

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____)
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Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

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MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 1, 20, 25, and 43 of the morning session and questions 4, 10, and 14 of the afternoon session of the Registration Examination held on April 21, 1999. 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 Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 63. On August 4, 1999, 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 Commissioner.

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 considered. Each question in the examination is worth one point.

Petitioner has been awarded points for morning questions 20, 27, 43 and 45 and afternoon questions 28 because these questions have been eliminated from the examination. Accordingly, Petitioner has been granted an additional five points on the examination, resulting in a regraded score of 68. However, no credit has been awarded for morning questions 1 and 25 and afternoon questions 4, 10, and 14.

Morning question 1 reads as follows:

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. The Office Action was dated September 15, 1998 and set a three month shortened statutory period for reply. P's unsigned reply, filed February 3, 1999, did not include a petition for an extension of time and contained only the following paragraph:

Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and have attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of those remarks. Please charge my deposit account number 99-1234 to cover the cost of any required fees.

P should not be surprised when the amendment is not entered because:

- (A) The reply was not signed.
- (B) An amendatory paper determined to contain objectionable remarks will be returned to sender.
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A), (B) and (C) are correct.

Choice (D) is correct because both choices (A) and (B) are correct. A reply that is not signed is not entered, but applicant is given an opportunity to ratify the reply. See Manual of Patent Examining Procedure (MPEP) § 714.01(a). A reply determined to contain objectionable marks will be returned. See 37 CFR § 1.3. Choice (C) is not correct because a general authorization to charge a deposit account is a request for an extension of time, albeit an unsigned one in this instance. See 37 CFR § 1.136(a).

Petitioner contends that choice (E) is the correct response because when a deposit account is charged, the paper must be signed. Petitioner's argument is not persuasive. The question asks why the amendment is not entered. When the deposit account is properly charged is a different issue. 37 CFR § 1.136(a) provides a statement of authorization to charge all required fees will be treated as a constructive petition for an extension of time. Since the reply contained a statement of authorization to charge any required fees, a constructive petition for the extension of time was included in the reply. Accordingly, the amendment is not entered because of a reason other than the fee for an extension of time. In this fact pattern, the reasons the amendment is not entered are (A) the reply was not signed and (B) the reply contains objectionable remarks. See MPEP §§ 714.19 (E) & (K) and 714.25. Thus, choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 25 reads as follows:

25. Bert and Ernie are joint inventors of a widget that automatically adjusts television volume levels during commercial breaks. A nonprovisional patent application was filed on October 15, 1998, and a first Office action on the merits was mailed on January 11, 1999. A reply was filed on January 28, 1999, and a Notice of Allowance was mailed on February 26, 1999. The Issue Fee has not been paid. What is the **last day** that Bert and Ernie can file a properly drafted Information Disclosure Statement (IDS) **without** having to pay a fee and to ensure that the information submitted in the IDS would be considered by the examiner?

- (A) Friday, January 15, 1999, via facsimile with a Certificate of Transmission.
- (B) Sunday, January 10, 1999, via facsimile with a Certificate of Transmission.
- (C) Thursday, January 28, 1999, via first class mail with no Certificate of Transmission.
- (D) Friday, January 15, 1999, via "Express Mail Post Office to Post Office" with a Certificate of Express Mailing.
- (E) Thursday, February 25, 1999, via facsimile with a Certificate of Transmission but without a statement that each item cited in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to submission of the IDS.

The correct answer is choice (A) because January 15, 1999 was the latest date that Bert and Ernie can file the IDS since it was accompanied by a properly executed certificate of facsimile transmission. 37 CFR § 1.97(b) and MPEP § 609(B)(1).

Petitioner contends that choice (D) is correct and that credit should be given for all answers (A) through (D). According to Petitioner, “the answer should be on February 25, 1999 with a proper statement about the items being cited in a communication from a foreign patent office.”

