



OCT 11 2000

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) requests for regrading questions 16, 28 and 42 of the afternoon section of the Registration Examination held on April 12, 2000. The petition, however, includes an argument for question 43, but not for question 42. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. Hence, the petitioner's request is treated as a request for regrading questions 16, 28 and 43. 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 68. On July 20, 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 CFR 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 afternoon questions 16, 28, and 43. Petitioner's arguments for these questions are addressed individually below.

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 *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 answer E should be given credit. Petitioner contends that choice B is incorrect because the phrase “nearly simultaneous” in choice B is too vague to apply to the facts given. Petitioner further argues that “the assumption that genuinely creative acts often occur independently though proximate in time is such a basic principle of our patent system that the first to file policy was instituted expressly to differentiate among these cases.” 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 they are not persuasive. The applicability of “nearly simultaneous invention” is not the issue in the question. It does not ask for a determination of whether nearly simultaneous invention existed, but whether nearly simultaneous invention as given in the facts may be evidence of the level of skill in the art at the time of the invention.

It is further noted that there is no first-to-file policy in the United States patent practice. 35 U.S.C. § 102 states that “[a] person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, **before the invention thereof** by the applicant for patent, or...” (emphasis

added). Furthermore, interference proceedings under 35 U.S.C. § 135 are conducted to determine the priority of invention between a pending application and one or more pending applications and/or one or more unexpired patents. This is generally known as the first-to-invent system.

The *Merck* case 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 “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art” at 1983, 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. 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 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 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 C.F.R. § 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 C.F.R. § 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 C.F.R. § 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 C.F.R. § 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 C.F.R. § 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 choice (A) is the best the answer. Petitioner contends that answer (A) states that the differences must be pointed out to provide the desired result, i.e. separate evaluation of the claims, and the wording of answer (A) does not negate the necessity of additional supporting elements. Petitioner gives no reason for why the model answer (E) is incorrect.

Petitioner's argument has been fully considered but they are not persuasive. The wording of answer (A) specifically states that each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover. As explained in the instructions, do not assume any additional facts not presented in the questions. It is unreasonable to assume answer (A) includes both a statement that the claims of the group do not stand or fall together and arguments on why the claims of the group are believed to be separately patentable as required by 37 CFR 1.192. Claims could be different but not separately patentable. 37 CFR 1.192 specifically further states that merely point out differences is not an argument as to why the claims are separately patentable. Accordingly, pointing out claim differences is not sufficient

to have claims stand or fall separately, rendering answer (A) incorrect. Further, petitioner provides no reason why answer (E) is incorrect. Answer (E) is the correct answer as shown above. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 43 reads as follows:

43. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) The practitioner entering into a business partnership with an individual who is neither an attorney nor a registered practitioner, where the activities of the partnership consist of the practice of patent law before the Office by the practitioner, and the individual will market the practitioner's services and the client's inventions.
- (B) Filing an amendment wherein claims are presented that have been copied from an issued patent of another, and knowingly withholding from the Office information identifying the patent from which the claims have been copied.
- (C) Telling a client that the client's application will go abandoned if the client's bill is not paid and refusing to file any papers in the PTO unless and until the fee is paid.
- (D) Upon being discharged by a client, filing a request to withdraw wherein the client's intent to discharge is set forth as the reason for the request.
- (E) When the client refuses to pay, without the client's consent after full disclosure, accepting compensation from a client's friend for the practitioner's legal services on behalf of the client.

The model answer is choice (D).

See 37 C.F.R. § 10.40 where it states: "(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:... (4) The practitioner is discharged by the client." As to (A), practitioner may not enter into a partnership with a nonpractitioner where any of the practice of the partnership consists of patent, trademark or other law before the PTO. 37 C.F.R. § 10.49. As to (B), see 37 C.F.R. § 10.23(c)(7) regarding knowingly withholding from the Office information identifying a patent of another from which one or more claims have been copied. As to (C), a practitioner is proscribed from neglecting an entrusted legal matter. 37 C.F.R. § 10.77(c). The practitioner must file a request to withdraw and avoid foreseeable prejudice to the client's rights where a client refuses to pay a practitioner. 37 C.F.R. § 10.40. As to (E), practitioner may not accept compensation from someone other than his or her client. 37 C.F.R. § 10.68.

Petitioner argues that answer (A) is also a correct answer. Petitioner contends that the phrase "business partnership" in answer (A) is broader than a legal business entity partnership discussed in the model answer, but rather also includes business arrangements colloquially referred to as partnering arrangements. Petitioner concludes that answer (A) is correct and does not argue that the model answer (D) is incorrect.

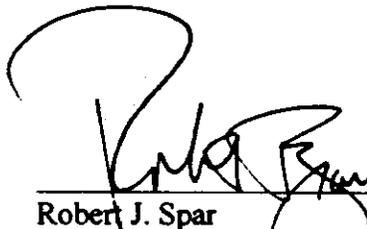
Petitioner's argument has been fully considered but they are not persuasive. Contrary to petitioner's statement that the phrase "business partnership" is broad enough to refer to any partnering arrangement, the question specifically states that "the activities of the partnership consist of ...", which excludes any arrangement other than a legal partnership. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, the business partnership referred to in answer (A) is a legal partnership, rendering question (A) false. The statement in answer (D) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. 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.



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Office of the Deputy Commissioner
for Patent Examination Policy