

R:2001-152



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 2023
www.uspto.gov

JAN 5 2001

In re

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

MEMORANDUM AND ORDER

(petitioner) requests for regrading questions 20 and 29 of the morning section and questions 1, 25, 48 and 49 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 67. On June 23, 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 petitioners' arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded one point for morning question 20. Accordingly, petitioner has been granted an additional point on the examination, resulting in a regraded score of 68.

However, no credit has been awarded for morning question 29 and afternoon questions 1, 25, 48 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 29 reads as follows:

29. You are attorney of record appointed by XYZ Corp. to prosecute a patent application directed to an invention assigned to the XYZ Corp. by an employee-inventor. In the course of prosecution, you receive an Office action rejecting all the claims as anticipated by a patent to Williams. After carefully reviewing the Office action and discussing the same with XYZ officers, it is concluded that the rejection is sound. In accordance with instructions from XYZ officers, you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention, and an express abandonment signed by you under 37 C.F.R. § 1.138. An appropriate PTO official acknowledges receipt and accepts the express abandonment. Shortly thereafter, you receive an urgent call from the employee-inventor, who informs you that she just learned of the action taken to abandon the application, and that she has reviewed the Williams patent and concluded that her invention differs therefrom in a subtle but significant manner. Which of the following courses of action, if any, are properly available to you to successfully revive the application in accordance with proper PTO practice and procedure?

- (A) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was without the inventor's consent.
- (B) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was the result of a mistake.
- (C) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(a) on the ground that the filing of the express abandonment was unavoidable.
- (D) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(b) on the ground that the filing of the express abandonment was unintentional.
- (E) None of the above.

The model answer is choice is (E). None of the above responses are proper procedures to successfully revive an application that has been expressly abandoned.

Petitioner selected answer (D). Petitioner argues that filing a petition is the proper response reinitiating the application process when a mistake has been made in the abandonment of an application. Petitioner argues that as a practical matter the application can be revived because all that is required is to state that the abandonment is unintentional. Petitioner then argues that not enough facts are given because he does not know if the company wants to revive the

In re

application or if the inventor's view is credible to support revival. Petitioner also argues that if the delay between the abandonment and the request to revive is not lengthy then the petition should be granted.

Petitioner's arguments have been fully considered but they are not persuasive. The application cannot be revived and answer (E) is the correct because the express abandonment was the result of a deliberative, intentional course of action. See MPEP § 711.01 and 711.03(c). While, the PTO may generally revive abandoned applications if petitions are filed in a timely manner, the applicant must be able to state in good faith that the abandonment was unintentional. Answer (D) is wrong because MPEP § 711.03(c) recites, "An intentional abandonment of an application...precludes a finding of unavoidable or unintentional delay pursuant to 37 C.F.R. § 1.137. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988)."

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?
 - (A) In a utility case, gross sales figures accompanied by evidence as to market share.
 - (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
 - (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
 - (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
 - (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice is (D). In a utility case, gross sales figures accompanied by evidence of brand name recognition does not constitute probative evidence of commercial success to support a contention of non-obviousness.

Petitioner selected answer (B). Petitioner argues that sales figures coupled with when they were sold without more are irrelevant to the question of commercial success to support a contention of non-obviousness. Petitioner argues that this information tells nothing of the impact the inventive component has on the commercial viability of the product. Petitioner argues that the model answer could be probative evidence because the evidence could show that despite low brand name recognition, the product outsold the other products. Petitioner asserts that "brand name recognition" provides no more or less a logical standard for the determination of commercial success than time period.

Petitioner's arguments have been fully considered but they are not persuasive. The instructions state that test taker is to select the most correct answer. The MPEP § 716.01(c) states "[i]n considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such **success is not the result of heavy promotion or advertising, shift in advertising . . .**" These factors are directly related to brand name recognition, thus choice D is not probative evidence of commercial success. Gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitation of accompanying evidence in (B) is logical in that it provides a comparative basis for determining commercial success. Gross sales figures accompanied by evidence as to time period during which the product was sold constitute probative evidence of commercial success to support a contention of non-obviousness. The time period during which the product was sold is needed to measure with the gross sales data. See

MPEP 716.03(b). Answer (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success.

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice is (B). To properly revoke the power of attorney, Snix, president of Fix Corp. may sign a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forward the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

Petitioner selected answer (D). Petitioner argues that binding a corporation is a matter of applicable state law and that a corporate counsel may therefore have the inherent power to revoke the Power of Attorney. Petitioner asserts that since the exam is supposed to test applicant's knowledge of patent law and U.S. Patent and Trademark Office rules, practice and procedure that this question and answer should be reconsidered.

Petitioner's arguments have been fully considered but they are not persuasive. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an officer having apparent authority. See MPEP 324 and 402.07. Answer (I) is incorrect since Joe is neither a registered practitioner nor an officer of the company, therefore he does not have authority to sign on behalf of the corporation.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice is (D). With respect 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the

properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (B). Petitioner argues that answer (B) contains no more deficiencies to make it less correct than the model answer. Petitioner argues that the ultimate question of validity is one of law and that the 35 U.S.C. § 103 question lends itself to an inquiry of the scope and content of the prior art, the differences in prior art and the claims and the level of ordinary skill. Petitioner argues that the main focus over the years has been the claims. Therefore, the PTO should reconsider and give credit for answer (B).

Petitioner's arguments have been fully considered but they are not persuasive. "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..." *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Art Part of 'As A Whole' Inquiry"). Regarding choice (B), the question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Choice (B) is incomplete in that it ignores the invention as a whole (MPEP 2141.02) and the level of ordinary skill in the art.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 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.



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