



FEB 19 2002

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 2, 17, 21, 25, 31 and 49 of the morning section and questions 1, 25, 36, 37, 46 and 49 of the afternoon section of the Registration Examination held on April 18, 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 64. On June 14, 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. 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 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 awarded an additional point for afternoon question 36. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 2, 17, 21, 25, 31 and 49 and afternoon questions 1, 25, 37, 46 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 2 reads as follows:

2. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 C.F.R. § 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

(A) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.

(B) To file a continuation-in-part application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to November 29, 1999.

(C) To file a continuation utility application of a prior complete nonprovisional utility application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date prior to May 29, 2000.

(D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.

(E) To file a divisional application of a prior complete nonprovisional plant application filed under 35 U.S.C. § 111(a). The nonprovisional application has an actual filing date after May 29, 2000.

The model answer is selection (C).

Under 37 C.F.R. § 1.53(d), "(1) A continuation...application...of a prior nonprovisional application may be filed as a continued prosecution application provided that: (i) The prior nonprovisional application is either: a utility...application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application." (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing a divisional application as a CPA of a prior provisional application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a continuation-in-part

application as a CPA of a prior complete nonprovisional utility application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete nonprovisional utility application filed on or after May 29, 2000.

Petitioner argues that answer (D) is correct. Petitioner contends that a practitioner may properly file a second continuation application of a first continuation application filed after May 29, 2000, as long as the original utility application was filed before May 29, 2000, and the first continuation application has not been abandoned, had prosecution proceedings cease, or has had the issue fee paid upon it. Also, a CPA file as in answer D would be treated as a request for continued examination by the USPTO.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a practitioner may properly file a second continuation application of a first continuation application filed after May 29, 2000, as long as the original utility application was filed before May 29, 2000, and the first continuation application has not been abandoned, had prosecution proceedings cease, or has had the issue fee paid upon it and that a CPA file as in answer D would be treated as a request for continued examination by the USPTO, (D) is not the most correct answer because pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner's contention that a CPA may be filed based on a continuation so long as the original parent of the first continuation was filed prior to May 29, 2000 lacks basis. Petitioner relies on the language of 37 CFR 1.53(d) to argue that a CPA is not a non-provisional application, and that so long as the parent is not a non-provisional application, a CPA may be filed. A nonprovisional application as used in this chapter [37 CFR] means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371. 37 CFR 1.9(3). A CPA meets this definition.

37 CFR 1.53(d) also identifies a CPA as a nonprovisional application (Application filing requirements - Continued prosecution (nonprovisional) application.).

Petitioner's contention that the USPTO would correct an incorrect CPA filing to be and RCE filing instead only serves as further evidence that answer (D) is incorrect; reliance on the USPTO to correct practitioner errors is not consistent with USPTO practice and procedure and answer (C) that comports with USPTO practice and procedure is minimally a decidedly better answer than (D) which does not comport with USPTO practice and procedure..

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.

Morning question 17 reads as follows:

17. Which of the following statements involving an examiner's statement of reasons for allowance in a Notice of Allowance dated February 8, 2001, is in accordance with USPTO rules and procedure?

(A) Failure by applicant or patent owner to file a statement commenting on the reasons for allowance cannot give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

(B) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement gives rise to the implication that the examiner agrees with applicant's statement.

(C) If applicant files a statement commenting on the reasons for allowance, failure by the examiner to respond to applicant's statement does not give rise to any implication.

(D) (A) and (C)

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.104(e) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54633 (September 8, 2000). As stated in 65 FR at 54633, middle column, "In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for

allowance would give rise to a presumption of acquiescence to those reasons..." Thus, (A) is incorrect. 65 FR at 54633, middle column, also provides, "That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement." Thus (B) is incorrect. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

Petitioner argues that answer (A) is correct. Petitioner contends that all the case law cited against answer (A) involve patent infringement litigation which is outside the scope of the examination, and therefore, within the scope of the USPTO practice and procedure, failure by applicant or patent owner to file a statement commenting on the reasons for allowance can give rise to an implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that all the case law cited against answer (A) involve patent infringement litigation which is outside the scope of the examination, and therefore, within the scope of the USPTO practice and procedure, failure by applicant or patent owner to file a statement commenting on the reasons for allowance can give rise to an implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner, shows no support for this contention. Further, petitioner begs the question of which forum would failure by applicant or patent owner to file a statement commenting on the reasons for allowance give rise to an implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

The instructions state that 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 court decision, a notice in the Official Gazette, or a notice in the Federal Register. In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom. 65 FR at 54633, middle column, provides that the statement in the rule that failure to file comments on reasons for allowance does not give rise to any implication that an applicant (or patent owner) agrees with or acquiesces in the reasoning of the examiner is obsolete and out of step with recent case law. The deletion of this statement from the rule should require applicant to set forth his or her position in the file if he or she disagrees with the examiner's reasons for allowance, or be subject to inferences or presumptions to be determined on a case-by-case basis by a court reviewing the patent, the Office examining the patent in a reissue or reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc. Accordingly, this

change to 37 CFR 1.104 sets forth Office procedure in recognition of such case law and is therefore within the scope of the examination and directly in conflict with answer (A).

Accordingly, model answer (C) 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 21 reads as follows:

21. Which of the following is true?

(A) For a nonprovisional utility patent application filed in the USPTO on January 10, 2001, formal drawings are required to overcome an objection issued during initial review that drawings in the application do not comply with 37 C.F.R. § 1.84(g) and (u)(1).

(B) If the primary examiner requires formal drawings at the time a patent application is allowed and sets a three month period of time from the mail date of a notice of allowability within which to file the drawings to comply with 37 C.F.R. § 1.84, the applicant may obtain an extension of time to file the formal drawings by filing a petition for an extension of time under 37 CFR § 1.136(a) or (b) and the appropriate fee.

(C) For a nonprovisional application filed on November 2, 2000, to claim the benefit under 35 U.S.C. § 119(e) of the filing date of a provisional application filed on November 6, 1999, the nonprovisional application must be copending with the provisional application.

(D) In those instances in which an applicant seeks to add new matter to the disclosure of an application, a request for continued examination is not a proper procedure for adding the new matter.

(E) A nonprovisional utility application in the name of inventor Smith filed on January 18, 2001, may properly claim the benefit of the filing date of a provisional utility application filed in Smith's name on January 24, 2000, where the provisional application is entitled to a filing date even though the basic filing fee for the provisional application was not paid.

The model answer is selection (D).

35 U.S.C. § 132(a); 37 C.F.R. § 1.114. "In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure set forth in § 1.114 is not available, and the applicant must file a continuation-in-part application under

§ 1.53(b) containing such new matter." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, right column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. At a minimum, corrected drawings suitable for reproduction are required. 37 C.F.R. § 1.85(b). (B) is not the most correct answer. As stated in 37 C.F.R. § 1.85(c), "If...a drawing does not comply with §1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a...formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b)." See also 37 C.F.R. § 1.136(b). (C) is not the most correct answer. 35 U.S.C. § 119(e)(2) has been amended to eliminate the copendency requirement. (E) is not the most correct answer. 37 C.F.R. § 1.78(a)(4). For a nonprovisional application to properly claim the benefit of the filing date of a provisional application the provisional application must be entitled to a filing date and the basic filing fee set forth in 37 C.F.R. § 1.16(k) must be paid within the time period set forth in 37 C.F.R. § 1.53(g). See also, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50094, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (C) is correct. Petitioner contends that both 35 USC 119 and 37 CFR 1.78 require copendency of the provisional and nonprovisional applications to claim priority.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that both 35 USC 119 and 37 CFR 1.78 require copendency of the provisional and nonprovisional applications to claim priority, 35 USC 119 states [n]o application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. This refers to the timing of an amendment, not the timing of the application, and it is subject to the requirement of the Director, rather than being fixed statutorily. As to the notification in 65 FR 78958 that the final rule was corrected to delete the reference to the elimination of the pendency requirement, this merely stated that such elimination was already noted in an earlier Federal Register notice and therefore was no longer applicable, given that the elimination had occurred previously. Neither 35 USC 119 nor 37 CFR 1.78 (a)(4) impose a requirement of copendency between provisional and nonprovisional applications. 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 25 reads as follows:

25. Which of the following is not in accordance with proper USPTO practice and procedure?

- (A) Conversion of a provisional application to a nonprovisional application will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application.
- (B) Conversion of a provisional application to a nonprovisional application cannot adversely impact on the term of any patent to issue from the application.
- (C) An applicant having filed a provisional application can avoid any adverse patent term impact resulting from converting the provisional application to a nonprovisional application by instead filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. § 119(e).
- (D) An applicant filing a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of an earlier provisional application, and not requesting conversion of the provisional to a nonprovisional application can avoid the fee required to convert a provisional application to a nonprovisional application, as well as an adverse patent term effect that would result from a conversion.
- (E) The twelve month period of pendency of a provisional application extends to the next secular or business day which is not a Saturday, Sunday, or Federal holiday in the District of Columbia if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c) falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia.

The model answer is selection (B).

As stated in "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000), "Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. § 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion under § 4801 of the American Inventors Protection Act of 1999)." However, the pendency is counted against the patent term. (A), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), third sentence. See also,

"Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (C), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3), fourth sentence. (D), being in accord with USPTO practice and procedure, is not the most correct answer. 37 C.F.R. § 1.53(c)(3). (E) is a correct statement, and there fore is not a correct answer. 35 U.S.C. § 119(e)(3).

Petitioner argues that answer (E) is correct. Petitioner contends that none of the answers are in accordance with USPTO practice and procedure and therefore answer (E) is as correct as (B). Petitioner contends that (B) is incorrect because conversion of a provisional application to a nonprovisional application results in the same term as any patent to issue from the application.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that none of the answers are in accordance with USPTO practice and that (B) is incorrect because conversion of a provisional application to a nonprovisional application results in the same term as any patent to issue from the application, 35 USC 154(2) provides that [s]ubject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed. The provisional application filing date claimed under 35 USC 119 is excluded from the list of earlier filed applications from which the 20 years begins. Converting a provisional to a nonprovisional application adversely reduces the patent term by the amount of time the provisional was pending prior to the conversion, consistent with the definitions of the word "adverse" supplied by the petitioner. 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.

Morning question 31 reads as follows:

31. Which of the following statements is correct regarding an antedating declaration or affidavit being used in accordance with proper USPTO practice and procedure?

(A) Where the reference publication date is more than one year before applicant's effective filing date.

(B) Where the reference is a prior U.S. patent to the same entity, claiming the same

invention.

(C) Where the subject matter relied on in the reference is prior art under 35 U.S.C. § 102(g).

(D) Where the reference, a U.S. Patent, with a patent issue date less than one year prior to applicant's effective filing date, shows but does not claim the same patentable invention.

(E) Where the effective filing date of applicant's parent application or an International Convention-proved filing date is prior to the effective date of the reference.

The model answer is selection (D).

35 U.S.C. § 102(a); MPEP § 715, subsection styled "SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED." (A) is incorrect. 35 U.S.C. 102(b), MPEP § 715. (B) is incorrect. The question involved is one of "double patenting." 37 C.F.R. § 1.131, MPEP § 715. (C) is incorrect. 35 U.S.C. § 102(g); 37 C.F.R. § 1.131. As explained in MPEP § 715, subsection styled "SITUATIONS WHERE 37 C.F.R. 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE," "i. ... 37 C.F.R. 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 C.F.R. 1.131 affidavit or declaration cannot be used to overcome it. In re Bass, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant's invention date. It is this presumption which may be rebutted by evidence submitted under 37 C.F.R. 1.131." (E) is incorrect. An affidavit or declaration under 37 C.F.R. 1.131 is unnecessary because the reference is not prior art and should not be used. MPEP § 715.

Petitioner argues that answer (E) is correct. Petitioner contends that a 37 CFR 1.131 declaration can be used to antedate a cited reference.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 37 CFR 1.131 declaration can be used to antedate a cited reference, this is not relevant with a reference that is not prior art. Answer (E) provides facts in which a reference date is after the effective filing date of the application, and therefore cannot be prior art. See MPEP 715, subheading "Situations Where 37 CFR 1.131 Affidavits Or Declarations Are Inappropriate", situation (D). 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.

Morning question 49 reads as follows:

49. In regard to disclosure of a utility in a nonprovisional utility patent application filed in the Office in April 2001, which of the following is not in accord with proper USPTO practice and procedure?

(A) For each claimed invention an applicant need only provide one credible assertion of specific and substantial utility to satisfy the utility requirement.

(B) A patent examiner can properly support a rejection based on lack of utility by providing documentary evidence regardless of the publication date to show a factual basis for the prima facie showing of no specific and substantial credible utility.

(C) Using a complex claimed invention as landfill is an example of a specific and substantial utility for the claimed invention.

(D) An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention, and the utility is specific, substantial, and credible.

(E) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention.

The model answer is selection (C).

See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001), "A claimed invention must have a specific and substantial utility. This requirement excludes 'throw-away,' 'insubstantial,' or 'nonspecific' utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101." (A) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1097, middle column (Jan. 5, 2001), "An applicant need only provide one credible assertion of specific utility for each claimed invention to satisfy the utility requirement." (B) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, middle column (Jan. 5, 2001), "Any rejection based on lack of utility should

include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support a factual basis for the prima facie showing of no specific and substantial credible utility." (D) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098, left column (Jan. 5, 2001), wherein it states, "An invention has a well-established utility (1) if a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a produce or process), and (2) the utility is specific, substantial, and credible." (E) is not the most correct answer. See, "Utility Examination Guidelines," 66 F.R. 1092, 1098 right column (Jan. 5, 2001), which states what is recited in (E).

Petitioner argues that answer (B) is correct. Petitioner contends that the utility guidelines conflict with case law in that utility must be judged as of the time the invention is made and therefore statement (B) is not in accordance with USPTO practice and procedure and is therefore a correct answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the utility guidelines conflict with case law in that utility must be judged as of the time the invention is made and therefore statement (B) is not in accordance with USPTO practice and procedure and is therefore a correct answer, the utility guidelines are an explicit recitation of USPTO practice and procedure rendering statement (B) in accordance with USPTO practice and procedure and therefore an incorrect answer.

As to the cited case law, footnote 129 in which the citations appear in 35 USCA 101 refers to comparison to other art, i.e. to the requirement of newness, not to utility. Where documentation provides evidence that an invention has no utility, that lack of utility may be inferred to hold at the time of the invention absent any countervailing evidence. The utility requirement is a positive rather than negative requirement; i.e. there must be utility under 35 USC 101. Evidence to the contrary is highly probative in the absence of any evidence in support as to the utility that might have existed at the time of the invention.

The utility guidelines set forth the practice for obtaining all the evidence required to make a determination, and therefore refer to procedure substantially different from that referred to in the cited cases. The guidelines specifically modify the practice in answer (B) by relegating it to establishing a prima facie case. 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.

Afternoon question 1 reads as follows:

1. Which of the following is in accord with proper USPTO practice and procedure?

(A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.

(B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.

(C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.

(D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.

(E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.

The model answer is selection (B).

37 C.F.R. § 1.53(c)(3) requires the presence of a claim to convert a provisional application to a nonprovisional application. The Office will set a time period within which a claim must be submitted for the Office to grant the request if the provisional application does not have a claim and a claim is not filed with the request. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50099, middle column, (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.53(c)(3). There is only one application, and that application has a single filing date, the filing date of the provisional application. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50099, left column (Aug.

16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 35 U.S.C. § 111(b)(7); 37 C.F.R. § 1.53(c)(4). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires that any request to convert a provisional application to a nonprovisional application be filed prior to abandonment of the provisional application. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. The provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (E) is correct. Petitioner contends that both 35 USC 119 and 37 CFR 1.78 require copendency of the provisional and nonprovisional applications to claim priority.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that both 35 USC 119 and 37 CFR 1.78 require copendency of the provisional and nonprovisional applications to claim priority, 35 USC 119 states [n]o application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. This refers to the timing of an amendment, not the timing of the application, and it is subject to the requirement of the Director, rather than being fixed statutorily. As to the notification in 65 FR 78958 that the final rule was corrected to delete the reference to the elimination of the pendency requirement, this merely stated that such elimination was already noted in an earlier Federal Register notice and therefore was no longer applicable, given that the elimination had occurred previously. Neither 35 USC 119 nor 37 CFR 1.78 (a)(4) impose a requirement of copendency between provisional and nonprovisional applications. 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 25 reads as follows:

25. Which of the following is in accordance with proper USPTO practice and procedure?

(A) The filing of a request for continued examination and payment of the fee for the

request in a nonprovisional utility application that was filed in January 2000, is sufficient to toll the running of any time period set in a final rejection for reply to avoid abandonment of the application.

(B) Where a request for continued examination, a submission, and requisite fee are filed in April 2001 for a nonprovisional utility application that was filed in January 2000, the submission will be considered though it was filed after the application became abandoned in February 2001.

(C) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination, a proper submission, and requisite fee, or by timely filing a continued prosecution application.

(D) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a request for continued examination, a proper submission, and requisite fee, and the application is entitled to patent term adjustment provisions of the Patent Statute.

(E) An applicant in a utility application originally filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination by timely filing in April 2001 a continued prosecution application under 37 C.F.R. § 1.53(d), but the CPA application is not entitled to patent term adjustment provisions of the Patent Statute.

The model answer is selection (C).

37 C.F.R. § 1.114 and 1.53(d). "An applicant in a utility application filed on or after June 8, 1995, and before May 29, 2000, may obtain further examination either by timely filing a request for continued examination under § 1.114, or by timely filing a continued prosecution application under § 1.53(d)." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.114(a) and (c). The filing of a request for continued examination and payment of the fee for the request is not sufficient to toll the running of any time period set in the final rejection for reply to avoid abandonment of the application. If a reply to an Office action is due, a submission meeting the requirements of 37 C.F.R. § 1.111 must be timely received to continue examination of an application. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(2). "Under the request for continued

examination procedure..., a submission will be considered if the submission and the requisite fee is filed prior to the abandonment of the application." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50096, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The application is not entitled to patent term adjustment. "If...an applicant in a utility...application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106-113." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 35 U.S.C. § 154, Pub. Law 106-113, § 4405. The CPA application is entitled to patent term adjustment. "If...an applicant in a utility...application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106-113." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50096, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (E) is correct. Petitioner contends that a CPA, not necessarily being filed under 35 USC 111(a), is not entitled to patent term adjustment (PTA).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a CPA, not necessarily being filed under 35 USC 111(a), is not entitled to patent term adjustment, this is incorrect and a CPA is entitled to PTA. Petitioner relies on the language of 35 USC 111 to argue that a CPA is not a filing under 35 USC 111(a) and therefore not subject to PTA under 35 USC 154. 35 USC 111(a) states that [a]n application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director. A CPA meets this definition. Petitioner argues that because a CPA need not have a duplicate disclosure filed, it does not have the components required by 35 USC 111(a). However, 35 USC 111(a) does not state that the contents of the filing receipt must have a complete disclosure, but that the application must have a complete disclosure. As admitted by the petitioner, the very practice of CPA filing ensures that a complete disclosure is in the application. Because a CPA is a filing under 35 USC 111(a) which 35 USC 154 makes susceptible to PTA, the application in answer (E) would be entitled to PTA. 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 37 reads as follows:

37. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

(A) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the examiner allows the claims.

(B) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR § 1.323.

(C) In an application that entered the national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(D) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in 37 CFR § 1.19(b)(1).

(E) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate.

The model answer is selection (A).

The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted, not before the examiner allows the claims, as is required by 37 CFR § 1.55 (Claim for foreign priority), subparagraph (a)(2), which states "(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17

must, in any event, be filed before the patent is granted..." As to (B), (B) contains the elements of 37 CFR § 1.55 (a)(2), which states "...If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323." As to (C), (C) contains the elements of 37 CFR § 1.55 (a)(1)(ii), which provides "(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT." As to (D), (D) contains the elements of 37 CFR § 1.14(c)(1)(i), which states "[i]f a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 .S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1)." As to (E), (E) contains all of the elements of 37 CFR § 1.14(c)(1)(ii), which states "If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1 .19(b)(1)."

Petitioner argues that answer (C) is correct. Petitioner contends that answer (C) is in conflict with PCT rule 26 bis and is therefore invalid and unconstitutional and therefore is a correct answer as being not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (C) is in conflict with PCT rule 26 bis and is therefore invalid and unconstitutional and therefore is a correct answer as being not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001, PCT rule 26 bis pertains to international applications whereas answer (C) pertains to national applications. Petitioner admits that answer (C) is in accord with explicit USPTO practice and procedure. The inapplicability of PCT rule 26 bis to answer (C) obviates any considerations of invalidity or unconstitutionality. Accordingly, model answer (A) 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 46 reads as follows:

46. Which of the following is in accordance with proper USPTO practice and procedure?

(A) The fee an applicant must pay to request continued examination of an application is set in an amount equal to the basic filing fee the same applicant must pay for a utility patent application.

(B) A Certificate of Mailing or Transmission under 37 C.F.R. § 1.8 is proper for filing a Continued Prosecution Application under 37 C.F.R. § 1.53(d) to obtain the date of the Certificate as the filing date for the application.

(C) The Office does not charge a fee for processing a fee paid by a check that has been refused, i.e., dishonored and returned, by a financial institution.

(D) To first request conversion of a provisional application containing a claim to a nonprovisional application after the provisional application has become abandoned, a petition to revive, accompanied by the appropriate fees, a showing of unavoidable delay, and a request for the conversion must be filed within one year of the date of abandonment.

(E) The conversion of a provisional application, for which a basic filing fee was properly paid, to a nonprovisional application will result in the savings of filing and other fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78 of the earlier provisional filing date.

The model answer is selection (A).

37 C.F.R. §§ 1.16(a) and 1.17(e). The fee to request continued examination of an application is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. The fee for filing each application for an original patent, except provisional, design, or plant applications is currently \$355.00 for a small entity, and \$710.00 for other than a small entity. See "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093 (Aug. 16, 2000), 1238 O.G.13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.8(a)(2) provides, in pertinent part, "The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following: (i) Relative to Patents and Patent Applications – (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d)." (C) is not the most correct answer. 37 C.F.R. § 1.21(m). See "Changes to Permit Payment of Patent and Trademark Fees by Credit Card,"

65 F.R. 33452-33455 (May 24, 2000), 1235 O.G. 38 (June 13, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.53(c)(3) requires the petition to convert be filed prior t the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. (E) is not the most correct answer. Under 37 C.F.R. § 1.53, a nonprovisional application based on conversion of a provisional application must include the filing fee for a nonprovisional application. The conversion request must be accompanied by the fee set forth in 37 C.F.R. § 1.17(i). In addition, the surcharge required by 37 C.F.R. § 1.16(e) if either the basic filing fee for a nonprovisional application, or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. A properly paid basic filing fee for a provisional application is not applied to the filing or other fees due for a nonprovisional application resulting from conversion of a provisional application. 37 C.F.R. § 1.53(c)(3), second sentence.

Petitioner argues that answer (D) is correct. Petitioner contends that the weekend and holiday rule may give an applicant more than a year to make a conversion.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the weekend and holiday rule may give an applicant more than a year to make a conversion, that rule merely defines the boundaries of wht the Office will accept as a year 35 CFR 1.7 by its terms defines how time periods may be interpreted when they would otherwise end on weekends or holidays. 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.

Afternoon question 49 reads as follows:

49. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

(A) Status information is available for Application B, that is a continuation of an application A, when application A has been published under 35 U.S.C. § 122(b).

(B) A person requesting status information may be provided the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier is available.

(C) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. §§ 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon

written request including the fee set forth in 37 CFR § 1.19(b)(1).

(D) A coinventor in a pending application may gain access to the application if his name appears as an inventor in the application, even if he did not sign the oath or declaration.

(E) Notwithstanding the fact that only a redacted copy of an application has been published, a member of the public is entitled to see the entire application upon written request.

The model answer is selection (E).

Since a redacted copy of the application was used for publication purposes, 37 C.F.R. § 1.14 (c)(2) provides that "(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy." As to (A), (A) contains the elements of 37 C.F.R. § 1.14(b)(2), which reads "When status information may be supplied. Status information of an application may be supplied by the Office to the public if any of the following apply: ... (2) The application is referred to by its numerical identifier in a published patent document (e.g., a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section)." As to (B), (B) is within the purview of 37 C.F.R. § 1.14(a)(1)(iii) which states: "(a)(1) Status information is: ... (iii) The application "numerical identifier" which may be: (A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or (B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage." As to (C), (C) contains the elements of 37 C.F.R. § 1.14(c)(1)(i), which states "(c) When copies may be supplied. A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply: (1) Application-as-filed. (i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1)." As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 C.F.R. § 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

Petitioner argues that answer (C) is correct. Petitioner contends that if the word "that" in answer (C) refers to the current rather than the referenced application, answer (C) would be incorrect because if the current applicatio were redacted, the application as filed would

not be made public.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that if the word "that" in answer (C) refers to the current rather than the referenced application, answer (C) would be incorrect because if the current applicatio were redacted, the application as filed would not be made public, there is no reason for such an assumption. The word "that" clearly refers to its most closest antecedent, the referenced application. Petitioner admits that under this construction, (C) would be a correct statement and therefore not a correct answer. Accordingly, model answer (E) 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, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. 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