



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

R2000-113

DEC 13 2000

In re

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

MEMORANDUM AND ORDER

(petitioner) requests for regrading questions 17, 18, 26, 34, 38 and 49 of the morning section and questions 10, 16, 28, 36, 47 and 48 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 66. On August 3, 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 petitioners' arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 17, 18, 26, 34, 38 and 49 and afternoon questions 10, 16, 28, 36, 47 and 48. Petitioners' arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice is (E). Both claims (B) and (C) would overcome a 35 U.S.C. § 102 rejection based on the prior art.

Petitioner argues that answer (E) is incorrect and that there is not a correct answer.

Petitioner argues that claim (C) is not a proper claim because it includes a negative limitation.

Petitioner argues that any claim containing a negative limitation which does not have basis in the original limitation should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement and with the given facts there is no mention that the

laminate does not include an adhesive layer. Petitioner argues that claim (C) indefinite and would be rejected on the basis of aggregation. See MPEP 2173.05(k). Petitioner asserts that since

- (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 is (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 answer (C) is also correct. Petitioner argues that (C) refers to sales, and not use, and question 18 is about use. Petitioner argues that each activity, 'public use' or 'on sale' is a separate and distinct from each other, thus policy considerations underlying "public use" and the "on sale" bars should not be clumped together. Petitioner argues that whether choice (C) is correct or not is arguably a matter of speculation and clearly outside the MPEP.

Petitioners' arguments have been fully considered but they are not persuasive. Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent is a policy underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996). As indicated in the instruction, 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*.

Morning question 26 reads as follows:

26. Which of the following statements is most correct?

(A) The same evidence sufficient to establish a constructive reduction to practice is necessarily also sufficient to establish actual reduction to practice.

(B) Proof of constructive reduction to practice does not require sufficient disclosure to satisfy the "how to use" and "how to make" requirements of 35 U.S.C. §112, first paragraph.

(C) A process is reduced to actual practice when it is successfully performed.

(D) The diligence of 35 U.S.C. § 102(g) requires an inventor to drop all other work and concentrate on the particular invention.

(E) The diligence of 35 U.S.C. § 102(g) does not impose on a registered practitioner any need for diligence in preparing and filing a patent application inasmuch as such the practitioner's acts do not inure to the benefit of the inventor.

The model answer is choice is (C). A process is reduced to actual practice when it is successfully performed.

Petitioner selected answer (B). Petitioner argues that answer (C) is also incorrect because the answer is only partially true. Petitioner argues that MPEP § 2138.05 requires that the claimed invention have a known utility to actually be reduced to practice and that since the MPEP requires the invention to have a utility, petitioner did not choose answer (C). Petitioner argues that since there is no correct answer that credit should be given to all answer choices.

Petitioner's arguments have been fully considered but they are not persuasive. The question asks which statement is most correct. As indicated in the instruction, 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. Answer (C) is the most correct answer. "A process is reduced to practice when it is successfully performed." *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP 2138.05

("Requirements To Establish Actual Reduction To Practice"). Answer (B) is incorrect. Proof of constructive reduction to practice clearly not requires sufficient disclosure to satisfy the "how to use" and "how to make" requirements of 35 U.S.C. §112, first paragraph. See MPEP 2138.05 ("Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph"). *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973).

Morning question 34 reads as follows:

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is **true**?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.
- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

The model answer is choice is (C). Nonobviousness may be demonstrated by producing evidence of the absence of a property the claimed invention would be expected to possess based on the teachings of the prior art.

~~Petitioner argues that answer (B) is correct. Petitioner argues several cases have~~  
determined that evidence of the prior art knowledge must be available to the public. Petitioner

argues that the publication is not available as a reference since it did not become available to the public until after the filing date of the application. Petitioner alternatively argues that he was confused because "classified" was not defined and therefore the question is vague. Petitioner argues since the "limited distribution" was not defined that there were too many questions unanswered to properly answer this question. Alternatively, petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. The instructions state "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*." The MPEP states "declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time," so clearly, this evidence is present. See MPEP § 707.05(f). Since the publication may be a reference, it is clearly incorrect to state that the "publication is not available as a reference because it did not become available to the public until after the filing date of your patent application." Choice B is not the most correct answer, because the publication is available as a reference. The article is *prima facie* evidence that the invention was known by others in this country. While petitioner may have been confused as to the meaning of "classified" material, the MPEP clearly states that declassified material may be used as of its printing date.

Morning question 38 reads as follows:

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution. The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

(A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.

(B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.

(C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.

(D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.

(E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

The model answer is choice is (A). Arguments alone may invoke the recapture doctrine and preclude one from obtaining the requested reissue.

Petitioner selected answer (B). Petitioner argues that Hester v. Stein was recently decided and was not included in the MPEP available at the time of the examination. Petitioner argues that it did not become available online until May 11, 2000, which was after the examination, therefore it cannot be relied upon. Petitioner further argues that the recapture doctrine is an equitable doctrine, and as such the courts not the MPEP determine the law. Petitioner asserts that the MPEP arguably does not fairly articulate the law. Alternatively, the petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (A) is the most correct answer. See *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998) and MPEP § 1412.02, Rev. 1, Feb. 2000. 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*. In this instant the MPEP relied upon was modified by a subsequent court decision, which was published in the O.G.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

(A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.

(B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.

(C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.

(D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.

(E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice is (A). A patent practitioner may refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful, even if there is some support for an argument that the conduct is legal. See 37 C.F.R. § 10.84(b)(2).

Petitioner argues that answer (D) is correct. Petitioner argues information received in the course of representation is normally privileged and cannot be revealed. See 37 C.F.R. § 10.56

Canon 4 and § 10.57. Since a practitioner "may reveal the crime according to section (c)(3) and not must reveal the crime as stated in choice (D) this makes choice (D) an untrue statement."

Petitioner's arguments have been fully considered but they are not persuasive. Answer (A) is false, 37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Answer (D) is not correct because the statement in (D) is a true statement. While, the rule in 37 C.F.R. § 10.57 is close to the situation, 37 C.F.R. § 10.85(b)(1) is the most pertinent rule and according to 10.85(b)(1), the practitioner must reveal the fraud.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) ~~File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.~~
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original

- reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice B, do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 are confirmed.

Petitioner selected answer E. Petitioner argues that B is incorrect, because further action is needed to make claims 2-10 allowable. Petitioner argues that answer E is correct because the attorney's action in choice E is not prohibited and that an attorney is supposed to zealously represent his client. 37 C.F.R. §§ 10.84, 10.61 and 10.77(c). Petitioner argues that choice (E) may not be the best choice, but it is better to keep the line of communication open with the applicant. Choice (E) does not state that Sam has withdrawn, but he can always file a petition to withdraw. Petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. The attorney has been told by his client that he does not have funds to continue prosecution. If the attorney does nothing as stated in choice B, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. An amendment incorporating the limitations of independent claim 1 into the dependent claims 2-10 is not required. Since the attorney agrees with the rejection of claim 1, the client would not be adversely affected.

Choice E is not the best answer because Sam should not charge his client in advance for services that are not required in the reexamination proceeding. To resolve any payment issues for

services rendered, Sam should request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. 10.40 and MPEP 402.06.

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 is (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 selected answer (E). Petitioner argues that answer (B) is inconsistent with the examination guidelines in the MPEP. Petitioner argues that neither *In re Merck & Co.*, nor *Newell Cos. V. Kenney Mfg.*, cited by the PTO in support of the answer (B) does not address simultaneous inventions and the level of skill in the art, nor are they cited or discussed in the MPEP for determining the level of ordinary skill in the art.

Petitioner's arguments have been fully considered but they are not persuasive. Answer B is correct because *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) noted that "[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)." The fact that near simultaneous invention may be evidence of the level of skill in the art at the time of the invention is also stated in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977, 1983 (Fed. Cir. 1998), "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art," referring to *Merck*. Furthermore, *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 442 (US Cl Ct, 1968), states that "[t]he fact of near simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art." 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.

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 is (E). In a reissue application, to claim foreign priority, the oath or declaration must claim foreign priority even though the priority claim was made in the original patent.

Petitioner selected answer (D). Petitioner argues that the claim for priority in a reissue is not required to be made in the oath or declaration. Petitioner asserts that MPEP 1417 second paragraph does not state where the applicant must make the claim for foreign priority. Petitioner argues that none of the other answers are correct as acknowledged by the model answers. Thus, petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. 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. While one section of the MPEP may not state the location of the foreign priority claim, other sections and the rules clearly specify the location for the claim.

Afternoon question 36 reads as follows:

36. Which of the following is **true**?

(A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.

(B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

(C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.

(D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.

(E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice is (B). At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

Petitioner selected answer (D). Petitioner argues that answer (B) violates the Due Process Clause of the U.S. Constitution. Petitioner argues that the PTO's interpretation of 37 C.F.R. § 10.11(b), which gives the Director power to remove practitioners without notice (warning) violates the principles of the Fifth Amendment of the U.S. Constitution. Petitioner argues that a basic tenet of procedural Due Process, is the opportunity to be heard. Petitioner argues that answer (B) is ultra vires and that the Director is only authorized to suspend or exclude practitioners for failure to comply with the regulations where notice and opportunity for a hearing have first been provided. Petitioner further argues that publication in the Official Gazette is

required under 37 C.F.R. § 10.11(b), but without the publication, notice is not served. Petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner's selected answer (D) is incorrect because registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). 37 C.F.R. § 10.11(b) does not require notice to be published before the names of individuals are removed. The rule states "[t]he name . . . will be removed from the register and the names of individuals so removed will be published in the Official Gazette," thus they have already been removed. There is no requirement for publication as argued by petitioner. Furthermore, contrary to petitioner's argument that 37 CFR 10.11(b) violates the Due Process Clause and the answer (B) is ultra vires, the letter sent by the Director of Enrollment is a notice and the letter is sent for the purpose of ascertaining whether they wish to remain on the register. 37 CFR 10.11(b) also provides that the name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in 37 CFR 1.21(a)(3).

Afternoon question 47 reads as follows:

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.

II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.

III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.

- (A) I. only.  
(B) II. only.  
(C) III. only.

- (D) I. and III.
- (E) None of the above.

The model answer is choice is (A). Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner comports with proper PTO rules and procedure as an initial step to dispute the propriety of the finality of an Office action.

Petitioner selected answer (B). Petitioner argues that the model answer is incorrect and that no answer is correct. Petitioner argues that the model answer cites MPEP 706.07(c) and that prematureness of a final rejection is a question of practice wholly distinct from the tenability of the rejection. Thus, answer (A) is incorrect because the PTO answer cites MPEP 706.07(c), which discusses final rejection rather than the tenability of the rejection. Petitioner concludes that since no answer is correct, that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner selected answer (B), answer (E) is none of the above, thus no credit should be given according to petitioner's arguments. However, the question is "which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure." Choice (A) is a correct answer. Any question as to the prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. MPEP 706.07(c) and (d). Therefore, it is unclear how the tenability of the rejection applies in this matter.

Afternoon question #8 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice is (D). Regarding 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (E). Petitioner argues that answer choice (D) is incorrect as written because "the PTO model answer suggests that this sentence refers to disclosed inherent properties (*i.e.*, inherent properties *which* are disclosed in the specification), but in fact the answer does not say that." Petitioner argues that according to correct English grammatical rules, this is a description of two types of properties that should be considered. Petitioner argues that each phrase should be considered, but that the model answer suggest they should be considered together, which is incorrect. Petitioner argues that the question is flawed and that none of the answers are completely correct. Petitioner concludes that since answer choice (D) is flawed as written that all answers should be given credit.

Petitioner's arguments have been fully considered but they are not persuasive. "In delineating the invention as a whole, we look not only to the subject matter which is literally

recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”) *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 (“Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”). Petitioners arguments that the model answer suggest the two properties should be considered together and is therefore improper is not persuasive. Answer (D) is the same as the quote Therefore, answer (D) is the best answer. Petitioners answer choice (E) is incorrect. As stated in MPEP 2141.02, “Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).”

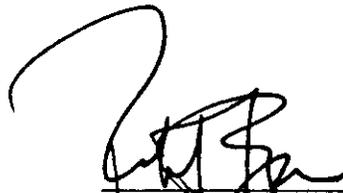
No error in grading has been shown as to morning questions 17, 18, 26, 34, 38 and 49 and afternoon questions 10, 16, 28, 36, 47 and 48. Petitioner’s request for credit on these questions is denied. The regrade of the petitioner’s examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO’s model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO’s Model Answers are a uniform standard. “[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading.” *Id.*, slip opinion at 5. The court concluded that “the decision of the Commissioner of the USPTO not to regrade Mr. Worley’s examination answers as correct when the answers did not conform with the USPTO’s Model Answers was not arbitrary and capricious.” *Id.*, slip opinion at 5-6.)

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. 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.



---

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