

Question 9 asked whether and why a rejection is proper or improper where X invented a compound Y useful for treating HIV patients. The question indicates inventor X attended a conference on AIDS in Chicago on Dec. 2, 1995, and gave an oral presentation specifically identifying compound Y and its method of use in treating HIV patients. An article was published in the local newspaper on Dec. 3, 1995, disclosing compound Y and its use in treating AIDS, including teaching each and every element of compound Y. Neither X's paper nor the newspaper article disclosed how to make compound Y. Inventor X filed a patent application on January 6, 1997, claiming compound Y. The Examiner rejected the claim as being anticipated by the newspaper article in view of two patents that issued in 1994. Those two patents teach methods of making compounds of the same general class as compound Y and describe methods to make Y. The patents disclosed using the compounds to digest food. The correct answer is choice D: that the rejection is proper because the article describes compound Y, and the patents evidence what was in the public's possession regarding how to make compound Y.

Petitioner asserts two possible answers for question 9: D and E. The premise of the question was that to be used as prior art, a reference must be fully enabled: it must teach how to make and use the invention. Petitioner correctly states that "[t]he determining point is whether in the instant situation additional references are necessary." Answer "D" states that the references are necessary, answer "E" states that the references are superfluous. Section 102 of title 35 states that: "A person shall be entitled to a patent unless...": it is always the burden of the PTO to show why an individual should not be given a patent. As set forth in *In re Donohue*, 226 USPQ2d 619, 621 (Fed. Cir. 1985): "It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention.

Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.” [citations omitted].

Thus, to be effective as prior art, the PTO must show that the prior art taught how to make and use the invention. As stated in the question, neither the oral presentation nor the Chicago Tribune article taught how to make compound Y. Without evidence that one of ordinary skill would have been able to make the article, the oral presentation and the Chicago Tribune article did not put the invention into the hands of the public. The PTO cannot reject a claim based upon a reference that does not put the invention into the hands of the public. The patents provided the necessary evidence of enablement of the invention and are needed to sustain the PTO’s position. Thus, answer D is the only correct answer.

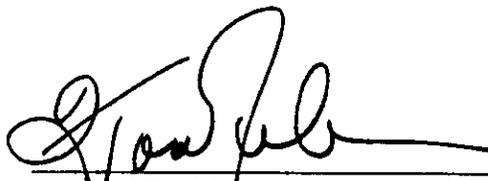
Petitioner’s argument--that because the applicant himself disclosed the non-enabled invention, the patents are superfluous--is not convincing, nor has petitioner pointed to any case law suggesting that an applicant is held to a higher standard than “one of ordinary skill in the art.” Therefore, the Petitioner has not carried his burden of showing that his answer is correct and that the deductions were improper.

Petitioner has also challenged the answer to question 34. Question 34 provided a list of claims and asked how many claims an applicant would be charged for. Complicating the issue was the presence of an improper multiple dependent claim. According to MPEP 608.01(n), such a claim counts as a single claim for fee calculation purposes. Petitioner argues that a competent practitioner would not file the improper multiple dependent claim and would not be charged for the claim that he did not file. This response does not follow the instructions. Those instructions indicate that “The following claims are included in a newly filed patent application.” Petitioner’s view that some of the claims would not be filed assumes there is a choice as to how many claims to file. Such an assumption requires facts that were not provided by the problem. The instructions specifically preclude assuming facts not provided for. Petitioner’s suggestion

that this is an inappropriate question is not persuasive. While petitioner may never be guilty of filing improper multiple dependent claims, practitioners may be required to prosecute cases that they did not draft and submit. A competent practitioner must be able to not only file applications, but also to assist inventors with all phases of prosecution, including prosecuting applications initially filed by others. This would include the ability to identify when an inventor has been overcharged or undercharged. Thus, it is necessary that an agent be able to calculate the proper cost for "a newly filed application." Therefore, no error is found in the Director's determination of Petitioner's score.

ORDER

Upon consideration of the petition to the Commissioner, it is ORDERED that the petition is denied, the decision of the Director of OED is affirmed, and the Petitioner's score for the morning section remains at 66 which is insufficient to pass the morning section of the examination.



Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks

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