



UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-86

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re

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:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:  
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### **MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 4, 8, 11, 15, and 21 of the morning section and questions 11 and 27 of the afternoon section of the Registration Examination held on April 17, 2002. 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 66. On August 1, 2002 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an one additional point for morning question 11 and no additional points for any afternoon question. Accordingly, petitioner has been granted one additional point on the Examination. No credit has been awarded for morning questions 4,8, 15, and 21 or afternoon questions 11 and 27. Petitioner's arguments for these questions are addressed individually below.

Morning question 4 reads as follows:

4. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

- (A) traverse the objection and specifically argue how the specification is enabling.
- (B) traverse the objection and submit an additional drawing to make the specification enabling.
- (C) file a continuation- in-part application that has an enabling specification.

(D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.

(E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

4. The model answer: (B) is the most correct answer. 35 U.S.C. § 113 reads “Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure.” Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

Petitioner argues that answer (C) is correct. Petitioner contends that the entire question should be thrown out because there are two answers, B and C, which are correct. Petitioner argues that filing a C-I-P would avoid a rejection in the C-I-P but have no effect on the objection in the original rejection.

Petitioner’s arguments have been fully considered but are not persuasive. Assuming *arguendo* that answer choice (C) is a correct answer, the petitioner did not choose answer choice (C). Rather, petitioner chose answer choice (D) that is not a correct answer. See 37 CFR 1.121. Petitioner’s argument that the C-I-P would not overcome the rejection in the original application is considered however, the petitioner appears to be reading limitations into the question that do not exist. The question merely asks whether the particular response by an applicant would overcome the rejection. Filing the C-I-P would overcome the objection. Note that the directions caution petitioner not to assume any additional facts not considered in the question. Accordingly, model answer B is correct and petitioner’s answer D is incorrect.

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

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark’s patent

application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(1)(3). ~~Also, evidence or common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (C) is also correct because answer choice (C) does not include all of the requisite information as to whether the affidavit material is proper. Moreover, petitioner asserts that it is unclear which section of 35 USC 102 the office is citing in answer choice (D).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer choice (C) is also a correct answer, answer choice (D) is the most correct answer. Note the directions expressly mention that there is one "most correct answer". Clearly answer choice (D) is the most correct answer. Answer choice (D) is correct because the prior art exception in 35 USC 103(c) only applies to references that are 102(e) references. A reading of the fact pattern would

reveal that the reference in question could have been rejected under 102(a) but not 102(e). Accordingly, the assertion of common ownership would not have been an effective response that would obviate the rejection. Accordingly, answer choice (D) would clearly be a wrong response and accordingly the right answer. On the other hand, answer choice (C) is correct in that a reply traversing the rejection by relying on an affidavit or declaration under 35 USC 1.132 containing evidence of criticality or unexpected or unexpected results would be in accordance with proper USPTO practice and procedures. Assuming *arguendo* that the answer could have included the content and form of the affidavit or declaration, the directions require petitioner to select the “most correct answer” which would lead a petitioner to select answer choice (D). Note that there is nothing inaccurate about this response while answer choice (D) is clearly not within USPTO practice and procedures. 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 11 reads as follows:

11. Petitioner has been awarded one point for answer choice (C) in morning question 11.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben’s consent, sends a proper associate power of attorney to the Office for Ben’s application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben’s comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and send to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is correct. Petitioner contends that the model answer choice (C) is not the best choice because answer choice (B) is also a correct choice and accordingly, the correct answer would be D which requires that both B and C are correct.. Petitioner argues that the model answer analysis is flawed because examinee must assume facts not presented in the question. Petitioner asserts that it would be unreasonable for examinee to assume that Ben knowingly would send an unexecuted power of attorney.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer choice (D) would be the correct answer, the correct answer choice (C) is the correct answer. Answer (B) is not a correct answer because the phrase "anyone B intends to represent him" would include non-registered practitioners who do not have any authority to act. Because answer choice B is not correct, answer choice (D) that says that both answers (B) and (C) are correct would be incorrect as well.

Petitioner's assertion that it would be unreasonable for examinee to assume that Ben would knowingly send an unexecuted power of attorney is an assumption that the directions warns against. Note that the directions expressly advise petitioner not to assume any additional facts not presented in the questions. Moreover, petitioner's assertion that answer choice (B) would reasonably require the execution of the power of attorney is also not considered persuasive because the model answer does not mention that the declaration must be executed. Note that answer choice (C) does expressly mention that Ben should execute the declaration. Accordingly, upon review of the choices petitioner must see that answer choice B would not require that the declaration be executed while answer choice (C) would require that the submitted declaration be executed. Accordingly, model answer choice (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.

Morning question 21 reads as follows:

21. Company X competes with Patentee Y. In response to an accurate notification from Company X, acting as a third party, that Patentee Y's patent contains a printing error, incurred through the fault of the USPTO, the USPTO:

- (A) must issue a certificate of correction.
- (B) must reprint the patent to correct the printing error.
- (C) need not respond to Company X.
- (D) should include Company X's notification in the patent file.
- (E) must notify Company X of any USPTO decision not to correct the printing error.

21. The model answer: (C) is the most correct answer. *See* 37 C.F.R. § 1.322(a)(2)(i) ("There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section"). *See* MPEP § 1480. (A), (B) and (E) are incorrect because they indicate that the USPTO must take some mandatory action as a result of the third party notification, while 35 U.S.C. § 254 and 37 C.F.R. § 1.322(a)(2)(i) leave whether and how to respond to such a third party notification to the discretion of the USPTO Director. (D) is incorrect. *See* 37 C.F.R. § 1.322(a)(2)(ii) ("Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office").

Petitioner argues that answer (C) is correct. Petitioner contends that a training manual issued by the Patent Office on December 12, 2000 states that "The Office will confirm to the party submitting such information that such information has been received by the Office if a stamped self addressed post card has been submitted." Petitioners assert that this statement makes answer choice (C) inaccurate and therefore no answer is correct.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the Office must respond to third parties assertions of Office error in the printing of a patent, the Office need not respond to the third party submission. *See* MPEP section 1480. MPEP 1480 states that third parties do not have standing to demand that the Office issue, or refuse to issue, a Certificate of Correction. Moreover, MPEP 1480 states that the Office will not correspond with third parties about the information. Rather, the Office will only confirm to the party submitting such information that the Office has in fact received the information if a stamped, self-addressed post card has been submitted. *See* MPEP section 1480 that has the same

language as petitioner's citation of the training manual. . A confirmation of receipt is not a response. Nothing in the patent, statutes, rules, manual, or regulations requires the Office to respond to a third party submission of error in printing of the patent. 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.

Afternoon question 11 reads as follows:

11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

(A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.

(B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.

(C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.

(D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.

(E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

11. The model answer: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second

provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7).

Petitioner argues that answer (C) is correct. Petitioner contends that the question is ambiguous and accordingly all answers should be awarded.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the question is ambiguous, the question is unambiguous. Moreover, applicants' answer choice (C) clearly could not be the correct answer because a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7). On the other hand, an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. Accordingly, answer choice (A) is correct. Therefore, 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 27 reads as follows:

27. Judy Practitioner is preparing the declaration form (PTO/SB/01) for her clients, inventors A and B, to sign prior to filing their utility patent application. Inventor A lives in California, and inventor B lives in Germany. Prior to sending declaration forms to the inventors, only inventor A had reviewed the final version of the application. Which of the following situations below would result in the declaration form(s) being compliant with 37 CFR 1.63(a) and (b)?

(A) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A with the instruction to return to her after he signs the declaration form. After inventor A returned the form, Judy then proceeded to mail out the declaration form to inventor B. After inventor B signed the declaration, Judy then attached the declaration, signed by both inventors, to the application and filed it with the USPTO.

(B) Judy mailed to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and only inventor A's full name and citizenship. At the same time, Judy sent by facsimile to inventor B only a copy of the declaration form, which identified the application and only inventor B's full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.

(C) Judy sent by facsimile (e.g. fax) to inventor A only a copy of the declaration form (PTO/SB/01) which identified the application and both inventors by their full names and citizenships. At the same time, Judy mailed to inventor B a copy of the application and a

copy of the declaration form, which identified the application and both inventors by their full name and citizenship. Judy then attached both signed declaration forms to the patent application and filed it with the USPTO.

(D) Judy mailed only a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, to inventor A. Judy then attached the declaration, signed only by inventor A, to the application and filed it with the USPTO.

(E) Judy files a petition under 37 CFR 1.48 just stating that inventor B's signature could not be obtained at this time, and files a copy of the declaration form (PTO/SB/01), which identified the application and both inventors by their full names and citizenships, signed by only inventor A.

27. The model answer: The correct answer is (C) because (1) the declaration identified the application and the full name and citizenship of both inventors and (2) a copy of the application was sent to inventor B to review and understand. Answer (A) is incorrect because inventor B never reviewed and understood the application prior to signing the declaration form. Answer (B) is incorrect because (1) each declaration form failed to identify all the inventors (e.g. both inventors A and B) and (2) a copy of the application was not sent to inventor B to review and understand. Answer (D) is incorrect because inventor B never signed the declaration. Answer (E) is incorrect because petitions for nonsigning inventors must be filed under 37 C.F.R. § 1.47, not § 1.48. Even if the petition is treated under § 1.47 a statement, that B's signature could not be obtained at this time, is insufficient.

Petitioner argues that answer (E) is correct. Petitioner contends that an answer choice (C) is the best possible answer but is incomplete because the question should have included a statement that inventor B was made aware of the need to review the application prior to executing the directions.

Petitioner's arguments have been fully considered but are not persuasive.. Petitioner's statement that answer choice (C) would be a better answer if the above mentioned information was included is not relevant. Note that the directions tell the applicant to select the most correct answer. Clearly answer choice (C) is the most correct answer because it is the only answer that provides inventor B with a copy to read prior to signing. Moreover, petitioner admits that the best choice would be answer choice (C). Petitioner's choice of answer choice (E) could not be the most correct answer because it cites 37 CFR 1.48 rather than the correct section, 37 CFR 1.47 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.

**ORDER**

For the reasons given above, one point have/has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. 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