

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section 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 considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question 1 reads as follows:

1. As patent counsel for the National Pharmaceutical Company (NPC), you prepared and filed in the PTO a patent application for an improved medication for treating osteomyelitis, an infectious inflammatory bone disease. The application listed John Jones, an NPC research biochemist who is obligated by an employment contract to assign all inventions to NPC, as the sole inventor. The specification referenced a prior art medication containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds used in the treatment of osteomyelitis, and noted that its use was often accompanied by nausea and muscle cramps. Comparative test data set forth in the specification revealed that the negative side effects of the use of the prior art medication could be essentially avoided by limiting the metal ion to a metal ion selected from the group consisting of osmium (atomic number 76), iridium (atomic number 77), platinum (atomic number 78), and gold (atomic number 79). Following several years of prosecution, the application issued as a patent on February 24, 1998, with the following single claim:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of osmium, iridium, platinum, and gold.

On February 10, 1998, Jones submitted an invention disclosure to you containing test data demonstrating that when iridium, platinum, or gold, as contrasted with osmium, is selected for the metal ion of the aforementioned organic compound, half as much organic compound is required to be effective in the medication for treating osteomyelitis. You then prepared and filed on February 23, 1998, a continuation-in-part application in the PTO on this discovery. In the first Office Action the primary examiner rejected the following claim on the ground of "statutory type" double patenting over the Jones patent based on 35 U.S.C. § 101:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of iridium, platinum, and gold.

Which of the following actions should overcome the examiner's rejection in accordance with proper PTO practice and procedure?

- (A) File a reply traversing the rejection and arguing that the same invention is not being claimed because the patent claim is broader than the rejected claim. Therefore, the patent claim can be infringed without infringing the rejected claim.
- (B) File an amendment rewriting the claim in accordance with 37 CFR § 1.121, and adding the corresponding atomic number immediately following the recitation of each metal ion.
- (C) File a terminal disclaimer under 37 CFR § 1.321.
- (D) File a declaration of prior invention under 37 CFR § 1.131.
- (E) File a reply traversing the rejection and arguing that 35 U.S.C. § 103(c), does not preclude patentability because "the subject matter and the claimed invention, were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The correct answer is (A) and Petitioner selected answer (C). The question inquires which of five actions should overcome an examiner's rejection in accordance with proper PTO practice and procedure. Choice (A) is the most correct answer in view of 37 C.F.R. § 1.111(b) which reads "[t]he reply by the applicant . . . must . . . distinctly and specifically point[] out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." In *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), the Court stated: "By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine,' because the former is broader than the latter . . . [a] good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." 422 F.2d at 441, 164 USPQ at 621-22; see also MPEP § 804, Part II A. Thus, the rejection is improper which needs to be pointed out by the applicant, as choice (A) indicates.

Petitioner contends that answer (C) is as correct as answer (A). Choice (C) is an incorrect answer. See MPEP § 804.02 (“A terminal disclaimer is not effective in overcoming a statutory double patenting rejection”). Petitioner correctly points out that statutory double patenting is inappropriate in the given factual circumstances and if obviousness-type double patenting exists, a terminal disclaimer must be filed. This argument, however, neither points out any errors in the grading of his examination nor shows that choice (C) conforms to proper PTO practice and procedure. As Petitioner’s argument indicates, the examiner’s statutory double patenting rejection is erroneous. Filing a terminal disclaimer is not the appropriate response for overcoming a standing statutory double patenting rejection. The response in (C) therefore does not comply with 37 C.F.R. § 1.111 inasmuch as it offers no reply traversing the rejection by pointing out the error in the standing statutory double patenting rejection. Thus, no grading error has been shown.

Question 2 reads as follows:

2. Your client, Mr. Jones, asked you to prepare a patent application for his new pasta maker. The key features of the invention are the different types of dough which can be used and the shapes of the pasta which can be made. The completed application was filed on Monday, May 18, 1998. After filing the application, you conducted a prior art search and found a published article by another which was published on May 16, 1997. The published article discusses a pasta maker very similar to your client’s pasta maker. In the course of your search, you also found a few patents, but none as pertinent as the article. You file all of the prior art in an Information Disclosure Statement on June 8, 1998. In your opinion, the article is the best available prior art. Assuming that this is true, under which of the following sections of Title 35 U.S.C., if any, would Mr. Jones not be entitled to a U.S. patent?

