



UNITED STATES PATENT AND TRADEMARK OFFICE

R2002-144
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

AUG 12 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to question 17 of the morning section and questions 4, 32, 38 and 48 of the afternoon section of the Registration Examination held on October 17, 2001. 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 68. On February 4, 2002, 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 CFR 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. 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 USPTO 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 court decision, a notice in the Official Gazette, or a notice in the Federal Register. 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 that 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.

No credit has been awarded for morning question 17 and afternoon questions 4, 32, 38 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

(A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.

(B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.

(D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(E) None of the above.

The model answer is selection (C).

35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is

incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the foreign patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that the preamble must be given patentable weight because of the structural differences between a fish tank and an ice cream aerator, and the possibility that the enabling disclosure of a fish tank aerator may not be an enabling disclosure of an ice cream aerator.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the preamble must be given patentable weight because of the structural differences between a fish tank and an ice cream aerator, and the possibility that the enabling disclosure of a fish tank aerator may not be an enabling disclosure of an ice cream aerator, the instructions clearly point out, "[d]o not assume any additional facts not presented in the questions". Petitioner has made specific note of this instruction in the argument. Neither Ted's nor Ned's subject matter portray structural differences as given in the fact pattern. Ted's claim is broadly defined and the body of the claim bears no dependence upon the preamble for life and meaning. The facts given regarding Ned's disclosure fully read on Ted's claim. There is no reason to assume any additional structural elements within Ted's claim, and so any structural differences between a fish tank and an ice cream aerator are moot. The question of enablement is also moot given the fact pattern in which Ned's disclosure fully supports Ted's claimed subject matter. 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 4 reads as follows:

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

(A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).

(B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.

(C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.

(D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.

(E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

The model answer is selection (B).

Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

Petitioner argues that answer (C) is correct. Petitioner contends that 35 USC 102(a) requires that the invention be by another, not the act or knowledge, to preclude patentability.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 35 USC 102(a) requires that the invention be by another, not the act or knowledge, to preclude patentability, the actual text of 35 USC 102(a) reads "A person shall be entitled to a patent unless - (a)the invention **was known or used by others** in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent." Charlie's public use of the invention was prior to Sydney's filing. Although Sydney may have invented the ice fishing method earlier than Charlie's use, Sydney may not establish such a date for the purpose of overcoming 35 USC 102(a) because of the provision of 35 USC 104(a)(1) "In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect

thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title." The portions of MPEP 2132 referred to by petitioner with respect to petitions under 37 CFR 1.131 and 132 are not relevant where all pertinent activity took place outside the U.S., any NAFTA, or any WTO country. Accordingly, model answer (B) 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 32 reads as follows:

32. Which of the following is true?

(A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

(C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.

(D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.

(E) Each of statements (B) and (C) is true.

The model answer is selection (E).

As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner argues that answer (D) is correct. Petitioner contends that (D) is also correct because an applicant in a later filed continuation application is not required to claim

priority under 35 U.S.C. § 120. Petitioner concludes that if one wants to claim priority, the correct section to claim is 35 U.S.C. § 119

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is also correct because an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120, the statute states "An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application **shall have the same effect**, as to such invention, **as though filed on the date of the prior application**, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and **if it contains or is amended to contain a specific reference to the earlier filed application.**" Although, as petitioner avers, there is a separate provision for claiming priority to foreign or provisional applications under 35 U.S.C. § 119, this statute does not refer to continuing applications; it is only under 35 U.S.C. § 120 that a claim for priority by way of continuity in a continuing application is addressed. 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.

Afternoon question 38 reads as follows:

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

(A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.

(B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.

(C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000.

The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.

(D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.

(E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

The model answer is selection (B).

35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client's application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is "by others," Able, Baker, and McGeiver. The reference is prior art "by others." See MPEP § 2132 ('Others' Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A "secret" use by another inventor of a machine to make a product is "public" if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

Petitioner argues that answer (E) is correct. Petitioner contends that absent facts regarding whether the resultant products were publicly sold and displayed over a year prior to filing, there is no way to ascertain that such a rejection could be made.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that absent facts regarding whether the resultant products were publicly sold and displayed over a year prior to filing, there is no way to ascertain that such a rejection could be made, it is the machine, rather than the product,

that is the invention, and the issue is whether John's use of the machine over a year prior to the application filing is a bar. The selection provides two facts that are in tension with each other, and the question is designed to determine whether the examinee knows how such tension is resolved in light of case law. The selection (E) characterizes John's use as secret, but also indicates that the use is inherently non-secret by virtue of the attributes of the products to present the details of the invention. The cited cases hold that in such circumstances, the original use of the machine is a public use. As held in *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975), "[w]e hold that the public use of Wagner's golf balls forecloses a finding of suppression or concealment [of the machine for making such balls]; that holding is consistent with both the decided cases and the underlying purposes of the statute." Because this use occurred over a year prior to the filing, the public use is a bar to patentability. Petitioner is directed to MPEP 2133.03(b) from which the portion of the model answer directed to selection (E) was extracted verbatim. 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.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

(A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.

(B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.

(C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.

(D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.

(E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Petitioner argues that answer (D) is correct. Petitioner contends that selection (C) is unreasonable because the trade magazine publication is not a bar and may not even be prior art, so no answer is reasonable and therefore all answers, including petitioner's, ought to be counted.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (C) is unreasonable because the trade magazine publication is not a bar and may not even be prior art, so no answer is reasonable and therefore all answers, including petitioner's, ought to be counted, the question specifically states that "Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent " and does not state that Acme asks for any subjective evaluation of the likelihood of prevailing. Inter-partes reexamination is an option specifically designed to accomplish Acme's objectives and therefore selection (C) is reasonable. Accordingly, model answer (C) 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.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. 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