

review of his answers to the following questions: Part 1- question 7; Part 2-questions 5, 18, 25, 27; and, Part 3-question 3.

Opinion

Pursuant to 37 CFR § 10.7(c), Petitioner **must** particularly point out the errors which the applicant believed occurred in the grading of his or her examination in the request for regrade. The directions also state that: "[n]o points will be awarded for incorrect answers or unanswered questions." The directions further state:

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. . . . 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.

The burden is upon the Petitioner to show that his **chosen** answer is the most correct answer.

Part 1- Question 7:

Question 7 reads as follows:

7. Publications dated after the filing date of an application providing information or the current state of the art first publicly disclosed after the filing date can supplement the disclosure in the application to make the disclosure enabling where the application did not disclose how to make or use the claimed invention, and claims in the application should not be rejected under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure.

The question calls for a True/False answer, (A) being True and (B) being False. Petitioner selected answer (A), True. In the model answers, choice (B), False, is stated as the correct

answer on the basis of 35 U.S.C. § 112, first paragraph and MPEP § 2164.05(a), which states in relevant part:

Publications dated after the filing date providing information publicly first disclosed after the filing date **generally** cannot be used to show what was known at the time of filing. *In re Gunn*, 537 F.2d 1123, [1128], 190 USPQ 402 [405-06] (CCPA 1976) [A] later dated publication cannot supplement an insufficient disclosure in a prior dated application to make it enabling (Emphasis added).

Petitioner seizes on the word “generally” in this passage to argue that this statement in the MPEP is not “all inclusive,” and therefore can sometimes be True. Accordingly, Petitioner argues that “both answers true (A) and false (B) are equally correct.”

Use of the word “generally” in the cited MPEP section cannot be used to controvert well established law under 35 U.S.C. § 112. For purposes of enablement, “the issue is not what the state of the art is today or what a skilled artisan today would believe, but rather what the state of the art was [at the filing date of the application] and what a skilled artisan would have believed at that time.” *In re Wright*, 999 F.2d 1557, 1563 n. 8, 27 USPQ2d 1510, 1514 n.8 (Fed. Cir. 1993) (citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1987) and *In re Hogan*, 559 F.2d 595, 604, 194 USPQ 527, 535 (CCPA 1977)). The Federal Circuit has stated that for purposes of enablement, developments occurring after the effective filing date of the application “are of no significance regarding what one skilled in the art believed as of that date.” *Wright*, 999 F.2d at 1563, 27 USPQ2d at 1514. Thus, the law clearly requires enablement to be established as of the filing date of the application.

Petitioner has made no suggestion as to how the later dated document described in question 7, having information not publicly disclosed until after the filing date of the application, can establish the state of the art as of the filing date. Instead, Petitioner argues that “PTO is in a

better position to identify the circumstances” than he is. Petitioner bears that burden, however, not the PTO. In this case, the burden has not been met. The directions for the examination clearly state that the most correct answer is the “policy, practice, and procedure which must, shall, or should be followed in accordance with” the patent statute, regulations, MPEP and case law. Here, the law and the MPEP are clear that documents dated after the filing date providing information publicly disclosed after the filing date “generally” cannot be used to establish knowledge in the art as of the filing date. Clearly, the most correct answer to the question consistent with the law and PTO policy is (B), false. No error has been shown and no points are awarded.

Part 2- Question 5:

Question 5 reads as follows:

5. You draft a patent application disclosing and describing an adjustable doll stand shown in the drawing to the right (Figure 1) having a clamp to hold a doll upright. You draft the following independent claim:
 1. A doll stand comprising a base (1), a hollow threaded tube (2) upstanding from the base, said hollow threaded tube having an outer diameter and an upper surface parallel to said base, a threaded rod (3) disposed in and threadedly interrelated with said hollow threaded tube, and a clamp consisting of two metal wires (4 and 5) secured to said rod.

In the absence of question of supporting disclosure, which of the following would not be a proper dependent claim in the application when the application is filed in the PTO.

- (A) 2. A doll stand according to Claim 1 further comprising a ring (6) coaxially disposed with respect to said hollow tube and threadedly interconnected with said rod, said ring having a bottom surface disposed in flat face contacting relation with the upper surface of the hollow tube, said ring being seated flush with said hollow tube.
- (B) 2. A doll stand according to Claim 1 wherein said base is pecan resin.

- (C) 2. A doll stand according to Claim 1 wherein said claim further comprises horizontally disposed ceramic arms on the end of said metal wires.
- (D) (A) and (C).
- (E) (A), (B), and (C).

Petitioner selected answer (A). In the model answer, choice (C) is correct because the use of the limiting language “consisting of” in claim 1 in the clause reciting the clamp would prohibit any dependent claim from reciting additional elements as part of the clamp. The dependent claims recited in answers (A) and (B) are not improper.

Petitioner argues that dependent claim (A) is invalid on the basis of indefiniteness under 35 U.S.C. § 112, ¶ 2 for lack of antecedent basis. Specifically, Petitioner states in his original petition for regrade that:

Answer (A) is a dependent claim which contains references to “said hollow tube” and “the hollow tube”, which lack antecedent basis and are confusing. The independent claim makes reference to “a hollow threaded tube” and “said hollow threaded tube”. It is unclear if the tube referenced in the dependent claim is the same tube in the independent claim. Therefore, the dependent claim of answer (A) is indefinite because it contains words or phrases whose meaning is unclear and confusing. (MPEP 2173.05(e)).

It is not clear how Petitioner came to the conclusion that the dependent claim lacks antecedent basis for the phrase “the hollow tube.” Petitioner admits that claim 1 describes a “hollow threaded tube.” No other hollow tube is mentioned or shown in the Figure, which presumptively includes all of the claimed elements. To conclude that there is some other “hollow tube” present would be to assume facts not presented in the question. Therefore, because there is no other possible hollow tube presented by the question, there is no chance of confusion and, therefore, no indefiniteness problem.

Even if it is assumed, for the sake of argument, that the dependent claim in (A) were improper for indefiniteness, (A) would not be the best answer because the claim in (C) is also not proper for the reasons stated above. Petitioner never contests that answer (C) is a proper claim. Thus, given this hypothetical, answer (D) would have been the best answer because it includes both (A) and (C). Therefore, answer (A) would never be the best answer, even accepting all of Petitioner's arguments. Because Petitioner has not established how answer (A) could be the "most correct" answer under any circumstances, no error has been shown and no points are awarded.

Part 2 - Question 18:

Question 18 reads as follows:

18. Your client informs you that he has discovered a chemical compound that exhibits outstanding insecticidal properties, and he provides you with reliable test data establishing this fact. Assume that the name "compound Z" fully and definitely identifies such compound. Preliminary to preparing a patent application, you conduct a search of the prior art, and find that the compound *per se* and a method for its preparation are disclosed in a scientific journal that was published some 75 years ago. Notwithstanding, you decide to file a patent application on your client's invention. Which of the following is the best way to claim your client's invention?
- (A) A method of preparing compound Z, said compound being characterized by outstanding insecticidal properties.
 - (B) An insecticidal compound consisting of compound Z.
 - (C) A process for using compound Z as an insecticide.
 - (D) An insecticide substantially as shown and described.
 - (E) An insecticide comprising compound Z and a carrier.

Question 18 is ambiguous, making it unclear which answer is most correct. Therefore, no points will be deducted for this question. Two points will be added to Petitioner's score.

Part 2 - Question 25:

Question 25 reads as follows:

Applicant filed a patent application relating to a prefabricated water-tight structure which utilized steel panels to which is bonded an elastomeric chlorosulphonated polythene. The elastomeric chlorosulphonated polythene is sold under the trademark HYPALON. It is acknowledged that those skilled in the art know how to make such materials adaptable for a variety of building applications. Assuming no issue of support arises, which of the following claims is properly rejectable under 35 U.S.C. § 112, second paragraph?

- (A) 1. A prefabricated panel for a building system having a surface comprising HYPALON continuously bonded to a surface of a thin sheet steel member by an adhesive which is resistant to corrosive fluids.
- (B) 1. A prefabricated water-tight structure comprising a prefabricated panel, said panel comprising a thin sheet steel member bonded by an adhesive to an elastomeric chlorosulphonated polythene, said elastomeric chlorosulphonated polythene being sold under the trademark HYPALON, and said adhesive being resistant to corrosive fluids.
- (C) 1. A prefabricated water-tight structure comprising an elastomeric chlorosulphonated polythene, an adhesive, and a thin sheet steel member, said elastomeric chlorosulphonated polythene being sold under the trademark HYPALON, and characterized by good wear resistance, and said elastomeric chlorosulphonated polythene being continuously bonded by said adhesive to a surface of a thin sheet steel member, said adhesive being resistant to corrosive fluids.
- (D) 1. The prefabricated panel for a structure having a surface comprising a thin membrane of an elastomeric chlorosulphonated polythene, said elastomeric chlorosulphonated polythene being continuously bonded to a surface of a thin sheet steel member by an adhesive.
- (E) 1. A prefabricated water-tight structural system comprising a diaphragm characterized by good heat, ozone and water resistance, said diaphragm having a surface comprising a thin membrane of an elastomeric chlorosulphonated polythene, said elastomeric chlorosulphonated polythene continuously bonded to a surface of a thin sheet steel member by an adhesive which is resistant to corrosive fluids.

In the model answer, choice (A) is identified as the best answer. Petitioner chose choice (E), but argues that the question is flawed because all of the answer choices are rejectable under 35 U.S.C. § 112 for indefiniteness.

As the model answer and the Director's decision point out, choice (A) would properly be rejectable under 35 U.S.C. § 112 as indefinite because it uses a trademark as a limitation to describe the claimed compound. MPEP § 2173.05(u) and the cases cited therein make it very clear that a trademark or trade name may only be used to identify a source of goods, *not the goods themselves*. Thus, the claim in choice (A) is indefinite, because the trademark in that claim is used as a limitation to describe the claimed compound itself, not as a designation as to the source of the claimed compound. In contrast, the trademark HYPALON in choices (B) and (C) is appropriately used as an identifier of source of the claimed compound, which is accurately described as an "elastomeric chlorosulphonated polythene." Answers (D) and (E) also appropriately identify the claimed compound by its chemical identity, without reference to the trademark. Therefore, assuming proper support, as required by the question instructions, answers (B) through (E) would not be rejected as indefinite.

Petitioner's arguments that all of the choices would be rejectable as indefinite are not persuasive. Specifically, Petitioner argues that "all the answers can be 'properly rejected' for indefiniteness as they all contain members and structure which have no supporting disclosure." These arguments ignore the premise of the question which expressly assumes that "no issue of support arises." No points are awarded.

Part 2 - Question 27:

Question 27 reads as follows:

27. Applicant filed a patent application relating to adhesive compositions having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer. The specification states, "The compositions of this invention must contain, as essential ingredients, at least one monomer of a class of alpha-cyanoacrylic acid

esters and at least one filler.” The compositions are characterized as being capable of being applied to a substrate submerged in water. Claim 1 reads as follows:

1. An adhesive composition having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer, the composition being capable of being applied to a substrate submerged in water.

The examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, by virtue of the functional statement regarding application to a substrate submerged in water therein, and under 35 U.S.C. § 112, first paragraph, as unduly broad. You decide to amend the application by canceling claim 1 and adding a new claim or claims. Assuming proper claim numbering, which of the following claims and arguments accords with proper PTO practice and procedure and would overcome the rejections?

* * * *

- (B) Claim - An adhesive composition having a paste-like consistency and comprising filler admixed with at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer, the composition being capable of being applied to a substrate submerged in water.

Argument - The 35 U.S.C. § 112, second paragraph, rejection is traversed on the ground that functional language in patent claims is permissible so long as it sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The 35 U.S.C. § 112, first paragraph, rejection is obviated because the breadth of the language “liquid monomer” has been narrowed to an essential ingredient, i.e., at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters.

* * * *

- (D) Claim - An adhesive composition having a paste-like consistency and comprising filler admixed with at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.

Argument - The 35 U.S.C. § 112, second paragraph, rejection is obviated because the functional statement is no longer recited in the claim. The 35 U.S.C. § 112, first paragraph, rejection is obviated because the breadth of the language “liquid monomer” has been narrowed to an essential ingredient, i.e., at least one liquid monomer of a class known as alpha-cyanoacrylic acid esters.

- (E) (B) and (D).

In the model answer, choice (E) is identified as the best answer. The reason given is that the claims set forth in (B) and (D) do not violate 35 U.S.C. § 112, first and second paragraphs.

Petitioner asserts that choice (D) is the most correct answer because the claim set forth in choice (B) contains functional language. Petitioner argues that choice (B) is not the most correct answer because it requires an interpretation of whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity and because leaving this “subjective evaluation” up to the examiner might not result in allowance of the claim. Petitioner believes that choice (D) is more correct because it avoids functional issues and related opinions and because it takes discretion out of the examiner’s hands. This argument assumes that the examiner will not act appropriately in response to arguments made that, according to the MPEP, would overcome a rejection. This is not a proper assumption to make for purposes of the examination. The question asks for both “claims and arguments” which accord with proper PTO practice to overcome the rejections.

The question asks “which of the following claims and arguments accords with proper PTO practice and procedure and would overcome the rejections.” Choice (E) is the best answer because the options given in (B) and (D) would both accord with proper PTO practice and procedure and would both overcome the rejections. While it is true that choice (B) requires the person taking the exam to determine whether the limitation “capable of being applied to a substrate submerged in water” circumscribes a particular area with a reasonable degree of particularity and requires a “subjective” decision to be made by the examiner, this does not make choice (B) any less correct than choice (D). Rather, because this limitation does circumscribe a particular area with a reasonable degree of particularity, the correct answer takes into account

that both (B) and (D) accord with proper PTO practice and procedure and would overcome the rejections. As the test directions require: “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.”

(Emphasis added). Because (E) contemplates that both (B) and (D) satisfy this condition, (E) is the best answer. No points are awarded.

Part 3 - Section 3 - Question 3:

Question 3 refers to a disclosure of a bottle stopper (not repeated here) and reads as follows:

3. Your client indicates that he wants protection on the ornamental aspects of his invention. You decide to prepare a design patent application for him. Which of the following would be a proper design patent claim covering your client’s invention?
- (A) The ornamental design for a bottle stopper.
 - (B) The ornamental design for a bottle stopper as shown and described.
 - (C) The ornamental design for an item as shown and described.
 - (D) A bottle stopper which controls the release of pressurized gas from the bottle as shown and described.
 - (E) The ornamental design for a champagne bottle neck and cap as shown and described.

The model answer identifies (B) as correct, based on 37 C.F.R. § 1.153(a) and MPEP § 1503.03. Petitioner chose answer (A). Section 1.153(a) states in relevant part: “The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” (Emphasis added). Petitioner argues that MPEP § 1503.03 makes use of the language “as shown” or “as shown and described” optional. Therefore, petitioner asserts that the MPEP is in conflict with 37 C.F.R. § 1.153 and, thus, answers (A) and (B) are equally correct and that both should be given credit.

MPEP § 1503.03, as of the time of the examination in August 1997, states in relevant part:

A design patent application may only include a single claim. The single claim should normally be in formal terms to “The ornamental design for (*the article as specified in the Title of the Invention*) as shown.” The description of the article in the claim should be consistent in terminology with the title of the invention. See MPEP § 1503.01.

When there is a properly included special description of the design in the specification (see MPEP § 1503.01), or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words “and described” should be added to the claim following the term “shown”; i.e., the claim should read “The ornamental design for (*the article as specified in the Title of the Invention*) as shown and described”. (Emphasis added).

Nothing in this passage of the MPEP suggests that the formal terms of claiming set out in 37 C.F.R. § 1.153 are optional. Petitioner’s argument that the MPEP and the regulation are in conflict is not persuasive. Moreover, the lack of the terms “as shown and described” in the claim of answer (A) would fail to particularly point out and describe the claimed invention as required by 35 U.S.C. § 112, ¶ 2. In any case, answer (A) does not conform to the formal claiming requirements of the regulation, whereas answer (B) does comply. The examination directions state in relevant part that the “most correct answer” is the “policy, practice, and procedure which must, shall, or should be followed” in accordance with the law, regulations, and MPEP. (Emphasis added). Thus, answer (A) could not be the “best answer” to this question under any circumstances, because it does not conform to the requirements of the regulation and the policy that “should” be followed under the MPEP requires the “as shown and described” language. No points are awarded.

CONCLUSION

Therefore, Petitioner's grade for the Afternoon Section is adjusted by the addition of two points, bringing the total score for the afternoon section to 67 points.

ORDER

Upon consideration of the petition to the Commissioner, it is

ORDERED that the petition is denied to the extent that Petitioner seeks a passing score, although two points are added to the score on the afternoon section of the exam for a total of 67 points.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

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

cc: