

incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The Registration Examination Directions include the following statement:

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 considered.

Question 3:

Two points are awarded for question 3.

Question 5:

Two points are awarded for question 5.

Question 10 reads as follows:

10. Applicant claims the following container lid combination:

1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under 35 U.S.C. § 102. Which of the following replies to the question would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

Choice (C) is the most correct answer because amending the claim to add specific structural dimensions or other limitations is most likely to distinguish Claim 1 from prior art X. MPEP § 2114. Choice (E) is incorrect because an amendment such as proposed in choice (C) is likely to overcome the rejection and result in issuance of the claim. Choice (A) is incorrect because analogous art is not a consideration for an anticipation rejection under 35 U.S.C. § 102. *See In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“the question whether a reference is analogous art is irrelevant to whether that reference anticipates”); MPEP § 2131.05. Choice (B) is incorrect because

dispensing candy pieces as mentioned in Claim 1 is merely a functional description that does not structurally distinguish Claim 1 from X, which can be used to dispense liquids or solids. In *Schreiber*, claims directed to a funnel top for a popcorn dispenser were not successfully distinguished over a prior art oil funnel on the grounds that the claimed top was used for popcorn because the oil funnel inherently performs this function. *Schreiber* at 1479, 44 USPQ2d at 1433 (“declaration fails to show that [anticipating reference] inherently lacks the functionally defined limitations recited in claim”). Choice (D) is incorrect because choices A and B are incorrect.

The correct answer is choice (C) and Petitioner selected choice (E). Petitioner contends that “[s]pecific limitations [in (C)] could be functional, which under MPEP 2114 would not structurally limit the apparatus claim, hence it would be held invalid under 35 U.S.C. § 102.”

Petitioner’s arguments are not persuasive. Petitioner misreads choice (C) and speculates that the specific limitations mentioned could be functional. The text in choice (C) indicates that the specific limitations intended are “specific limitations to the dimensions.” (Emphasis added). The specific limitations are expressly stated to be structural, not functional. Thus, Petitioner’s argument that the “specific limitations could be functional” is wrong. Based on the facts provided in the question, amending Claim 1 to add specific limitations to the dimensions of the dispensing top is the most correct answer. That is, the strategies proposed by choices (A) and (B) are less likely to result in overcoming the rejection and issuance of the claim than the strategy in choice (C). MPEP § 2114 provides that “[e]ven if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.” See

also *In re Danyl*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) (claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function). The strategy in choice (C) is thus more likely to overcome the rejection and result in issuance of the claim than the strategy in either choice (A) or (B). No error in grading has been shown. Petitioner's request for credit on Question 10 is denied.

Question 22 reads as follows:

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.
- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.
- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because each of claims (A) – (C) is in proper format.

The correct answer is choice (E) and Petitioner selected choice (A). Petitioner contends that “answer ‘A’ is claim [sic] is ‘not in proper format,’” based on MPEP

§ 2173.05(e), entitled Lack of Antecedent Basis. According to Petitioner, “Answer ‘A’ lacks a definite article.” Petitioner proposes that the claim should read, in part, “wherein the two side walls are joined to the front and **[the or said]** rear walls.” (Petitioner’s emphasis). Petitioner argues “[a]lternatively, the claim lacks enablement under 35 U.S.C. § 112 and should read . . . wherein the two side walls are joined to the front and **[said side] rear** walls.” (Portions omitted).

Petitioner’s arguments are not persuasive. Petitioner provides no explanation supporting the argument that “Answer ‘A’ lacks a definite article.” There is no reason that choice (A) needs the definite article Petitioner proposes because the meaning of the claim is clear without it. The portion of the MPEP quoted by Petitioner states, in part, “[i]f the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” The scope of the claim in choice (A) would be reasonably ascertainable by those skilled in the art. Petitioner provides no evidence or reasoning to support a contrary determination. Petitioner argues that there is an enablement problem in choice (A) but fails to identify any enablement problem. There is no enablement problem. Petitioner’s proposes to cure the purported problem with an amendment replacing “rear” with --said side--. However, the proposed amendment would introduce confusion because the amended claim would say the two side walls are joined to themselves. No error in grading has been shown. Petitioner’s request for credit on Question 22 is denied.

Question 25 reads as follows:

25. Which of the following is false?

- (A) The meaning of terms in a claim should be ascertainable by reference to the description in the specification.

- (B) While a term used in a claim may be given a special meaning in the description, no term may be given a meaning repugnant to the usual meaning of the term.
- (C) Trademarks may be used in claims only if each letter in the trademark is capitalized.
- (D) Claims may not contain tables or chemical or mathematical formulas.
- (E) Figures may be incorporated by reference in the claims.

Both choices (C) and (D) contain false statements and are, therefore, correct answers. Choice (C) is a false statement because capitalization alone is not enough to constitute proper use of a trademark in a claim. Trademarks should be identified by capitalizing each letter of the mark. See MPEP § 608.01(v). However, as discussed in MPEP § 2173.05(u), a claim should be carefully analyzed to determine how a trademark is used in the claim. “If the trademark . . . is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph.” *Id.* citing *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). In such a case, the claim scope is uncertain since a trademark is a source identifier, not an identification of a particular material or product. “If a trademark . . . appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed.” MPEP § 2173.05(u). Thus, it is not true that trademarks may be used in the claim **only if** each letter in the trademark is capitalized. Claims may contain chemical or mathematical formulas and, if necessary, may contain tables. 37 C.F.R. § 1.58(a). Thus, choice (D) is a false statement.

Both choices (C) and (D) are correct answers and Petitioner selected choice (E). Petitioner contends that the statement in choice (E) “is in conflict with 37 CFR 1.58.” According to Petitioner, 37 C.F.R. § 1.58 states that “The specification, including the

claims, may contain chemical and mathematical formulas, but **shall not contain drawings or flow diagrams.**” (Emphasis by Petitioner.) Petitioner concludes, therefore, that “answer E is ‘false’ as required by the question because drawings are not allowed by 37 CFR 1.58.”

Petitioner’s arguments are not persuasive. Petitioner has misread the statement in choice (E). The statement “[f]igures may be incorporated by reference in the claims” does not mean a claim may contain a drawing. (Emphasis added). The statement means a claim may contain a reference to a drawing, not the drawing itself. Figures may be incorporated by reference where necessary. See MPEP § 2173.05(s); *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Int. 1993). Thus, choice (E) is a true statement and not a correct answer to the question asked. No error in grading has been shown. Petitioner’s request for credit on Question 25 is denied.

Question 30 reads as follows:

30. Which of the following requirements of 35 U.S.C. § 112 do NOT apply to design patent claims?
- (A) The written description requirement of the first paragraph.
 - (B) The best mode requirement of the first paragraph.
 - (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.
 - (D) The requirement in the third paragraph for an independent claim.
 - (E) None of the above.

Choice (E) is correct. 35 U.S.C. § 171 provides “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided.”

Petitioner contends that choice (A) is the most correct answer because 37 C.F.R. § 1.153 provides “No description ... is ordinarily required.”

Petitioner's argument is not persuasive. Petitioner's quotation of Rule 1.153 omits an important phrase. The sentence in its entirety reads "[n]o description, other than a reference to the drawing, is ordinarily required." (Emphasis added). The correct interpretation of the Rule is that the duty to provide a written description of the invention to support a design claim is ordinarily satisfied by a reference to the drawing. The Rule does not discharge design patents from the requirement to provide a written description. It provides guidance that compliance with the written description requirement of 35 U.S.C. § 112 is usually by a simple reference to the drawing. Note that the Rule does not preclude a requirement for further description in some cases. No error in grading has been shown. Petitioner's request for credit on Question 30 is denied.

Question 32 reads as follows:

32. Applicant's patent application is directed to a light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend having a set point activated by ultraviolet light. The polymer is made from at least 60% by weight monomer X, and at least 0.1% by weight monomer Y. 74%, 79%, and 85% are exemplary weight percentages of monomer X, with the respective weight percentage balances of the polymer being monomer Y. Set point is defined as the phase change when the amorphous polymer transforms to a hard, rigid, enamel-like state from a soft, flexible, rubbery state. The set point is directly related to the types of monomer selected and monomer proportions selected. A prior art reference properly cited against the application discloses a dental reconstruction compound comprised of polymer and non-reactive metal blends made from the same monomers, and the same proportions as that disclosed by Applicant. The prior art reference does not disclose the method of inducing a set point by exposing the compound to ultra-violet light. The reference compositions are disclosed as being used in veterinary dentistry. Which of the following claims, if any, is (are) patentable over the reference?

- (A) A light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising at least 60% by weight monomer X, and at least 0.1% by weight monomer Y, wherein a set point is induced using ultra-violet light.

- (B) A light sensitive dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising 74% by weight monomer X, and the balance monomer Y, wherein a set point is induced using ultra-violet light.
- (C) A dental reconstruction compound comprising a polymer and non-reactive metal blend, said polymer comprising 79% by weight monomer X, and the balance monomer Y, wherein a set point is induced using ultra-violet light.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because claims (A), (B) and (C) are drawn to the unpatentable composition. In composition claims, where the claimed and prior art products are identical or substantially identical, a prima facie case of either anticipation or obviousness has been established. *See In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). None of claims (A), (B) or (C) is patentable over the reference because none is drawn to a novel method or process.

Petitioner contends that choice (B) is the most correct answer because it includes a new limitation “wherein a set point is induced using ultra-violet light” and that this makes the claim in choice (B) a “product by process claim.” Petitioner maintains that “[t]he end product is produced through irradiation of ultra-violet light.” According to Petitioner, “[t]he claim describes a ‘set’ product created by using the process of irradiation” and “the ‘set’ product by process is distinguishable over the unset product.” Petitioner reasons that the “product by process claim is patentable over the prior art.”

Petitioner’s arguments are not persuasive. Claim (B) is not a product-by-process claim because it is directed to the unpatentable composition. Contrary to Petitioner’s argument, claim (B) is not drawn to a “set” product because it is drawn to “light sensitive dental reconstruction compound.” Using Petitioner’s terminology, the claim is drawn to

the “unset product” because the claim states the compound is still light sensitive. In other words, the light sensitive dental reconstruction compound has not been exposed to ultra-violet light that could transform it to a set product. No error in grading has been shown. Petitioner’s request for credit on Question 32 is denied.

ORDER

Four points have been added to Petitioner’s score in the Afternoon Section of the Examination. Therefore, Petitioner’s score is adjusted to 68. This score is insufficient to pass the Afternoon Section of the Examination.

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

This is a final agency action.



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