attorney or agent "shall constitute a representation to the United States Patent and Trademark Office that... he or she is authorized to represent the particular party in whose behalf he or she acts." Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

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

Afternoon question 43 reads as follows:

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the

following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 3.
- (E) None of the above.

The model answer is selection D.

MPEP § 2173.05(h). *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that the third sentence of the question is ambiguous and could be fairly interpreted to mean that “the article” teaches a metallic shoelace. Petitioner’s arguments have been fully considered but are not persuasive. The third sentence makes clear that the article does not mention a metallic shoelace for any purpose whatsoever. Accordingly, model answer (D) 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.

Afternoon question 49 reads as follows:

49. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 U.S.C. § 111(a) using the procedures of 37 C.F.R. § 1.53(b) by providing:

(A) A copy of the prior application, including a copy of the signed declaration in the prior application, as amended.

(B) A new and proper specification (including one or more claims), any necessary drawings, a copy of the signed declaration as filed in the prior application (the new specification, claim(s), and drawings do not contain any subject matter that would have been new matter in the prior application), and all required fees.

(C) A new specification and drawings and a newly executed declaration. The new specification and drawings may contain any subject matter that would have been new matter in the prior application.

(D) A new specification and drawings, and all required fees.

(E) (A), (B), (C) and (D).

The model answer is selection B.

37 C.F.R. §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), subsection styled "Specification and Drawings," 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 C.F.R. § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (B) is correct and petitioner's answer (E) 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, 1 point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 64. 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