UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re	)	Decision on Petition for Review Under 37 CFR § 10.2(c)

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) dated August 12, 1996, denying Petitioner's request for a higher score on the morning section of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on May 3, 1995 (Examination). The petition is denied.

Background

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both morning and afternoon sections of the Examination. Petitioner scored a 68 on the morning section of the Examination.[1]

[1] As indicated in a Notice (dated September 27, 1995) that was forwarded to Petitioner, two points were added to Petitioner's initial morning Examination score of 66 due to an error in programming the answer key, thus giving Petitioner a score of 68.

On October 25, 1995, petitioner requested a regrade of questions 17 and 44 from the morning section of the Examination. On March 14, 1996, OED denied Petitioner's regrade request adding no points to Petitioner's score.

On April 5, 1996, Petitioner requested reconsideration of the decision denying Petitioner's regrade request for questions 17 and 44. On August 12, 1996, the Director of OED denied Petitioner's reconsideration request adding no points to Petitioner's score.

Petitioner now asks the Commissioner to reverse the Director's decision denying credit for questions 17 and 44, and add four points to Petitioner's morning Examination score.

Opinion

Pursuant to 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions to the morning section state: "No points will be awarded for incorrect answers or unanswered questions." The burden is upon the Petitioner to show that her chosen answer is the most correct answer. Petitioner has failed to meet this burden.

Furthermore, Petitioner's arguments are replete with assumptions that are not supported by the facts presented in the questions. The directions to the morning section 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 agent. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with U.S. patent statutes, the PTO 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 subsequent court decision or a notice in the Official Gazette.

validity of the model answers and the Director's decision. All of petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

QUESTION 17

(B) Yes, by filing an amendment naming Y as a joint inventor and a new oath signed by both X and Y.

(C) Yes, by filing a request for a certificate of correction.

(D) Yes, by filing a continuing application with a declaration signed by X and Y.

(E) Yes, by filing a reissue application with an oath naming both X and Y as the inventors along with a new oath signed by X and Y setting forth how the error arose without deceptive intent.

In the model answer, choice (D) is identified as the correct answer on the basis of 35 U.S.C. § 116; 37 C.F.R. §§ 1.48(a) and 1.324; and MPEP 201.03, 1402, and 1481.

MPEP 201.03, entitled "Correction of Inventorship in an Application," states:

> Correction of inventorship is permitted by amendment under 35 U.S.C. 116. If at least one of the correct inventors has been named in an application but it is discovered that correction of inventorship is necessary, applicants are advised to consider abandoning the application and the <u>filing of a continuing application</u> under 37 C.F.R. 1.53 with the correct inventive entity named. This will eliminate the need for a petition for correction of inventorship under 37 C.F.R. 1.48. See 35 U.S.C. 120 and 37 C.F.R. 1.78 regarding claiming the benefit of the filing date of a prior application.

(Emphasis added). Thus, MPEP 201.03 expressly provides that one can correct inventorship by filing a "continuation application." Therefore, choice (D) is the correct answer. Petitioner,

however, selected choice (B).

One may also correct inventorship by filing an amendment accompanied by (1) a petition, (2) a declaration, (3) the appropriate fee, and (4) a written consent of any assignee. See 37 C.F.R. § 1.48(a). Section 1.48(a) (entitled "Correction of inventorship") states:

> If the correct inventor or inventors are not named in a nonprovisional application through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and <u>must be accompanied by</u>:
>
> (1) <u>A petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred</u>;
>
> (2) An oath or declaration by each actual inventor or inventors as required by § 1.63;
>
> (3) The fee set forth in § 1.17(h); and
>
> (4) The written consent of any assignee.

Therefore, choice (B) is incorrect since it does <u>not</u> include the filing of a petition along with the amendment as required by 37 C.F.R. § 1.48(a).

Petitioner makes several arguments as to why Petitioner believes choice (B) is the correct answer, none of which have merit. Petitioner argues that the statement in the body of the

question "[a]ssuming payment of any fees involved" indicates that a petition was included with the amendment and the oath recited in choice (B). The statement regarding fees simply indicated that the reader need not concern oneself with the appropriate amount of fees that needed to be paid. The reader was told to assume that all fees would be paid for "any" action regardless of the action. This statement did not indicate that a petition accompanied the amendment and the oath of choice (B).