- (A) 102(a)
- (B) 102(b)
- (C) 102(d)
- (D) 102(e)
- (E) None of the above.

Choices (A) and (E) are correct answers. Petitioner selected answer (B). Both (A) and (E) are considered correct answers in light of the statement that the “published article discusses a pasta maker very similar to your client’s pasta maker.” As explained in MPEP § 706.02, “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” The phrase “very similar” can be understood to mean that the published article explicitly or impliedly discloses every aspect of the claimed invention. Under this interpretation, (A) is correct because the published article is prior art under 35 U.S.C. § 102(a) (used to reject claims to an invention that “was known . . . by others in this country, or . . . described in a printed publication in this . . . country, before the invention thereof by the applicant for patent”).

The phrase “very similar” could also be taken to mean that the published article did not teach every aspect of the claimed invention as required for anticipation under 35 U.S.C. § 102. Based on this interpretation, answers (A), (B), (C), and (D) would be rendered incorrect because they are all based on sections of 35 U.S.C. § 102. Accordingly, answer (E) “[n]one of the above,” is also a correct answer.

Answer (B) is not a correct answer because of when the one year anniversary date occurs for the published article and when the patent application needs to be filed. “When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken or the fee paid, on the next succeeding secular or

business day.” 35 U.S.C. § 21(b). This statute modifies the one year or twelve month periods specified in other parts of Title 35 including 35 U.S.C. § 102(b). See MPEP §§ 706.02(a); 2133. Therefore, the article would be a reference under 35 U.S.C. § 102(a) and not under § 102(b), since May 16, 1998, falls on a Saturday. *Ex parte Olah*, 131 USPQ 41, 43 (Bd. App. 1960).

Petitioner contends that the question is inherently ambiguous since more than one answer is correct. The question is not rendered ambiguous by the fact that there are two correct answers. The fact that two answers were provided which covered the alternative meanings of “very similar” provided Petitioner with an opportunity to correctly answer the question regardless of which meaning Petitioner considered. Petitioner does not dispute that answers (A) and (E) comply with PTO practice and procedure. Accordingly, Petitioner’s argument neither points out any errors in the grading of his examination nor shows that choice (B) conforms to proper PTO practice and procedure. No grading error has been shown.

Question 7 reads as follows:

7. Which of the following statements regarding a Continued Prosecution Application (CPA) is not correct?
- (A) The request for a CPA can be filed by facsimile and processed entirely in the examining group.
 - (B) The CPA will use the same file jacket as the prior application.
 - (C) The application number of the CPA remains the same as the prior application.
 - (D) No continuation-in-part CPA is permitted.
 - (E) Priority to the parent application is granted only if there is reference to the parent application in the first paragraph of the specification of the CPA.

The correct answer is (E) and Petitioner selected answer (D). Answer (E) is the correct answer because it states something that is incorrect, i.e., that a CPA refer to the prior application in the first paragraph of its specification. Under 37 C.F.R. § 1.53(d)(2), a request for a CPA must identify the prior application. However, the CPA “will utilize the file jacket and contents of the prior application, including the specification” 37 C.F.R. § 1.53(d)(2)(iv). Thus, it is the request for a CPA paper that refers to the prior application and not its specification which is still in the prior application. Accordingly, answer (E) is the correct answer because there is no requirement that a CPA refer to the prior application in the first paragraph of its specification.

Answer (D) is a correct statement pursuant to the rules for CPA’s. 37 C.F.R. §§ 1.6(a)(3) and 1.53(d) (effective December 1, 1997). Because the question asked which answer choice was incorrect, answer (D) cannot be the correct answer.

Petitioner requests full credit for his answer because the question required the evaluation of a “negative,” and therefore was quite confusing and inherently ambiguous. Petitioner has not pointed out any ambiguity in the question as a consequence of the “negative.” Review of Petitioner’s answer sheet shows Petitioner correctly answered other questions requiring evaluation of a negative, e.g., questions 12, 18, and 20. Further, Petitioner’s argument neither points out any errors in the grading of Petitioner’s examination nor shows that choice (E) conforms to proper PTO practice and procedure. No grading error has been shown.

Question 13 reads as follows:

13. Jenkins is principal attorney of record in a patent application assigned to the Titan Pharmaceutical Co. in Sacramento, California. The application is directed to one of Titan's most important discoveries, i.e., an improved method of synthesizing quinoline consisting of the steps (a), (b), (c), and (d). After receiving a first Office action objecting to all the claims because of improper form, Jenkins filed an associate power of attorney in the PTO on January 21, 1998, naming Harris as an associate with full power. On February 10, 1998, Harris filed an amendment canceling all the claims and adding new claims 11 and 12, accompanied by appropriate argument. The new claims related to the synthesis of quinoline and consisted of the steps, (a), (b), and (c). On April 6, 1998, the examiner considered the Harris amendment in light of the argument and rejected the two claims as clearly anticipated under 35 U.S.C. § 102 as unpatentable over a 1953 publication by Skraup. Harris forwarded the Office action rejecting the claims along with a copy of the Skraup publication to Jenkins for his review. Jenkins determined that Harris had inadvertently omitted (d), the fourth step of the process. This step was neither disclosed by nor obvious in light of Skraup's teaching. Assuming Jenkins is correct in his determination, which of the following is the best action designed to (1) accord with proper PTO practice and procedure, (2) to overcome the rejection, and (3) be conducive to expeditious prosecution?

- (A) Jenkins should file an amendment adding step (d) to Claims 11 and 12, and offering appropriate argument.
- (B) Jenkins should file an amendment adding Claim 13, which depends from Claim 12. Claim 13 is directed to only step (d), and is accompanied by appropriate argument for patentability.
- (C) The assignee should file a revocation of Jenkins' power of attorney, and concurrently, Harris should file an amendment adding step (d) to the claims and offering appropriate argument.
- (D) The assignee should file a revocation of Jenkins' power of attorney, and after acceptance of the revocation by the PTO, Harris should file an amendment adding step (d) to the claims and offering appropriate argument.
- (E) Harris should file an amendment adding Claim 13, which would depend from Claim 11. Claim 13 would be directed to only step (d). Harris would offer appropriate argument for patentability.

The correct answer is (A) and Petitioner chose answer (E). Choice (A) is correct because the amendment overcomes the obviousness rejection, in view of the facts of the question. Choice (E) does not overcome the rejection since no

amendment is filed for Claims 11 and 12, which stand rejected for anticipation. Petitioner contends that choice (A) “strongly suggests a violation of 37 CFR Section 1.124,” which proscribes “amend[ing] an amendment.” Petitioner further contends that “[d]ue to this ambiguity,” (E) is more correct. Petitioner’s argument neither points out any errors in the grading of Petitioner’s examination nor shows that choice (E) conforms to proper PTO practice and procedure.

First, the argument is premised upon an assumption of facts, *i.e.*, that there is an amendment of an amendment, and such facts are not recited in the question. The instructions on the test booklet expressly warn against assuming facts not given to answer the questions. In requesting a regrade, arguments premised in any manner on assumptions show no error in grading the examination.

Second, as of December 1, 1997, 37 C.F.R. § 1.124 was “removed and reserved.” The provisions of 37 C.F.R. §§ 1.121 and 1.124 were revised effective December 1, 1997. The revision was published in the *Federal Register* on October 10, 1997, 62 Fed. Reg. 53131, and in the *Official Gazette* on October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. All the answers in Question 13 take into consideration the revision found in 37 C.F.R. §§ 1.121 and 1.124 as well as corresponding changes in PTO practice and procedure instituted as a result of the revision of rules published in the *Federal Register* on October 10, 1997, 62 Fed. Reg. 53131. The revision was in effect well before Petitioner took the registration examination held on August 26, 1998. Reliance on the 1996 version of 37 C.F.R. § 1.124 shows no error in grading Petitioner’s answer to the question. No grading error has been shown.

Question 26 reads as follows:

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block encoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider are adequately disclosed in the specification. The functions of the phase comparator and divider having two inputs and one output. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phrase [sic, phase] comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.
- (B) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, and that these elements were "routinely built."
- (C) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built," and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university."

- (E) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The professor was involved with the construction of the digital transmission system.

Answers (C) and (D) are both correct and Petitioner selected answer (A).

The question asks which of five declarations would be minimally legally sufficient to overcome the examiner’s rejection in accordance with proper PTO practice and procedure. The declarations in both answer (C) and answer (D) state that the divider and phase comparator were “well-known to those of skill in the art as of June 17, 1997” and that these elements were “routinely built.” Answer (C) also states that the declarant “provides details in the declaration concerning the structure and function of the elements.” Choice (C) contains additional “details” so as to constitute “something more than a conclusory statement” as referred to in MPEP § 2164.05. Providing these details in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. See fact pattern to question (“the claims [stand rejected] under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed”) (emphasis added).

As such, credit has been given for answer (C). As explained in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.” *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)

“expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement”).

The declaration in (D) states that these elements were “sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. Again, having this statement in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. For these reasons, (D) is a correct answer. A specification need not disclose what is well-known to those skilled in the art and may omit that which is well-known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Petitioner contends that choice (A) should also be given credit because it provides information which would be minimally sufficient to overcome the rejection. As noted in MPEP § 2164.05, an expert’s opinion in a declaration is evidence that will be considered. However, the opinion, particularly if it is only a conclusory statement on the ultimate legal conclusion, is not necessarily convincing evidence. As stated in *Buchner*, an “expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement.” 929 F.2d at 661, 18 USPQ2d at 1332. As stated in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount

of factual evidence the declaration or affidavit contains to support the conclusion of enablement.”

Additionally, what answer (A) also lacks is a declaration which includes a direct answer to the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. In sharp contrast, the declarations in answers (C) and (D) do not lack this direct response to the examiner’s concern.

Petitioner also contends that the question is inherently ambiguous since more than one answer is correct. The question is not rendered ambiguous by the fact that there are two correct answers. The fact that there are two correct answers provided Petitioner with two opportunities to correctly answer the question. Petitioner did not identify any ambiguous wording or facts. Petitioner does not dispute that answers (C) and (D) comply with the policy, practice, and procedure that must, shall, or should be followed. Petitioner has not demonstrated why (C) or (D), as opposed to (A), could not have been selected if one or both are recognized as being correct. Accordingly, Petitioner’s argument neither points out any errors in the grading of Petitioner’s examination nor shows that choice (A) conforms to proper PTO practice and procedure. In view of the above, no grading error has been shown.

Question 28 reads as follows:

28. Inventor Smith prepared and filed on February 11, 1997, a provisional application regarding a machine Smith invented in the United States on November 5, 1996. A Notice to File Missing Parts dated March 6, 1997, informed Smith that the filing fee was omitted, and that the filing fee along with the surcharge are required. The Notice set a period for reply which was two months from the filing date. Smith failed to pay the filing fee and the required surcharge. The provisional application became abandoned. A Notice of Abandonment, dated May 11, 1997, was sent to Smith. Smith engaged practitioner P to prepare and file a patent application, and informed P that Smith had filed a provisional application on February 11, 1997. On February 11, 1998, P filed a complete nonprovisional patent application for Smith, claiming benefits under 35 U.S.C. 119(e) of the filing date of the provisional application. On March 4, 1998, Smith furnished P with a copy of a publication by Allon, dated February 2, 1997, fully describing the machine and a manner of making and using the machine. Also on March 4, 1998, Smith gave P copies of the two notices. P, upon asking Smith why no reply had been filed to either notice, learned that Smith had been hospitalized for a heart attack and ensuing complications from March 5 through May 4, 1997, and Smith's significant other put the notices away without opening or showing them to Smith so as not to disturb Smith, and then forgot about the notices. Smith first learned of the notices on March 3, 1998, while sorting through papers to prepare Smith's 1997 income tax return. To properly protect Smith's patent rights, the most appropriate course of action for P to take is

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- (A) to do nothing inasmuch as the regulations no longer provide for revival of an abandoned provisional application after a nonprovisional application has been filed.
 - (B) to promptly file a request to withdraw the holding of abandonment explaining that abandonment was improper inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices. Also, with the request file the filing fee, a copy of the Allon publication, and an explanation of the relevance of the Allon publication.
 - (C) to promptly file a petition requesting the Commissioner to exercise his supervisory authority to withdraw the holding of abandonment as improvident inasmuch as Smith's significant other had withheld the notices from Smith, and Smith had not received the notices.

