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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 2023  
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JAN 5 2001



In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 3, 18, 34 and 40 of the morning section and questions 10 and 28 of the afternoon section of the Registration Examination held on April 12, 2000. 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 July 31, 2000, 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, all regrade requests have been considered in the first instance by the Director of the USPTO.

**OPINION**

Under 37 C.F.R. § 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. Any reference to a practitioner is a reference to 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 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*. 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 which 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," "PTO," or "Office" are used in this examination, they mean the U.S. 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 3, 18, 34 and 40 and afternoon questions 10 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

(A) may indirectly serve as a basis for another multiple dependent claim.

(B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.

(C) may directly serve as a basis for another multiple dependent claim.

(D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.

(E) (B) and (D).

The model answer is choice (E).

Choice (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (D) is correct. Petitioner agrees with the model answer that answer (D) is correct but contends that answer (B) is incorrect because it is untrue that the fee is required before the amendment is entered. Petitioner concludes that answer (E) is incorrect and maintains that answer (D) is correct.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that it is untrue that the fee is required before the amendment is entered, MPEP § 608.01(n) (top of p. 600-65) states that if a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. Accordingly, a fee is required before a multiple dependent claim is entered, rendering (B) correct. Because both (B) and (D) are correct, the statement in answer (E) is most correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?
- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
  - (B) Favoring the prompt and widespread disclosure of inventions.
  - (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
  - (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
  - (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D).

Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

Petitioner argues that (A) is the best answer given that answer (D) is a nonsense statement that cannot not be a policy to anything because nothing extends the effective patent term set by statute. Petitioner admits that in general, answer (A) may be a policy and therefore incorrect, but argues that in certain circumstances, (A) would be correct. Petitioner concludes that answer (D) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (D) is not a correct answer because it is nonsense, statement (D) states that economic value of a patent increases with life of protection. Statement (D) speaks to the effective term, not the statutory term, and is therefore meaningful; the later the patent expires, the more extended is the ending date of the effective term. Petitioner's argument that answer (A) may not be a factor underlying such policy is negated by the holding in *Lough v. Brunswick Corp.*, which states "[w]e have defined "public use" as including "any use of [the claimed]

invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor." *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983) (citing *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881)). An evaluation of a question of public use depends on "how the totality of the circumstances of the case comports with the policies underlying the public use bar." *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 1198, 31 USPQ2d 1321, 1324 (Fed. Cir. 1994), *cert. denied*, 115 S. Ct. 1356 (1995). These policies include: (1) discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available; (2) favoring the prompt and widespread disclosure of inventions; (3) **allowing the inventor a reasonable amount of time following sales activity to determine the potential economic value of a patent**; and (4) prohibiting the inventor from commercially exploiting the invention for a period greater than the statutorily prescribed time." (Emphasis Added.) The statement in answer (D) is the only statement not included among the enumerated factors and is therefore correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 34 reads as follows.

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is true?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

The model answer is choice (C).

As stated in MPEP § 707.05(f), "For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time." (A) is incorrect. The reference supports the rejection inasmuch as each element of the claimed invention is disclosed in the reference. (B), (D), and (E) are not the most correct. MPEP § 707.05(f).

Petitioner argues that none of the answers is correct. Petitioner contends that the question is impermissibly vague and not susceptible to answer because of the vagueness of the term "classified". Petitioner concludes that all answers should be accepted including the petitioner's answer (B).

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the question is impermissibly vague, the question specifically states that the examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. As stated in MPEP § 707.05(f), "For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time." Accordingly, the question is directly spoken to by MPEP 707.05, rendering the question sufficiently clear. The

statement in answer (C) is correct. Petitioner provides no support for answer (B). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 40 reads as follows:

40. Which of the following is **true**?

- (A) Once the claims of a patent application are determined to be invalid by the Board of Patent Appeals and Interferences, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (B) Once the claims of a patent application are determined to be invalid by the Court of Appeals for the Federal Circuit, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (C) Collateral estoppel bars an applicant from filing several applications for obvious improvements of the same invention.
- (D) **The failure of an independent claim in a patent to claim a feature of the invention, which is not found in a genus, results in Jenson estoppel against the inventor claiming the invention with the feature in another patent application.**
- (E) During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims.

The model answer is choice (E).

Since independent claims are the broadest claims in an application, and dependent claims depend on the independent claims, broadening of a dependent claim can not broaden the scope of invention. This logical deduction was also noted in *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir.1997). As to (A) and (B), continuation applications may be filed before application pendency terminates. Moreover, since narrower claims may be patentable, even though the broader claims are determined to be unpatentable, the narrower claims are not barred. As to (C), obviousness-type double patenting prevents several patents from being based upon obvious improvements. As to (D), failure to claim a feature not found in a genus is of no consequence.

Petitioner argues that none of the answers is correct and any answer should be given credit. Petitioner contends that model answer (E) cannot be the correct answer because answer (E) implies that claims may be broadened during reexamination but the rules and regulations prohibit claims from being broadened during reexamination.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (E) implies that claims may be broadened during reexamination, the question specifically states that during reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims. As explained in the instructions, no assumptions beyond the facts given should be made. Accordingly, there is no reason to assume any implication that answer (E) allows broadening of claims during reexamination. Further, petitioner fails to acknowledge the reality that patent owners in reexamination may attempt to broaden claims, although such an attempt would be rejected by the examiner. Answer (E) merely implies that applicants need not be concerned about broadening claims by changes to dependent claims. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam

receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that none of the answers is correct and answer (D) is the at least a good answer among the incorrect answers as any. Petitioner contends that Sam must file something because the claims 2-10 are incomplete because they depend from canceled claim 1. Petitioner does not argue that answer (D) is best.

Petitioner's argument has been fully considered but is not persuasive. Answer (D) is incorrect because there are no divisional reexaminations. Contrary to petitioner's statement that Sam must file something because the claims 2-10 are incomplete because they depend from

canceled claim 1, the question specifically states that the proceedings are those of reexamination. The issue of bankruptcy is not relevant to the reexamination proceeding. Contrary to petitioner's argument, no action is required. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required as per MPEP § 2260.01. The statement in answer (B) is correct and the statement in answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is true?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing

out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (E) is incorrect because there is no requirement to claim foreign priority in the declaration or oath and that answer (C) is correct because an examiner may make a new ground of rejection of claims added after final. Petitioner concludes that answer (E) is incorrect and maintains that answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that there is no requirement to claim foreign priority in the declaration or oath, 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. Petitioner states that this requirement is not a claim for foreign priority, but such a listing is inherently a claim for foreign priority. As to (C), 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8.

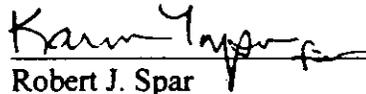
2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

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

This is a final agency action.



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