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UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

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, 11, 18, 19, 39 and 44 of the morning section and questions 10, 12, 14, 16, 28, 36 and 48 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 65. On June 26, 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.

Petitioner has been awarded two points for morning questions 19 and 44. Accordingly, petitioner has been granted an additional two points on the Examination. However, no credit has been awarded for morning questions 3, 11, 18 and 39 and afternoon questions 10, 12, 14, 16, 28, 36 and 48. 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 (B) is also correct. Petitioner contends that answer (D) is incorrect because multiple dependent claims do not incorporate all of the limitations of all of the claims to which they refer and further such claims may have a singular limitation whereas the question uses the plural form. Petitioner concludes that answer (E) is incorrect and maintains that answer (B) is correct.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that multiple dependent claims do not incorporate all of the limitations of all of the claims to which they refer, answer (D) specifically states that a multiple dependent claim is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers. The statement states that each limitation, not all limitations, are incorporated. As to the singular versus the plural form, the phrase “all the limitations” will be, in fact singular, where only one limitation exists. The statement in answer (D) is correct and therefore answer (E)

is the best answer because it states that both (B) and (D) are true. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While traveling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The model answer is choice (E).

Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

Petitioner argues that (B) is correct, but not (A) or (C). Petitioner contends that (A) is incorrect because the invention was neither conceived nor reduced to practice in Canada and that (C) is incorrect because the article was published before the invention was reduced to practice.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (C) is incorrect because the article was published before the invention was reduced to practice, the answer (C) specifically states that Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article. Accordingly, the question asks about establishing a date of invention, which 35 USC 104 allows activities in a NAFTA country to be considered in establishing, not a date of reduction to practice, rendering answer (C) correct. Similarly, answer (A) states that activities in Germany may be considered, which is correct because Germany is a WIPO country. Neither answer (A) nor (C) ask about the conclusion to be drawn, but merely what activity may be considered. Neither of those answers even mention whether the activities were relevant, only that they might be considered. Both (A) and (C) are true, as is (B) and therefore (E) is the best answer for stating that (A), (B) and (C) are 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 answer (C) is correct. Petitioner contends that *Lough* is outside the scope of the examination because it is not cited in the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that *Lough* is outside the scope of the examination because it is not cited in the MPEP, the instructions specifically states that 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*. Although (C) refers to use, it is specifically cited by *Lough*. Accordingly, *Lough* is within the scope of the examination as a court decision enunciating the policy behind the U.S. patent statutes, rendering answer (C) incorrect.

The statement in answer (D) is correct because extending patent term is not a policy underlying any section of 35 U.S.C. § 102. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 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." (E) is incorrect because a (C) is correct.

Petitioner argues that (A) is correct and (C) is incorrect based on the MPEP version available at the time of the examination. Petitioner contends that the MPEP available at the time of the examination did not discuss that arguments alone can cause surrender of subject matter.

Petitioner argues that the model answer (C) includes the case where the limitation now being omitted or broadened in the present reissue was originally argued in the original application to make the claims allowable over a rejection or objection made in the original application, which the prior version of the MPEP was silent on. Petitioner argues that (A) is correct because the limitation added is the same as required in the original application so that the reissue claims are of

the same scope as those canceled from the original application. Petitioner concludes that answer (C) is incorrect and maintains that answer (A) is correct because of that omission from the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the answer (A) is the best given the information in MPEP available at the time of the invention, the instructions specifically state that 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*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture. The statement suffix in answer (C) is correct. (A) is incorrect because limitations added to make claims allowable in an original application, will continue not broaden the scope of claims when added during reissue; i.e. answer (A) refers to limitations added to rather than removed from claims in reissue. 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 (E) is correct and (B) is incorrect. Petitioner contends that a responsible attorney would remind the applicant of their financial responsibility and (E) is the same as (B) but also reminds the applicant of their financial responsibility. Petitioner concludes that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to remind the applicant of their financial responsibility, the answer (E) specifically states that the attorney advises the applicant that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO. Answer (E) is more than a reminder, it is a statement of intended action and Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. 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. Given that no action is required and a registered practitioner would know not to threaten to withdraw representation absent PTO permission, the statement in answer (B) is correct and the statement in answer (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

(A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.

(B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.

(C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.

(D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.

(E) (B) and (C).

The model answer is choice (E).

Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. However, since protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. As to (D), since the inventorship is not correct, and was deceptively filed, the issued patent is likely to be declared invalid and he would not recover any royalties. (A) is incorrect because Clem is misrepresenting that he believes himself to be the sole inventor, whereas he has admitted that the invention "was partly Tine's idea." 37 C.F.R. § 1.56.

Petitioner argues that (B) is the best answer. Petitioner contends that the singular "the proper advice" precludes plural (E) as an answer and that between (B) and (C), (B) is the better answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the singular "the proper advice" precludes plural (E) as an answer, the question specifically states which of the following is the proper advice, clearly admitting singular or plural. Accordingly, (C) is also correct because protests may be filed pursuant to 37 C.F.R. § 1.291, rendering 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 14 reads as follows:

14. A practitioner submitted a new patent application to the PTO using the Express Mail service of the U.S. Postal Service. The PTO never receives the new patent application. Which of the following is not necessary to comply with the requirements for receiving the date of deposit with the U.S. Postal Service as the filing date?