- (D) promptly file a petition and fee to revive the provisional application as being unintentionally abandoned, the appropriate surcharge, the filing fee, and a statement that the entire delay was unintentional. Also file in the nonprovisional application an IDS listing the Allon publication along with a copy of the Allon publication, and an explanation of the relevance of the Allon publication to the claims in the patent application.
- (E) promptly file a petition and fee for a two month extension of time, a petition and fee to revive the provisional application as being unintentionally abandoned, the filing fee, and a statement that the entire delay was unintentional.

The correct answer is (D) and Petitioner selected answer (B). The question asks which of five courses of action should P take to properly protect Smith's patent rights. Choice (D) is the most correct answer. The petition to revive the provisional application and required fees should promptly be filed after Smith learned of the abandonment of the application. See 37 C.F.R. § 1.137(b). The facts present a case of unintentional abandonment. If the petition to revive the provisional application is granted, Smith's application may claim the benefit of the filing date of the provisional application since the application is filed within twelve months from the filing date of the provisional application. See 37 C.F.R. § 1.78(a)(3); MPEP § 201.11. If the petition is granted, the Allon publication is prior art under 35 U.S.C. § 102(a) with respect to the claims of the application because the publication was published less than one year before the earliest effective filing date of Smith's application, and Smith can antedate the publication with an antedating affidavit under 37 C.F.R. § 1.131. The duty of disclosure regarding the Allon publication is met. See 37 C.F.R. § 1.56.

Petitioner contends that the most important requirement for the revival of an abandoned application is a showing that the delay was unavoidable and answer (D) fails to include such a showing. However, under 37 C.F.R. § 1.137, a petition to revive an

abandoned application can be based on either unavoidable delay (subsection (a)) or unintentional delay (subsection (b)). Answer (D) includes a petition for the abandoned application under subsection (b). In contrast, Petitioner's choice, answer (B), does not include the filing of a petition under either subsection (a) or subsection (b). The request to withdraw the abandonment merely identifies the delay as "improper" without selecting to proceed under either the unavoidable or the unintentional standard. Neither does answer (B) state that a proper "petition" fee is filed.

Accordingly, Petitioner's argument neither points out any error in the grading of his examination nor shows that choice (B) conforms to proper PTO practice and procedure. No grading error has been shown.

Question 34 reads as follows:

34. On November 6, 1997, the practitioner filed a complete patent application, filing fee, and declaration under 37 CFR § 1.63 identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. Inventors A and B did not assign, and were under no obligation to assign their rights in the invention to any other party. A primary examiner required restriction between the invention of Claims 1-5, and the invention of Claims 6-10. The practitioner elected the invention of Claims 1-5. The examiner withdrew Claims 6-10 from consideration. On July 15, 1998, the practitioner filed a reply to a first Office action dated May 8, 1998, which did not set a period for reply. In the reply, Claims 6-10 were canceled, and Claims 1 and 3 were amended by adding limitations supported by information disclosed, but unclaimed in the application. The limitations were substantially embraced by the statement of invention in the application. Claim 1 is an independent claim, and Claims 2-5 depend directly or indirectly from Claim 1. On August 1, 1998, inventors A and B then provided the practitioner with information clearly showing that Claims 1-5, as amended, were not the joint invention of A and B, and that such error arose without deceptive intent. Which of the following actions fulfills proper PTO practice and procedure for correcting inventorship?

- (A) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file an amendment to name only A as the sole inventor of the invention set forth in Claims 1-5, together with a statement by the practitioner to correct the inventorship. The foregoing should be filed promptly, and preferably before the next Office action.
- (B) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file an amendment deleting B as an inventor, and adding C as a joint inventor. The amendment should be accompanied by a petition including a statement by B and C that the error in inventorship occurred without deceptive intent on their part, a statement identifying B as the named inventor who is being deleted and acknowledging that B's invention is no longer being claimed, and a statement by C that the amendment is necessitated by the amendment of the claims. An oath or declaration under 37 CFR § 1.63 by A and C should also accompany the amendment. The foregoing should be filed promptly, and preferably before the next Office action.
- (C) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventor only A, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (D) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventors A and C, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application, and addition of C as an inventor. The request is accompanied by a new declaration under 37 CFR § 1.63 naming A and C as the inventors. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (E) All of the above.

The correct answer is (C) and Petitioner selected answer (B). The question inquires which of four actions fulfills proper PTO practice and procedure for correcting inventorship. Choice (C) is the most correct answer because the procedure in (C) follows the practice set forth in 37 C.F.R. § 1.53(d), including subsection (d)(4). A newly executed oath or declaration is not needed inasmuch as none is required when a continuation application is filed under the continuing prosecution application procedure in § 1.53(d).