Petitioner next argues that although choice (D) is "correct," it fails to mention 35 U.S.C. § 120 and also fails to indicate that the prior application must be abandoned. First, Section 120 concerns the benefit of the early filing date and is unrelated to the issue at hand (i.e., correction of inventorship). In addition as Petitioner concedes, an application will become abandoned if no action is taken with respect thereto. See 37 C.F.R. § 1.135(a) ("If an applicant of a patent application fails to respond within the time period provided under §§ 1.134 and 1.136, the application will become abandoned . . . ."[2] Moreover, since abandonment has no effect on the change of inventorship, whereas a petition is required to

[2] Petitioner's discussion of 37 C.F.R. § 1.138 is irrelevant since it deals with express abandonments.

change inventorship by amendment, choice (D) is the correct answer.

Finally, Petitioner argues that it is more prudent to correct inventorship by amendment as opposed to filing a continuing application. This is irrelevant to the question at hand because the filing of an amendment alone would not correct inventorship. Quite simply, if one followed the actions recited in choice (B) chosen by Petitioner, inventorship would not be corrected since a petition was not included as is required. Therefore, choice (B) is an incorrect answer; choice (D) is the correct answer.

Petitioner's request for credit on question 17 is denied.

QUESTION 44

Question 44 read as follows:

44. You submitted through the U.S. Postal Service a patent application containing a specification and claims to the PTO which describe amino acid sequences. The application was accompanied by a certificate of mailing under 37 C.F.R. § 1.8 dated May 5, 1994. The application was received by the PTO on May 12, 1994. The name of the inventor was inadvertently omitted and was filed with the PTO on May 15, 1994, along with a petition setting forth the reasons for the delay and the petition and surcharge fees. The amino acid sequences, in Computer Readable Format (CRF) were filed in the PTO on May 20, 1994, and were entered into the case on June 20, 1994. Your application is entitled to a filing date of:

(A) May 5, 1994.
(B) May 12, 1994.
(C) May 15, 1994.
(D) May 20, 1994.
(E) June 20, 1994.

In the model answer, choice (B) was identified as the correct answer on the basis of 37 C.F.R. §§ 1.8(a)(2)(i)(A) and 1.53(b); and MPEP 512 and 601.01.

Section 1.53(b)(1) of 37 C.F.R. states:

> The filing date of an application for patent filed under this section, except for a provisional application, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41.

Therefore, since the question indicates that the "application containing a specification and claims . . . . was received by the PTO on May 12, 1994," choice (B) is the correct answer. See MPEP 601.01(a). Petitioner, however, selected choice (D).

Petitioner argues that choice (D) (May 20, 1994), the date the CRF was filed with the PTO, is the correct answer. However, since a CRF is not a prerequisite to obtain a filing date (as for example a claim is), Petitioner's argument fails.

The presence of a sequence listing is not required for an application to obtain a filing date. MPEP 2429 ("Compliance is

not a filing date issue."). In addition, Section 1.821(g) of 37 C.F.R. provides procedures for the correction of an application that fails to comply with the sequence rules. For example, if a satisfactory listing is not submitted at the time of filing, the PTO sends a notice to the applicant indicating the compliance requirements. Thus, failure to comply with the sequence listing requirements is curable. More importantly, the failure to submit a CRF in no way affects the filing date of an application.

Petitioner argues that the submission of the CRF amounted to the submission of "new matter" and thus a later filing date. Since there is nothing in the question to indicate that the CRF contained new matter, Petitioner's argument fails.

Petitioner's request for credit on question 44 is denied.

CONCLUSION

Petitioner's grade for the morning section will not be changed. The final grade for the morning section is 68 points.

ORDER

Upon consideration of the Petition to the Commissioner under 37 CFR § 10.2(c), it is

ORDERED that the petition is denied.

6-3-97
Date

Lawrence J. Goffney, Jr.
Acting Deputy Assistant Secretary of Commerce
and Deputy Commissioner of Patents
and Trademarks

cc: