

AUG 6 1991

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

In re)	DECISION ON REQUEST TO
)	REVIEW O.E.D. DIRECTOR'S
)	DECISION OF APRIL 2, 1991
<hr/>)	ON REQUEST FOR REGRADE

I

Petitioner requests review of a portion of the decision of the Director of the Office of Enrollment and Discipline (OED) dated April 2, 1991 on his request for regrade. For the reasons stated below, the petition is denied.

II

Petitioner took the morning portion of the examination for registration given on October 10, 1990. He received a grade of 47 on that examination. Forty-nine points is the minimum passing grade. Petitioner requested regrading of questions 3, 14, 21, 46, and 64 by the Director and was awarded no additional points. Petitioner requests review of the Director's refusal to grant any additional points for his answers to questions 14, 21, 46, and 64. The Director's decision with respect to question number 3 has been accepted by the petitioner.

III

Question 14 asks: "In a reexamination proceeding wherein the reexamination is requested by a third party requester, which of the following statements is true?" The correct answer to question 14 is choice e) and petitioner's choice d) is incorrect.

Choice d) states:

Unamended claims in the original patent, as well as any new claims presented during a reexamination proceeding, will be examined for patentability on the basis of prior art patents and printed publications and also for compliance with the requirements of 35 U.S.C. 112. [Emphasis added.]

37 CFR § 1.552(a) states:

Patent claims will be reexamined on the basis of patents or printed publications.

MPEP § 2258 provides:

Original patent claims will be examined only on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103.

37 CFR § 1.552(b) states:

Amended or new claims presented during a reexamination proceeding must not enlarge the scope of the claims of the patent and will be examined on the basis of patents or printed publications and also for compliance with the requirements of 35 U.S.C. 112 and the new matter

prohibition of 35 U.S.C. 132. [Emphasis added.]

Choice d) states that unamended claims will be examined for compliance with the requirements of 35 U.S.C. § 112. Choice d) is incorrect because 37 CFR § 1.552(b) and MPEP § 2258 together provide that only amended original claims or claims newly presented in the reexamination proceeding will be examined for compliance with 35 U.S.C. § 112.

Petitioner asserts that choice d) is ambiguous as to whether every element in the second clause of the sentence relates to every element in the first clause. Petitioner provides an example:

[T]he sentence "The cooking and the cleaning will be done by Bob and Mary" could be interpreted as either "The cooking will be done by Bob and the cleaning will be done by Mary" or "The cooking will be done by Bob and Mary and the cleaning will be done by Bob and Mary."

Petitioner further asserts that choice d) is not entirely untrue because at least some portion of all of the claims in the application will be reexamined for patentability on the basis of prior art and also for compliance with the requirements of 35 U.S.C. § 112.

Petitioner's arguments are not persuasive. Petitioner has failed to provide an accurate example for the statement of

choice d) by omitting the words "as well as" and "also" from his example. These words clear up any ambiguity which may exist. Accordingly, choice d) clearly requires that "[u]namended claims in the original patent" and "any new claims" must each be examined for patentability on the basis of both "prior art patents and printed publications" and "for compliance with the requirements of 35 U.S.C. 112." Choice d) is incorrect under 37 CFR § 1.552(b) and MPEP § 2258 as shown above.

Choice e), however, is correct. It states:

Only ex parte interviews between the examiner and the patent owner and/or his or her representative are permitted."

Choice e) reiterates the first sentence of MPEP § 2281 verbatim, "Only ex parte interviews between the examiner and patent owner and/or the patent owner's representative are permitted." In addition, 37 CFR § 1.560(a) provides, "Requests that reexamination requesters participate in interviews with examiners will not be granted." (Emphasis added.) Choice e) is, therefore, correct.

Petitioner asserts that choice e) is incorrect because an examiner may conduct "interviews" with requesters and other third parties in response to questions on "purely procedural matters," pointing to MPEP § 2281, paragraph 4. Petitioner further asserts that the Director interprets the term "interview" narrowly. Petitioner asserts that a telephone

conversation between an examiner and a requester's attorney or agent regarding a procedural inquiry falls within the definition of "interview" set forth in MPEP § 713.

