

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

APR 13 1999

In re )  
 ) Decision on  
 ) Petition for Review  
 ) Under 37 C.F.R. § 10.2(c)  
 )

**MEMORANDUM AND ORDER**

(“Petitioner”) seeks review of the decision of the Director of the Office of Enrollment and Discipline (“Director”), dated August 7, 1998, denying his request for a higher score on the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office (“Examination”), held on August 27, 1997. The petition is denied.

**Background**

An applicant for registration to practice in patent cases before the Patent and Trademark Office (hereafter “PTO”) must achieve a passing score of 70 in both the morning and afternoon sections of the Examination. Petitioner took the Examination held on August 27, 1997, and received a score of 66 on the morning section.

After receiving his morning section score, petitioner requested that questions 25, 28, and 50 be regraded, and that his score be raised two points for each question. On August 7, 1998, the Director denied the request to increase petitioner’s score.

Petitioner now seeks review, under 37 C.F.R. § 10.2(c), by the Commissioner of Patents and Trademarks, of the Director’s decision denying credit for petitioner’s answers to questions 25 and 28. Petitioner urges that two points be added to his score for each of these questions, and

that he be awarded a passing grade for the morning section of the Examination held on August 27, 1997.

### **Opinion**

Petitioner bears the burden of establishing error in the grading of his answers to examination questions 25 and 28. 5 U.S.C. § 556(d). All of petitioner's arguments have been considered and, for the following reasons, no points will be added to his morning section score for the examination held on August 27, 1997.

#### **Question 25:**

Question 25 reads as follows:

25. Alice invented a new pharmaceutical compound. You have prepared, filed, and prosecuted a patent application containing Claims 1 through 15 directed to the compound. All of the claims were finally rejected under 35 U.S.C. § 102(b) in view of the Leary patent. You appealed the final rejection and have received a decision from the Board of Patent Appeals and Interferences affirming the rejection of Claims 1 to 10 in view of Leary and reversing the rejection of Claims 11-15. However, the Board has entered a new ground of rejection of Claims 11 through 15 under 35 U.S.C. § 103 in view of the Garcia patent. Which of the following is/are correct response(s) to the Board's new ground of rejection?

- (A) File a request for reconsideration by the Board within one month of the date of the Board decision.
- (B) File a Notice of Appeal regarding the Board's decision respecting claims 1-5 with the U.S. Court of Appeals for the Federal Circuit within 60 days of the date of the decision.
- (C) Submit an amendment to the Examiner that amends Claims 11-15 to avoid the Garcia reference along with an affidavit providing evidence of the non-obviousness of the claimed compound compared to the compound disclosed by Garcia, within the appropriate time period set in the Board Decision.
- (D) Submit an amendment to the examiner amending claim 1 to define over Leary and amending Claims 11-15 to define over the Garcia Patent.
- (E) Both (A) and (C) are correct.

The correct answer to Question 25 is (E). Petitioner argues that (C) is not a correct answer, and therefore (E) cannot be correct, leaving (A) as the correct answer.

The Board may enter a new ground of rejection under conditions set forth in 37 CFR § 1.196(b). Rule § 1.196(b), as it stood in August 1997, provided, in relevant part:

... When the Board of Patent Appeals and Interferences makes a new rejection of an appealed claim, the appellant may exercise either of the following two options with respect to the new ground:

(1) The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter reconsidered by the examiner . . . .

(2) The appellant may have the case reconsidered under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . . .

Thus, answer (A) is supported by § 1.196(b)(2) and § 1.197(b) (requiring that a request for reconsideration be filed within one month except under circumstances not here relevant).

Answer (C) is supported by § 1.196(b)(1). As Petitioner expressly admits, an amendment is a correct response to the Board's new ground of rejection under § 1.196(b). Petition at 2, n.1. Petitioner also expressly admits that a showing of facts may be submitted in response to the Board's new ground of rejection under § 1.196(b). Petition at 2 (citing 37 CFR § 1.196(b)). However, Petitioner contends that "an affidavit providing evidence..." as described in Answer (C) need not involve a "showing of facts" as recited in 37 CFR § 1.196.

Petitioner's argument relies upon a strained reading of a definition of "evidence" and whether or not "evidence" constitutes a "showing of facts" as called for by § 1.196. However, Answer (C) specifies that the evidence takes the form of an affidavit which is "[a] written or printed declaration or statement of facts...." Black's Law Dictionary (6th Ed.) 58. Thus, the affidavit mentioned in answer (C) corresponds to "making a showing of facts" as permitted under

37 CFR § 1.196. Accordingly, the Director did not err in denying petitioner credit for his answer to question 28.

**Question 28:**

Question 28 reads as follows:

28. Inventor Jones received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also tells you that the original patent with the blue ribbon seal has been lost. Your advice to Jones should include:

- (A) under 35 U.S.C. § 251, new matter cannot be added to a reissue application.
- (B) any added claims to the new embodiment would not satisfy 35 U.S.C. § 112.
- (C) under 35 U.S.C. § 251, it is too late to enlarge the scope of the issued claims in a reissue application.
- (D) under 35 U.S.C. § 251, Jones cannot get a reissue of a patent that has been lost.
- (E) (A) and (B).

The correct answer is (E). More specifically, the question inquires which of four statements should be included in advice to inventor Jones who received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also informs you that the original patent with the blue ribbon has been lost. Choice (A) is a correct statement: new matter cannot be added to a reissue application. 35 U.S.C. § 251. Choice (B) is also correct: any added claims to the new embodiment, which according to the fact pattern has not been disclosed, would not satisfy 35 U.S.C. § 112. In particular, the written description requirement of the first paragraph of § 112 would not be satisfied. Choice (C) is not correct, because a broadening reissue can be filed within 2 years of the issued claims, and only 18 months have elapsed. Choice

(D) is not correct, because 35 U.S.C. § 251 does not preclude reissuance of a patent because the blue-seal copy has been lost. See 37 C.F.R. § 1.178 (providing that an affidavit attesting to the loss of the patent may be submitted in lieu of the original patent). Accordingly, the best answer is choice (E), which is both (A) and (B).

The Petitioner argues in relevant part:

Answer choice (b), "any added claims to the new embodiment would not satisfy 35 U.S.C. § 112", is not necessarily true.

As a general rule, an applicant may be allowed claims which cover more than the specific embodiment shown in the specification. *See In re Newton*, 414, F.2d 1400, 1406, 163 USPQ 34, 39 (CCPA 1969). 35 U.S.C. § 112 does not require a detailed description of each potential embodiment of the invention. As long as the embodiment is narrower in scope than those disclosed, a claim may be drafted to cover the embodiment without being overly specific, therefore not requiring any further description in the specification.

Petition at 3 (emphasis in original). In essence, Petitioner's argument is that Answer (B) is not necessarily correct because new claims could be added which would cover the new embodiment without further description in the specification. However, Answer (B) regards "any added claims to the new embodiment." Thus, the new claims necessarily include the specifics of the embodiment. Applicant appears to recognize that such specificity would require further description in the specification when he states in the negative "...a claim may be drafted to cover the embodiment without being overly specific, therefore not requiring any further description in the specification." Petition at 3 (emphasis added).

Accordingly, Petitioner's argument depends upon misreading Answer (B) to state "no claim can be drafted which would cover the new embodiment and still satisfy 35 U.S.C. § 112." This, of course, is not what Answer (B) states. Question 28 specifically provides that the patent "failed to disclose an embodiment of the invention," and Answer (B) posits whether any added

claims to the new embodiment would satisfy 35 USC 112. Answer (B) asks whether a claim drawn to the new embodiment (i.e. including the specific limitations of the new embodiment) could be added. Answer (B) cannot be reasonably interpreted as asking whether a claim could be added which would "cover" the new embodiment. Accordingly, the Director did not err in denying petitioner credit for his answer to question 28.

**ORDER**

Upon consideration of the petition to the Commissioner for a higher score on the morning section of the examination held on August 27, 1997, it is

**ORDERED** that the petition is denied.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", with a long horizontal flourish extending to the right.

Q. Todd Dickinson  
Acting Assistant Secretary of Commerce and  
Acting Commissioner of Patents and Trademarks