



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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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 questions 17 and 25 of the morning session and questions 5, 11, 12, 32, and 43 of the afternoon session 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 sessions of the Registration Examination. Petitioner scored 49.

On December 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 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 sessions 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.

Petitioner has been granted one additional point on the Examination for his answer (A) to afternoon question 12. Petitioner's answer sheet shows that afternoon question 5 was answered correctly and petitioner has received credit for the question in the original score. No additional credit has been awarded for morning question 17 or 25, and no additional credit has been awarded for afternoon question 5, 11, 32 or 43. Petitioner's arguments for these six 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).

17. ANSWER: (C) is the correct answer. 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 Japanese patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (E) is the most correct answer because the model answer, answer (C), "can not be a statutory bar under 35 U.S.C. 102 because of its failure to describe the invention used to aerate the proper chemical state." Petitioner argues that ice cream is a solid and that water is a liquid, and that the preamble is depended upon by the claim for completeness of the invention. While it is likely that a review of the entire record would reveal differences between the apparatus intended to be used for aerating ice cream and the apparatus intended to be used for aerating water in a fish tank, claim 2

does not recite any structure that is missing from the teachings of the patent to Ned described in answer (C). The "DIRECTIONS" provided the following instruction: "Do not assume any additional facts not presented in the questions."

As provided in MPEP § 2111.02:

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

In morning question 17, the preamble of the claim does not provide a distinct definition of any structural difference that distinguishes the claimed apparatus from the apparatus disclosed in the U.S. patent to Ned described in answer (C). Accordingly, answer (C) is the most correct answer.

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

Morning question 25 reads as follows:

25. Ada invented a computer memory retrieval system in the United States. In June 1999, at the request of MC Computer Corp. and with the benefit of an export license, Ada demonstrates her invention at a testing facility in England. MC Computer Corp. signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Ada, MC Computer Corp. installs the computer memory retrieval system on its MC computers and begins selling its computers in England in September 1, 1999, with Ada's memory retrieval system. The first sale in the United States of MC Computer Corp's computers with Ada's memory retrieval system occurs on October 1, 1999. On August 1, 2000, MC Computer Corp. publishes an advertisement in the United States, and files a U.S. patent application that discloses but does not claim the memory

retrieval system invented by Ada. The MC Computer Corp.'s patent issues on October 1, 2001. On September 12, 2000, Ada files a patent application. On October 15, 2001, the examiner rejects all the claims in Ada's application based upon MC Computer Corp.'s advertisement published on August 1, 2000. Which of the following is true?

- (A) Since the MC Computer Corp. misappropriated the invention and since Ada did not authorize the sales in England on September 1, 1999, or the advertisement on August 1, 2000 in the United States, the rejection may be overcome by showing that the idea was misappropriated by MC Computer and the sales were not authorized by Ada.
- (B) Ada is not entitled to a patent since the invention was on sale more than one year prior to the date of the application for patent in the United States.
- (C) Ada may file a declaration pursuant to 37 CFR 1.131 to antedate MC Computer Corp.'s published advertisement.
- (D) Ada may file a request for reexamination of the MC Computer Corp.'s patent on the grounds that her idea was misappropriated.
- (E) The MC Computer Corp.'s patent is invalid for breach of the confidentiality agreement and disclosing the invention of another.

The model answer is selection (C).

25. ANSWER: (C). Ada may file an affidavit or declaration pursuant to 37 CFR 1.131. As to (A), In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997), the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). However, the sale occurs in [England] and not in the United States as is required by 35 U.S.C. § 102(b). As to (B), the sale in [England] is not a bar. 35 U.S.C. § 102(b) requires the sales to be in the United States. As to (D), reexaminations are based solely upon patents and printed publications. (E) is incorrect since disclosure of another's idea does not render a patent invalid and breach of the confidentiality agreement does not render the patent invalid.

Petitioner has noted that the model answer refers to sale of a product in China and that China is not mentioned in the question. The model answer should refer to England instead of China. The inaccurate reference to the name of the foreign country in the model answer does not change which answer is the most correct answer. Morning question 25 properly referred to England instead of China.

Petitioner has argued that (B) is the most correct answer. The arguments have been fully considered but they are not persuasive.

Petitioner argues that Ada's demonstration in England was inherently an offer for sale, and that because Ada has ties to the U.S., the on-sale activity took place in the United States. As provided in MPEP § 2133.03(d), public use or on sale activity must take place in the United States for purposes of judging the applicability of the statutory bar under 35 U.S.C. 102(b). While it is true that "on sale" status can be found if substantial activity prefatory to a "sale" occurs in the United States, the facts in morning question 25 do not indicate that under the totality of the circumstances, the inventor placed her invention on sale. Answer (C) is the most correct answer because under 37 CFR 1.131, Ada may establish invention of the claimed subject matter prior to MC Computer Corp.'s advertisement published on August 1, 2000. The examiner's rejection may be overcome by "swearing back" of the reference as explained in MPEP § 715.

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

Afternoon question 5 reads as follows:

5. You are a registered patent agent with a busy patent practice in Arlington, Virginia. You are scheduled to leave for a long-awaited three-week trip to the Galapagos Islands on Friday, October 19, 2001. You recently completed a draft of a provisional patent application and forwarded it to the client for review and comment. On October 12 you left a message with the President of your client, a company, reminding her of your trip and inquiring about the status of her review. She returns your message on Wednesday, October 17 and informs you for the first time that the provisional patent application relates to an invention upon which the continued success of her business depends and that she first offered the invention for sale on October 21, 2000. She also informs you that the

provisional application is ready for filing, but that she will be unable to forward to you a declaration signed by the inventors for at least four weeks. Understandably, you wish to make absolutely certain that the provisional application, having ten pages of specification, and three sheets of drawings, is properly filed with the USPTO and accorded a filing date before you leave for your trip, and that you are timely informed should anything be omitted. Which of the following scenarios provides the best evidence that the USPTO has received the provisional application with no missing parts, and the application is accorded a filing date?

- (A) You promptly hand-carry the provisional application, an application data sheet, and the appropriate filing fee to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting that the deposited document is a new application and reciting the title of the invention and listing the names of the inventors.
- (B) You promptly mail the provisional application, an application data sheet, and the appropriate filing fee to the official USPTO address employing a proper Certificate of Mailing in accordance with 37 CFR 1.8.
- (C) You promptly mail the provisional application, an application data sheet and the appropriate filing fee to the official USPTO address employing Express Mail Post Office to Addressee service of the U.S. Postal Service in accordance with 37 CFR 1.10.
- (D) You promptly mail the provisional application to the official USPTO address accompanied by a Return Postcard identifying the type of deposited document as a new patent application and reciting the title of the invention and listing the names of the inventors.
- (E) You promptly hand-carry the provisional application and an application data sheet to the USPTO Customer Service Window. You file these materials and have the attendant date stamp a card reciting the title of the invention, the names of the inventors, and listing the number of pages of the cover sheet, the number of pages of specification, and the number of sheets of drawings.

The model answer is selection (E).

5. ANSWER: (E) is the most correct answer. (A) is not the best answer inasmuch as all the items, such as the number of pages of specification and sheets of drawings, are not itemized on the card. (B) and (C) are wrong because they do not provide for a receipt from the USPTO. (B) is also wrong because § 1.8 cannot be used for obtaining an early filing date when filing a new application. (D) will not provide the earliest possible filing date. (A) and (E) will both provide an early information showing a filing date. But (E) is the best answer because it provides the best evidence of the documents received in the USPTO. See MPEP § 503, under the heading "RETURN POSTCARD." ("A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date

stamped thereon by the PTO. *** The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested.... If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification... number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application), etc.”).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (A) is the most correct answer because “although it does not assure you prima facie evidence if an item is to be found missing affords the filer the same benefit at an earlier time.”

On his answer sheet, petitioner chose answer (E) to afternoon question 5 and petitioner has already been given credit for choosing the correct answer to afternoon question 5.

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

Afternoon question 11 reads as follows:

11. A patent application filed in the USPTO contains the following three original 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 USPTO practices and procedures, which of the following replies best overcomes the examiner’s objection and provides the client with the broadest range of patent protection?

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

The model answer is selection (A).

