



AUG 6 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 question 6 of the morning section and questions 3 and 21 of the afternoon section of the Registration Examination held on October 18, 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 February 1, 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 the Office 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. 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" 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.

Petitioner has been awarded an additional point for morning question 6. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for afternoon questions 3 and 21. Petitioner's arguments for these questions are addressed individually below.

Afternoon question 3 reads as follows:

3. Which of the following statements regarding amending a reissue application is not correct?

- (A) An entire paragraph in the specification other than the claims may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.
- (B) In a claim, hand entry of an amendment of five words or less is permitted.
- (C) Each amendment submission must set forth the status, on the date of the amendment, of all patent claims and of all added claims.
- (D) When responding to an Office action, each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment.
- (E) A new claim added by amendment must be presented with underlining throughout the claim.

The model answer is selection B.

Hand entry of amendments to a claim in a reissue application is no longer permitted. 37 C.F.R. § 1.121(b)(2). Answers (A), (C) and (D) are all changes that were made pursuant to the December 1, 1997, change. 37 C.F.R. §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 C.F.R. § 1.121(b)(2)(i)(A) and MPEP § 1453.

Petitioner argues that answer (A) is also correct. Petitioner contends that answer

(A) failed to add that the precise point in the specification is located as required by 37 C.F.R. §§ 1.121(b)(1)(ii) and therefore the statement in (A) is not correct, making (A) a correct answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (A) failed to add that the precise point in the specification is located as required by 37 C.F.R. § 1.121(b)(1)(ii) and therefore the statement in (A) is not correct, a statement deleting an entire paragraph would inherently satisfied the requirement in 37 CFR 1.121(b)(1)(ii). Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

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

Afternoon question 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make a amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (B) is also correct. Petitioner contends that the Office accepts drawing amendments either incorporated in the response to an Office action or as a separate paper, relying on the phrase "should be in a separate paper" in 37 C.F.R. § 1.121(a)(3)(ii) as contrasted with "must".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the Office accepts drawing amendments either incorporated in the response to an Office action or as a separate paper, MPEP § 608.02(r) states that any correction must be embodied in a separate letter. Accordingly, model answer (C) 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.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 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.



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