



OCT 11 2000

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to question 18 of the morning section and question 16 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 69. On July 27, 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.

No credit has been awarded for morning question 18 and afternoon question 16.

Petitioner's arguments for these questions are addressed individually below.

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). Increasing the economic value of a patent by extending the effective term of the patent up to one year is not a policy underlying the public use bar of 35 U.S.C. 102(b).

Petitioner argues that the most correct answer is choice (C). Petitioner argues that allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent is not a policy underlying the public use bar of 35 U.S.C. 102(b). In support of this contention, petitioner states that the one year grace period under Sec. 102(b) discourages market testing, encourages prompt disclosure, and does not provide enough time for determining the potential economic value of a patent. Petitioner further points to 35 U.S.C. 102(g), under which reasonable diligence can not be demonstrated by market testing. Petitioner acknowledges that increasing the economic value of a patent by extending the effective term of the patent up to one year (choice D) is not a policy underlying the public use bar of Sec. 102(b). However, petitioner contends that since the grace period under Sec. 102(b) may have the effect of extending the effective term of a patent, choice (C) is the most correct answer.

Petitioner's arguments have been fully considered but they are not persuasive. The Court of Appeals for the Federal Circuit has repeatedly stated that one of the policies underlying the public use bar of 35 U.S.C. 102(b) is allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent. Note *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996); *Tone Brothers v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); and *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985). The Federal Circuit lists all of the answer choices, with the exception of choice (D) (i.e. increasing the economic value of a patent by extending the effective term of the patent up to one year) as policies underlying the public use bar of 35 U.S.C. 102(b).

Further, petitioner's comparison of the effect of market testing in an analysis of reasonable diligence under Sec. 102(g) and the policies underlying the public use bar under Sec. 102(b) lacks merit. The policies underlying Sec. 102(g) and Sec. 102 (b) are different, as are the determinative issues involved in the application of both sections. Sec. 102(b) provides for a one year grace period prior to filing an application, whereas Sec. 102(g) analysis involves a showing of reasonable diligence from a time prior to conception by another party until actual or constructive reduction to practice. Market testing is permissible during the grace period under Sec. 102(b), but would not demonstrate the requisite diligence for purposes of Sec. 102(g). Thus, the application of Sec. 102(g) can not be relied upon for demonstrating the policies underlying the public use bar of Sec. 102(b).

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

Petitioner argues that the most correct answer is choice (C). Petitioner argues that nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention. Petitioner contends that there may have been recent technological advances permitting the possibility of such an invention, and that simultaneous invention shortly after such technological advances may evidence a long felt need. While acknowledging that nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention (choice B), petitioner contends that choice (B) is no more correct than choice (C).

Petitioner's arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. See *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *International Glass Co. v. U.S.*, 159 USPQ 434 (US CICt 1968). Therefore, choice (B) is correct. As to choice (C), simultaneous invention is not evidence of a long-felt need for the invention. Long-felt need for an invention is demonstrated by attempts over *a long period of time* to solve a particular problem or to fill a particular need, or at least recognition of the existence of such problem or need for *a long period of time*. See MPEP 716.04. By its very nature, *simultaneous* invention is contemporaneous, and thus can not demonstrate long-felt need (i.e. it does not take place over *a long period of time*). Therefore, choice (C) is not the most correct answer.

No error in grading has been shown as to morning question 18 and afternoon question 16. Petitioner's request for credit on these questions is denied.

**ORDER**

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.



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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy