



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 his answers to questions 10, 12 and 43 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 July 24, 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.

Petitioner has been awarded one point for morning question 20. Accordingly, petitioner has been granted an additional point on the examination, resulting in a regraded score of 69.

However, no credit has been awarded for afternoon questions 10, 12 and 43. Petitioner's arguments for these questions are addressed individually below.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice B, do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 are confirmed.

Petitioner selected answer E. Petitioner argues that answer E is correct because the attorney's action in choice E is not prohibited by 37 CFR 10.40, 37 CFR 10.77(c), and MPEP

402.06 since the question does not state that Sam contemplated withdrawing employment as Hurly's attorney. According to petitioner, without additional facts, answer E is correct.

Petitioner's arguments have been fully considered but they are not persuasive. The attorney has been told by his client that he does not have funds to continue prosecution. If the attorney does nothing as stated in choice B, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since the attorney agrees with the rejection of claim 1, the client would not be adversely affected.

Choice E is not the best answer because Sam should not charge his client in advance for services that are not required in the reexamination proceeding. To resolve any payment issues for services rendered, Sam should request to withdraw and obtain permission from the PTO in accordance with 37 CFR 10.40 and MPEP 402.06.

Afternoon question 12 reads as follows:

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

- (A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.
- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.

- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

The model answer is choice E. Both choices B and C are examples of proper advice to give Clem in accordance with proper PTO practice and procedure.

Petitioner selected answer C. Petitioner argues that choice C is the best answer because the question did not ask to give all possible legal options and choice B would not be the most direct course of action to protect Clem.

Petitioner's arguments have been fully considered but they are not persuasive. While recommending filing a protest is a proper advice, the best answer is choice E that included both B and C because simply recommending the filing of a protest is insufficient to protect Clem's right. Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. Since a protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. Clem has no right in the application filed deceptively by Tine. Filing the patent application with the correct inventorship will protect Clem's right in the invention.

Afternoon question 43 reads as follows:

43. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) The practitioner entering into a business partnership with an individual who is neither an attorney nor a registered practitioner, where the activities of the partnership consist of the practice of patent law before the Office by the

- practitioner, and the individual will market the practitioner's services and the client's inventions.
- (B) Filing an amendment wherein claims are presented that have been copied from an issued patent of another, and knowingly withholding from the Office information identifying the patent from which the claims have been copied.
 - (C) Telling a client that the client's application will go abandoned if the client's bill is not paid and refusing to file any papers in the PTO unless and until the fee is paid.
 - (D) Upon being discharged by a client, filing a request to withdraw wherein the client's intent to discharge is set forth as the reason for the request.
 - (E) When the client refuses to pay, without the client's consent after full disclosure, accepting compensation from a client's friend for the practitioner's legal services on behalf of the client.

The model answer is choice D. Upon being discharged by a client, filing a request to withdraw wherein the client's intent to discharge is set forth as the reason for the request is not prohibited conduct for a practitioner under 37 CFR 10.40.

Petitioner selected answer C. Petitioner argues that choice C is an equally correct answer because the applicability of 37 CFR 10.77(c) would assume facts not given in the question. Petitioner argues that "answer C doesn't go so far as to contemplate actually withdrawing from representing the client before the PTO, nor does it mention missing any deadlines by not filing papers or causing the client foreseeable prejudice." Petitioner asserts that since "withdraw" is not mentioned in answer C, the provisions of 37 CFR 10.40 do not apply. Petitioner argues that "answer C only contemplates a conversation between a practitioner and a deadbeat client."

Petitioner's arguments have been fully considered but they are not persuasive. As to answer C, a practitioner is proscribed from neglecting an entrusted legal matter. 37 CFR 10.77(c). Under 37 CFR 10.40, the practitioner must file a request to withdraw and avoid foreseeable prejudice to the client's rights where a client refuses to pay a practitioner. The

withdrawal is effective when approved rather than when received. See MPEP 402.06. This is so that the applicant will have sufficient time to obtain other representation or take other action. Under 37 CFR 10.77(c), the attorney has an obligation to file papers as required in the proceeding until the withdrawal is effective. Accordingly, the attorney's action in choice C would be considered knowingly giving misleading information to the client which is prohibited under 37 CFR 10.23.

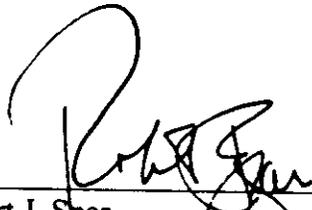
No error in grading has been shown as to afternoon question 10, 12 and 43.

ORDER

For the reasons previously given, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score has been adjusted to 69. 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.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy