



R-2000-123

DEC 13 2000

In re

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

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading questions 2, 16, 19, 39, and 49 of the morning section and question 16 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 10, 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 additional one point on the Examination. However, no credit has been awarded for morning questions 16, 19, 39 and 49 and afternoon question 16. Petitioner's arguments for these questions are addressed individually below.

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 (C) is the most correct. Petitioner contends that claim 9 fails to satisfy 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 101, and therefore dependent claims 10 and 11 are also improper.

Petitioner's argument has been fully considered but is not persuasive. The question on asking about the respective claims under **35 U.S.C. § 112, fourth paragraph**. The question specifically restricts its scope to matters of 35 U.S.C. § 112, fourth paragraph. Claim 9, as an independent claim, is proper under 35 U.S.C. § 112, fourth paragraph. Only claim 11 is improper under 35 U.S.C. § 112, fourth paragraph. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 19 reads as follows:

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim 1, the sole claim. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled "electronics control unit." Claim 1 of the Williams application is as follows:

Claim 1. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit coupled to the infrared sensor and the timer mechanism.

You received a final Office action, dated February 1, 2000, containing an indication that claim 1 is allowable subject matter, but objecting to the specification, on the grounds that the subject matter of the electronics control unit, though adequately described in the original specification, was required to be shown in the drawings. Which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection?

- (A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.

- (C) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2000, file a petition urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

The model answer is choice (B).

Answer (B) is correct. 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). Choices (A), (C), and (D) are incorrect. As stated in MPEP § 706.03(o), "If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing." See MPEP § 608.01(l). (D) is incorrect because the reply is not timely. (E) is incorrect because (B) is correct.

Petitioner argues that answer (A) is the most correct answer. Petitioner contends that the subject matter of the electronics control unit was adequately described in the specification, therefore (A) is correct. Petitioner also maintains that answer (B) is incorrect because it does not include a reply.

Petitioner's argument has been fully considered but is not persuasive. The objection is on the grounds that the subject matter of the electronics control unit is not adequately shown in the drawings. A brief pointing out that the subject matter of the electronics control unit was adequately described in the specification will not overcome an objection on the drawings. Accordingly, answer (A) cannot be correct. Answer (B) is correct because the drawing, itself, is the reply to the objection. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists \_\_\_\_\_

- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
- (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
- (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that none of the answer (B) is correct. Petitioner citing *Jonsson v. Stanley Works*, 711 F.Supp. 1395 (Fed. Cir. 1990) and *Jamesbury Corp. v. United States*, 518 F.2d 1384 (Ct. Cl. 1975), contends that the courts have used the term "recapture" to prevent enlarging claims in continuation applications, and not just reissue applications.

Petitioner's argument has been fully considered but is not persuasive. The cases cited by the petitioner are not applicable to the question. The courts in these cases were deciding the scope of

the claims for patent infringement purposes. The question asks for a circumstance that impermissible recapture exists in **an application**. According to MPEP 1412.02, the recapture rule applies to reissue applications. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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 (A).

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. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

Petitioner argues that answers (B) is correct. Petitioner contends that the term "non-practitioner" should be interpreted as a non-registered attorney because the exam instructions

state "any reference to a practitioner is a reference to a registered patent practitioner."

Petitioner's argument has been fully considered but is not persuasive. The instructions did not define the term "non-practitioner." Furthermore, 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*. According to 37 CFR 10.49, "[a] practitioner shall not form a partnership with a **non-practitioner** if any of the activities of the partnership consist of the practice of patent, trademark, or other law before the Office." Therefore, answer (B) cannot be the correct answer because the statement in answer (B) is true. 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*. Furthermore, "[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." *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 443 (US Cl Ct, 1968). 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.

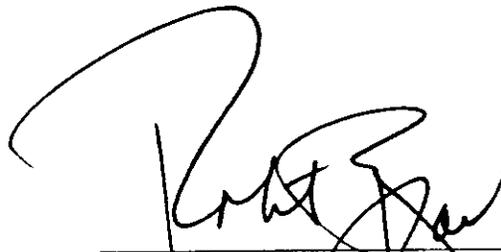
Petitioner's request for credit on this question is denied.

**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 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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