



OCT 11 2000

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) requests for regrading question 38 of the morning section and questions 16 and 49 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On August 4, 2000, petitioner requested regrading, 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 Director of the USPTO.

**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 morning and afternoon sections 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 fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 38 and afternoon questions 16 and 49.

Petitioner's arguments for these questions are addressed individually below.

Morning question 38 reads as follows:

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution. The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

- (A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.
- (B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.
- (C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.
- (D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.
- (E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

The model answer is choice (A).

Selection (A) is the best answer as per *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because "late claiming" was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v.*

*Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

Petitioner argues that (B) is also correct. Petitioner contends that if the reissue claim is broader in an aspect unrelated to the rejection in the original application, then the recapture rule does not bar the claim and that it is not unreasonable to interpret a claim that has been made broader in an aspect unrelated to the rejection in the original application as one that has not been substantively amended. Petitioner concludes that answer (B) is correct because a claim not substantially amended cannot be broadened in an aspect related to a rejection.

Petitioner's argument has been fully considered but is not persuasive. Petitioner's argument is based on facts not given in the question, specifically "the reissue claim is broader in an aspect unrelated to the rejection in the original application." It is also an unreasonable interpretation of the question because choice B states that the claims were not amended substantively during original prosecution. The reissue claims were substantively amended and directly related to the rejection in the original application because they were broadened without limitations relied upon by Roberts during original prosecution.

According to MPEP 1412.02, under heading **ARGUMENT (WITHOUT AMENDMENT TO THE CLAIMS) IN THE ORIGINAL APPLICATION MAY BE SUFFICIENT TO ESTABLISH RECAPTURE**, page 1400-10, the *Clement* Court stated that "[to determine whether an applicant surrendered particular subject matter, we look to the prosecution history for **arguments** and changes to the claims made in an effort to overcome a prior art rejection." [Emphasis added] 131 F.3d 1464, 1469, 45 USPQ2d 1641, 1164. This statement in *Clement* was subsequently discussed in *Hester Indus., inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641

(Fed. Cir. 1998), where the Court observed that surrender of claimed subject matter may occur by **arguments** made during the prosecution of the original patent application *even where there was no claim change made*. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture “can occur through arguments alone.” 142 F.3d at 1482, 46 USPQ2d at 1649. Therefore, answer A is the best answer.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie’s behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie’s patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie’s. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie’s patent application is substantively identical to Billie’s patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable and that requiring practitioners to be cognizant of case law not referenced in the MPEP would be an arduous task. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, 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*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, “[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’ *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983).” *Monarch Knitting* stated “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art” at 1983, referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention. Therefore, choice E is not correct because choice B is the best answer. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A,

B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice (E).

The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically not abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 ("If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first."). See MPEP § 710.01(a), fourth paragraph.

Petitioner argues that answer (C) is correct. Petitioner contends that the question did not state that shortened statutory time periods were assigned to applications C and D, in which case, both were copending when application E was filed and application E could get the benefit of application C's filing date of October 29, 1993. Petitioner concludes that answer (E) is incorrect.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the question did not state that shortened statutory periods were assigned to applications C and D, the instructions specifically state that 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*. As explained in MPEP § 710.02(b), under the authority given him by 35 U.S.C. § 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. That same MPEP

action on the merits. Accordingly, applications C and D were assigned shortened statutory periods according to the PTO rules of practice and procedure, rendering applications C and D abandoned at the time of application E's filing. Therefore, choice E is the best answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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