



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. 2023
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R2000-121

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 his answers to questions 7 and 20 of the morning section and questions 1, 16, 28, and 49 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 65. On July 18, 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 an additional point for morning question 20. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning question 7 and afternoon questions 1, 16, 28 and 49. Petitioner's arguments for these questions are addressed individually below.

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 answer (A) is also correct. Petitioner contends that answer (A) has fewer limitations than (B) because (A) has only a single limitation for the single finger loop pad. Petitioner admits that answer (A) lacks antecedent basis as described in the model answer, but argues that answer (B) also lacks antecedent basis for “said midpoint”, and that, given that both (A) and (B) lack antecedent basis, (A) is more correct because (A) is broader than (B). Petitioner concludes that answer (B) 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 answer (B) also lacks antecedent basis for “said midpoint”, answer (B) specifically states that “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.” Answer (B) does not contain the phrase “said midpoint” as

argued by petitioner and the only reference to a midpoint in answer (B) requiring an antecedent is within "at their respective midpoints", which is set up by both instances of "having a mid-point." Accordingly, answer (B) does not lack antecedent basis as argued by petitioner, rendering answer (B) more correct than answer (A) which does lack antecedent basis. The phrase "said mid-point" in (iv) is specifically the mid-point of the second cutting member set forth in (B), and therefore answer (B) provides proper antecedent basis for "said mid-point" in (iv). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice (D).

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device,

rather than the utilitarian function of the device. MPEP § 716.03(b).

Petitioner argues that answer (B) is also a correct answer because gross sales figures accompanied by evidence as to the time period during which the product was sold may signify nothing more than a high unit product price. Petitioner contends that such sales figures may reflect a subjective marketing decision rather than evidence of obviousness. Petitioner concludes that answer (B) does not constitute probative evidence of commercial success to support a contention of non-obviousness and is also correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that such sales figures may reflect a subjective marketing decision rather than evidence of obviousness, the question specifically asks which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness. As explained in MPEP § 716.03(b), gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). Accordingly, sales figures accompanied by evidence as to the time period during which the product was sold does constitute probative evidence of commercial success, rendering answer (B) an incorrect response. 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 (E) is correct because none of the other answers is correct. Petitioner argues that the existence of interference practice proves that near simultaneous invention cannot be evidence of skill in the art for otherwise an interference would indicate that others of ordinary skill in the art would also have conceived of the invention, rendering the invention obvious.

Petitioner further argues that skill in the art is not definable by credentials. Petitioner also argues that near simultaneous invention does not rule out work of genius and is therefore not a true reflection of the level of ordinary skill. 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. Contrary to petitioner's arguments that the answer (B) states that near simultaneous invention proves obviousness, the question specifically states 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." This does not ask about proof of obviousness but evidence of skill. It asks whether if near simultaneous invention existed, would such be evidence of the level of skill in the art at the time of the

invention.

International Glass stated at 442, “[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.” *Merck* 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 at 1983, “[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*. 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 answer (A) is also correct. Petitioner contends that answer (A) does not say that pointing out differences is sufficient for determination of patentability, but merely that arguments are necessary. Petitioner argues that answer (A) is correct because presenting arguing claims separately causes claims to stand or fall separately. Petitioner makes no argument against answer (E). Petitioner concludes that answers (A) and (E) are each correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (A) does not say pointing out differences is sufficient for determination of patentability, but merely that arguments are necessary, that answer states each appealed claim stands or falls separately **as a result of** appellant pointing out differences in what the claims cover. This answer states that it is sufficient to point out differences to have claims stand or fall separately. As shown in the model answer, this is not sufficient, rendering answer (A) 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.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice (E).

The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically not abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 ("If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first."). See MPEP § 710.01(a), fourth paragraph.

Petitioner argues that answer (A) is correct. Petitioner contends that the question did not state that shortened statutory time periods were assigned to applications C and D, in which case, both were copending when E was filed and E could get the benefit of B's filing date of October 21,

1993 to which both C and D claimed and were copending with. Petitioner concludes that answer

(E) is incorrect.

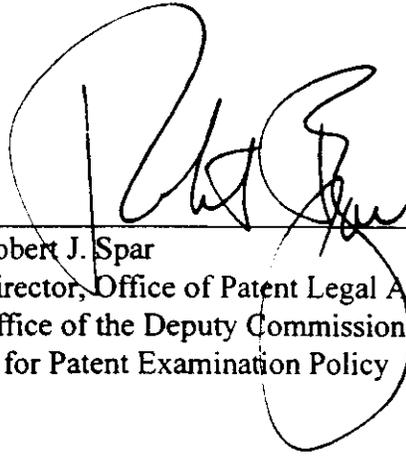
Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the question did not state that shortened statutory periods were assigned to applications C and D, the instructions specifically state that the most correct answer is the policy, practice, and 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*. As explained in MPEP § 710.02(b), under the authority given him by 35 USC § 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. That same MPEP section also states that such shortened period is 3 months to reply to any Office action on the merits. Accordingly, the Office actions that were mailed on April 20, 1999 for applications C and D were assigned shortened periods according to the PTO rules of practice and procedure, rendering C and D abandoned at the time of E's filing and making the correct answer (E). 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 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