



R 3000-118

DEC 13 2000

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading questions 2, 3, 7, and 16 of the morning section and questions 10, 16, and 28 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 63. On July 24, 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.

Petitioner has been awarded one point for morning question 2. Accordingly, petitioner has been granted one additional point on the Examination. However, no credit has been awarded for morning questions 3, 7 and 16 and afternoon questions 10, 16 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

(A) may indirectly serve as a basis for another multiple dependent claim.

(B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.

(C) may directly serve as a basis for another multiple dependent claim.

(D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.

(E) (B) and (D).

The model answer is choice (E).

Choice (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (D) is correct. Petitioner agrees with the model answer that answer (D) is correct but contends that answer (B) is incorrect because 37 C.F.R. § 1.75(c) does not state that the fee is required before the amendment is entered. Petitioner concludes that answer (B) is incorrect and maintains that answer (D) is correct.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that the proper fee is not required before the amendment is entered, MPEP § 608.01(n) (top of p. 600-65) states that if a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. Accordingly, a fee is required before a multiple dependent claim is entered, rendering (B) correct. Because both (B) and (D) are correct, the statement in answer (E) is most correct.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally

secured to each other by a connector; and”

(E) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”

The model answer is choice (B).

Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

Petitioner argues that none of the answers is correct and answer (E) is the best given that the question did not ask about 35 U.S.C. § 112. Petitioner contends that answer (B) fails to provide proper antecedent basis for “said mid-point” in (iv) and is therefore incorrect. Petitioner concludes that all answers are incorrect and maintains that answer (B) is incorrect and therefore credit should be given for all answers.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that answer (B) fails to provide antecedent basis for “said mid-point” in (iv) and is therefore incorrect, the question in (iv) specifically states “said second cutting member additionally including a pointer loop between said finger loop and said mid-point”. As explained in answer (B), each of the first and second cutting means has a mid-point. Accordingly, answer (B) provides antecedent basis for the second cutting means mid-point in (iv), rendering the

statement in answer (B) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than $\frac{1}{2}$ gigabyte of storage.

Which of the following statements is or are true about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice (E).

(E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of $\frac{1}{2}$ gigabyte.

Petitioner argues that answer (A) is the most correct. Petitioner contends that the sole difference between model answer (E) and petitioner's answer (A), whether claim 11 is proper or improper, should be answered that claim 11 is proper because claim 11 added limitations. Petitioner concludes that answer (E) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that claim 11 added limitations, the claim 11 does not further limit claim 10, which claim 11 depends on. The claim 11 specifically states that the random access memory is greater than $\frac{1}{2}$ gigabyte of storage. As explained in claim 9, the personal computer of claim 10 comprises a microprocessor and a random access memory including at least 1 gigabyte of storage. Accordingly, the purported limitation in claim 11 of random access memory is greater than $\frac{1}{2}$ gigabyte of storage is not an added limitation because parent claim 9 already stated memory was greater than $\frac{1}{2}$ gigabyte of storage - in fact, greater than 1 gigabyte, rendering claim 11 absent any added limitation relative to its parent claim 10. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues (A) is correct and (B) is incorrect. Petitioner contends that a responsible attorney would call the examiner as a zealous practice and then do whatever is consistent with

PTO practice, and that doing nothing is poor practice and violate 37 C.F.R. § 10.84 and 10.61, Cannon 5. Petitioner concludes that answer (A) is incorrect.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to give an examiner a call, the answer (A) specifically states that the attorney should 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. As explained in 35 USC § 305, reexamination proceedings are conducted with special dispatch. Accordingly, a registered practitioner is charged with knowing that there is no mechanism for suspending a reexamination proceeding until a bankruptcy is settled, rendering answer (A) incorrect because it asserts an action contrary to PTO rules and practices. The issue of bankruptcy is not relevant to the reexamination proceeding. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to request suspension of a reexamination proceeding, the statement in answer (B) is correct and the statement in answer (A) is incorrect. As to 37 C.F.R. § 10.84 and 10.61, both sections direct the attorney to exercise professional independent judgement, which is consistent with the stated fact that the attorney agrees with the Examiner's view of the status of the claims. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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 *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *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 none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. 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 is not persuasive. As indicated in the instructions, 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 cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

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 and therefore answer (E) incorrect because (B) is 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. 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 (B) is also correct. Petitioner contends that answer (B) is true as per 37 C.F.R. 1.136 which states that an applicant may extend the time period for reply unless one of 5 events occur, and none of the 5 events include filing a petition. Petitioner also argues that answer (E) is incorrect because MPEP § 201.14(b) makes the location of the claim to foreign priority permissive rather than mandatory. Petitioner concludes that answer (E) is incorrect and maintains that answer (B) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that when desiring to claim foreign priority, the oath or declaration in a reissue application need not claim foreign priority even though the priority claim was made in the original patent because MPEP § 201.14(b) is permissive, 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

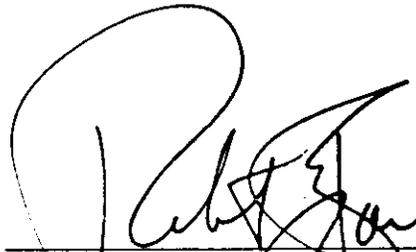
As to answer (B), that answer states 2-month period for filing a petition mentioned in 37 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 1.136(a). As indicated by petitioner, 37 C.F.R. § 1.136(a) allows an applicant may extend the time period for reply unless one of 5 events occur, but 37 C.F.R. § 1.136(a) applies to the time period for a required reply to an Office action. A petition is not a required reply and therefore 37 C.F.R. § 1.136(a) is not applicable. Further, 37 C.F.R. § 1.181(f) provides that any petition not filed within 2 months from the action complained of may be dismissed as untimely. MPEP § 1002 further states that the 2 month period is not extendable under 37 C.F.R. § 1.136(a) since the time is within the discretion of the Commissioner, rendering answer (B) incorrect. The statement in answer (E) 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, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 64. 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