MPEP § 2281 states that "questions on purely procedural matters may be answered by the examiner." (Emphasis added.) However, MPEP § 2281 does not state that questions on purely procedural matters constitute an "interview", as petitioner asserts. On the contrary, MPEP § 2281, paragraphs 1 and 4 each expressly state that interviews with third parties will not be conducted. Furthermore, the general terms of MPEP § 713 were not intended to, and cannot, countermand the specific directive of 37 CFR § 1.560(a) that interviews with third parties will not be granted. Therefore, the correct answer to question 14 is choice e).

IV

Question 21 states:

You prepared and filed a patent application. More than one year after filing the application you discovered that an important element of the invention was shown in the drawings, but was not described in the specification or set forth in the claims. [Emphasis added.]

The question then asks: "Which of the following statements is true?" The correct answer to question 21 is choice d) and petitioner's choice a) is incorrect.

Choice a) states, "You cannot add the description of the element to the specification because it would be new matter." Choice d) states, "You can amend the specification and/or existing claims or add new claims to include the element as shown in the drawings." (Emphasis added.)

37 CFR § 1.118 provides:

All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application.

The former Court of Customs and Patent Appeals stated in In re Wolfensperger, 302 F.2d 950, 955, 133 USPQ 537, 542 (1962),

Patent Office Rule 118 authorizes, by implication at least, the amendment of the words in the written specification so as to add statements not originally contained in it to conform to originally filed drawings. . . . Whatever [the drawings] disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning

of the law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."

Choice a) is incorrect because it states in absolute terms that the description of the element cannot be added to the specification because it would be new matter. On the contrary, 37 CFR § 1.118 and In re Wolfensperger, 302 F.2d at 955, 133 USPQ at 542, provide that an amendment to the specification may include subject matter that was set forth in the drawings at the time the application was filed and not be new matter.

37 CFR § 1.118 provides that the specification, as well as the claims, may be amended so long as they conform to the drawings at the time of filing. Choice d) limits the amendment to the specification and/or the claims to include the element as shown in the drawings. Therefore, an amendment prepared pursuant to choice d) would not be new matter. Accordingly, choice d) is the correct answer.

Petitioner asserts that an applicant would have no reason to add to the specification a description of an element already shown in the drawings, unless the drawings were unclear or did not fully describe the element. Petitioner's argument is not persuasive. Question 21 provides that an important element of the invention was shown in the drawings, but was not described in the specification. 35 U.S.C. § 112, first paragraph, requires that the specification contain a written description of the invention in such full, clear, concise, and

exact terms as to enable any person skilled in the art to which it pertains to make and use the same. Clearly, the description of an important element of an invention would be necessary to comply with the requirements of 35 U.S.C. § 112, first paragraph. Therefore, contrary to petitioner's assertions, in order to comply with 35 U.S.C. § 112, a written description of the element of question 21 conforming to the drawings must be added to the specification.

Furthermore, petitioner asserts that a description of the element shown in the drawings cannot be added to the specification because it would constitute new matter. As pointed out above, 37 CFR § 1.118 permits amendments to the specification and/or claims if such amendments conform to the drawings at the time of filing. Even though the element is only originally disclosed in the drawings, it is part of the original disclosure nonetheless, and a description of the element cannot constitute new matter if the description conforms to the drawings at the time of filing. In re Wolfensperger, 302 F.2d at 955, 133 USPQ at 542.

Petitioner himself admits:

If for some reason the new description were truly limited to the element "as shown in the drawings," then the specification could be amended to include the description as asserted in choice d).

Since choice d) does provide that the amendment is limited to include the element "as shown in the drawings" (emphasis added) the petitioner, by his own statement above, admits that choice d) is correct.

While it is true that enablement under 35 U.S.C. § 112 is evaluated as of the filing date, and that claims supported by a new description in the specification might be invalidated if the description were later construed to be new matter, neither choice a) nor choice d) suggest this situation. Thus, the correct answer to question 21 is choice d) and petitioner's choice a) is incorrect. Accordingly, the prudent patent agent would follow the course of action in choice d) to eliminate the need to file an additional application for the sole purpose of including a description of an element originally shown in the drawings and omitted from the specification and claims.

V

Question 46 concerns an inventor, Doppelmeier, working in Sweden and filing patent applications in Sweden, France, and the United States. The question, in part, states:

He files an application disclosing and claiming the invention in the Swedish Patent Office on January 3, 1989. One week later, he offers the boot described and claimed in the application for sale in the United States. On March 3, 1989 he files an application with an identical disclosure

in the French Patent Office, claiming the benefit of the prior Swedish filing date. On March 2, 1990, he files an application in the USPTO corresponding to the Swedish and French applications. The U.S. application includes a priority document claiming the benefit of the French filing date. The U.S. application is identical to both the French and Swedish applications. The Swedish Patent Office issued a patent to Doppelmeier on March 1, 1990.

The question then asks: "Which of the following statements is or are true?" The correct answer to question 46 is choice e) and petitioner's choice d) is incorrect.

Choice d) states: "(a) and (c) only." Choice a) states: "Doppelmeier's U.S. application is entitled the benefit of the French filing date, but not the Swedish filing date."

Chisum, Patents § 14.03[2][b] (1990) provides an example similar to the situation presented in question 46:

Section 119 specifies that the twelve-month period is to run from the "earliest date" upon which a foreign application for the same invention was "regularly filed."

Thus, an applicant filing in France on January 2, 1975, in Germany on March 3, 1975, and in the United States on

February 2, 1976, is entitled to no right of priority at all. The twelve-month provision precludes priority based on the French application. The first application provision precludes priority based on the German application. [Footnote omitted.]

35 U.S.C. § 119 (first paragraph) requires a U.S. application to be filed within 12 months from the earliest filing of the foreign application. Based on the facts presented in the question, the earliest date would be the filing date of the Swedish application, January 3, 1989. Doppelmeier is not entitled to the date of his earliest foreign filed application, January 3, 1989, because it was filed more than 12 months prior to the filing of the U.S. application. Furthermore, he is not entitled to the date of his second foreign filed application, March 3, 1989, because March 3, 1989, is not the date on which the first foreign application was filed, as required by 35 U.S.C. § 119. Therefore, choice a) is incorrect.

Petitioner cites several cases, Ex parte Yamaguchi, 6 USPQ2d 1805 (Bd. Pat. App. 1987), relying on Ahrens v. Gray, 1931 Dec. Comm'r Pat. 9 (Bd. Pat. App. 1929), and Olson v. Julia, 209 USPQ 159 (Bd. Pat. App. 1979), which stand for the proposition that foreign priority may not be claimed for a second application disclosing the same invention as a first application filed in the same foreign country. On the other

hand, 35 U.S.C. § 119, third paragraph, provides that benefit of a foreign filing date may be claimed for a subsequently filed application in the same foreign country, however, all rights in the first application must be terminated in order to receive the benefit of the filing date of the subsequently filed foreign application. Petitioner correctly distinguishes the above authorities from the situation presented in question 46 where there are two foreign applications filed in two different foreign countries.

The later filed U.S. application is not entitled to the benefit of the earlier French filing date under 35 U.S.C. § 119 since the French application was not the first filed foreign application. Petitioner asserts that this conclusion is based on an erroneous interpretation of 35 U.S.C. § 119 which is not supported by case law and is contrary to the plain meaning of the statute. Petitioner points to Nelson v. Wolf, 97 F.2d 632, 38 USPQ 137 (CCPA 1938), as suggesting that an applicant may not be entitled to rely on the filing date of a second foreign application filed in a second foreign country for the same invention. However, petitioner asserts that R.S. 4887 (Act of March 3, 1903, ch. 1019, § 4887, 32 Stat. 1225), the controlling law at the time Nelson v. Wolf was decided, was significantly different than its modern counterpart, 35 U.S.C. § 119.

Federico compares R.S. 4887 with 35 U.S.C. § 119:

This so-called right of priority was provided for in the second paragraph of R.S. 4887 which is the basis for the first paragraph of section 119 of this title. . . . The new statute made no changes in these conditions of the corresponding part of the old statute except to revise the language slightly [Emphasis added.]

Federico, "Commentary on the New Patent Act," 35 U.S.C.A. 29 (1954). Thus, R.S. 4887 is not "significantly different" from its modern counterpart, 35 U.S.C. § 119, as petitioner contends. Rather, as pointed out above, the substance of 35 U.S.C. § 119 is practically identical to R.S. 4887 with only a "slight" revision of the language.

Petitioner correctly argues that R.S. 4887 required that applications be filed in the U.S. within twelve months "from the earliest date on which any such foreign application is filed" in order to claim foreign priority. Ahrens v. Gray, 1931 Dec. Comm'r Pat. at 10 (emphasis added). However, petitioner asserts that the current statute reduces this last requirement to "the earliest date on which such foreign application was filed." Petitioner further asserts that, accordingly, the statute does not require that foreign priority be based on the first application filed "anywhere in the

world." Rather the statute prohibits claims for priority based on a second or later application filed in the same foreign country as a first application. Petitioner concludes that Doppelmeier's U.S. application is therefore entitled to the benefit of the French filing date since the French application was the earliest of all the applications for the same invention filed in France.

Federico states:

As stated, the twelve months is from the first foreign application which fulfills the other requirements. The language of the statute referring to this, "if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed," would be clearer if the word "any" appeared before "such." [Emphasis added.]

Federico, "Commentary on the New Patent Act," 35 U.S.C.A. at 30 (1954).

Therefore, 35 U.S.C. § 119 requires, as did R.S. 4887, that in order to claim foreign priority, applications must be filed in the U.S. within twelve months from the earliest date on which any such foreign application is filed. Accordingly, 35 U.S.C. § 119 requires that foreign priority be based on the first application filed "in a foreign country which affords similar privileges in the case of applications filed in the

United States or to citizens of the United States." Thus, Doppelmeier is not entitled to the date of his second application, March 3, 1989, filed in France, because it is not the date on which the first foreign application was filed, nor was it the earliest date on which any such foreign application was filed as required by 35 U.S.C. § 119.

Petitioner contends that OED's interpretation of 35 U.S.C. § 119 would mean that an applicant who fails to satisfy the requirements for 35 U.S.C. § 112 in the earliest foreign application would have to refile in the original foreign country before claiming priority in the United States. Petitioner further asserts that such an interpretation would contradict the:

"right of priority" accorded by section 119 [which] can aptly be described as a right to prove a date of invention no earlier than the date of the foreign filing.

Kawai v. Metlesics, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973).

To be accorded the benefit of an earlier foreign filing date, a foreign application must satisfy the requirements of § 112. Such a requirement does not contradict the "right of priority," as petitioner contends. The former Court of Customs and Patent Appeals in Kawai v. Metlesics, 480 F.2d at 885-86, 178 USPQ at 162-63 continued:

It is our opinion that this "right to prove" a date of invention corresponding to the date of filing in the foreign country requires that the act of filing the foreign application be regarded for purposes of United States law as a constructive reduction to practice of the invention in the same way that a filing of a United States application can be so regarded. . . . Therefore, we are of the opinion that the foreign application must meet the requirements of the first paragraph of section 112 if the act of filing it is to be regarded as a reduction to practice of the invention.

. . . .

If these are requirements which a United States specification must meet if it is to be adequate to support a reduction to practice by the act of filing the application, it follows that a foreign application must meet the same requirements if it is to be used to prove a date of invention.

The net effect of not requiring the foreign application to meet the disclosure requirements of United States law would be

that an inventor could file a patent application for promising chemical compounds in a foreign country not requiring a disclosure of utility and have up to one year to determine a practical utility before filing in the United States and yet claim an earlier date of invention. We do not think section 119 should be construed as permitting this.

[Emphasis added.]

Thus, 35 U.S.C. § 119 confers a "right of priority." However, an applicant is not entitled to the "right of priority" if the earlier foreign filed application does not meet the requirements of 35 U.S.C. § 112. Accordingly, an applicant who fails to satisfy the requirements of 35 U.S.C. § 112 in the earlier foreign filed application would not be entitled to the benefit of the earlier foreign filing date under 35 U.S.C. § 119.

Petitioner correctly distinguishes 35 U.S.C. § 102(d) from 35 U.S.C. § 119. Section 102(d) is a bar to issuance of a patent if a foreign application filed more than twelve months before the U.S. application is filed and is patented in the foreign country. 35 U.S.C. § 119, on the other hand, prevents entitlement to the benefit of an earlier foreign filing date if the application in this country is filed more than twelve

months from the earliest date on which such foreign application was filed.

Petitioner further asserts that the last paragraph of 35 U.S.C. § 119 which states "but no patent shall be granted" applies only to the grant of patent rights and not to the benefits of a foreign filing date. Petitioner further provides an example to illustrate his point:

[I]f Doppelmeier fulfills all the requirements of § 119, he is entitled to the benefit of the French filing date, regardless of whether or not he can receive a patent based on that date due to the on-sale bar. In contrast, Doppelmeier is clearly not entitled to the benefit of the Swedish filing date because it is more than one year before the U.S. filing date.

