



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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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, 7, 8, 11, 12 and 42 of the morning section and questions 11, 22, 26 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

67. On August 9, 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 2 points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional 2 points on the Examination. No credit has been awarded for morning questions 1, 4, 7, 8 or 42 and afternoon questions 11, 22, 26 or 27. 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 does not argue that a particular answer 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), (B) 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. Accordingly, model answer (C) is correct and petitioner's answer 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 answer (C) will NOT overcome the objection to the client's patent application for lack of enablement. Petitioner asserts that a continuation-in-part has new matter that will be accorded a new filing date, and the client's patent application will die, but the objection is NOT overcome because the continuation-in-part is a separate application.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that filing a continuation-in-part (CIP) application that

has an enabling specification will not overcome the objection to the client's patent application for lack of enablement, this is 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 be effective to overcome the objection for lack of enablement. 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. 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 7 reads as follows:

7. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

7. The model answer: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of

obviousness must be commensurate in scope with the claims. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. See *In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Petitioner does not argue that a particular answer is correct. Instead, Petitioner contends that Question 7 does not have a reasonably incorrect answer. Petitioner argues that the model answer cites *In re Geisler* and that the general rule is that facts must be submitted to rebut a *prima facie* case of obviousness. Petitioner contends that in *Geisler*, the results were surprising and the court cites an earlier case of *In re Soni*, stating that “naked attorney argument is insufficient to establish unexpected results.” Petitioner asserts that Answer (D) specifies sound argument and is not, according to case law, incorrect, therefore question 7 should be removed from consideration.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to Petitioner’s assertion that Answer (D) specifies sound argument and is not, according to case law, incorrect, this is not persuasive. Once a *prima facie* case of obviousness is established, the burden shifts to the applicant to provide arguments and/or evidence to rebut the *prima facie* case. See, e.g., *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1901. However, arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). A showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997). Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.”). See MPEP § 716.01(c) and 2144.08 (II. B. *Determining Whether Rebuttal Evidence Is Sufficient to Overcome the Prima Facie Case of Obviousness*). Therefore, although sound argument may not be incorrect, in the instant scenario, it would not be effective to overcome a *prima facie* case of obviousness without the support of factual evidence of unexpected results. Accordingly, model answer (D) is correct and petitioner’s answer 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(l)(3). 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 does not argue that a particular answer is correct. Petitioner contends that he has no idea what section of 35 U.S.C. § 102 the examiner is citing, but states that if the examiner is citing 35 U.S.C. § 102(e), then answer (D) is a proper response. Petitioner contends that 35 U.S.C. § 102(a) may not apply because of domestic priority or foreign

priority, and since neither is mentioned in the questions, it does not stop answer (E) from premising it. Second, given the precise wording of the question, one cannot assume that this reply is the ONLY reply, perhaps the response also in some way removes the 35 U.S.C. § 102(a) rejection. Third, answer (B) is subject to the same defect in that antedating the issue date of the Jones Patent does NOT automatically remove the 35 U.S.C. § 102(e) rejection because the filing date of Jones is the date to beat. The question does say that Jones and Clark do not claim the same invention, but (B) does not indicate which date is being antedated. Therefore question 8 should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 35 U.S.C. § 102(a) may not apply because of domestic priority or foreign priority, this is not well-founded. It should be noted that the Jones patent was issued prior to the filing of the Clark application, and therefore does qualify as prior art under § 102(a). Since 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), the Jones patent cannot be disqualified as a reference via 35 U.S.C. § 103(c), as proposed in answer (D). See MPEP § 706.02(l)(3). With regard to answer (E), this is a proper reply because in perfecting a claim of priority to an earlier filed German application, this would disqualify the Jones reference as prior art. Regarding the contention that "one cannot assume that this reply is the ONLY reply, perhaps the response also in some way removes the 35 U.S.C. § 102(a) rejection," note that in the examination instructions, petitioner was instructed not to make any assumptions, specifically, "Do not assume any additional facts not presented in the questions." Also, the question being asked is "Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?" (emphasis added). Therefore, given the precise wording of the question, petitioner was specifically asked to identify the one reply that would not be in accordance with proper USPTO practice and procedure. Finally, regarding answer (B), note that an affidavit or declaration under 37 CFR 1.131 can be used to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(a), as well as to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e), that shows but does not claim the same patentable invention. The date to be overcome under 37 CFR 1.131 is the effective date of the reference (i.e., the date on which the reference is available as prior art). See MPEP § 715. Accordingly, model answer (D) is correct and petitioner's answer is incorrect.

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

Morning question 42 reads as follows:

42. Applicant Homer filed a non-provisional utility application on December 3, 2001 with 3 sheets of drawings. He received a non-final Office action on the merits on March 1, 2002 rejecting all claims under 35 U.S.C. § 102(b) with reference A and including objections to the drawings. The Office action set a shortened statutory period of 3 months

for reply. Homer wants to submit several references in an information disclosure statement (IDS) for the examiner's consideration. Under proper USPTO practices and procedures which of the following actions, if taken, would avoid abandonment?

(A) Homer timely files a continued prosecution application under 37 CFR 1.53(d) with an IDS and required fees.

(B) Homer timely files a request for continued examination under 37 CFR 1.114 with an IDS and required fees.

(C) Homer timely files a request for suspension of action under 37 CFR 1.103 with an IDS and required fees.

(D) Homer timely files a photocopy of the originally filed claims with proposed amendments marked in red, arguments that support the claims are patentable over the reference, proposed drawing corrections, an IDS, and any required fees or certification.

(E) Homer timely files conclusory arguments that the examiner's rejection is without merit and has no statutory basis.

42. The model answer: (D) is the most correct answer. See MPEP § 714.03. Homer's reply is a *bona fide* attempt to advance the application to final action. The amendment will be considered as a non-responsive amendment because it does not comply with 37 C.F.R. § 1.121. The applicant will be given a new time period of one month or 30 days from the mailing date of the notice of non-compliance to correct the amendment. 37 C.F.R. § 1.135(c); MPEP § 714.03. Answer (A) is incorrect because the application filed on December 3, 2001 is not eligible for the CPA practice. See MPEP § 706.07(h), page 700-71. Answer (B) is incorrect because the prosecution in the application is not closed. A reply in compliance with 37 C.F.R. § 1.111 is missing. See 37 C.F.R. § 1.114(a); MPEP § 706.07(h). Answer (C) is incorrect because action cannot be suspended in an application which contains an outstanding Office action awaiting reply by the applicant. See 37 C.F.R. § 1.103; MPEP § 709. Answer (E) is incorrect because the reply does not meet the requirements of 37 C.F.R. § 1.111 and is not considered a *bona fide* attempt under 37 C.F.R. § 1.135(c). Also the response does not reply to the drawing objections.

Petitioner does not argue that a particular answer is correct. Petitioner contends that the question that should have been asked is "What actions are a *bona fide* attempt to advance prosecution according to proper USPTO practices and procedures?" None of the answers will avoid abandonment without a response to the Notice. The question is not worded well and should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that "None of the answers will avoid abandonment without a response to the Notice" it is unclear what is intended by this argument. Petitioner was instructed by the question to identify "Under proper USPTO practices and

procedures which of the following actions, if taken, would avoid abandonment?." Since answer (D) is the only one of the suggested replies that constitutes proper USPTO practices and procedures for the given fact situation, and it is a *bona fide* attempt to advance the application to final action, it is the only appropriate answer to this question. Accordingly, model answer (D) is correct and petitioner's answer 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 insufficient facts are provided, making this a confusing and ambiguous question. One interpretation is that the original invention was a camera that had two aspects – being waterproof and being capable of operating at high temperatures. Were they unitary in the sense that part of the invention was a single camera capable of doing both, or separate in the sense that the camera could operate in either environment, and the ability to operate in both wasn't significant? This is not clear based on the facts presented, and if it's the former then the non-provisional application of answer A cannot provide priority, and answer (E) provides an acceptable alternative.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the non-provisional application of answer A cannot provide priority, it should be noted that an actual reduction to practice is not a necessary requirement for filing an application so long as disclosure of the invention in the first application and in the second application is sufficient to comply with the requirements of the first paragraph of 35 USC 112. Answer (E) is not the correct answer because Henrietta would not obtain a patent protection for the means that fix the leakage problem. Answer (A) is the correct answer because Henrietta would obtain the broadest patent protection, covering both aspects of her invention, a camera that withstands high temperatures and is waterproof. Answer (A) would also provides the benefit of the filing date of the provisional application for the high temperature aspect of Henrietta's invention. 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.

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 Smarter'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. (A) is incorrect. There must be copendency 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 does not argue that a particular answer is correct. Petitioner contends that the mere fact that the specification would have supported claims is not enough to support a reissue; there must also have been a mistake made. Applicants accept narrower claims because they think it necessary to define over the prior art, or because it is the cheaper alternative. No responsible practitioner would ever give the advice of (E) knowing only

the facts of this question. None of the answers are acceptable and the question should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the mere fact that the specification would have supported claims is not enough to support a reissue; there must also have been a mistake made, such a broadening reissue application is provided for by the statute. 35 USC 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 patentee was entitled. See MPEP 1412.03. Accordingly, model answer (E) is correct and petitioner's answer is incorrect.

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

Afternoon question 26 reads as follows:

26. Jack Flash filed an application for patent on December 16, 1998, disclosing and claiming self-extinguishing safety candles, methods of making them, and a special reflective housing for holding the burning candles. Following a three-way restriction, Mr. Flash prosecuted the claims for the candle, and was granted a patent ("P1"), which issued on April 6, 1999. Mr. Flash filed a divisional application containing claims for the method of making the candles and for the reflective housing on April 5, 1999. The examiner did not restrict the claims, but before the first action on the merits was mailed, Mr. Flash suffered business reversals and canceled the claims to the reflective housing to reduce the cost of obtaining his patent. A patent on the method of making the candles ("P2"), issued on November 30, 1999. Although you reviewed and signed all of the papers in the prosecution of the applications, your assistant, Annie, did all the work under your supervision. On April 1, 2001, Mr. Flash jumps into your office. He has just won a million dollars on some television game show you've never heard of, and he wants to "revive his patents." He is also concerned about an article he tore out of the February 1986 issue of the trade publication Wicks and Sticks, that shows a drawing of a dissimilar candle that would nevertheless raise a question of patentability, with the caption "It's just a dream: it can't be made we've tried a thousand times, don't bother." He also has a video tape first sold by a local hobbyist at his store in October 1999, showing a process of candle making that may be within the scope of his process claims. "But it's such a stupid way to do things - it's expensive and it doesn't work very well- it doesn't even make a safety candle," Jack shouts, jumping on your desk. He is so excited he can barely get the words out. Annie volunteers to work with him to figure out what he can do. On the next day, Friday, April 2, just as you are getting ready to close up and head for the LeTort Creek with your cane rod Annie drops five proposals on your desk. After reviewing

Annie's proposals, but before you leave, you must instruct her to take the action that will best protect Mr. Flash's patent rights. Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?

- (A) File a broadening reissue application on P1, alleging error in failing to claim sufficiently broadly by not filing claims for the reflective housing.
- (B) File a request for reexamination of P1 based on the Wicks and Sticks article.
- (C) File a new, nonprovisional patent application claiming benefit of the filing date of parent application that issued as patent P2.
- (D) File a request for reexamination of P2 in view of the video tape, intending to narrow the process claims to avoid the video tape if the USPTO finds a significant new question of patentability, and seeking to add claims to the reflective housing.
- (E) File a broadening reissue of P2, alleging error in claiming the process too broadly, because it covers the process disclosed on the video tape, and alleging further error in claiming less than the inventor had a right to claim, by not claiming the reflective housing.

26. The model answer: The best answer is (B), because, under the facts as stated, the Wicks and Sticks article "shows a drawing of a dissimilar candle that would nevertheless *raise a question of patentability*" (italics added). Although the published article might not be anticipatory, it can raise a substantial new question of patentability under 37 C.F.R. § 1.515. (A) is incorrect because it is not error to fail to claim restricted inventions that were not elected and that were not claimed in divisional applications. In re *Orita* 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977); MPEP § 1450. (C) is not the best answer because there is no copendency between the new nonprovisional application and parent application that issued as patent P2. 35 U.S.C. § 120. (D) is not correct because a request for reexamination cannot be based on a video tape. (E) is not the best answer because it is not clear there is an "error" under 35 U.S.C. § 251 with respect to the claims for the reflective housing. MPEP §§ 1402, 1450.

Petitioner does not argue that a particular answer is correct. Petitioner contends that the question is not clear as to whether a reexamination is in Flash's best interests and even whether it is possible to do so. Reexamination requires a substantial new question of patentability and the facts of the question do not indicate whether the question of patentability is substantial or new. On top of that the reference makes the invention look nonobvious. Flash will spend a great deal of time and money by filing a reexamination without the appearance of any chance of success. Finally, the reexamination will probably trigger a lawsuit. None of the answers are acceptable and the question should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the question is not clear as to whether a reexamination is in Flash's best interests and even whether it is possible to do so, of the choices provided, answer (B) is the most correct answer. The question asks "Which of the following acts would be in accordance with proper USPTO practice and procedure, and Annie should be authorized to follow?" Since all of the other answers include suggestions that would either not be in accordance with proper USPTO practice and procedure or not make them the best answer for the reasons set forth *supra*, this leaves answer (B) as the most correct answer. Accordingly, model answer (B) is correct and petitioner's answer 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 does not argue that a particular answer is correct. Petitioner contends that answer (B) by itself, is insufficient for proper execution of the declaration; just sending a copy of an application to inventor B without informing inventor B by email, phone or letter that he must read it before signing the application will not result in a proper oath; Inventor B must further be instructed to read the declaration or it has no legal effect. Petitioner asserts that none of the answers are acceptable and the question should be removed from consideration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that "answer (B) by itself, is insufficient for proper execution of the declaration; just sending a copy of an application to inventor B without informing inventor B by email, phone or letter that he must read it before signing the application will not result in a proper oath; Inventor B must further be instructed to read the declaration or it has no legal effect." These arguments are unclear, perhaps petitioner intended to provide these arguments with regard to answer (C). Please note that whether or not Inventor B was provided with instructions to read the application and declaration before signing such is not part of the fact pattern presented in the question. The examination instructions specifically indicated: "Do not assume any additional facts not presented in the questions." The most correct answer is answer (C) because the declaration identified the application and the full name and citizenship of both inventors and a copy of the application was sent to inventor B to review and understand. The other answers had deficiencies which rendered them incorrect, as explained *supra*. Accordingly, model answer (C) is correct and petitioner's answer 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, 2 points have 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