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UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re

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

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 1, 4, 27, 32 and 45 of the morning section and questions 22 and 37 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 67. On August 6, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

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

### **OPINION**

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

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

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

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

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

No credit has been awarded for morning questions 1, 4, 27, 32, and 45, and afternoon questions 22 and 37. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Which of the following is the best way to recite a claim limitation so that it will be interpreted by the examiner in accordance with 35 U.S.C. § 112, paragraph 6?

- (A) dot matrix printer for printing indicia on a first surface of a label.
- (B) dot matrix printer means coupled to a computer.
- (C) means for printing indicia on a first surface of a label.
- (D) printer station for printing indicia on a first surface of a label.
- (E) All of the above.

1. The model answer: (C) is the most correct answer. MPEP § 2181 expressly requires that for a claim limitation to be interpreted in accordance with 35 U.S.C. § 112, paragraph 6, that limitation must (1) use the phrase “means for”, (2) the “means for” must be modified by functional language, and (3) the “means for” must not be modified by sufficient structure for achieving the specified function. In the above fact pattern, only answer choice (C) satisfies the above requirements. (A) is wrong because it does not use the phrase “means for” and recites structure for achieving the specified function (“printer”). (B) is wrong because it modifies the “means” with structure, and also fails to modify the “means” with functional language. (D) is wrong because it does not use the phrase “means for” and also recites structure modifying “mechanism.”

Petitioner argues that answer (B) is correct. Petitioner contends that while model answer (C) is one way to answer the question, he asserts that it is not the only way, as MPEP 2181 does NOT require “means for” in the language of the claim in order to be interpreted under 35 U.S.C. § 112(6) paragraph. Petitioner argues that this section says that if you don’t meet these four requirements, then you must show that the language in question qualifies in context for § 112(6) paragraph treatment. Petitioner contends that the CAFC has repeatedly said that there is no requirement that the specific word “means” be present for a claim recitation to fall within the purview of § 112(6) paragraph. Petitioner asserts as such, the specification would be used for interpretation and model answer (C) would not be the only answer, therefore, this question should be thrown out or reworded.

Petitioner’s arguments have been fully considered but are not persuasive. Although petitioner’s argument has some merit in that MPEP 2181 does not require “means for” in the language of the claim in order to be interpreted under 35 U.S.C. § 112(6) paragraph, petitioner’s arguments are not persuasive. It should be noted that MPEP 2181 also clearly indicates that if applicant wishes to have a claim limitation treated under 35 U.S.C. § 112(6) paragraph, then applicant must either amend the claims to include the phrase “means for” or “step for,” or show that even though the phrase “means for” or “step for” is not used, that the claim limitation is written as a function to

be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. § 112(6) paragraph (emphasis added). Therefore, since answers (A) and (D) do not merely claim the underlying function, but also recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. § 112(6) paragraph, petitioner's arguments are not persuasive. Answer (B) is wrong since not only does it modify the "means" with structure, it fails to modify the means with functional language. Therefore, (B) does not present a claim limitation written as a function to be performed. Contrary to petitioner's statement that all of the responses are subject to proper interpretation under 35 U.S.C. § 112, paragraph 6, the question asks which is the best way so that it will be so interpreted. 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.

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 neither answer (B) nor answer (C) can revive a fatally defective application by trying to add new matter. Petitioner apparently argues that filing a continuation-in-part (CIP) application with an

enabling specification will not overcome the objection to the original application for lack of enablement.

Petitioner's arguments have been fully considered but are not persuasive. It should be noted that the CIP application must be filed while the earlier application is still pending, i.e., before the patenting or abandonment of the earlier application, and if enabled, the CIP application would effectively overcome the objection for lack of enablement in the original application. In other words, the lack of enablement deficiency would be cured by the filing of the CIP application and the enablement objection would accordingly not be carried over/maintained in the prosecution of the CIP application. The question reads "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:" Petitioner appears to be reading too much into the question. It sounds like petitioner is reading the question as stating --To overcome this objection in this application . . .-- which is not the case. Contrary to petitioner's argument that an objection to new matter cannot be overcome in a single application, the question is not restricted to overcoming the objection in a single application. Finally, the petitioner should note that the continuation-in-part application is entitled to the benefit of the earlier filing date of the parent application, except for the subject matter directed *solely* to the added subject matter filed in the continuation-in-part application. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

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

Morning questions 27 through 29 are based on the following factual background. Consider morning questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non-hormonal substance XYZ ("Antiagra") that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non-hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal

substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

Morning question 27 reads as follows:

27. Upon initial examination, the patent examiner issues a requirement for restriction on the basis that the application claims two or more independent and distinct inventions. Specifically, the examiner requires an election between (a) claims directed to the non-hormonal substance *per se* (claims 1-5); (b) claims directed to the salt lick and to the method of forming the salt lick (claims 6-14); and (3) claims directed to the method of controlling deer population by distributing salt licks that are treated with XYZ to reduce pregnancy rates (claims 15-20). The restriction requirement was set forth in an Office action dated December 12, 2001, and the examiner set a one month (not less than 30 days) shortened statutory period for response. December has 31 calendar days. Which of the following is most likely to be treated by the USPTO as a timely, fully responsive reply to the Office action.

(A) You contact the examiner on the telephone on December 27, 2001 and make an oral election of the subject matter of claims 6-14 without traverse, and request cancellation of claims 1-5 and 15-20 without prejudice to resubmission of those claims in a continuation application. You do not, however, subsequently confirm the substance of the telephone conversation in writing and the examiner does not complete an Interview Summary Record.

(B) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the requirement would force the small entity applicant to file multiple patent applications and is therefore unduly burdensome. The Reply to Office Action requests reconsideration of the restriction without making an election.

(C) On February 12, 2002, you file a Reply to Office Action, a Petition for Two Month Extension of Time and all necessary fees. The Reply to Office Action does not make an election. Instead, the Reply to Office Action traverses the restriction requirement and requests reconsideration of the restriction without specifically pointing out the supposed errors in the examiner's action.

(D) On February 14, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action traverses the restriction requirement on the basis that the claims as originally presented in a single application do not pose a serious burden on the examiner, and therefore requests reconsideration of the election requirement. The Reply to Office Action provisionally

elects the subject matter of claims 6-14. There is no authorization to charge a deposit account.

(E) On February 12, 2002, you file a Reply to Office Action, a Petition for One Month Extension of Time and all necessary fees. The Reply to Office Action elects claims 6-14 without traverse.

27. The model answer: The best answer is (E). The original deadline for responding to the Office action was one month from December 12, 2001, *i.e.* January 12, 2002. A one-month extension of time would be required for a response filed from January 12, 2002 to February 12, 2002. Answer (D) is incorrect because the responses are not timely. Answer (B) is incorrect because a proper reply must include an election even if the restriction requirement is traversed (MPEP § 818.03(b)). Furthermore, although small entity status entitles an applicant to pay reduced fees, small entity status does not change the manner in which restriction requirements are considered. Answer (A) is incorrect because the reply must be in writing. See, *e.g.*, MPEP § 818.03(a). Answer (C) is incorrect because the Reply to Office Action does not make an election and because it does not specifically point out the supposed errors in the Examiner's action. See MPEP § 818.03(a).

Petitioner argues that answer (D) is correct. Petitioner contends that since, in answer (D), applicant paid all necessary fees, the payment of these fees must be treated as a constructive petition for two months extension of time on February 14, 2002. Petitioner further contends that the number of months requested on the petition are irrelevant, provided that the petition was filed within the statutory period and all necessary or required fees are paid. Petitioner argues that, as provided for under 37 CFR 1.136(a)(3), an authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of this fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission. Petitioner draws attention to the dictionary definition of the word "necessary" as "absolutely required, essential, needed, compulsory, indispensable, unavoidable".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that all necessary fees in (D) would include the fee for a two month extension, answer (D) specifically states that "There is no authorization to charge a deposit account." 37 CFR 1.136(a)(3) requires only that *an authorization to charge fees* be treated as a constructive petition. Since there is no authorization to charge fees in (D), there is no constructive petition for a two month extension of time. Accordingly, model answer (E) 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 32 reads as follows:

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a co-inventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.
- (D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.
- (E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

32. The model answer: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered co-inventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the

prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

Petitioner argues that answer (C) is correct. Petitioner contends that the question is flawed because the question fails to provide a U.S. filing date. Petitioner alternatively contends that she would never be barred from obtaining patent protection for the floor coating material if she filed a patent application on or before January 30, 2002. Petitioner also argues that the USPTO assumes that the coating material is barred, and that if the coating material is barred, the coating material becomes prior art and James' invention becomes an obvious variant of the prior art.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner has the burden of showing that his chosen answer is the *most correct* answer. Contrary to petitioner's statement that the question must provide a U.S. filing date, the question simply asks, "Which of the following is true?". As stated in the directions to both the morning and afternoon sections, petitioner must not assume any additional facts not presented in the questions. The question simply provides that on January 1, 2002, James discusses patent protection with Johnnie. There is nothing in the question to indicate that an application has yet been filed. As stated in the model answer, Johnnie conducted an experimental use of the article (and of the coating material) from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article (and/or the coating material). Johnnie may file a patent application before January 30, 2002. (B) is clearly true, since James thought of the idea to use the material in microwave ovens on January 1, 2002, and since Johnnie invented the material. (C) is incorrect since (C) states "[s]ince for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, Johnnie would never be barred. Public use, however, occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. Answer (C), therefore, is not the *most correct* answer. Petitioner argues that the USPTO assumes that only the coating material is barred. However, the coating material is not barred. The model answer states that the article of manufacture is not barred even though the *floor material itself* (i.e., *the floor tiles*) cannot be patented. James' invention would not become an obvious variant of the prior art, given these facts, since there is nothing in the fact pattern that would provide one of ordinary skill with a motivation to combine the coating material with the microwave oven, absent James' idea. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

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

Morning question 45 reads as follows:

45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art.

(B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by “another.”

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).

(D) (A) and (C).

(E) (A), (B) and (C).

45. The model answer: (E). See MPEP § 706.02(b) page 700-23 (8<sup>th</sup> ed.), under the heading “Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent.” (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

Petitioner argues that answer (A) is correct. Petitioner quotes MPEP 706.02(b) (D) and simply contends, without more, that answer (C) is defective since it misstated or misapplied MPEP 706.02(b).

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that MPEP 706.02(b)(D) is misstated or misapplied, no misapplication can be found. MPEP 706.02(b)(D) states that when the claims of the reference and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Answer (C) specifically provides for filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is NOT a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s). No misapplication was made. MPEP 706.02(b)(D) also states: “Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference *is not a U.S. patent* (or application in the case of a provisional rejection) *claiming the same patentable invention as defined in 37 CFR 1.601(n)*. The “same patentable invention” as defined in 37 CFR 1.601(n) is one which is the same invention or an obvious variant of the other invention. Again, no misapplication can be found. (A), (B), AND (C) are therefore correct. (E) is the most correct answer because it is the most inclusive. Accordingly, model answer (E) 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 22 reads as follows:

22. Patentee, Iam Smarter, filed and prosecuted his own nonprovisional patent application on November 29, 1999, and received a patent for his novel cellular phone on June 5, 2001. He was very eager to market his invention and spent the summer meeting with potential licensees of his cellular phone patent. Throughout the summer of 2001, all of the potential licensees expressed concern that the claim coverage that Smarter obtained in his cellular phone patent was not broad enough to corner the market on this technology, and therefore indicated to him that they feel it was not lucrative enough to meet their financial aspirations. By the end of the summer, Smarter is discouraged. On September 5, 2001, Smarter consults with you to find out if there is anything he can do at this point to improve his ability to market his invention. At your consultation with Smarter, you learn the foregoing, and that in his original patent application, Smarter had a number of claims that were subjected to a restriction requirement, but were nonelected and withdrawn from further consideration. You also learn that Smarter has no currently pending application, that the specification discloses Smart's invention more broadly than he ever claimed, and that the claims, in fact, are narrower than the supporting disclosure in the specification. Which of the following will be the best recommendation in accordance with proper USPTO practice and procedure?

- (A) Smarter should immediately file a divisional application under 37 CFR 1.53(b) including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application that issued as the patent.
- (B) Smarter should file a reissue application under 35 U.S.C. § 251, including the nonelected claims that were subjected to the restriction requirement in the nonprovisional application that issued as the patent.
- (C) Smarter should file a reissue application under 35 U.S.C. § 251, broadening the scope of the claims of the issued patent, and then file a divisional reissue application presenting only the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (D) Smarter should simultaneously file two separate reissue applications under 35 U.S.C. § 251, one including broadening amendments of the claims in the original patent, and one including the nonelected claims that were subjected to a restriction requirement in the nonprovisional application which issued as the patent.
- (E) Smarter should file a reissue application under 35 U.S.C. § 251 on or before June 5, 2003, broadening the scope of the claims of the issued patent.

