



UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-92
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

FEB 10 2003

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 11, 15 and 48 of the morning section and question 11 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 68. On August 7, 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 additional point for morning question 11. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 15 and 48 and afternoon question 11. Petitioner's arguments for these questions are addressed individually below.

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 sent 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 (A) is correct. Petitioner contends that (C) is wrong because the facts do not indicate that intended registered representative consented to representation and that (A) is correct because 37 CFR 1.33(a) allows the registered

representative to reply on the applicant's behalf by simply providing the representative's name and registration number.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (C) is wrong because the facts do not indicate that intended registered representative consented to representation and that (A) is correct because 37 CFR 1.33(a) allows the registered representative to reply on the applicant's behalf by simply providing the representative's name and registration number, (C) does not speak to the representative's action, but the applicant's action and therefore the issue of consent is irrelevant, although consent would be inherent in the complete representation transaction, and (A) is incorrect because the Office will only communicate with the applicant, irrespective of 37 CFR 1.33. Even if the Office accepts a reply from the practitioner under 37 CFR 1.33, the Office response will be mailed to the applicant, so any instruction for the applicant to have no further contact with the Office is erroneous. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

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

Morning question 48 reads as follows:

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

(A) the application must be filed under large entity status because enrollment in the university exceeds 500.

(B) the application must be filed under large entity status because PTI has entered into a license agreement.

(C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.

(D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.

(E) None of the above.

48. The model answer: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that (B) is incorrect because the article “a” modifying “license agreement” in selection (B) means that the license agreement in (B) is different from the license agreement with the large entity and that (E) is correct because none of the other answers, including (B) are correct.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that (B) is incorrect because the article “a” modifying “license agreement” in selection (B) means that the license agreement in (B) is different from the license agreement with the large entity and that (E) is correct because none of the other answers, including (B) are correct, the article “a” modifying “license agreement” does not preclude the license agreement with the large entity. In fact, this is the only license agreement mentioned in the entire fact pattern, so it is not only not precluded, it is the same identical license agreement. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. Petitioner’s argument actually agrees with selection (B) on p. 11 “Proper advice to PTI would be that the present application must be filed under large entity status because PTI has licensed the invention to Atlantic Telecom. Accordingly, model answer (B) is correct and petitioner’s answer (E) is incorrect.

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

Afternoon question 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 (E) is correct. Petitioner contends that the applicant cannot claim priority to claimed subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect, and (E) is the only remaining correct selection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the applicant cannot claim priority to claimed subject matter that was inoperable in the original application for lack of utility as to the waterproof aspects, making (A) incorrect, and (E) is the only remaining correct selection, a nonprovisional application may claim the benefit of the filing date of an earlier filed provisional application for the subject matter disclosed in the provisional application. Here, Henrietta's provisional application provides support for a camera that operated at high temperature. Furthermore, answer (A) is correct because Henrietta would obtain the broadest patent protection covering both aspects of her invention, a camera that can operate at a high temperature and is waterproof. Answer (E) is incorrect because Henrietta would not obtain the patent protection for the means that fixed the leakage issue. Accordingly, model answer (A) 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 has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

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

This is a final agency action.



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



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APR 3 2003

In re

:
: DECISION ON
: PETITION FOR
: REVIEW OF DIRECTOR'S
: DECISION
: UNDER 37 CFR 10.2(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for review of the Director's decision mailed on February 10, 2003 under 37 CFR 10.2(c) and requests reconsideration for the answer to question 48 of the morning 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

68. On August 7, 2002, petitioner requested regrading, arguing that the model answers were incorrect. On February 10, 2003, the Office mailed a decision on the petition for regrade denying the petition to the extent that the petitioner sought a passing grade on the Registration Examination. Petitioner was given credit for question 11 of the morning session, and accordingly, petitioner's score was increased to 69. On March 18, 2003, petitioner filed a petition for review of Director's decision under 37 CFR 10.2(c).

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 the Office of Patent Legal Administration.

OPINION

Under 37 CFR 10.2(c), any petition for review of Director's decision shall contain (1) a statement of the facts involved and the points to be reviewed and (2) the action requested. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the Director and no new evidence will be considered by the Director in deciding the petition. For a petition for regrade, pursuant to 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 no additional points for morning question 48.

Accordingly, petitioner has been granted no additional points as a result of the review of the Director's decision. No credit has been awarded for morning question 48.

Petitioner's arguments for this question are addressed individually below.

Morning question 48 reads as follows:

48. Engineers and scientists at Poly Tech Institute (PTI) have invented a new system for a wireless computer network. On November 9, 2001, they asked you to file a U.S. patent application for their invention. PTI is located in the United States, has an attendance of over 5,000 students, and (1) admits, as regular students, only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate, (2) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education, (3) provides an educational program for which it awards a bachelor's degree or provides less than a 2-year program which is acceptable for full credit toward such a degree, (4) is a public institution, and (5) is accredited by a nationally recognized accrediting agency. You also find out that Poly Tech's research which led to the invention of the new system was funded by Atlantic Telcom Corporation (ATC) (a for profit corporation with over 500 employees and that does not meet the small business standard defined in 13 CFR 121) and a license agreement has been signed which would give ATC the right to participate in the prosecution of the patent application and also the right to make and use the invention, upon the payment of royalties, if the application ultimately issues as a patent. Based on the above facts, you should advise PTI that:

- (A) the application must be filed under large entity status because enrollment in the university exceeds 500.
- (B) the application must be filed under large entity status because PTI has entered into a license agreement.
- (C) the application may be filed under small entity status because the enrollment at PTI exceeds 5000 students.
- (D) the application may be filed under small entity status because PTI is an institution of higher education located in the United States.
- (E) None of the above.

48. The model answer: (B) is the most correct answer. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) which prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. In the example above, the licensee, ATC, does not qualify for small entity status. See also MPEP § 509.02 at pp. 500-32 to 500-34. Answer (A) is incorrect, because it does not matter that the university has over 500 students. A university can still qualify for small entity status even though it has more than 500 students. 37 C.F.R. § 1.27(a)(3)(ii)(A). Answer (C) is incorrect because the invention has been licensed to a large entity, and the size of the student body does not determine whether a university qualifies as a small entity. Answer (D) is incorrect because although PTI is an institution of higher education, there has been a license to an organization that

does not qualify for small entity status. Answer (E) is incorrect because answer (B) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that (B) is incorrect because the article "a" modifying "license agreement" in selection (B) means that the license agreement in (B) may be different from the license agreement with the large entity and that (E) is correct because none of the other answers, including (B) are correct. Petitioner particularly argues that the indefinite article "a" preceding the phrase "licensing agreement" fails to link the licensing agreement referred to in selection (B) to the licensing agreement specified in the body of question 48. Petitioner particularly points out that the selection (B) and the question do not preclude the existence of another licensing agreement. Petitioner stresses that it is the grammatical construction of selection (B) that renders that selection as an improper answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (B) is incorrect because the article "a" modifying "license agreement" in selection (B) means that the license agreement in (B) is different from the license agreement with the large entity and that (E) is correct because none of the other answers, including (B) are correct, the article "a" modifying "license agreement" does not preclude the license agreement with the large entity. In fact, this is the only license agreement mentioned in the entire fact pattern, so it is not only not precluded, it is the same identical license agreement. Even were there an additional licensing agreement, the licensing agreement with ATC would be such a licensing agreement as to require large entity status. Selection (B) simply indicates that this is the reason for large entity status. 37 C.F.R. § 1.27 (a)(3)(i) & (ii) prohibits claiming of small entity status if the nonprofit organization (a university) has assigned, granted, conveyed, or licensed any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization. Petitioner's argument actually agrees with selection (B) on p. 11 "Proper advice to PTI would be that the present application must be filed under large entity status because PTI has licensed the invention to Atlantic Telecom. There is at least one, i.e. "a", licensing agreement that requires large entity status as indicated in selection (B). Therefore, Petitioner's assertion that there is no proper interpretation of the English language that will allow model answer (B) to be correct, is, as an argument, unpersuasive. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

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

ORDER

In the decision for the petition for regrade, 1 point was added to petitioner's score on the Examination. Therefore, petitioner's score is 69. No points have been added as a result of the petition for review of the Director's decision. Accordingly, petitioner's score is still 69. This score is insufficient to pass the Examination.

Upon review of the Director's decision and reconsideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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