

R-2001-136



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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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 her answers to question 16 of the morning section and question 10 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 31, 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.

No credit has been awarded for morning question 16 and afternoon question 10.

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 ½ 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). Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

Petitioner argues that the most correct answer is choice (C). Petitioner argues that claim 9 is not supported in the specification and improper under the first paragraph of 35 U.S.C. 112.

Petitioner's arguments have been fully considered but they are not persuasive. Claims 9 and 10 are original claims in the application and constitute part of the original disclosure. Thus, they are self supporting, and satisfy the requirements of the first paragraph of 35 U.S.C. 112.

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.

Petitioner argues that the most correct answer is choice (E). Petitioner argues that while choice (B) is an appropriate course of action, the letter described in choice (E) is equally or more correct, and that it will result in the same outcome as choice (B) if the client does not submit payment in advance in response to the letter. Petitioner argues that the letter does not constitute a formal withdrawal, but just a request for payment in advance.

Petitioner's arguments have been fully considered but they are not persuasive. The letter described in choice (E) would not be a proper course of action because Sam must first request to withdraw and obtain permission from the PTO in accordance with 37 CFR 10.40 and MPEP 402.06. Further, Sam has been told by his client that they do not have funds to continue prosecution. If Sam does nothing, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since the Sam agrees with the propriety of the rejection of claim 1, the client is not prejudiced, nor is it adversely affected. The facts state that Sam received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client. The client then advised Sam that they have no funds available to further prosecute the reexamination proceeding. Thus, the client is aware of the office action and Sam's agreement with the Examiner. Choice (E) is improper because the letter states that Sam will take no further action in the proceeding and file no papers with the PTO unless he is paid, however, no further action or filing is necessary on the part of Sam. No papers need to be filed with the PTO to preserve the client's rights, so Sam should not be charging the client or withdrawing if no advanced payment is made.

No error in grading has been shown as to morning question 16 and afternoon question 10. 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

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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 68. 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