- (A) A petition showing that the number of the Express Mail mailing label was placed on the application before the application was sent.
- (B) A true copy of the new application showing certificate of mailing thereon signed by the practitioner's secretary stating when the correspondence was deposited with the U.S. Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.
- (C) A true copy of the of the Express Mail mailing label showing the "date-in" or other official notation entered by the U.S. Postal Service.
- (D) A true copy of the new application showing the number of the Express Mail mailing label thereon.
- (E) A true copy of any returned postcard receipt.

The model answer is choice (B).

Certificate of mailing is not required for Express Mail. See 37 C.F.R. § 1.10(e); MPEP 513 at 500-47. As to the others see 1.10(e) or MPEP 513 at 500-49. (A), (C), (D) and (E) are necessary to comply with the provisions of 37 C.F.R. § 1.10(e).

Petitioner argues that answer (E) is correct. Petitioner contends that because the application was never received, no postcard is available and cannot be required. Petitioner further argues that (B) is incorrect because 37 CFR 1.10(e) applies only where correspondence was mailed with sufficient postage and addressed as set forth in 37 CFR 1.1(a). Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that because the application was never received, no postcard is available

and cannot be required, 37 CFR 1.10(e) specifically states that a copy of any returned post card receipt is required, i.e. if any post card receipt is received by applicant, a copy must be submitted. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, there is no reason to assume that incorrect postage was applied or that the application was improperly addressed, rendering answer (B) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

(A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

(B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

(C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

(D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the question is improper because the model answer is subjective in light of a purported omission in the MPEP on the examined point and that none of the cited cases support (B). Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, 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*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law. *International Glass* stated at 442, “[t]he fact of near simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.” *Merck* stated at 380, “[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’” *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983).” *Monarch Knitting* stated at 1983, “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art”, referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct. Although petitioner argues that the statement in *Merck* is mere dicta, that does not mean there is no legal effect, or that the same statement was not held in the other cases. 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 (A) is correct and (E) is incorrect. Petitioner argues that answer (A) is correct because separate argument alone is sufficient to preclude appealed claims rising or falling together. Petitioner also argues that answer (E) is incorrect because MPEP § 201.14(b) makes the location of the claim to foreign priority permissive rather than mandatory. Petitioner concludes that answer (E) 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 when desiring to claim foreign priority, the oath or declaration in a reissue application need not claim foreign priority even though the priority claim was made in the original patent because MPEP § 201.14(b) is permissive, 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.

As to answer (A), that answer states each appealed claim stands or falls separately as a **result of** appellant pointing out differences in what the claims cover. This answer states that it is sufficient to point out differences to have claims stand or fall separately and the answer is silent on argument of each claim. As shown in the model answer, this is not sufficient, rendering answer (A) incorrect. 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 36 reads as follows:

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

(A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.

(B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

(C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.

(D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.

(E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

As to (B), see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that all answers are incorrect and any answer should be given credit.

Petitioner contends that 37 CFR 10.11(b), which authorizes the Director of Enrollment and Discipline at any time sending out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, removing the name from the register, is unconstitutional for lack of notice or due process, although petitioner provides no case citations supporting this conclusion. Petitioner concludes that answer (B) is incorrect, as are all the others, and maintains that all answers should be given credit.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that 37 CFR 10.11(b), which authorizes the Director of Enrollment and Discipline at any time sending out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, removing the name from the register, is unconstitutional for lack of notice and due process, 37 CFR 10.11 specifically states that the names will be removed after mailing to the last known address (i.e. notice and due process) and will be reinstated as may be appropriate (due process). Answer

(B) is an administrative procedure to ensure addresses of registered practitioners are accurate, in view of practitioners' duty to keep the Office informed of address changes, 37 CFR 10.11(a).

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

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 (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("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..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Art Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

(B) is incorrect. MPEP 2141.02. 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).

(C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

(E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that (B) is correct and (D) is incorrect. Petitioner contends that answer (B) is incorrect because properties inherent in the subject matter may not be considered if they are not disclosed in the specification or known to one of ordinary skill in the art. Petitioner provides an extensive grammatical critique of answer (D) to show that the answer has two independent assertions that consideration is given to the properties of the subject matter which are inherent in the subject matter and that consideration is given to the properties of the subject matter disclosed in the specification, and petitioner contends the first of these two contentions is incorrect. Petitioner contends that answer (B) is correct because it is part of the *Graham v. Deere* factual inquiry.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) is correct although incomplete because it is part of the *Graham v. Deere* factual inquiry, answer (B) states "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." As petitioner correctly notes, the differences form a part of but

do not form the entire *Graham v. Deere* inquiry. Answer (B) states that it **resolves**, i.e. answers the entire inquiry, which is incorrect.

As to answer (D), contrary to petitioner's statement that consideration is not given to subject matter that is inherent but disclosed or known to one of ordinary skill, the model answer's cited case *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977), specifically states that "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...**" (Emphasis added.) This shows the correctness of answer (D) and negates petitioner's arguments both by stating that consideration is given to the invention as a whole, which necessarily incorporates all properties, and by grammatically mirroring answer (D). To the extent answer (D) is subject to multiple interpretations, so is the case that demonstrates the correctness of answer (D). Therefore, answer (D) cannot be negated on grammatical grounds. Further *Antoine* and MPEP § 2141.02 both state that the invention as a whole is considered which necessarily includes inherent properties. Accordingly, answer (D) is correct and answer (B) is incorrect. 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

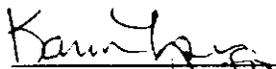
Model Answers was not arbitrary and capricious.” *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 67. 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