22. The model answer: (E) is the correct answer. 35 U.S.C. § 251. The reissue permits Smarter to broaden the claimed subject matter. (A) is incorrect. There must be

dependency between the divisional application and the original application. 35 U.S.C. § 120. (B) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). (C) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*, including a divisional reissue application. MPEP § 1402. (D) This is incorrect, as an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue, *Id.*

Petitioner argues that answer (C) is correct. Petitioner contends that all of the answer choices are defective, and that the question should be disregarded and answers (A-E) including answer choice (C) should be accepted as the most correct answer. Petitioner argues that (E) is wrong because there is no clear error in the prosecution. Petitioner argues that Smarter intentionally obtained a cellular phone patent that was not broad enough to corner the market on this technology. Petitioner also argues that the USPTO cannot accept (E) as the most correct answer because in Question 26 of the April 17, 2002 Examination, Afternoon Session Model Answer, the USPTO stated that it was not clear there is an "error" under 35 U.S.C. 251 with respect to the claims for the reflective housing. In that case Jack Flash's failure to broaden his claims as to the reflective housing was due to an intentional business decision to reduce cost due to reversals suffered in his business.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Smarter intentionally obtained a patent that was not broad enough to corner the market, there is nothing in the fact pattern that would indicate that Smarter had such an intention. Few patentees intentionally obtain a patent that is not broad enough to corner the market. Contrary to petitioner's statement that there is no clear error in the prosecution, 37 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "no reissue patent shall be granted enlarging the scope of the original patent *unless applied for within two years from the grant of the original patent.*" In the situation where the patentee has claimed less than the patentee had the right to claim in the patent, this error is correctable via reissue practice, as the error that arose /occurred was the failure to fully appreciate the claim scope to which the patentee was entitled. See MPEP 1412.03 and, particularly, MPEP 1414 "Content of Oath/Declaration", under the heading: "I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT." Petitioner should note that model answer (E) simply states that the reissue application broadens the scope of *the claims of the issued patent*. The issued patent does not contain claims which were nonelected and withdrawn from consideration. Note that model answer (E) does not provide for the filing of a reissue application which includes the *nonelected, withdrawn* claims. Smarter can broaden the scope of the claims of the issued patent; however,

Smarter will not be able to prosecute the nonelected claims since an applicant's failure to timely file a divisional application while the original application is still pending is not considered to be an error correctable via reissue. Smarter intentionally did not elect, and withdrew, these claims. In the model answer to Question 26, Jack Flash did not merely fail to claim less than he had a right to claim, he *cancelled* the claims to the reflective housing. Since this cancellation may be considered to be intentional, an answer stating that the inventor claimed less than he had a right to claim *by not claiming the reflective housing* is not the best answer, since it is not clear that there is error under 35 U.S.C. § 251 with respect to the cancelled claims for the reflective housing. In other words, when the inventor actively does something to remove the claims from prosecution (nonelection, withdrawal, cancellation), the inventor may be said to have intentionally done so. Nuances in claim construction, such that the claim is narrowed or broadened, are not necessarily intentional. 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.

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 (A) is correct. Petitioner contends that (A) is equally correct as (C). Petitioner provides no further showing that his chosen answer (A) is the most correct answer. Petitioner argues that the declaration did not include the "reviewed and understood", "original and first" and "duty to disclose" statements. Petitioner contends that the USPTO assumes that inventor B reviewed the application in (C), and that experienced practitioners know that inventors often fail to read or understand declarations, specifications, or claims without necessary intervention by the practitioner, and that answer (C) does not indicate whether inventor (A) understood the application, or whether (B) reviewed or understood the application.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner assumes that the declaration did not include the "reviewed and understood", "original and first" and "duty to disclose" statements. However, as stated in the directions for both the morning and evening sessions, do not assume any additional facts not presented in the questions. There is nothing in the fact pattern to indicate that these statements were not present in the declaration. Furthermore, as stated in the directions for both the morning and the evening sessions, there is only one most correct answer for each question. The burden is on the petitioner to show that his chosen answer is the *most correct* answer. (A) is clearly wrong since inventor B never reviewed and understood the application prior to signing the declaration form, and Judy did not send inventor B a copy

of the application for his review, along with the declaration. Answer (A), therefore, provides no possibility that the declaration form(s) would be compliant with 37 CFR 1.63(a) and (b), since (A) provides no possibility that inventor B would review and understand the application prior to signing the declaration form. Answer (C) states that the declaration form identified the application and the full name and citizenship of both inventors, specifies that a copy of the declaration form was mailed to both inventor A and inventor B, and states that at the same time, Judy mailed a copy of the application to inventor B. Answer (C), therefore, is the most correct answer since only answer (C) provides the possibility that inventor B would be able to review and understand the application prior to signing the declaration form, and additionally provides that the declaration form identified the application and the full name and citizenship of both inventors, and that the declaration form was mailed to both inventors. 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.

**ORDER**

For the reasons given above, no points have 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.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is written above a horizontal line.

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