



FEB 19 2002

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 questions 11, 19, 40 and 45 of the morning section and question 41 of the afternoon section of the Registration Examination held on April 18, 2001. 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 66. On August 3, 2001, 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, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and

37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **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. 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 court decision, a notice in the Official Gazette, or a notice in the Federal Register. 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 that 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" or "Office" are used in this examination, they mean the United States 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 11, 19, 40 and 45 and afternoon question 41. Petitioner's arguments for these questions are addressed individually below.

Morning question 11 reads as follows:

11. Registered practitioner Ethel prepares a utility patent application (not a CPA) for inventor Fred, using her only copy of a published article, "Engineering Design," published June 8, 1995, to draft the application. Thereafter, Ethel accidentally runs the copy of the article through her paper shredder. Ethel duly files the application in the USPTO on May 29, 1999. The examiner sends Ethel a non-final Office action dated December 7, 2000, setting a three-month period for reply, including a rejection of claim 1 and a requirement for information under 37 CFR § 1.105 requiring her to submit a copy of the article, "Engineering Design." Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?

- (A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.
- (B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).
- (C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.
- (D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.
- (E) None of the above.

The model answer is selection (C).

37 CFR § 1.105(a)(3) (effective November 7, 2000), "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000), and 37 CFR § 1.136(a)(1). (C) is correct pursuant to 37 CFR § 1.105(a)(3). (A) is incorrect because it is not responsive to the requirement for information. (B) is incorrect because "each attorney or agent who prepares or prosecutes the application," is identified an individual under 37 CFR § 1.56(c). (D) is incorrect because information used to draft an application may be required under 37 CFR § 1.105(a)(1)(iv). (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that Ethel's statement that a published article is not readily available is inappropriate because it is disingenuous and would make Ethel subject to possible discipline.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Ethel's statement that a published article is not readily available is inappropriate because it is disingenuous and would make Ethel subject to possible discipline, the question asked is which of the choices would properly be accepted by the USPTO as a complete reply to the requirement for information. (C) is correct pursuant to 37 CFR § 1.105(a)(3). (E) is incorrect because (C) is correct. The question neither offers any facts evidencing the ready availability of the published article nor asks whether any of the choices would place a practitioner in jeopardy of sanctions. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

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

Morning question 19 reads as follows:

19. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.

(D) (A) and (C).

(E) None of the above.

The model answer is selection (A).

In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that Eve's heating system is a distinct invention, different from MC Motor's reverse heating system and therefore Eve would be entitled to a patent making (A) incorrect and leaving (E) as the only choice.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Eve's heating system is a distinct invention, different from MC Motor's reverse heating system and therefore Eve would be entitled to a patent making (A) incorrect and leaving (E) as the only choice, the facts state "Eve demonstrated her reverse automobile heating system at a testing facility in Germany". Thus Eve's invention is the same reverse heating system as MC Motors' application discloses, irrespective of the title Eve applies to the disclosure. and Eve is not entitled to a patent on the same invention. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

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

Morning question 40 reads as follows:

40. In June 1998, Jack and Jill, a married couple, are vacationing in Vietnam (not a WTO country) when they encounter a man selling bamboo knives for cleaning fish. The particular curvature of the bamboo both lends support to the knife to prevent it from bending and breaking and facilitates cleaning inside the fish. Jill takes a picture of Jack with the knife cleaning the fish. Subsequently, in November 1998, when Jack returns to the United States he begins to make and sell an identical knife to the one seen in Vietnam. In July 1999, he files a patent application claiming the nearly identical knife. Jack discloses no prior art during the prosecution of his application and fails to mention the knife he saw in Vietnam. The examiner finds no prior art similar to the claimed knife,

and Jack is awarded a patent in December 2000. Meanwhile, Jill divorces Jack, and associates with Sam. Unfortunately, Sam is penniless. To raise cash, Sam and Jill begin selling a knife identical to the one Jack produces, only Sam and Jill make their knife out of plastic. The knives of Sam and Jill sell like hotcakes. Jack sues for infringement. Jill and Sam come to you for advice. Which of the following is not true?

- (A) Jack is entitled to patent protection since Vietnam is not a WTO country and evidence of the Vietnamese knife cannot be used against him to reject his patent claims.
- (B) Jack had a duty under 37 C.F.R. § 1.56 to disclose his discovery of the bamboo knife in Vietnam to the examiner during the original patent prosecution.
- (C) Since the use in Vietnam was not in this country, it does not constitute a public use bar under 35 U.S.C. § 102(b).
- (D) If Jill's attorney files a request for reexamination, it will be denied because the picture is not a patent or printed publication.
- (E) Although Jack marketed the invention before obtaining a patent, the patent claims cannot be invalidated under 35 U.S.C. § 102(a) since Jack's making and selling of the knife cannot be used against him under 35 U.S.C. § 102(a).

The model answer is selection (A).

Answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137. Answer (B) is correct in that Jack should have disclosed "all information material to patentability," including the existence of the Vietnamese knife, during the original patent prosecution. (C) is correct in that to qualify as prior under 35 U.S.C. § 102(b), the use must be in this country. (D) is correct in that a request for reexamination must be based upon patents and printed publications. (E) is correct in that public use derived from the inventor's own work cannot be used against the inventor under 35 U.S.C. § 102(a). MPEP § 2132.

Petitioner argues that answer (B) is correct. Petitioner contends that (A) is not an appropriate answer because Jack's knife, although nearly identical, was not identical and therefore not subject to 35 USC 102(f), and that (B) is an appropriate answer because it is possible Jack believes the knife in Vietnam is not material to patentability.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (A) is not an appropriate answer because Jack's

knife, although nearly identical, was not identical and therefore not subject to 35 USC 102(f), and that (B) is an appropriate answer because it is possible Jack believes the knife in Vietnam is not material to patentability, answer (A) is not true since Jack did not invent the knife, therefore he is not entitled to a patent. Jack derived the invention from another, and the picture of Jack with the Vietnamese knife is evidence of derivation. 35 U.S.C. § 102(f); MPEP § 2137. Answer (B) is correct in that Jack should have disclosed "all information material to patentability," including the existence of the Vietnamese knife, during the original patent prosecution. The facts show no patentable distinction between the knife in Vietnam and the knife Jack claimed and the facts also indicate the two are nearly identical, so the Vietnam knife reads on Jack's claimed knife. The near identity of the two knives is within the definition of materiality of patentability. Jack must adhere to the requirements of 37 CFR 1.56 because the Vietnam case provides a prima facie case of unpatentability. Petitioner has shown no patentable distinction between the Vietnam knife and Jack's claimed knife and the facts clearly indicate that there is no such distinction. Accordingly, model answer (A) is correct and petitioner's answer (B) is incorrect.

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

Morning question 45 reads as follows:

45. In regard to patent application drawings, which of the following is in accord with proper USPTO practice and procedure?

(A) Views in a drawing may be connected by projection lines, and views may contain center lines in patent applications filed in April 2001.

(B) Photographs must be developed on paper that is DIN size A4 or 8½ by 11 inches, and meet margin requirements set by regulation in applications filed in April 2001.

(C) Color drawings are permitted by regulation, and without further authorization, in an application submitted under the Office electronic filing system in April 2001.

(D) The Office will accept black and white photographs in utility or design applications filed in April 2001 only if three copies of black and white photographs, and a petition and fee are filed to have such photographs accepted.

(E) In applications filed in April 2001, the scale of a drawing must be properly indicated by statements such as "actual size" or "scale ½."

The model answer is selection (B).

37 C.F.R. § 1.84(e), (f) and(g). See, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031-57032 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (A) is not the most correct answer. 37 CFR § 1.84(j) provides that views in a drawing must not be connected by projection lines, and views must not contain center lines. (C) is not the most correct answer. 37 C.F.R. § 1.84(a)(2) provides that "[c]olor drawings are not permitted in...an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications...only after granting a petition filed under this paragraph explaining why the color drawings are necessary." Any such petition must include a fee and meet the certain requirements set forth in the last sentence of § 1.84(a)(2). See, Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 F.R. 57024, 57031 (September 20, 2000), 1239 O.G. 125 (Oct. 17, 2000). (D) is not the most correct answer. 37 C.F.R. § 1.84(b)(1) was "amended to eliminate the requirement for three copies of black and white photographs and a petition to accept such photographs." See, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, middle column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.84(k) provides that "Indications such as 'actual size' or 'scale ½' on the drawings are not permitted since these lose their meaning with reproduction in a different format." See, Changes to Implement The Patent Business Goals, Final Rule, 65 F.R. 54604, 54628, right column (September 8, 2000), 1238 O.G. 77 (Sept. 19, 2000).

[Note re Question 45, choice (E), first line: Examination proctors were instructed to direct examination candidates to insert after "must," the word --be--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if any or all of the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.]

Petitioner argues that answer (C) is correct. Petitioner contends that 37 CFR 1.84(f) is silent as to whether all photographs must be developed on A4 or 8 ½ x 11 paper and any such requirement would exclude digital photographs.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 37 CFR 1.84(f) is silent as to whether all photographs must be developed on A4 or 8 ½ x 11 paper and any such requirement would exclude digital photographs, 37 CFR 1.84(e) states "[p]hotographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section" and 37 CFR 1.84(f) states "[a]ll drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

- (1) 21.0 cm. by 29.7 cm. (DIN size A4), or
- (2) 21.6 cm. by 27.9 cm. (8 ½ by 11 inches)."

Petitioner admits that answer (C) is incorrect. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

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

Afternoon question 41 reads as follows:

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

- (A) Applicant's mailing address.
- (B) Applicant's citizenship.
- (C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.
- (D) (B) and (C).
- (E) All of the above.

(C) or (D) are accepted as correct answers.

37 CFR § 1.76(d) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant's mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant's citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if "applicant" in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted

because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that the sentence “The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship.” in the fact pattern may mean only that an application data sheet can include the applicant's full name, residence, mailing address, and citizenship, which is true, and where (A) is true, (E) would be the best answer..

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the sentence “The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship.” in the fact pattern may mean only that an application data sheet can include the applicant's full name, residence, mailing address, and citizenship, which is true, and where (A) is true, (E) would be the best answer, there is no reason to assume the application data sheet did not include the applicant's full name, residence, mailing address, and citizenship, given the explicit use of the verb “includes” without any subjunctive modifier (e.g. can, could, should, would) in the cited sentence. Applicant's mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. Accordingly, model answer (C) or (D) is correct and petitioner’s answer (E) is incorrect.

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

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 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.



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