

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

JUL 28 1999

) Decision on
) Petition for Regrade
) Under 37 C.F.R. § 10.7(c)
)

In re _____)

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading her answers to questions 7, 10, 17, 23, 27 and 50 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 62 on the afternoon section. On January 4, 1999, Petitioner requested regrading of six two-point questions on the afternoon section, 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, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 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 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 7 reads as follows:

7. Inventor Jones received a patent that, through error and without deceptive intent, failed to describe an embodiment of her invention. Eighteen months after the patent was issued, Jones filed a complete reissue application adding a claim directed to the omitted embodiment, together with Jones’ declaration explaining the error, and the other required papers. In accordance with PTO practice and procedure,

- (A) The claim is subject to a rejection under 35 U.S.C. § 132.
- (B) The specification is subject to an objection as failing to provide proper antecedent basis for the claimed subject matter and require correction.

- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

The most correct answer is choice (C) and Petitioner selected choice (D). Choice (C) is the most correct answer because the amendment claiming the omitted embodiment is new matter. MPEP § 1411.02. Choice (D) is incorrect because Jones did not describe the omitted embodiment in the original patent.

Petitioner contends that “even assuming that the recapture of the canceled subject matter was narrower in scope, then the patentee is free to acquire through reissue without the time limit.” According to Petitioner, “[t]hus, even assuming that the matter broadened the scope of the original patent, the reissue was filed complete (which lead me read [sic] that it was according to statute with oath/declaration) and the time limit 18 months was within the prescribed 2 year limit.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, the facts of the question specifically state that “Inventor Jones received a patent that . . . failed to describe an embodiment of her invention.” The question does not concern “canceled subject matter” as Petitioner calls it. The question instead concerns an embodiment omitted from the patent and described for the first time in the reissue application, i.e. new matter. MPEP § 1411.02 provides that “[n]ew matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. § 251.” MPEP § 1411.02 further provides that a claim drawn to new matter should be rejected under 35 U.S.C. § 112, first paragraph. Choice (D) is incorrect because Jones did not describe the embodiment in the original patent. The claim directed to the

omitted embodiment is not allowable because it lacks support in the original written description. No error in grading has been shown. Petitioner's request for credit on Question 7 is denied.

Question 10 reads as follows:

10. Applicant claims the following container lid combination:

1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under 35 U.S.C. § 102. Which of the following replies to the rejection would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

The most correct answer is choice (C) and Petitioner selected choice (E). Choice (C) is the most correct answer because amending the claim to add specific structural dimensions or other limitations is most likely to distinguish Claim 1 from prior art X. MPEP § 2114. Choice (E) is incorrect because an amendment such as proposed in choice (C) is likely to overcome the rejection and result in issuance of the claim. Choice (A) is

incorrect because analogous art is not a consideration for an anticipation rejection under 35 U.S.C. § 102. See *In re Schreiber*, 128 F.3d 1473,-1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“the question whether a reference is analogous art is irrelevant to whether that reference anticipates”); MPEP § 2131.05. Choice (B) is incorrect because dispensing candy pieces as mentioned in Claim 1 is merely a functional description that does not structurally distinguish Claim 1 from X, which can be used to dispense liquids or solids. In *Schreiber*, claims directed to a funnel top for a popcorn dispenser were not successfully distinguished over a prior art oil funnel on the grounds that the claimed top was used for popcorn because the oil funnel inherently performs this function. *Schreiber* at 1479, 44 USPQ2d at 1433 (“declaration fails to show that [anticipating reference] inherently lacks the functionally defined limitations recited in claim”). Choice (D) is incorrect because choices A and B are incorrect.

Petitioner disregarded choice C because “answer C did not mention what exactly were the ‘specific limitations’ that were added.” According to Petitioner, “[n]ot all ‘specific limitations’ would result in the issuance of Claim 1, unless they particularly pertain to the exact dimension of the dispensing top to traverse the rejection over prior art reference X.”

Petitioner’s arguments are not persuasive. The question is directed to which of the replies to the 35 U.S.C. § 102 rejection “would be most likely to result in issuance of Claim 1.” Based on the facts provided in the question, amending Claim 1 to add specific limitations to the dimensions of the dispensing top is the most correct answer. MPEP § 2114 provides that “[e]ven if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.”

See also *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) (claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function). Adding specific limitations to the dimensions of the dispensing top differentiates Claim 1 from prior art X in terms of structure rather than function. Choice (C) is thus the most likely of the replies to result in issuance of Claim 1. No error in grading has been shown. Petitioner's request for credit on Question 10 is denied.

Question 17 reads as follows:

17. For a certain chemical composition, the original written description sets forth a range of "35% - 80%" and specific examples of "40%" and "65%." A corresponding claim includes the limitation, added by amendment, of "at least 42%." There is no other range or specific example disclosed in the application. Which of the following is correct?

- (A) The claim limitation is indefinite.
- (B) The claim limitation is not supported by the written description.
- (C) The disclosure is enabling with respect to the claim limitation.
- (D) The claim limitation is within the scope of "35% - 80%" in the written description.
- (E) The inventor has concealed the best mode.

The most correct answer is choice (B) and Petitioner selected choice (A). Choice (B) is correct because the claim limitation "at least 42%" includes embodiments greater than the 80% upper limit in the original written description. The phrase "at least" includes all embodiments greater than the lower defined limit. In addition to the fact that the written description does not support amounts greater than 80%, the original written description does not support the narrower range "at least 42%." Choice (A) is incorrect because the claim limitation is definite.

