



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 afternoon 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.

Question 5:

Two points are awarded for question 5.

Question 9 reads as follows:

9. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case.

Claim 1 reads as follows:

1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

The most correct answer is choice (E) because none of choices (A) – (D) would accord with proper PTO practice and procedure. Choice (A) is defective because it is misdirected to “a copper base alloy” while the claim it depends upon is directed to “a ship propeller.” Choice (B) is defective for two reasons. First, it purports to add a process step to a product claim. A claim directed to more than one statutory class of invention violates 35 U.S.C. § 112, second paragraph. Second, choice (B) purports to add aluminum to the copper base alloy of Claim 1. This is impermissible because Claim 1 recites “copper base alloy consisting of . . . .” (Emphasis added). The transitional phrase “consisting of” excludes any element, step or ingredient not specified in Claim 1. See MPEP § 2111.03 (“A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step.”). Choice (C) is wrong because

it purports to add “2 to 10 percent aluminum” to the propeller of Claim 1. Since the specification teaches the addition of aluminum to the copper base alloy, not to the propeller, choice (C) introduces new matter. Thus, choice (C) is subject to rejection under 35 U.S.C. § 112, first paragraph. See MPEP § 608.04. Choice (D) is wrong because it purports to include “2 to 10 percent aluminum” in the alloy in Claim 1. However, the alloy in Claim 1 is defined by the term “consisting of.” The transitional phrase “consisting of” excludes any element, step or ingredient not specified in Claim 1.

The most correct answer is choice (E) and Petitioner selected choice (D). Petitioner contends that choice (D) is correct “because the claim is allowable when it is read in light of the specification.” Petitioner contends that because the phrase “consisting essentially of” is the first phrase confronted when the claim is read, MPEP § 2111.03 makes it possible “to add aluminum without materially affecting the basic and novel characteristics claimed, i.e. corrosion resistance.”

Petitioner’s arguments are not persuasive. Petitioner’s focus on adding elements to the ship propeller is misplaced because choice (D) purports to add an element to “said alloy.” While the phrase “consisting essentially of” limits the ship propeller, it is not the pertinent limitation on the alloy. Instead, the alloy is limited by the phrase “consisting of.” Choice (D) fails to observe the “consisting of” limitation in the clause directed to the alloy. See Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc., 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986) (the phrase “consisting of” appearing in a clause limits the element set forth in the clause); see also, MPEP 2111.03 (“When the phrase ‘consists of’ appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not

excluded from the claim as a whole”). Petitioner’s reliance on the “first phrase confronted” is erroneous. The transitional phrase “consisting of” excludes any element, step or ingredient not specified in the alloy of Claim 1. Thus, aluminum is excluded from the alloy. No error in grading has been shown. Petitioner’s request for credit on question 9 is denied.

**Petitioner’s Arguments on the Calculation of the Grade:**

Petitioner contends that “[w]hen the number of wrong questions are totaled the correct score should be 68.” According to Petitioner, “[s]ince 16 question were answered wrong, the score reported should have been 68 [100-(16x2)].”

Petitioner’s answer sheet was reviewed and the correct total score for the Afternoon Section is 66. Petitioner had a total of 17 questions wrong. Petitioner’s list of incorrect questions did not include Question 1. The correct answer for Question 1 is choice (D) and Petitioner selected choice (E). No additional points are awarded.

**Examination Conditions:**

Petitioner provides “informational feedback to the USPTO, Office of Enrollment and Discipline” on the Los Angeles test site. Petitioner states that “[t]he test conditions for the August 26, 1998 examination were well beyond the normal test conditions expected for such a high caliber examination.”

The nature of the Los Angeles testing conditions have been duly noted. The Office of Personnel Management is taking steps to address the situation and to ensure that the situation is not repeated.

**ORDER**

For the reasons given above, two points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 68. This score is insufficient to pass the Afternoon Section of the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Afternoon 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