

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section 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, but lack merit. For the following reasons, two points will be added to Petitioner's score for the morning section of the Examination.

Question 22 reads as follows:

22. Prior art references may be combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness,

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show obviousness.”
- (E) A suggestion to modify the art can come from recent nonanalogous prior art references.”

The most correct answer is choice (C) and Petitioner selected choice (E).

Choice (C) is the most correct answer because a suggestion to modify the art may be inherently or implicitly taught in a reference to show obviousness. *See, e.g., In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983); Manual of Patent Examination Procedure (“MPEP”) § 2112.

Petitioner’s choice was (E) which states: “[a] suggestion to modify the art can come from recent nonanalogous prior art references.” Answer (E) is not the most correct answer because only analogous art can be used in a 35 U.S.C. § 103 rejection. *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Petitioner states that the *Napier* case cited in the model answer is based upon an arbitrary definition of “the art.” However, contrary to Petitioner’s argument, *Napier* is cited to demonstrate that it is proper to rely upon the inherent teaching of a reference.

Petitioner contends that any reference is prior art regardless of whether the teachings relate to “analogous” arts. This position is legally incorrect. To properly apply a reference in a 35 U.S.C. § 103 rejection, the applied reference must be from an analogous art. *Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1445; MPEP § 2141.01(a).

The question asked for the most correct statement regarding obviousness. Petitioner’s comments as to whether the “art” is new or not goes beyond the scope of the question. Petitioner further contends that the question is vague as to the meaning of “nonanalogous.” Petitioner’s argument has been considered, but is not persuasive. A reference is analogous if it is from the same field of art as the invention or teaches solving a problem pertinent to that which the inventor was concerned. *Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1445. An explanation of what constitutes analogous or nonanalogous art is set forth in MPEP § 2141.01(a).

Question 25 reads as follows:

25. Claimed subject matter has been rejected under 35 U.S.C. § 103 over a combination of prior art references, which purport to render the claimed subject matter *prima facie* obvious. Which of the following rebuttals properly demonstrates in the given circumstances that the references could not render the claimed subject matter *prima facie* obvious, and thereby overcome the rejection?

(A) Where the primary reference is a Russian patent certificate, the secondary reference is a U.S. patent, and a registered practitioner argues that *prima facie* obviousness has not been demonstrated because the assumption that the person of ordinary skill in the art would be familiar with all prior art references pertaining to a given art is in conflict with reality.

- (B) Where the claimed subject matter is a method for detecting and measuring minute quantities of nitrogen compounds, the primary reference teaches a method for detecting and measuring minute quantities of sulfur having – in addition to all the limitations of the claimed method – a solvent to collect the sample and stating that the presence of nitrogen in the sample will interfere with measuring sulfur quantities, a secondary reference teaching a method of detecting minute quantities of nitrogen in the atmosphere, and a registered practitioner argues that the references may not be properly combined to formulate a rejection of *prima facie* obviousness because there is nothing to suggest that they be combined since the primary reference seeks to avoid nitrogen.
- (C) Where neither the primary nor secondary reference explicitly states that its teachings may be combined with the teachings of the other reference, a registered practitioner should argue that the references may not be properly combined to formulate a rejection of *prima facie* obviousness absent an express suggestion in one prior art reference to look to another specific reference.
- (D) Where the claimed detergent uses sugar to enhance the compatibility of softeners with other components of the detergent, the primary reference teaches a detergent having all the claimed limitations except for the presence of sugar, and the secondary reference teaches using sugar as a filler or weighting agent in detergents having softeners, a registered practitioner should argue that the claimed detergent cannot be *prima facie* obvious unless one reference teaches using sugar for the same purpose it is used in the claimed detergent.
- (E) Where the claimed food additive uses YXY to sweeten food, the primary reference teaches food additive having all the claimed limitations except for using XY as a preservative, and the secondary reference teaches the equivalence of XY and YXY as preservatives in food, a registered practitioner should argue that to establish a *prima facie* case of obviousness there must be a suggestion from the prior art that the claimed invention will have the same or similar utility as the one newly discovered by Petitioner.

The correct answer is (B) and Petitioner selected answer (D). The question asks which of five rebuttals properly demonstrates in the given circumstances that references could not render the claimed subject matter *prima facie* obvious, and thereby overcome the rejection. The recited circumstances are that the claimed subject matter has been

rejected under 35 U.S.C. § 103 over a combination of prior art references, which purport to render the claimed subject matter *prima facie* obvious.

Choice (B) is the most correct answer. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988) (although rationale to combine references need not be expressly stated in the prior art, it is error to find obviousness where references “diverge from and teach away from the invention at hand”); *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

Petitioner contends that choice (B) is not the correct answer because although the primary reference may “teach away” from the use of nitrogen in the measurement of sulfur, it does not “teach away” from measuring nitrogen. Petitioner is incorrect in his analysis of the primary reference. The primary reference in the rejection is measuring sulfur. The reference also states that the presence of nitrogen will interfere with the measuring of the sulfur. The method will not work properly if nitrogen is present. This statement expressly prohibits the use of nitrogen or modifying the primary reference to measure nitrogen. Hence, the rejection can be overcome and this makes (B) the correct answer.

