



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 17 and 34 of the morning session and questions 7, 14, 15, 33, 36, and 43 of the afternoon session of the Registration Examination held on April 18, 2001. Credit is being given for petitioner's answer to morning question 34 and afternoon question 36. However, 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 62 on the Registration Examination as it was originally graded. On July 26, 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 C.F.R. §§ 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 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 awarded two additional points. Credit has been awarded for morning question 34 and afternoon question 36. Petitioner's arguments concerning each of the eight questions under reconsideration are addressed individually below.

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 C.F.R. § 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 choice (D) including (A) and (C) is the most correct answer. The argument is not persuasive. 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...” Accordingly, (A) is incorrect because the 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. It follows that (D) is incorrect and that (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 34 reads as follows:

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions. Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 U.S.C. § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor’s oath or declaration and without the required filing fee. The Office issued a “Notice to File Missing Parts – Filing Date Granted” on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001. Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26,

2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied. A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

34. The Office determined that the applicant failed to engage in reasonable efforts to conclude prosecution of the application. Which of the following statements is most true?

(A) Joseph is entitled to no patent term extension because neither the Uruguay Round Agreements Act nor the Patent Term Guarantee Act of 1999 applies to Joseph's patent application.

(B) Although the Patent Term Guarantee Act of 1999 applies to Joseph's application, Joseph forfeited any patent term extension by failing to engage in reasonable efforts to conclude prosecution of the application.

(C) Joseph is entitled to a total patent term extension of approximately two (2) months because the application was pending for more than three (3) years.

(D) Joseph's successful appellate review adds approximately 11 months to any calculation of patent term extension.

(E) By replying to the Notice to File Missing Parts approximately two (2) months after the deadline set by the USPTO, Joseph reduced any patent term extension by two (2) months.

The model answer is selection (D).

See, 37 C.F.R. §§ 1.702(e) and 1.703(e). Answer (A) is incorrect at least because the Patent Term Guarantee Act of 1999 applies to Joseph's application, which was filed after May 29, 2000. Answer (B) is incorrect because a failure to engage in reasonable efforts to conclude prosecution may reduce patent term extension, but is not a complete forfeiture of any extension. Answer (C) is incorrect because the three year period set forth in 37 C.F.R. § 1.702(b) does not include time consumed by review by the Board of Appeals and Patent Interferences or any delay in processing of the application that was requested by the applicant. Answer (E) is incorrect because any reduction is based on an expected reply within three months of the Office action, regardless of the deadline set by the USPTO. See, 37 C.F.R. § 1.704(b) and "37 CFR Part 1 Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule," Federal Register Vol. 65, No. 181 at 56371.

Petitioner argues that (B) was the most correct answer because Joseph could have forfeited any patent term extension by failing to engage in reasonable efforts.

An error in grading has been shown in the grading of morning question 34. In addition to model answer (D), credit is being given for answer (A), (B), (C), or (E).

Since petitioner argues that (B) was the most correct answer, a point has been added to petitioner's score.

Afternoon question 7 reads as follows:

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

(A) The elements of the design application, if applicable, should appear in the following order:

- (1) design application transmittal form;
- (2) fee transmittal form;
- (3) application data sheet;
- (4) specification;
- (5) drawings or photographs; and
- (6) executed oath or declaration.

- (B) The specification should include the following sections in order:
- (1) preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied;
  - (2) cross-reference to related applications (unless included in the application data sheet);
  - (3) statement regarding federally sponsored research or development;
  - (4) description of the figure or figures of the drawing;
  - (5) feature description; and
  - (6) a single claim.
- (C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.
- (D) The elements of the design application, if applicable, should appear in the following order:
- (1) design application transmittal form;
  - (2) fee transmittal form;
  - (3) photographs;
  - (4) application data sheet;
  - (5) specification;
  - (6) drawings; and
  - (7) executed oath or declaration.
- (E) None of the above.

The model answer is selection (D).

Photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 C.F.R. § 1.154. As to (A), (A) contains the elements set forth in 37 C.F.R. § 1.154 (a), which provides “(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b)).” As to (B), (B) contains the elements set forth in 37 C.F.R. § 1.154 (b), which provides: “(b) The specification should include the following sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim.” As to (C), (C) contains the elements set forth in 37 C.F.R. § 1.154 (c), which provides “(c) The text of the specification sections defined in paragraph (b) of this

section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.” Since (D) is incorrect, (E) is not the right answer.

Petitioner argues that choice (C) is the best answer because choice (C) uses the language “should” rather than “...are to be...” The argument is not persuasive. The “should” language appears in 37 C.F.R. § 1.154(c). No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 14 reads as follows:

14. Which of the following statements concerning a restriction requirement in a reissue application filed January 10, 2001, is in accordance with proper USPTO rules and procedure?

(A) The Office cannot properly make a restriction requirement in the reissue application between claims added in the reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention defined by the original patent claims.

(B) The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims.

(C) If restriction is required by the Office, the subject matter of the original patent claims will not be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

(D) (A) and (B)

(E) None of the above.

The model answer is selection (B).

37 C.F.R. § 1.176(b) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54644 (September 8, 2000). As stated in 65 FR at 54644, left column, “Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an

invention which is separate and distinct from the invention(s) defined by the original patent claims.” Thus (A) is incorrect. (C) is incorrect because the original patent claims “will be held to be constructively elected...” 37 C.F.R. § 1.176(b). (D) is incorrect because (A) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that choice (E) is the most correct answer because the Office may properly elect either subject matter of the original claims and subject matter added in reissue or both, but is not restricted to making a restriction requirement of only the subject matter of the original claims but the subject matter added in reissue as well. The argument is not persuasive. In 65 FR 54604 at page 54644, right-hand column, it is stated that:

“The Office will continue to not require restriction among original claims of the patent (*i.e.*, among claims that were in the patent prior to filing the reissue application) and the rule has been amended to reflect that practice. In order for restriction to be required between the original patent claims and added claims, the added claims must be directed toward inventions which are separate and distinct from the invention(s) defined by the original patent claims.”

Accordingly, choice (B), which reads “The Office cannot properly make a restriction requirement involving only subject matter of the original patent claims” is correct. If a restriction requirement involves only subject matter of the original claims, it follows that the restriction requirement does not involve inventions which are separate and distinct from the invention(s) defined by the original patent claims. The restriction requirement cannot properly be made unless it involves claims directed toward invention(s) which are separate and distinct from the invention(s) defined by the original patent claims. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 15 reads as follows:

15. Joe and Jim, local businessmen, conceived the idea of an improved fishing pole. Thereafter, they had a prototype made, and after successfully testing the pole, they filed a patent application on their invention. Both men are widowers, Joe with a grown son, and Jim with a grown daughter. Joe and Jim invite their children to come to the next Lions Club social event, and it isn't long before the children are thinking in terms of wedding bells. Ecstatic at the thought of the upcoming marriage, Joe and Jim decide to assign their patent application to their children as a wedding present. Accordingly, they execute a document properly assigning their patent application to their children effective on the date of their marriage, and mail it to the USPTO with a cover letter requesting that the document be recorded. Shortly after the document is recorded, Joe's son meets another woman, and breaks off his engagement to Jim's daughter. In light of this scenario, which of the following statements is true?

- (A) Since the assignment was conditioned on the marriage of the children, and the condition was not fulfilled, the USPTO will regard the assignment as without effect for Office purposes.
- (B) Since the assignment was recorded, the USPTO will require the parties to certify that the marriage condition was fulfilled before the assignment will be effective for Office purposes.
- (C) Since the assignment was recorded, the USPTO will not determine whether the marriage condition was fulfilled and will regard the assignment as absolute.
- (D) Since the USPTO does not record conditional assignments, the recording of the assignment document will be regarded as inadvertent, and without effect for Office purposes.
- (E) Since the assignment was recorded, the USPTO will regard it as a determination of the validity of the document and the effect that the document has on the title to the patent application.

The model answer is selection (C).

37 C.F.R. § 3.56 recites, "Assignments which are made conditional... are regarded as absolute assignments for Office purposes... The Office does not determine whether such conditions have been fulfilled." MPEP § 317.03. (A), (B), (D), and (E) are incorrect because they are false statements. Regarding (B), MPEP §

317.03 recites, "Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred." Regarding (E), MPEP § 317.03 recites, "[T]he recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent."

Petitioner argues that (E) is the most correct answer because since the assignment was recorded, the assignment is valid and because it was recorded it is absolute. The argument is not persuasive. The recordation of an assignment document does not make the assignment valid. See MPEP § 317.03. Choice (C) is the best answer because it states that the USPTO will not determine whether the marriage condition was fulfilled and will regard the assignment as absolute. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

- I. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.
- II. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.
- III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

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

- (D) I and II.
- (E) None of the above.

The model answer is selection (A).

MPEP § 2144.03. II is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (B) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (A) is correct.

Petitioner argues that statement II (and thus choice (D)) is correct because the traverse can arise any time during the prosecution of an application. Petitioner has argued that statement II can be interpreted to read that the applicant can traverse an examiner's statement of common knowledge in the art at any time ("seasonably") during the prosecution. The argument is not persuasive. It is improper to assume that statement II includes the word "seasonably." Including the word "seasonably" in statement II alters the meaning of statement II. The words "at any time during the prosecution" appear in statement II and these words distinguish statement II from statement I, which does include the word "seasonably."

As provided in MPEP § 2144.03, "applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." It is therefore not proper to rebut the well known statement at another time during the prosecution of the application. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. A member of the public submits a protest under 37 C.F.R. § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is "approximately June 1, 2000." Which of the following would be proper for the examiner to include in the next Office action?

- (A) A requirement that the date in the reply be made more specific.
- (B) A holding that the previous reply is incomplete.
- (C) A requirement seeking confirmation that "approximately June 1, 2000" is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.
- (D) (A) and (C).
- (E) None of the above.

The model answer is selection (C).

37 C.F.R. § 1.105 (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000). The example at 65 FR 54634, column 2, states, "The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply." Thus (A) and (B) are incorrect and (C) is correct. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

Petitioner argues that choice (D) is the most correct answer because both (A) and (C) are correct answers. An error has been shown in the grading of afternoon question 36. In addition to model answer (C), credit is being given for answer (A),

(B), (D), or (E). Since petitioner argues that (D) was the most correct answer, a point has been added to petitioner's score.

Afternoon question 43 reads as follows:

43. Claims 1 and 2 in a patent application state the following:

Claim 1. An apparatus for sitting comprising:

- (i) a square shaped base member;
- (ii) four elongated members mounted to the bottom of the base member; and
- (iii) a circular back member mounted to the base member.

Claim 2. An apparatus as in claim 1, further comprising a spring connected to the back member and to the base member. Which, if any, of the following claims fully supported by the specification and presented in the application, is in accordance with USPTO rules and procedure?

(A) 3. An apparatus as in claim 1, wherein the base member is rectangularly shaped.

(B) 3. An apparatus as in claim 2, wherein the wheels connected to each of the elongated members are plastic.

(C) 3. An apparatus as in any of the preceding claims, in which the circular back member is wooden.

(D) 3. An apparatus as in the preceding claims, further comprising a pressure-sensing device connected to the base member.

(E) None of the above.

The model answer is selection (C).

MPEP § 608.01(n). (A) is incorrect because a dependent claim must further limit the subject matter of a previous claim. 37 C.F.R. § 1.75(c). The claim in (B) is actually inconsistent with claim 1. (B) is incorrect because there is no antecedent basis for the wheels. MPEP § 2173.05(e). (D) is incorrect because it does not refer back in the alternative only. MPEP § 608.01(n). (E) is incorrect because (C) is correct.

Petitioner argues that choice (A) is the most correct answer because in choice (A), the claim is further limiting because the square is a rectangle and not an equilateral square. The argument is not persuasive. A square, by definition, is a rectangle having all four sides of equal length. Accordingly, specifying that the square shaped based member is “rectangularly shaped” does not provide any further limitation on the subject matter of claim 1. Specifying that a square is not an equilateral square is inconsistent with the usual meaning of the term “square.” While it is true that an applicant is able to be their own lexicographer, petitioner is reminded that in the “DIRECTIONS” to the Afternoon Session, the following instruction was provided: “Do not assume any additional facts not presented in the questions.” The question did not present facts stating that the applicant had defined a square as being capable of having sides of unequal lengths. Furthermore, an applicant may not be their own lexicographer when the meaning assigned to the term is repugnant to the term’s well known usage. See MPEP § 2111.02 and MPEP § 2173.05(a). According to well known usage, all squares are rectangles, but not all rectangles are squares. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

**ORDER**

For the reasons given above, two (2) points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 64. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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