Petitioner’s proposed answer would have more correct than the answers given, but it was not one of the choices. Furthermore, Petitioner’s argument that credit should be given for choice (D) is not persuasive. Choice (D) is wrong because it states that “Express Mail Post Office to Post Office” service is used, instead of “Express Mail Post Office to Addressee” service. Post Office to Post Office service should not be used. “‘Post Office’ to ‘Post Office’ Express Mail does not provide for delivery but instead is retained at the postal facility for pickup...the ‘Post Office’ to ‘Post Office’ Express Mail will not reach the Patent and Trademark Office.” MPEP § 502, page 500-7, left hand column. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 4 reads as follows:

4. In early 1997, Goforgod, a company based in Australia, developed a widget with increased reflective properties. Goforgod filed a patent application in the Australian Patent Office on January 8, 1997, and filed a corresponding application in the USPTO on January 5, 1998. All research activities for the inventions disclosed and claimed in the U.S. and Australian applications took place in Australia. The U.S. patent application contains five claims:

1. A widget comprising elements A and B.
2. A widget according to Claim 1 wherein the widget further includes element D.

3. A widget comprising elements A and C.
4. A widget according to Claim 3 wherein the widget further includes element E.
5. A widget comprising elements A, B, and C.

The Australian application only supports claims 1, 2, and 5 of the U.S. application. During the course of prosecution of the U.S. application, the examiner properly rejected all of the claims under 35 U.S.C. § 102(e) as being anticipated by a U.S. patent assigned to Gotthesilver. The Gotthesilver patent was granted on October 6, 1998, on a U.S. application filed on June 15, 1997. The Gotthesilver patent specifically describes, but does not claim, the widget in claims 1-5 of the U.S. application filed by Goforgold. The subject matter of the Gotthesilver patent was reduced to practice in Flushing, New York as of February 12, 1997. Which of the following proposed arguments or actions would properly overcome the examiner's § 102(e) rejection with respect to all the claims?

- (A) File an affidavit under 37 CFR § 1.132 swearing behind the claims of the Gotthesilver patent by relying on the 1997 research activities of Goforgold in Australia.
- (B) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application and canceling Claims 3 and 4.
- (C) File a claim for a right of priority based on the application filed in Australia along with a certified copy of the Australian patent application.
- (D) File an affidavit under 37 CFR § 1.132 swearing behind the February 12, 1997, reduction to practice date of the Gotthesilver patent.
- (E) File a terminal disclaimer.

Choice (B) is the most correct answer because the Australian application provides support for claims 1, 2, and 5 of the U.S. application, but not claims 3 and 4. The filing date can be antedated by applicant's earlier foreign priority application if 35 U.S.C. 119 is met and the foreign application supports the claims of the U.S. application. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989)."

Petitioner contends that choice (D) is preferable over choice (B) because it would properly overcome the examiner's rejection without canceling claims 3 and 4. According to Petitioner, "there is no desire to have the PTO determine whet[h]er the facts establishing swe[a]ring back obviate a 102(g) rejection based upon the Gotthesilver reduction to practice in Queens."

Petitioner's arguments are not persuasive. Choice (D) is not the correct answer because an affidavit under 37 CFR 1.132 would not be appropriate in this example since no facts were presented in the question to suggest that the Gotthesilver disclosure was derived from Goforgold. Affidavits under 37 CFR 1.131 are used to overcome a prior art rejection by swearing behind a certain date. 37 CFR 1.132 affidavits are used to establish that the reference discloses applicant's invention. See MPEP § 715.01 (not §715.04 as stated in Petitioner's argument), which states "an affidavit or declaration under 37 CFR § 1.132 would be appropriate to overcome a rejection under 35 U.S.C. 102(f) or (g) rejection by proving that the subject matter relied upon and the claimed invention were commonly owned or subject to common assignment at the time the later invention was made." MPEP § 715.01 further explains "[a]n affidavit or declaration filed under 37 CFR § 1.131 would be appropriate to overcome a prior art rejection by proving invention of the claimed subject matter by applicant prior to the effective date of the reference relied upon in the rejection." Thus, an affidavit under 37 CFR § 1.132 is inappropriate for the situation presented in the question and choice (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. You are a registered patent agent with an office in Buffalo, New York. On January 13, 1998, Murphy, a resident of Canada, came to your office for purpose of obtaining a U.S. patent on here invention. She tells you that she first conceived her invention at her home in Ontario on December 18, 1996, and that she reduced it to practice on January 10, 1997, at her home. On January 13, 1998, Murphy provided you with a detailed written description fully disclosing her invention. You diligently proceeded to prepare the application. You filed the application in the PTO on February 12, 1998. Consider each of the situations presented in the questions below in light of the facts presented above and determine which paragraph of 35 U.S.C. § 102, if any, would prevent Murphy from obtaining a U.S. patent.

After the application was filed in the U.S., Murphy admitted that in order to make the claimed invention operative, the mechanic who built the prototype of Murphy's invention added a novel feature without consulting Murphy which is included in all the claims of the application.

- (A) 35 U.S.C. § 102(a).
- (B) 35 U.S.C. § 102(b).
- (C) 35 U.S.C. § 102(f).
- (D) 35 U.S.C. § 102(g).
- (E) None of the above.

Choice (C) is the correct answer because Murphy did not invent the subject matter sought to be patented. The subject matter being claimed included Murphy's invention and the novel feature added by the mechanic. The novel feature added by the mechanic made the claimed invention operative and was included in all the claims. 35 U.S.C. § 102(f) bars the issuance of a patent where an applicant did not invent the subject matter being claimed and sought to be patented. MPEP § 706.02(g). Thus, a 102(f) rejection is properly applied in this situation.

Petitioner contends that choice (D) is the most correct answer, not choice (C), since the mechanic is a co-inventor not named through error and inadvertence. According to the Petitioner, "the mechanic's contribution is said to be 'a' and not 'the' novel feature, it can only form part of a 103 rejection that can be overcome by the usual ways 103 rejection are overcome." Petitioner further assumes "Murphy came up with the novel feature as did the mechanic independently."

Petitioner's arguments are not persuasive. 35 U.S.C. § 102(g) bars the issuance of a patent where another made the invention in the United States before applicant and had not abandoned, suppressed, or concealed it. MPEP § 706.02(h). A 102(g) rejection applies only if Murphy also invented the claimed subject matter including the novel feature invented by the mechanic. However, the facts in the question did not show that Murphy invented the feature in

question. Choice (D) is not the correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 14 reads as follows:

14. A Certificate of Correction **cannot** be used to correct:

- (A) The failure to make reference to a prior copending application.
- (B) An incorrect reference to a prior copending application.
- (C) The omission of an inventor's name from an issued patent through error and without deceptive intent.
- (D) The omission of a preferred embodiment in the original disclosure overlooked by the inventor which would materially affect the scope of the patent.
- (E) (A), (B), and (D).

Choice (D) is the correct answer because the omission of a preferred embodiment that would materially affect the scope of the patent is not considered to be of the "minor" character required for the issuance of a Certificate of Correction. MPEP § 1481.

Petitioner contends choice (E) to be the most correct answer because Petitioner thought both choice (D) and choice (C) are correct. According to Petitioner, a Certificate of Correction may be issued only where the correction is being made pursuant to a court order. Petitioner further assumes that there was an error in the question's wording and concludes that "the correct answer is E."

Petitioner's arguments are not persuasive. MPEP § 1481 gives several examples of where Certification of Correction is appropriate, including: to correct a typographical error, to correct the naming of the inventors (choice (C)), both where there is a court order and where a petition under 37 CFR 1.324 has been granted, and to perfect a claim for priority under 35 U.S.C. § 119 or 120 (choices (B) and (C)). MPEP § 1481 also states that Certificate of Correction is not

appropriate where the changes would constitute new matter or would require reexamination (choice (D)). Accordingly, choice (D), to add a preferred embodiment to the disclosure which would materially affect the scope of the patent describes a change that cannot be made by certificate of correction. Choices (A), (B), and (C) describe changes that may be made by certificate of correction. Accordingly, choice (C) is not correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

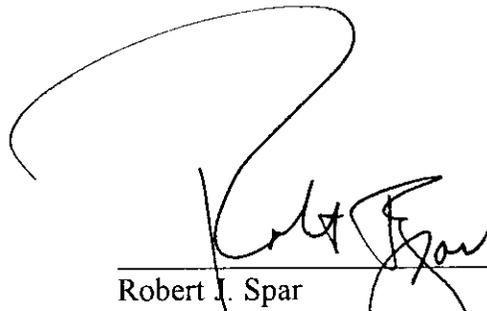
No error in grading has been shown as to questions 1 and 25 of the morning session and questions 4, 10, and 14 of the afternoon session. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, five points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

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

This is a final agency action.



Robert J. Spar
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for Patent Policy and Projects