



JAN 5 2001

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 17, 19, 26, 29, 38 and 40 of the morning section, and questions 1, 10, 15, 16, 23, 48 and 50 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 originally scored 63. On June 12, 2000, petitioner requested regrading, arguing that the model answers were incorrect. On July 18, 2000, petitioner submitted a supplemental request containing additional arguments. On June 30, 2000, the Office revised the petitioner's score to 64 because it has been concluded that answers (A), (B), and (C) of question 15 in the afternoon session will be accepted as correct and one point was added to the petitioner's score. This decision is based on petitioner's score of 64 and the regrading of questions 17, 19, 26, 29, 38 and 40 of the morning section, and questions 1, 10, 16, 23, 48 and 50 of the afternoon section.

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.

No credit has been awarded for morning questions 17, 19, 26, 29, 38 and 40, and afternoon questions 1, 10, 16, 23, 48 and 50. Petitioner's 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 (E). Choice (E) is correct because choices (B) and (C) are correct. Choice (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. Choice (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective

layer. Choice (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer.

MPEP 2173.05(i).

Petitioner argues that answer (B) alone is correct. Petitioner argues that answer (C) is incorrect because the negative limitation in answer (C) may, but will not necessarily, overcome the 35 U.S.C. 102 rejection. Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is incorrect for the same reason.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's contention, the negative limitation "not including an adhesive layer" of choice (C) would overcome a 35 U.S.C. § 102 rejection based on the prior art which shows a laminate containing a transparent protective layer and a light-sensitive layer held together by an **intermediate adhesive layer**. Choice (C) avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. Accordingly, answer (C) is correct. Therefore, answer (E) is the most correct answer. 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 is (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.

Petitioner selected answer (C). Petitioner argues that choice (B) is incomplete because a "response" is required to respond to any office action. Petitioner asserts that since choice (B) does not indicate a "response" was filed with the drawing pursuant to 37 C.F.R. 1.113 that answer (B) is incomplete. Petitioner argues that choice (C) is correct since applicants may appeal from decisions of the primary examiner, and the best answer would be to point out that a black box depiction is sufficient.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (B) is the most correct answer. See 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). 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). The examiner indicated that claim 1 is allowable and required a drawing. The drawing is the response to the office action. Answer (B) is correct because the drawing, itself, is the reply to the objection.

In regard to choice (C), note that it proposes the filing of "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." However, there has been no allegation by the examiner that the addition of a drawing showing the electronics control unit would constitute the addition of new matter. The drawings are objected to because they fail to adequately show an electronic control unit as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter will not overcome the objection to the drawings. Accordingly, answer (C) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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

Petitioner argues that answer (E) is correct because diligence imposed on a registered practitioner is subjective, and nothing more than reasonable diligence is required. Petitioner further contends that answer (C) is incorrect because a method does not have to be successfully performed to have an actual reduction to practice.

Petitioner's argument has been fully considered but is not persuasive. Answer (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP § 2138.06 (section styled "Diligence Required In Preparing And Filing Patent Application). *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable). Petitioner appears to acknowledge that at least "reasonable" diligence is imposed on the practitioner.

The statement in answer (C) is correct because a method does have to be successfully performed to have an actual reduction to practice, *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928) ("A process is reduced to practice when it is successfully performed."). See MPEP § 2138.05 (section styled "Requirements To Establish Actual Reduction To Practice"). Since the statement in answer (C) is correct and the statement in (E) is incorrect, no error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 29 reads as follows:

29. You are attorney of record appointed by XYZ Corp. to prosecute a patent application directed to an invention assigned to the XYZ Corp. by an employee-inventor. In the course of prosecution, you receive an Office action rejecting all the claims as anticipated by a patent to Williams. After carefully reviewing the Office action and discussing the same with XYZ officers, it is concluded that the rejection is sound. In accordance with instructions from XYZ officers, you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention, and an express abandonment signed by you under 37 C.F.R. § 1.138. An appropriate PTO official acknowledges receipt and accepts the express abandonment. Shortly thereafter, you receive an urgent call from the employee-inventor, who informs you that she just learned of the action taken to abandon the application, and that she has reviewed the Williams patent and concluded that her invention differs therefrom in a subtle but significant manner. Which of the following courses of action, if any, are properly available to you to successfully revive the application in accordance with proper PTO practice and procedure?