Petitioner contends that there is no requirement in 37 C.F.R. § 1.48 to file a continuation application, and there is no indication in the question that in order to continue prosecution, a CPA is required. Petitioner's arguments are unpersuasive. The issue is not whether there is a requirement to file a CPA application. The question sought which of four actions fulfills proper PTO practice and procedure for correcting inventorship. Choice (C) addresses changes in PTO practice and procedure instituted as a result of the revision of rules published in the *Federal Register* on October 10, 1997, 62 Fed. Reg. 53131. The revisions became effective on December 1, 1997. Thus, the revisions were in effect well before Petitioner took the registration examination administered on August 26, 1998. The revision of the rules, as well as revised PTO practice and procedure under the revised rules were addressed in Changes in the Patent Practice and Procedure, Final Rule published in the Federal Register, 62 Fed. Reg. 53131 (October 10, 1997), and in the *Official Gazette* of October 21, 1997, 1203 *Off. Gaz. Pat. Office* 63. The revised rules and revised PTO practice and procedure are controlling. 37 C.F.R. § 1.53 was revised, effective as of December 1, 1997. Among the revisions to section 1.53 is the addition of subsection (d)(1) describing the application filing

requirements for continued prosecution applications (CPA). Section 1.53 was also amended by adding subsection (d)(4), which provides for filing a CPA:

“by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons being who are not inventors of the invention being claimed in the new application.”

To delete an inventor, a statement requesting deletion is necessary. 37 C.F.R. § 1.53(d)(4). The CPA will utilize the file jacket (including the same application number and filing date) and contents of the prior application to constitute the new application. The procedure in 37 C.F.R. § 1.53(d)(4) is an alternative to, and nevertheless consistent with, the procedure in 37 C.F.R. § 1.48(b) (amended December 1, 1997) for correcting inventorship when, as a result of an amendment, fewer than all the currently named inventors are the actual inventors of the claimed invention.

The question sought the procedure that conforms to proper PTO practice and procedure. The answer to the question is not limited to the procedures set forth in 37 C.F.R. § 1.48. Accordingly, pointing out that filing a CPA is not required does not show that the procedure in answer (C) is incorrect. Petitioner has cited no error in (C). Accordingly, Petitioner does not point out any errors in the grading of Petitioner’s examination.

The procedure in (B) is improper for incompleteness because the petition fee has not been paid. 37 C.F.R. § 1.17(i). See also Changes in the Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53131, 53141 (October 10, 1997). Petitioner’s argument that answer (B) is “substantially correct, except for the omission of the payment of the fee under 37 CFR Section 1.48 (which, in practice, would be covered by a Deposit

Account),” implicitly acknowledges that (B), by omitting the fee, does not conform to proper PTO practice and procedure. Thus, no grading error has been shown.

Question 35 reads as follows:

35. During the pendency of inventor Smith’s first patent application, he filed a request for a Continued Prosecution Application (CPA). On February 4, 1998, a primary examiner again rejected Claims 1-4 in the CPA application under 35 U.S.C. § 103 over references X and Y, and again rejected Claim 5 under 35 U.S.C. § 103 over references X, Y, and Z. The examiner did not set a shortened statutory period for reply. On August 4, 1998, the practitioner filed a notice of appeal to the Board of the Patent Appeals and Interferences from the examiner’s decision rejecting Claims 1-5. Claims 6-10 in the CPA application stand allowed. Which of the following actions was not in accord with proper PTO practice and procedure regarding the appeal and Smith’s CPA application?

- (A) The practitioner timely filed the notice of appeal containing an authorization to charge fees to a deposit account, which is signed by the practitioner.
- (B) The practitioner timely filed the notice of appeal containing an authorization to charge the appeal fee to a deposit account which is signed by the practitioner and does not specify which claims are appealed.
- (C) The practitioner timely filed the notice of appeal containing an unsigned authorization to charge the appeal fee to a deposit account; the notice of appeal specifies which claims are appealed.
- (D) The practitioner timely filed an unsigned notice of appeal; the notice of appeal specifies which claims are appealed; a proper authorization to charge fees to a deposit account accompanied the notice of appeal.
- (E) The practitioner timely filed the notice of appeal which was signed by the practitioner; the notice of appeal specifies which claims are appealed; the appropriate fee accompanies the notice of appeal. An appeal brief was filed with a request for extension of time and the requisite fee seven months after the notice of appeal was filed.