Petitioner contends that "the amendment of 'at least 42%' did not have an upper limit and caused the claim to read literally on embodiments over the 40% and 65% range

and thus causing the claim to be indefinite.” Petitioner states “I agree with answer B that the claim limitation is not supported by written description, BUT answer A pin points this clearly saying that since the amendment has not [sic] upper limit it causes the claim to be indefinite and hence not supported by the written description.”

Petitioner’s argument is not persuasive. Petitioner’s position that “since the amendment has not [sic] upper limit it causes the claim to be indefinite” is without merit. The claim limitation of “at least 42%” is definite; i.e. the claim is distinctly limited to 42% and above. MPEP § 2173.05(c) shows that an “at least” percentage limitation is not indefinite where no other claim language creates an ambiguity in the inherent 100% upper limit. Petitioner’s position appears to confuse the requirements of definiteness and written description. As set forth in MPEP § 2174, “[t]he requirements of the first and second paragraphs of 35 U.S.C. § 112 are separate and distinct.” No error in grading has been shown. Petitioner’s request for credit on Question 17 is denied.

Question 23 reads as follows:

23. Which of the following statements is (are) true?

- (A) A claim may not be dependent on any claim which is itself a dependent claim.
- (B) A dependent claim may not contain means-plus-function limitations.
- (C) A dependent claim will always be infringed by any device that would also infringe the base claim from which it depends.
- (D) Any dependent claim may be re-drafted as an independent claim.
- (E) All of the above statements are true.

Choice (D) is the correct answer and Petitioner chose choice (C). Choice (D) is correct because the third paragraph of 35 U.S.C. § 112 states that “[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” See also 37 CFR § 1.75(c). Thus, any dependent claim may be rewritten as an

independent claim by expressly including all of the limitations of the base claim to which it referred.

Petitioner contends that “I chose [C] over D because, I read the answer to mean ‘a dependent claim having all the devices that would infringe the base claim’.” According to Petitioner, “I did not assume the answer to include a dependent claim having additional or further limitations.”

Petitioner’s arguments are not persuasive. Choice (C) is false because it is possible that, even though a device might infringe a base claim, the dependent claim would not be infringed. A dependent claim recites a further limitation over the base claim. Thus, a device infringing a base claim may not contain the further limitation of the dependent claim. Such a device does not infringe the dependent claim because the device does not meet the dependent claim’s further limitation. Petitioner’s assumption that the answer did not “include a dependent claim having additional or further limitations” is contrary to the requirement of 35 U.S.C. § 112, fourth paragraph, that “a claim in dependent form shall . . . specify a further limitation.” No error in grading has been shown. Petitioner’s request for credit on Question 23 is denied.

Question 27 reads as follows:

27. Applicant filed a patent application claiming a polyester. The application discloses that the claimed polyester having structural formula R-R’ is used to form a stain resistant fabric. The examiner properly rejected the claims as unpatentable over prior art disclosing the claimed polyester having structural formula R-R’ and its use to form various fabrics. Given the fact that applicant’s specification discloses that the polyester may be produced by a process comprising steps A, B, C, and D, and such process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyester having structural formula R-R' used to form a stain resistant fabric, the polyester being produced by the process comprising the steps A, B, C, and D.
- (B) A polyester-producing process comprising steps A, B, C, and D, said process resulting in a polyester having structural formula R-R' capable of forming a stain resistant fabric.
- (C) A polyester produced by the process comprising the steps A, B, C, and D.
- (D) A polyester comprising the resultant product of steps A, B, C and D.
- (E) A polyester produced by the process comprising the steps A, B, C, and D, said polyester used to form a stain resistant fabric and having structural formula R-R'.

The correct answer is choice (B) and Petitioner selected choice (E). Choice (B) is correct because it is directed to the novel and unobvious process. Choice (E) is incorrect because it is directed to the product anticipated by the prior art.

Petitioner contends that “[i]n choosing answer E, I gave importance to the **process** for producing the polyester as the process was set forth clearly from the steps involved with the use to form [sic] a stain resistant fabric being novel and unobvious over the prior art.” According to Petitioner, “[j]ust claiming the product by process without being clear that the claim is directed to the product, makes me conclude that claim is directed to the process as the steps of the process was clearly elucidated and thus I chose answer E.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s argument, choice (E) is not directed to the novel process because it is directed to the non-patentable product. Thus, choice (E) is wrong because it claims the product in product-by-process format, whereas the novelty is in the process, not the product. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method

of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted); *Ex parte Edwards*, 231 USPQ 981 (Bd. Pat. App. & Int. 1986); MPEP § 2113. Based on the facts provided in the question, choice (B) is correct because it properly claims the novel and nonobvious process. No error in grading has been shown. Petitioner’s request for credit on Question 27 is denied.

Question 50:

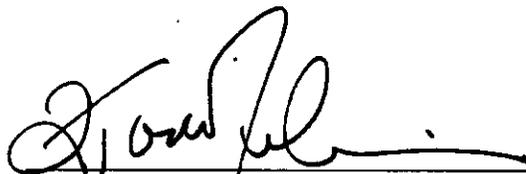
Two points are awarded for question 50.

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 64. This score is insufficient to pass the Afternoon Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition for a passing grade on the Afternoon Section of the Examination is denied.

This is a final agency action.



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

