



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 13 2002

In re : DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 8, 20, 24, and 36 of the morning section and questions 11, 33 and 45 of the afternoon section of the Registration Examination held on October 17, 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 65. On February 1, 2002, 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 CFR 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 USPTO 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.

Petitioner has been awarded an additional point for afternoon question 45. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning questions questions 8, 20, 24, and 36 and afternoon questions 11 and 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Joan comes to you wanting to know the status of the applications of her competitor Pete. During Joan's previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of application A and a redacted copy of application A has been published under 35 U.S.C. § 122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following is not true?

- (A) Joan may obtain status information for Application B that is a continuation of an application A since application A has been published under 35 U.S.C. § 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier are available.
- (C) Joan may obtain status information for Application D since a U.S. patent includes a specific reference under 35 U.S.C. § 120 to Application D, an abandoned application. Joan may obtain a copy of that application-as-filed by submitting a written request including the fee set forth in 37 CFR 1.19(b)(1).
- (D) Joan may obtain status information as to Application C since a coinventor in a pending application may gain access to the application if his or her name appears as an inventor in the application, even if she did not sign the § 1.63 oath or declaration.
- (E) Joan may obtain access to the entire Application A by submitting a written request, since, notwithstanding the fact that only a redacted copy of Application A has been published, a member of the public is entitled to see the entire application upon written request.

The model answer is selection (E).

Since a redacted copy of the application was used for publication purposes, 37 CFR 1.14(c)(2) provides that "(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy." For (A) and (B), see 37 CFR 1.14(b)(2) and 1.14(b)(4). For (C) see 37 CFR 1.14(b)(2) and (c)(1)(i). As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 CFR 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

Petitioner argues that like model answer (E), answer (B) is not a true statement, and that accordingly, both answer (B) and model answer (E) are correct. Answer (B), however, is a true statement and thus an incorrect answer in terms of question 8. The statement of answer (B) is true because the patent claiming priority to application D will reveal the

filing date of application D as well as its six-digit serial number. Application D's filing date combined with its six-digit serial number is the "numerical identifier" of application D under 37 CFR 1.14(a)(1)(iii)(B). Accordingly, model answer (E) 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 20 reads as follows:

20. Which of the following is true?

- (A) The statement, "Whether claims 1 and 2 are unpatentable," complies with the requirement of 37 CFR 1.192(c)(6) for a concise statement in the appeal brief of the issues presented for review.
- (B) A reissue application may be filed in order to broaden claims back to their original form where the claims were mistakenly narrowed during the original prosecution to avoid the prior art provided that the narrowing of the claims was made without deceptive intent on the part of the applicant.
- (C) Following a new ground of rejection raised by the Board of Patent Appeals and Interferences, the applicant may request a rehearing, or submit an appropriate amendment of the rejected claims or a showing of facts relating to the rejected claims.
- (D) If the Board of Patent Appeals and Interferences decides to require an appellant to address a particular matter, and the appellant cannot respond within the time period set, he may obtain an extension of time by paying the requisite fee.
- (E) In an *ex parte* reexamination proceeding of a patent that arises from an application filed in the United States before November 29, 1999, a third party requester who is dissatisfied with a decision of the Board of Patent Appeals and Interferences may seek judicial review by appeal to either the U.S. Court of Appeals for the Federal Circuit or by civil action in the U.S. District Court for the District of Columbia.

The model answer is selection (C).

See 37 CFR 1.196(b); MPEP § 1214.01. As to (A) see MPEP § 1206, p.1200-8, "(6) Issues." As to (B), the recapture doctrine prevents claims from being recaptured. See MPEP § 1412.02. As to (D) see 37 CFR 1.196(d) and MPEP § 1212 where it states that failure to respond in time will result in dismissal of the appeal. As to (E), third party may not appeal 37 CFR 1.310 and 1.303(a). *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination under 35 U.S.C. § 302 is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989) (third parties do not participate in *ex parte* reexamination before the USPTO).

Petitioner argues that in addition to model answer (C), answer (D) is a correct answer. Petitioner contends that obtaining an extension of time by paying a fee “does in fact constitute a response for purposes of 37 CFR 1.196(d)... Because 37 CFR 1.196(d) sets forth that the time period for responding to a requirement thereunder is “non-extendable,” petitioner’s contention is incorrect. Accordingly, model answer (C) is correct, and petitioner’s answer (D) is incorrect.

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

Morning question 24 reads as follows:

24. Able and Baker conceived an improved gas grille for cookouts. Using elements A, B, C, D, E and F found in their backyards, as well as elements G, H, I, J, K, L, M and N purchased at a local hardware store, they successfully constructed and used a gas grille conforming to their concept. The grille includes subcombination of elements K, L and M conceived by Able, and subcombination C, D, F, G and M conceived by Baker. Able and Baker conceived their respective subcombinations separately and at different times. Able and Baker retain you to prepare and file a patent application for them. You are considering whether and what can be claimed in one patent application. Which of the following is true?

(A) For Able and Baker to properly execute an oath or declaration under 37 CFR 1.63 in a patent application claiming not only the grille, but also the two subcombinations, Able and Baker must be joint inventors of the grille, and each of the two subcombinations.

(B) A characteristic of U.S. patent law that is generally shared by other countries is that the applicant for a patent must be the inventor.

(C) If Able and Baker execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application claiming the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), the existence of the claim to the grille is evidence of their joint inventorship of the individual elements.

(D) Able and Baker may properly execute an oath or declaration under 37 CFR 1.63 as joint inventors and file an application containing claims to the grille (a combination of elements A, B, C, D, E, F, G, H, I, J, K, L, M and N), claims to the subcombination conceived by Able, and claims to the subcombination conceived by Baker.

(E) Able and Baker could not properly claim the combination unless they successfully and personally reduced the grille to practice.

The model answer is selection (D).

35 U.S.C. § 116, first paragraph; MPEP § 2137.01, "Inventorship," and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (A) is not correct. MPEP § 2137.01 (Requirements for Joint Inventorship) and see *Kimberly-Clark Corp. v. Procter & Gamble Distributing*, 23 USPQ2d 1921, 1925 - 26 (Fed. Cir. 1992); and *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960). (B) is not correct. 35 U.S.C. §§ 101, 115; MPEP § 2137.01. (C) is not correct. MPEP § 2137.01. The inventor of an element, per se, and the inventor of a combination using that element may differ. See *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982); and *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). (E) is not correct. There is no provision in the Patent Statute requiring the invention to be reduced to practice in order to file a patent application claiming the invention. Further, see MPEP § 2137.01; and see *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982).

Petitioner argues that answer (C) is a correct answer. The paragraph above, however, explains why answer (C) is incorrect. Further, the fact pattern of the question makes clear that joint inventorship of the individual elements of the combination (the grille) does not, in fact, exist. Accordingly, model answer (D) 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.

Morning question 36 reads as follows:

36. The claims of a pending patent application were rejected in an Office action mailed Thursday, November 23, 2000. The Examiner set a three-month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Friday, February 23, 2001 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 23, 2001.
- (B) Friday, March 23, 2001.
- (C) Saturday, March 24, 2001.
- (D) Monday, March 26, 2001.
- (E) Thursday, May 24, 2001.

The model answer is selection (C).

The one-month extension of time filed February 23, 2001 properly extended the deadline for reply to Friday, March 23, 2001. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, i.e., the application was abandoned at 12:01 AM on Saturday, March 24, 2001. The fact that March 24 was a Saturday does not change the abandonment day because the reply was due on March 23, a business day. MPEP § 710.01(a).

Petitioner argues that answer (B) is a correct answer. MPEP § 710.01(a) states that “the application is regarded as abandoned after midnight of the date the reply period for reply expired.” Therefore, the date of abandonment of the application described in the fact pattern is March 24, 2001, not March 23, 2001. A reply to the November 23, 2000 Office action filed in the Office on March 23, 2001 would have been considered timely in view of the previously filed one-month extension of time. 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.

Afternoon question 11 reads as follows:

11. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner’s objection and provides the client with the broadest range of patent protection?

(A) Cancel Claim 3. Add Claim 4, which reads: “An Ethernet cable made by a process comprising the steps of A, B and C.” Add Claim 5, which reads: “An Ethernet cable made by a process comprising the steps of A, B, C and D.”

(B) Amend Claim 3 to read: “The Ethernet cable as made by the process set forth in claims 1-2.”

(C) Cancel Claim 3.

(D) Cancel Claim 3 and add Claim 4, which reads: “An Ethernet cable made by a process comprising the steps of A, B and C.”

(E) Cancel Claim 3 and add Claim 4, which reads: “An Ethernet cable made by a process comprising the steps of A, B, C and D.”

The model answer is selection (A).

The cancellation of Claim 3 overcomes the examiner’s objection. The addition of Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (B) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 CFR 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (C)

alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2. Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D. Answer (E) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

Petitioner argues that answer (E) correct. As explained above, answer (E) is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C. 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.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

(A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

(B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

(C) Traverse the rejection arguing that the examiner does not create a prima facie case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

(D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.

(E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (B) is the only correct answer. The paragraph above, however, explains why answer (B) is incorrect, and why model answer (D) is the only correct answer. Contrary to petitioner's arguments, there is nothing stated in the fact pattern indicating that the "Foreign patent" implied the use of either a lens or a parabolic reflector to focus solar rays. Whether or not such use is well known is an issue specific to obviousness rejections. Claim 1, however, was rejected under 35 U.S.C. § 102(d) as anticipated by the "Foreign patent." Accordingly, model answer (D) 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 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.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is positioned above the typed name and title.

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