Petitioner chose answer (D) which is not the most correct answer. *See In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (a reference need not show the inventor's problem for obviousness); *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562-63 (CCPA 1972) (it is not necessary that the prior art suggest the combination to achieve the same advantage or the same purpose); MPEP § 2144. In particular, § 2144 states: “it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the

applicant to make the claimed invention” (emphasis in original). The references applied in the rejection set forth in answer (D) are both detergents. The invention is a detergent using sugar to enhance the compatibility of softeners with the other components in the detergent. The secondary reference applied in the rejection also contains sugar in detergents having softeners.

Petitioner contends that there must be some motivation to combine the references. Petitioner’s argument has been considered, but is not persuasive. Both references are from the same art of detergents. There is a suggestion to combine the two references. Petitioner has cited *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995), as authority for the proposition that it may be obvious to try to put sugar in a detergent but without motivation it would not be obvious. Petitioner’s argument overlooks the statement that the secondary reference teaches using sugar in a detergent. In *Deuel*, the invention involved a complex biotech invention relating to isolated and purified DNA and cDNA molecules. The Federal Circuit reversed the decision of the Board of Patent Appeals and Interferences and stated that the combined references applied in the rejection did not teach or suggest the claimed cDNA molecules. Based on the information given in answer (B), there is a suggestion to combine the references. No error in grading has been shown.

Question 39 reads as follows:

39. The Jones patent application was filed in the PTO in January 1998. Jones conceived and reduced the claimed invention to practice in the United States. A claim in the application has been rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or visa versa, and at no time were Smith and Jones obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1993, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1993, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1996, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1997, on an application filed in June 1993, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1993, of each species claimed in the Smith patent.

The correct answer is (A) and Petitioner selected answer (C). The question asks in which of five situations involving a rejection of a claim in Jones' patent application should a declaration by Jones under 37 C.F.R. § 1.131 overcome the rejection in accordance with proper PTO practice and procedure. The facts are as follows: Jones' patent application

was filed in the PTO in January 1998; he conceived and reduced the invention to practice in the U.S.; a claim in the application has been rejected under 35 U.S.C. § 102 over the Smith patent; Smith did not derive anything from Jones, or vice versa; and at no time were Smith or Jones obligated to assign their inventions to the same employer.

Choice (A) is the most correct answer. MPEP § 715.03 reads: “Where the claim under rejection recites a species and the reference discloses the claimed species, the rejection can be overcome under 37 CFR § 1.131 directly by showing prior completion of the claimed species See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).”

Petitioner chose answer (C) which is incorrect. To overcome a reference indirectly, as in (C), a showing of prior completion of a different species should be coupled with a showing that the claimed species would have been an obvious modification of the species completed by Petitioner. *Spiller*, 500 F.2d at 1178, 182 USPQ at 620, *In re Clarke*, 148 USPQ 665, 670 (CCPA 1966); *In re Plumb*, 470 F.2d 1403, 1407, 176 USPQ 323, 326 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966); MPEP § 715.03.

Petitioner contends that answer (A) should also be an incorrect choice because according to Petitioner “a species may anticipate the genus.” Petitioner cites *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990), as authority. *Chester* concerns an interference and the Petitioner’s reliance on a parent application which was found not to provide support for the continuation-in-part (CIP) application claims involved in the interference. The Court in *Chester* stated that the species may anticipate a genus in the context of the species being disclosed in the parent application and anticipating a genus in

a CIP claim. 906 F.2d at 1577, 15 USPQ2d at 1336. Petitioner's argument regarding answer (A) is not persuasive. To state that a species may anticipate a genus is stating what the answer (A) sets forth, *i.e.*, Smith discloses a species of the genus claimed by Jones. Such circumstances do not mean that the reference cannot be overcome. As set forth in MPEP § 715.03, paragraph B: "Where the only pertinent disclosure in the reference is a single species of the claimed genus, the Petitioner can overcome the rejection directly under 37 CFR 1.131 by showing prior possession of the species disclosed in the reference."

Petitioner contends that choice (C) is the best answer because a species may disclose the genus, relying on *Vas-Cath Inc., v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). There is no disagreement with that statement. The examination question is directed to overcoming a rejection based upon anticipation, not whether a species may disclose a genus. Petitioner further contends: "If the species in the declaration discloses to one of ordinary skill in the art that Jones invented the claimed genus, it is irrelevant that the claim is narrower than what Jones had a right to claim." Petitioner's statement is not understood. Answer (C) states that the species in the declaration is different from the species disclosed in the patent to Smith, and that the species is also different from the species that would be within the scope of the genus claim. In this situation, to overcome the rejection, the patent applicant must also show that the reference species would have been obvious in view of the species shown to be made by the applicant. Answer (C) does not state that the reference species would have been obvious in view of the earlier species completed by Jones. For the reasons set forth above, (C) is incorrect. No error in grading has been shown.

Question 47:

Two points are awarded for question 47.

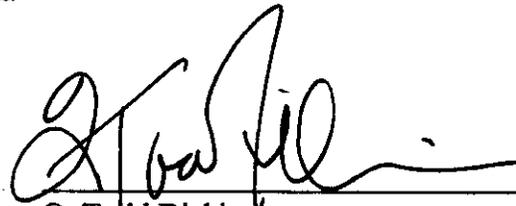
ORDER

For the reasons given above, two points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score is adjusted to 64. This score is insufficient to pass the Morning Section of the Examination.

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

This is a final agency action.

JUL 22 1999



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