Petitioner may be correct that the last paragraph of 35 U.S.C. § 119 applies to the grant of patent rights and not to the benefits of a foreign filing date. However, Doppelmeier did not meet the requirements of 35 U.S.C. § 119 and, therefore, would not have been entitled to the benefit of either foreign filing date.

Petitioner concedes that choices b) and c) are correct. Since choice a) is incorrect and choices b) and c) are each correct, choice e) which states "(b) and (c) only" is the

correct answer and petitioner's choice d) which states "(a) and (c) only" is incorrect.

VI

Question 64 states:

An examiner's answer, approved by the supervisory primary examiner, contains a new ground of rejection of the claims on appeal under 35 U.S.C. 102 involving a new reference.

The question then asks: "Which of the following best describes a proper manner of responding to the examiner's answer?"

(Emphasis added.) The correct answer to question 64 is choice a) and petitioner's choice b) is incorrect.

Choice b) states:

Within 2 months of the date of the Examiner's Answer, file a petition requesting the Commissioner exercise his supervisory authority to remand the application to the examiner to consider new evidence of priority of invention.

MPEP § 1208.03 and 37 CFR § 1.193(b) explicitly describe the proper manner of responding to an examiner's answer which contains a new ground of rejection. MPEP § 1208.03 provides:

Where a new ground of rejection is raised in the examiner's answer, the appellant, under 37 CFR 1.193(b) has two

months within which to file a reply brief. The appellant's reply, insofar as the new ground of rejection is concerned, may include any amendment or material appropriate to the new ground.

. . . .

The final sentence of 37 CFR 1.193(b) provides that the reply brief may be accompanied by any amendment or material appropriate to the new ground of rejection. This makes it clear that any amendment or other material appropriate to the new ground of rejection must be presented in a separate paper, rather than in the reply itself. [Emphasis added.]

Choice a) reiterates the manner of response described in MPEP § 1208.03 and 37 CFR § 1.193(b). Choice a) states:

Within 2 months of the date of the Examiner's Answer, file a reply brief responding to the new ground of rejection accompanied by a paper, separate from the reply brief, containing an amendment appropriate to the new ground rejection.

Accordingly, choice b) is not the best manner of responding to the situation presented in question 64. As provided in MPEP § 1208.03 and 37 CFR § 1.193(b), additional evidence for

consideration by the examiner should be submitted with the reply brief in a separate paper. It is not necessary for the Commissioner to direct the examiner to consider the evidence in the situation presented in question 64. Choice a) is, therefore, correct.

Petitioner asserts that while a reply brief may be required, a petition may also be filed requesting the Commissioner to remand the application to the Examiner. However, petitioner provides no authority for his assertion. Nevertheless, assuming, arguendo, that a petition may be filed with the Commissioner requesting the application be remanded to the examiner, question 64 asks for the best description of the proper manner of responding to the examiner's answer. The explicit instructions of MPEP § 1208.03 and 37 CFR § 1.193(b) provide the best description of the proper manner of response.

Petitioner further asserts that an amendment to the claims, as provided in choice a), may not be an appropriate response to a rejection under 35 U.S.C. § 102 where the rejection could easily be overcome by filing an affidavit under 37 CFR §§ 1.131 or 1.132. The proper manner of response set forth in 37 CFR § 1.193 and MPEP § 1208.03 includes not only amendments appropriate to the new ground of rejection but also "any . . . material appropriate to the new ground." Clearly, an affidavit under 37 CFR § 1.131 or 37 CFR § 1.132 which would overcome the new grounds of rejection would be "material

appropriate to the new ground." Accordingly, 37 CFR § 1.193 and MPEP § 1208.03 authorize the filing of an affidavit under 37 CFR § 1.131 or 37 CFR § 1.132 as a proper manner of response where the new ground rejection is made under 35 U.S.C. § 102. Therefore, choice a) is correct and petitioner's choice b) is incorrect.

VII

For the reasons stated above, the petition is denied.

Date:

8/5/91



EDWARD R. KAZENSKE
Executive Assistant to the
Commissioner of Patents
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cc: