

P. 2001-153



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. 20231
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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) requests for regrading questions 9 and 32 of the morning section and questions 3, 10 and 45 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 66. 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 petitioners' arguments have been fully considered. Each question in the Examination is worth one point.



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No credit has been awarded for morning questions 9 and 32 and afternoon questions 3, 10 and 45. Petitioners' arguments for these questions are addressed individually below.



Morning question 9 reads as follows:

9. A non-final Office action contains, among other things, a restriction requirement between two groups of claims, (Group 1 and Group 2). Which of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?

I. Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."

II. Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."

III. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."

IV. Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."

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

The model answer is choice (D). Applicant must distinctly point out detailed reasons why he believes the examiner erred in requiring the restriction, traverse the restriction and make an election to respond to a restriction requirement to preserve the right to petition the Commissioner to review the restriction requirement.

Petitioner argues that (B) is also correct. Petitioner asserts that choice II (making an election and traversing the restriction requirement because the examiner erred in requiring a

restriction) is also a correct answer because this practice would be and has been an acceptable form to respond to the PTO.

Petitioner's arguments have been fully considered but they are not persuasive. Applicant's answer choice is incorrect because choice II does not distinctly point out the supposed errors in the examiner's action. Applicant must distinctly point out detailed reasons why he believes the examiner erred in requiring the restriction to preserve the right to petition the Commissioner to review the restriction requirement. See 37 C.F.R. § 1.111(b); MPEP §§ 818.03(a)-(c). The question ask "[w]hich of the following, if included in a timely reply under 37 C.F.R. § 1.111, preserves applicant's right to petition the Commissioner to review the restriction requirement?"

While applicant's response may be acceptable, it does not preserve the right to petition the Commissioner to review the restriction requirement.

Morning question 32 reads as follows:

32. Nonobviousness of a claimed invention may be demonstrated by:
- (A) producing evidence that all the beneficial results are expected based on the teachings of the prior art references.
 - (B) producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.
 - (C) producing evidence showing that unexpected results occur over less than the entire claimed range.
 - (D) producing evidence showing that the unexpected properties of a claimed invention have a significance less than equal to the expected properties.
 - (E) (A), (B), (C) and (D).

The model answer is choice is (B). Nonobviousness may be demonstrated by producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.

Petitioner argues that answer (C) is also correct. Petitioner argues that nonobviousness of a broader claimed range could be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend and allow the artisan to extend the probative value thereto. Petitioner cites MPEP 716.02(d).

Petitioner's arguments have been fully considered but they are not persuasive. Answer (C) is incorrect because petitioner is not told that one of ordinary skill in the art would be able to determine a trend in the exemplified data, which would allow the artisan to reasonably extend the probative value thereof, thus the citation is inapplicable. Furthermore, the instructions state not to assume any additional facts not presented in the questions. 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. The question is what may demonstrate nonobviousness of a claimed invention and B is the only correct answer with the given facts.

Afternoon question 3 reads as follows:

3. Which of the following is true?

(A) Interferences will generally be declared even when the applications involved are owned by the same assignee since only one patent may issue for any given invention.

(B) A senior party in an interference is necessarily the party who obtains the earliest actual filing date in the PTO.

(C) Reexamination proceedings may not be merged with reissue applications since third parties are not permitted in reissue applications.

(D) After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.

(E) None of the above.

The model answer is choice is (D). After a reexamination proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate by ordering a copy of the patent.

Petitioner argues that answer (B) is correct. Petitioner argues that 37 CFR § 1.601(m) provides that the senior party is the party with the earliest filing date, not the earliest effective filing date as stated in the model answer. Petitioner argues that if one party has been accorded an earlier filing date with one count and the other party has been accorded the earlier filing date with another count, then the senior party is the party with the earliest date.

Petitioner's arguments have been fully considered but they are not persuasive. The question is which statement is true. Choice (B) states that a senior party in an interference is necessarily the party who obtains the **earliest actual filing date** in the PTO. This is false, because it does matter whether the filing date is the actual filing date or the effective filing date. If one party has the earliest effective filing date with respect to all counts, then that party is the senior party. 37 C.F.R. § 1.601(m) does not necessarily provide that the senior party is the party with the earliest filing date, as argued by petitioner, it states that "[a] senior party is the party with the earliest effective filing date as to all counts or, if there is no party with the earliest effective filing date as to all counts, the party with the earliest filing date. A junior party is any other party." Choice (D) is true, because after the proceeding is terminated and the certificate has issued, any member of the public may obtain a copy of the certificate. See MPEP § 2292.

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 is (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

Petitioner's selected answer (E). Petitioner argues that a patent attorney should contact his client upon being notified by the client that he no longer has funds available for representation. Petitioner argues that the best answer is choice E, because then the client can decide if it wants to continue to pay for representation. Petitioner further argues that the question did not suggest that Sam is seeking to withdraw his representation as suggested by the model answer.

Petitioner's arguments have been fully considered but they are not persuasive. The attorney has been told by his client that he does not have funds to continue prosecution. If the attorney does nothing, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since the attorney agrees with the rejection of claim 1, the client is neither prejudiced, nor adversely affected. An amendment incorporating the limitations of independent claim 1 into the dependent claims 2-10 is not

required. The facts state that Sam received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client. Hurley Corp. then advised Sam that they had no funds available to further prosecute the reexamination proceeding. Thus, the client was aware of the office action and Sam's agreement with the Examiner. Choice E is improper because it states that Sam would take no further action in the proceeding and file no papers with the PTO unless he was paid, when no further action was necessary. Since this is a **Reexamination proceeding** and claims 2-10 are objected to, they are allowable over the art of record.

Afternoon question 45 reads as follows:

45. You obtained a patent for inventor Jones. The patent, although disclosing a use for her invention, and the best mode contemplated by Jones at the time the application was filed for making and using her invention, through error and without deceptive intent, failed to describe an embodiment of her invention. The embodiment has become a commercial success. Eighteen months after the patent issued, you filed a reissue application adding a claim and new, necessary supporting disclosure directed to the omitted embodiment, together with Jones' declaration explaining the error, and other required papers. In accordance with proper PTO practice and procedure:

- (A) The claim is subject to a new matter rejection under 35 U.S.C. § 132.
- (B) The specification is subject to rejection under 35 U.S.C. § 101 for failure to disclose the best mode for achieving commercial success.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

The model answer is choice is (C). The claim is subject to a new matter rejection under 251 and a first paragraph rejection.

Petitioner's selected answer (A). Petitioner argues that a claim is subject to 35 U.S.C. § 132 new matter rejection if new matter is inserted into the specification to support a claim. Petitioner further argues that the a patent may not be reissued on an application filed to insert a new feature.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (A) is incorrect because a rejection for new matter in a reissue application must be made under 35 U.S.C. § 251, not 35 U.S.C. § 132. Matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251. The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Any change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942). See MPEP § 1411.02.

No error in grading has been shown as to morning questions 9 and 32 and afternoon questions 3, 10 and 45. Petitioner's request for credit on these questions is denied.

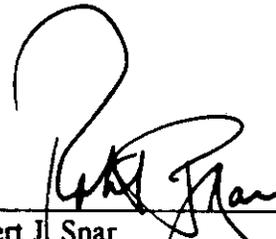
The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model 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 point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. 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