Answer (C) is the most correct answer and Petitioner selected answer (B). In answer (C), the practitioner is filing two items with the PTO: (1) a notice of appeal, and (2) an unsigned authorization to charge the appeal fee to a deposit account. Answer (C) is most correct because an unsigned authorization to charge the appeal fee to a deposit

account does not pay the fee that is required by 37 C.F.R. §§ 1.191(a) and 1.17(b).

The general rule is that papers, such as an authorization to charge a deposit account, filed in an application “must be signed.” 37 C.F.R. § 1.33(b). A notice of appeal is an exception to this general rule and need not be signed. 37 C.F.R. § 1.191(b); see also Changes in the Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53131, 53167 (October 10, 1997). However, 37 C.F.R. § 1.191(b) does not extend to or cover payment of an appeal fee by an unsigned authorization to charge a deposit account. Accordingly, answer (C) is the most correct answer to the question which action is not in accord with proper PTO practice and procedure.

Choice (B) complies with proper PTO practice and procedure since the notice and authorization to charge the appeal fee to a deposit account is signed and claims 1-5 have been twice rejected, and is therefore an incorrect answer to the above question. There is no requirement in 37 C.F.R. § 1.191 that the claims be identified by number or as twice rejected. Petitioner argues “[w]hile the examinee was obviously wrong, it was his intention to select C as the correct answer. Please note that both answers B and C are substantially identical, except for the omission of the critical words ‘. . . does not . . . ,’ which, given the time pressures involved in the lengthy examination, was easy for the examinee to overlook.” Petitioner’s argument neither points out any errors in the grading of his examination nor shows that choice (E) conforms to proper PTO practice and procedure. Grading is based on the selected answer as indicated by the darkened space on the answer sheet. The grading is not shown to be erroneous by a later expressed intent or a suggestion that a difference between answers may have been overlooked. No grading error has been shown.

Question 37 reads as follows:

37. In an original patent application having Claims 1 through 10, where Claims 1 and 4 are independent claims, a primary examiner properly rejected Claims 1-5 under 35 U.S.C. § 112, second paragraph, and Claims 4-10 under 35 U.S.C. § 103 over a combination of prior art references. The Office action set a three month shortened statutory period for reply. A patent practitioner's reply (both amendment and arguments) addressed the rejections of Claims 4-10 under 35 U.S.C. § 103 and of Claims 4 and 5 under 35 U.S.C. § 112, but failed to reply to the rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph. Which of the following does not comply with PTO practice and procedure regarding the reply?

- (A) If the Office action was a non-final Office action on the merits dated January 12, 1998, and the reply was filed on Monday, April 13, 1998; then the examiner, in a communication dated April 17, 1998, may properly call attention to the omission of a reply to the rejection of Claims 1-3, and set a one month shortened statutory period to complete the reply, and the practitioner may properly avoid abandonment of the application by filing on Tuesday, October 17, 1998, a request and fee for a five month extension of time, and a reply to the rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph.
- (B) If the Office action was a final Office action dated January 12, 1998, and the reply was filed on Monday, April 13, 1998, and in an Advisory action dated April 20, 1998, the examiner informed the practitioner that the amendment in the reply did not *prima facie* place the application in condition for allowance; then the practitioner may properly avoid abandonment of the application by filing, on July 10, 1998, a notice of appeal and appeal fee.
- (C) If the Office action was a non-final Office action on the merits dated January 12, 1998, and the reply was filed on Monday, April 13, 1998; then the primary examiner, in a communication dated April 17, 1998, may properly call attention to the omission of a reply to the rejection of Claims 1-3 and set a one month shortened statutory period to complete the reply, and the practitioner can properly achieve copendency between the application and a continuing application by filing a request and filing fee for a continued prosecution application on or before May 13, 1998, all without completing the reply.

- (D) If the Office action was a second, final Office action on the merits dated September 9, 1997, and the reply was filed on March 9, 1998, together with a request and fee for a three month extension of time; and if the examiner informed the practitioner in the second, final Office action that the same rejection of Claims 1-3 under 35 U.S.C. § 112, second paragraph, had been made in the first, non-final Office action and that there was an omission of a reply to the rejection of Claims 1-3 in the practitioner's reply to the first, non-final Office action; then the examiner may properly determine that the omission in the reply filed on March 9, 1998, was not inadvertent, so inform the practitioner in an Advisory action, and the application becomes abandoned for an incomplete reply.
- (E) All of the above.

The correct answer is (B) and Petitioner selected answer (A). The question asks which of five answers does not comply with PTO practice and procedure regarding the reply. The reply in (B) is incomplete with regard to Claims 1-3, and no request and fee have been filed for an extension of time to file the notice of appeal. Therefore, the notice of appeal is untimely and abandonment is not avoided. An applicant filing a proposed amendment under 37 C.F.R. § 1.116 or arguments in reply to a final Office action has no assurance that such reply will necessarily result in allowance of the application. The only reply under 37 C.F.R. § 1.113(a) that ensures avoidance of abandonment is a timely filed notice of appeal and appeal fee under 37 C.F.R. § 1.191.

Choice (A) is not the most correct answer because it complies with proper PTO procedure. That is, where the reply to a non-final action is incomplete, an applicant may be granted a shortened statutory period of time within which to supply the omission and may supply the omitted reply within the newly set shortened statutory period of time or within the maximum period for reply set by statute if a request for a five month extension of time and appropriate fee are filed. 37 C.F.R. §§ 1.135 and 1.136(a).

Petitioner urges that answer (A) is the most correct answer because the application is abandoned inasmuch as a complete response was filed on October 17, 1998, which is more than six months after the Office action dated January 12, 1998. However, the procedure followed in answer (A) is in accord with 37 C.F.R. §§ 1.135 and 1.136(a), effective December 1, 1997. That is, since the examiner set a one month shortened period to respond, the “applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute [i.e., six months, 35 U.S.C. § 133] or five months after the time period set for reply.” 37 C.F.R. § 1.136(a)(1) (also identifying exceptions not applicable here). Accordingly, answer (A) is not a proper choice for the above question which asks for the choice that does not comply with PTO practice and procedure. No grading error has been shown.

Question 43 reads as follows:

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

(A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.

- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.
- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.
- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.
- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

The correct answers are (A) and (B) and Petitioner chose answer (C). The question presents five different situations wherein the attorney of record calls an error to the attention of the examiner and asks for the one that is not in accord with proper PTO practice and procedure. Answers (A) and (B) are the most correct answers. MPEP § 710.06 provides that “[i]f the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to

substantially equal the time remaining in the reply period.” Since the errors in both (A) and (B) were called to the examiner’s attention more than one month after the date of the Office action, the Office would set a new period for reply “to substantially equal the time remaining in the reply period.” Under this practice, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a “three month shortened statutory period” is not in accord with proper PTO practice and procedure. MPEP § 710.06 also provides that the Office will set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. MPEP § 710.06.

Choice (C) is in accordance with proper PTO practice described in the first paragraph of MPEP § 710.06. Petitioner contends that the question is ambiguous since more than one answer is correct. He argues that the question is confusing and he therefore misread it. Petitioner’s argument is conclusory and unpersuasive of grading error. The fact that the question has more than one correct answer does not establish ambiguity in the question. It in fact provided Petitioner with two opportunities to correctly answer the question. Further, misreading the question does not show any fault in the question or answers. Petitioner does not dispute that answers (A) and (B) fail to state the policy, practice, and procedure that should be followed. Petitioner has not demonstrated why (A) or (B), as opposed to (C), could not have been selected if one or both is recognized as being correct. Accordingly, Petitioner’s argument neither points out any errors in the grading of his examination nor shows that choice (C) fails to conform to proper PTO practice and procedure.

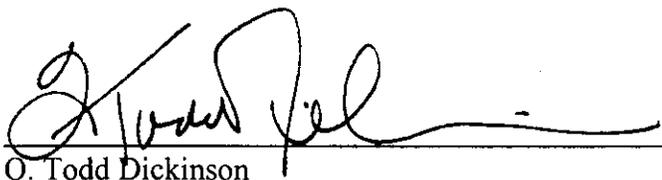
ORDER

For the reasons given above, no points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score remains at 62. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied.

This is a final agency action.

AUG 18 1999

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

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