- (A) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was without the inventor's consent.
- (B) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was the result of a mistake.
- (C) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(a) on the ground that the filing of the express abandonment was unavoidable.
- (D) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(b) on the ground that the filing of the express abandonment was unintentional.
- (E) None of the above.

The model answer is choice (E). None of the other choices are properly available to successfully revive the application in accordance with proper PTO practice and procedure.

Petitioner argues that choice (A) should be given credit. Petitioner appears to argue that choice (E) is incorrect because the question is vague, and because some or all of choices (A), (B), (C) or (D) could be correct under PTO practice and procedure.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (E) is the correct answer because the express abandonment was the result of a deliberative, intentional course of action. MPEP 711.03 (c) states:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137 (b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldaque*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

An intentional abandonment of an application precludes a finding of unavoidable or unintentional delay pursuant to 37 C.F.R 1.137. Further, choice (A) is incorrect because an express abandonment is effective if signed by the attorney or agent of record. 37 CFR 1.138. Choices (A), (B), (C) and (D) are incorrect, and choice (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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 (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. *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). Choice (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* Choice (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. Choice (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. Choice (E) is incorrect because “late claiming” was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

Petitioner appears to argue that choice (B) is the most correct answer because the recapture doctrine cannot apply.

Petitioner’s argument has been fully considered but is not persuasive. Choice (A) is the most correct answer and choice (B) is wrong because arguments alone can cause a surrender of

subject matter that may not be recaptured in reissue. In *Hester Indus., inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998), the Court observed that surrender of claimed subject matter may occur by **arguments** made during the prosecution of the original patent application **even where there was no claim change made**. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone." 142 F.3d at 1482, 46 USPQ2d at 1649. Therefore, answer (A) is the best answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 40 reads as follows:

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

- (A) Once the claims of a patent application are determined to be invalid by the Board of Patent Appeals and Interferences, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (B) Once the claims of a patent application are determined to be invalid by the Court of Appeals for the Federal Circuit, an applicant may not thereafter file another patent application regarding the same invention with narrower claims.
- (C) Collateral estoppel bars an applicant from filing several applications for obvious improvements of the same invention.
- (D) The failure of an independent claim in a patent to claim a feature of the invention, which is not found in a genus, results in Jenson estoppel against the inventor claiming the invention with the feature in another patent application.
- (E) During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims.

The model answer is choice (E). During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims.

Petitioner argues that choice (E) is incorrect, and choice (C) is the most correct answer.

Petitioner contends that choice (E) contains awkward wording because claims cannot be broadened during reexamination under 37 CFR 1.530(d). Petitioner appears to argue that choice (C) also contains awkward wording, and that collateral estoppel does bar an applicant from filing several applications for obvious improvements of the same invention.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner's contentions regarding perceived awkward wording in the answer choices are unfounded. Choice (E) is a true statement. During reexamination, if the independent claims of a patent are not broadened, then amendments to the dependent claims cannot broaden the scope of the invention covered by the claims. Since independent claims are the broadest claims in an application, and dependent claims depend on the independent claims, broadening of a dependent claim can not broaden the scope of invention. This logical deduction was noted in *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). As to choice (C), obviousness-type double patenting, not collateral estoppel, prevents an applicant from filing several applications for obvious improvements of the same invention. Therefore, choice (E) is the best answer. 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 is (D). In a utility case, gross sales figures accompanied by evidence of brand name recognition does not constitute probative evidence of commercial success to support a contention of non-obviousness.

Petitioner selected answer (B). Petitioner argues that the question is not clear, and that each of answers (A), (B), (C) and (D) are probative as well as not probative to varying degrees. Petitioner argues that answer (D) is incorrect because there is a "nexus" between the evidence of commercial success and the claimed invention. Petitioner argues that answer (B) is correct because there is no "nexus" between the evidence of commercial success and the claimed invention.

Petitioner's arguments have been fully considered but they are not persuasive. In regard to petitioner's contention that the different answers lack or have the requisite showing of a "nexus" between the evidence of commercial success and the claimed invention, it is noted that the question does not require such a showing. The question asks which choice does not constitute "probative evidence" of commercial success to support a contention of non-obviousness, **not** whether the requisite "nexus" between such evidence and the claimed invention can be shown in any given case. The issue is which types of evidence described in the choices are, or are not, "probative evidence" of commercial success.

In regard to choice (D), MPEP 716.01(c) states "[i]n considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived

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from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such **success is not the result of heavy promotion or advertising, shift in advertising . . .**” These factors are directly related to brand name recognition, thus choice (D) is not probative evidence of commercial success.

In regard to choice (B), gross sales figures accompanied by evidence as to the time period during which the product was sold does 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. Choice (D) is the most correct response. 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). Sam should do nothing, and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2-10 is confirmed. See MPEP §§ 2287 and 2288. As to choice (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 choice (A), bankruptcy will not stay a reexamination. As to choice (C), false representations are prohibited by the rules. As to choice (D), there are no divisional reexaminations.

Petitioner argues that choice (B) is incorrect and choice (D) is correct. Petitioner argues that choice (B) is not correct because the patentability of dependent claims 2-10 will not be confirmed. Further, petitioner argues that choice (D) is correct because a divisional application should be filed.

Petitioner's argument has been fully considered but is not persuasive. Answer (D) is incorrect because **there are no divisional reexaminations**. Contrary to petitioner's contention that Sam must file something because the patentability of dependent claims 2-10 will not be confirmed, no action is required in a 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 as per MPEP § 2260.01. Rewriting patentable dependent claims in independent form in a reexamination proceeding is not required. As the original patent claim numbers are not changed in a reexamination proceeding, the content of the canceled base claim would remain in the printed patent and would be available to be read as part of the allowed dependent claim. See MPEP 2260.01. No papers need to be filed with the PTO to preserve the client's rights. Sam should do nothing, and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2-10 is confirmed. See MPEP §§ 2287 and 2288. The statement in answer (B) is correct and the statement in answer (D) is incorrect. 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). 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 argues that choice (B) is incorrect, and that the most correct answer is choice (C).

Petitioner argues that choice (B) is not correct because MPEP 2141.03 does not list nearly simultaneous invention as evidence of the level of skill in the art. Petitioner further contends that

case law does not support choice (B). Petitioner argues that choice (C) is correct because nearly simultaneous invention may be evidence of a long-felt need for the invention.

Petitioner's arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. See *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) (...evidence of contemporaneous invention is probative of "the level of knowledge in the art at the time the invention was made."). See Also *International Glass Co. v. U.S.*, 159 USPQ 434, 442 (US Cl Ct 1968) (The fact of nearsimultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.). Choice (B) finds clear support in the cited case law. As to choice (C), simultaneous invention is not evidence of a long-felt need for the invention. Long-felt need for an invention is demonstrated by attempts over a long period of time to solve a particular problem or to fill a particular need, or at least recognition of the existence of such problem or need for a long period of time. See MPEP 716.04. By its very nature, *simultaneous* invention is contemporaneous, and thus can not demonstrate long-felt need (i.e. it does not take place over a long period of time). Therefore, choice (B) is correct, and choice (C) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid,

and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advise on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advice Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

The model answer is choice (C). Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second

patent directed to the windshield wiper for trucks embodiment. As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. Cf. MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to answer (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to answer (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to answer (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

Petitioner argues that choice (D) is the most correct answer. Petitioner contends that answer (C) is incorrect because Ajax may attempt to claim their modification to the truck windshield

wiper, and Chris would be barred from filing a new application. Petitioner argues that answer (D) is correct because Chris could file a continuation-in-part application and avoid the testing by Ajax.

Petitioner's argument has been fully considered but is not persuasive. In regard to answer (C), the question says nothing about Ajax filing an application, nor would such be relevant to choice (C). Answer (C) specifically states that Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment. This is a true statement. Statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. In regard to answer choice (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 because a continuation-in-part application would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment. Therefore, choice (D) is incorrect, and choice (C) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 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 (D). Choice (D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("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..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). Choice (A) is incorrect. See MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry **more** weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Choice (B) is incorrect. See MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Choice (C) is incorrect. See MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

Choice (E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry), "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)."

Petitioner argues that choice (E) is correct and choice (D) is incorrect. Petitioner contends that answer (D) is incorrect because properties inherent in the subject matter may not be considered if they are not disclosed in the specification or known to one of ordinary skill in the art. Petitioner provides an extensive grammatical critique of answer (D) to show that the answer has two independent assertions that consideration is given to the properties of the subject matter which are inherent in the subject matter and that consideration is given to the properties of the subject matter disclosed in the specification, and petitioner contends the first of these two contentions is incorrect. Petitioner contends that answer (E) is correct because later discovered advantages can be used to establish secondary considerations.

As to answer (D), contrary to petitioner's statement that consideration is not given to subject matter that is inherent but disclosed or known to one of ordinary skill, the model answer's cited case *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977), specifically states that "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..." This shows the correctness of answer (D) and negates petitioner's arguments both by stating that consideration is given to the invention as a whole, which necessarily incorporates all properties, and by grammatically mirroring answer (D). To the extent answer (D) is subject to multiple

interpretations, so is the case that demonstrates the correctness of answer (D). Therefore, answer (D) cannot be negated on grammatical grounds. Further *Antoine* and MPEP § 2141.02 both state that the invention as a whole is considered which necessarily includes inherent properties. Accordingly, answer (D) is correct.

As to answer (E), it is a statement regarding what "obviousness" can be predicated on, and is not a statement regarding the establishment of secondary considerations for demonstrating "nonobviousness". As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry), "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)." Accordingly, answer (D) is correct and answer (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 50 reads as follows:

50. Which of the following is true?

- (A) Reissue applications may be filed to correct errors made without deceptive intent provided that an application is filed within two years from issuance.
- (B) An interference may be declared between three parties who invent their inventions in three different countries and each party may be declared the winner for some of the counts at issue.
- (C) An assignment may not be made conditional on the performance of the payment of money since the public has no way of knowing whether or not payment is made.
- (D) A patent may not be issued to an assignee and if the inventor dies before the patent issues, the rights to the invention are forfeited.
- (E) Anyone may obtain reexamination of a patent upon filing a request for the same as many times as they please provided they pay the required fee each time.

The model answer is any of choices (A) or (B) or (E). As to choice (A), reissue applications may be filed to correct errors made without deceptive intent provided that an application is filed within two years from issuance. 35 U.S.C. 251. As to choice (B), an interference may be declared between three parties who invent their inventions in three different countries and each party may be declared the winner for some of the counts at issue. There is no limit on the number of parties or countries or winners. A given inventor may have reduced to practice certain counts without having reduced to practice others. As to choice (E), anyone may obtain reexamination of a patent upon filing a request for the same as many times as they please provided they pay the required fee each time. This is true inasmuch as no facts are given that the request is filed for purposes of harrassment. As to choice (C), an assignment **may** be made conditional on the performance of the payment of money. 37 CFR 3.56. As to choice (D), a patent **may** be issued to an assignee, and the rights to the invention are **not** forfeited if the inventor dies before the patent issues.

Petitioner argues that choice (C) is correct and choices (A) and (E) are incorrect. Petitioner argues that choice (A) is partially incorrect because it is not limited to reissue applications which seek to broaden the scope of the claims. Petitioner argues that choice (E) is partially incorrect because it does not address the issues of harassment or the presence of a substantial new question of patentability. Petitioner argues that choice (C) is correct because such an assignment is regarded as absolute when recorded, and when such an assignment is recorded the conditional statement is known to the public.

Petitioner's argument has been fully considered but is not persuasive. In regard to choice (C), an assignment **may** be made conditional on the performance of the payment of money. This

is specifically stated in 37 CFR 3.56. Therefore, choice (C) is incorrect. The fact that such a conditional assignment is treated as absolute by the PTO has no bearing on whether the statement in choice (C) is true. In regard to choice (A), reissue applications may be filed to correct errors made without deceptive intent provided that an application is filed within two years from issuance. See 35 U.S.C. 251. In regard to choice (E), anyone may obtain reexamination of a patent upon filing a request for the same as many times as they please provided they pay the required fee each time. This is true inasmuch as no facts are given that the request is filed for purposes of harrassment. The presence of a substantial new question of patentability only arises in the context of determining whether the request for reexamination will be granted, not in the context of whether the request may be filed. No error in grading has been shown. Petitioner's request for credit on this question is denied.

No error in grading has been shown as to morning questions 17, 19, 26, 29, 38 and 40, and afternoon questions 1, 10, 16, 23, 48 and 50. 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 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