11. ANSWER: (A) is the most correct answer. The cancellation of Claim 3 overcomes the examiner's objection. The addition of Claims 4 and 5 provide 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 (B) 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), part (I)(B)(1). Answer (C) 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. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (E) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (C) is the most correct answer. Petitioner argues that, "in order to arrive at answer A, we must make the assumption that the amended claims will be allowed and hence give broader patent protection." It is true that in order to have patent protection, the examiner must allow the claims to issue over the prior art. The choice of answer (C) does not differ significantly from answer (A) in this regard because

both answers require patents to issue in order for there to be patent protection. Based on the facts presented, it is fair to assume that the examiner would examine claims 1-2 and 4-5 and allow all of the claims patentable over the prior art to issue. Canceling claim 3 without replacing the subject matter of claim 3 with claims 4 and 5 surrenders the subject matter of original claim 3 without obtaining patent protection for this subject matter and without obtaining a clear ruling from the examiner on the patentability of this subject matter. Answer (A) is the best answer because protection for the subject matter of original claim 3 is maintained in new claims 4-5.

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.
- (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).

32. ANSWER: (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's arguments have been fully considered but are not persuasive.

Petitioner chose answer (C) and argues that (E) is not the best answer because (E) indicates that each of statements (B) and (C) is true and that statement (B) can not be a true statement as it is written. Petitioner argues that statement (B) can not be a true statement because MPEP § 711.03(c) requires not only money, but a petition and a showing that the delay was unavoidable. The facts presented in answer (B) show that the petition is made by the statement "the delay in making the payment is **shown** to be unavoidable" (emphasis added). The only method consistent with USPTO practice and procedure to make a showing is to file a written statement of facts to support the assertion that the delay was unavoidable. In addition, the petition fee was supplied by the statement "upon payment of a fee for delayed payment." Therefore, since all the necessary requirements of 37 CFR 1.137(a) were met in answer (B), the answer is correct. Accordingly, (B) and (C) are both correct answers, and (E) is the best answer.

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

Afternoon question 43 reads as follows:

43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

The model answer is selection (D).

43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With "Sufficient Specificity"). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific examples falling within the claimed, a case by case determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35

U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (E) is the best answer because the claim is not necessarily anticipated in answer (A), (B), (C), or (D). Answer (A) sets forth a situation where the prior art clearly discloses a species falling within the genus claimed in the client's application. As provided in MPEP § 2131.02 under the heading: "A SPECIES WILL ANTICIPATE A CLAIM TO A GENUS," a generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus. The species in that case anticipates the genus. Petitioner cites MPEP § 2131.03 and argues that the species may not be described with "sufficient specificity" to constitute an anticipation under the statute. The argument is not persuasive because answer (A) provides that the prior art "clearly discloses a species falling within the claimed genus."

Regarding answer (B), the answer indicates that the species claimed in claim 4 is clearly disclosed by name in the prior art. As provided in MPEP § 2131.02, the named species anticipates the genus. See also *Ex parte A*, 17 USPQ2d 1716 (Bd. App. & Inter. 1990). Further regarding answer (B), petitioner additionally argues that the species may constitute an unrelated application or non-analogous art. As explained in MPEP § 2131.05, such arguments are not germane to a rejection under section 102. See *Twin*

Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)).

Regarding answer (C), petitioner argues that “copper oxygen” does not necessarily anticipate “copper, oxygen.” Petitioner has failed to point out the limitations required by “copper oxygen” that are not disclosed in the reference. Additionally, the “DIRECTIONS” for the Afternoon Session included the following instruction: “Do not assume any additional facts not presented in the questions.” Accordingly, it would be improper to assume that a definition of “copper oxygen” was provided in the specification which distinguishes “copper oxygen” from “copper, oxygen”.

Since the claim is anticipated in answers (A), (B), and (C), answer (D) is not necessarily anticipated by the prior art. As explained in MPEP § 2131.03, when the prior art teaches a range which overlaps with the claimed range, but no specific examples falling within the claimed range are disclosed in the prior art, a case by case determination must be made. Accordingly, answer (D) is the most correct answer to afternoon question 43.

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

ORDER

For the reasons given above, one additional point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 50. 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.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is positioned above the typed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy