



R2000-114

DEC 13 2000

In re

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

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 38 and 42 of the morning section and questions 6, 10, 27 and 42 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 69. On July 15, 2000, petitioner requested regrading, arguing that the model answers were incorrect which was supplemented on July 17, 2000, with a supplemental petition.

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 petitioners' arguments have been fully considered. Each question in the Examination is worth one point.

However, no credit has been awarded for morning questions 38 and 42 and afternoon questions 6, 10, 27 and 42. 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 is (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.

Petitioner selected answer (B). Petitioner argues that Hester v. Stein was decided on May 7, 1998 and was not included in the July 1998 MPEP, therefore it cannot be relied upon. Petitioner argues that the question posed is distinguishable from Hester, because in Hester the inventor argued over a 7-year prosecution that his cooker was distinguishable over the prior art because it included two limitations. Petitioner asserts the court was clear that had Williams not emphasized these two distinctions, Williams would not have obtained the patent. Petitioner states the facts are different because “. . . the claims were unduly narrow, narrow and . . . the limitations argued by Roberts were not necessary to the patentability of the invention.”

Petitioner's arguments have been fully considered but they are not persuasive. Choice A is the most correct answer. See *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998) and MPEP § 1412.02, Rev.1, Feb. 2000. (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Contrary to Petitioner's assertions the facts are not so different because “. . . **Charles realized** the claims were unduly narrow, narrow and . . . the limitations argued by Roberts were not necessary to the patentability of the invention.” In the question posed it was Charles, the inventor who now believes the claims were too narrow, the examiner did not allow the application until the practitioner Roberts had repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from the prior art. Thus, the facts are not distinguishable over Hester.

Morning question 42 reads as follows:

42. Which of the following can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a)?

(A) A drawing, labeled “Prior Art,” submitted by the applicant.

- (B) Canceled matter in an application that matured into a U.S. patent where the matter is not published in the patent.
- (C) An abandoned patent application referenced in a publication available to the public.
- (D) The combination of two references, where one of the references is used merely to explain the meaning of a term used in the primary reference.
- (E) A reference authored only by applicant, and published less than one year prior to the effective filing date of applicant's patent application.

The model answer is choice is (E).

Petitioner selected answer (D). Petitioner argues that terms in a patent are unique, as applicant may be his own lexicographer. Petitioner further asserts that it is contrary to PTO practice to define terms with other patents.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (D) is incorrect because multiple reference rejections under 35 U.S.C. § 102 may be used where one reference is used to merely explain a term used in the primary reference. See MPEP 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) cited therein. Choice (E) is correct since the reference is not by "another."

Afternoon question 6 reads as follows:

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.

(B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.

(C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

(D) All of the above.

(E) None of the above.

The model answer is choice is (C). To properly revive an abandoned application that went abandoned because the practitioner did not receive a mailing from the office, practitioner should timely file a petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. The petition should also include a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

Petitioner selected answer (B). Petitioner argues that the proper answer is to file a petition to revive the abandoned application. See MPEP 7.11.03(c)III Petitioner further argues that the fee is included with a grantable petition under § 1.137(b). Petitioner further argues since both B and C are correct, that the most correct answer would be one that states B and C, thus the most correct answer is D, as it includes both B and C. Petitioner argues that if the petition is filed pursuant to 37 C.F.R. § 1.137(b), it is logical to interpret that 37 C.F.R. § 1.137(b)(1)-(4) are complied with because the question states that the petition is pursuant to 37 C.F.R. § 1.137(b).

Petitioner's arguments have been fully considered but they are not persuasive. Choice (C) is correct because it sets forth the modified showing discussed in MPEP § 711.03(c), item subsection II, and complies with the fact noted in MPEP § 711.03(c), subsection I, that a petition to withdraw holding of abandonment does not require a fee. The petition to withdraw the holding of abandonment **does not require the payment of a fee** and is the best way to protect the interest of the client. Answer C does not include the payment of the petition fee, nor the issue fee, which are required under a petition to revive an abandoned application. See 37 C.F.R. §§ 1.17(l) and (m). Petitioner assumes facts that are not given in the answer C. According to 37 C.F.R. § 1.137(b), a "grantable petition pursuant to this paragraph must be accompanied by: . . . required reply . . . petition fee . . ." Additionally, under the petition to revive, the applicant must submit a Terminal Disclaimer and surrender patent term, which is not the best way to protect the client's interest.

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 is (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's selected answer (E). Petitioner argues that a patent attorney should contact his client upon being notified that he no longer has funds available for representation. Petitioner further argues that "the attorney's failure to act by 'doing nothing' (as suggested in answer "B") will result in prejudice to the client's position." Petitioner also argues that following the model answer would lead to neglect that rises to the level of incompetence and violate the Model Rules of Professional Conduct. Petitioner argues that the best answer is choice E, because then the client can decide if it wants to continue to pay for representation. Petitioner argues that B is incorrect, because further action is needed to make claims 2-10 allowable. Petitioner further argues that the question is incomplete because the patent exam examinee is told not to assume additional facts not presented, but then the examinee is without sufficient facts to know whether claims 2-10 are allowable.

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, 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 is not prejudiced, nor is it adversely affected. An amendment incorporating the limitations of independent claim 1 into the dependent claims 2-10 is not required. The facts state that Sam received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client, Hurley Corp. Hurley Corp. then advises Sam that they have no funds available to further prosecute the reexamination proceeding. Thus, the client is aware of the Office action and Sam's agreement with the Examiner. Choice E is improper because it states that Sam will take no further action in the proceeding and file no papers with the PTO unless he is paid, when no further action is necessary. No papers need to be filed with the PTO to preserve its rights. This is a **Reexamination**. Since claim 1 is the only claim rejected under art and claims 2-10 are objected to, the claims 2-10 are allowable over the art of record.

Afternoon question 27 reads as follows:

27. A patent application is filed with the following original Claim 1:

A steam cooker comprising:

- (i) a steam generating chamber having a steam generator;
- (ii) a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- (iii) a heat exchanger secured within said steam generator, said heat exchanger including at least one heating zone comprised of an inner having raised surface projections thereon, an outer panel having raised surface projections thereon, and a path between said raised surface projections whereby flue gases may pass for heating the walls of the heat exchanger.

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 4, after "steam" insert, --generator--.

- (B) In Claim 1, line 6, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, line 3, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and--.
- (E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

The model answer is choice is (B), but (A) is acceptable. Both choices A and B are amendments in accord with proper PTO amendment practice and procedure.

Petitioner selected answer (E). Petitioner argues that since there is obvious confusion on the exam whether the preamble is line 1 of the claim or not, given that both A and B have been deemed to be correct answers, then answer E is the best answer because it is the only selection that identifies the correct line of the claim. Petitioner further argues that in answer E, the insertion should be made where the deletion is made.

Petitioner's arguments have been fully considered but they are not persuasive. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made, and is limited to five words or less. The preamble is considered to be line 1 of the claim. See 37 C.F.R. § 1.121; MPEP § 714.22. Choice E is incorrect because it fails to identify the correct point where the deletion and insertion are to be made, "secured within" does not occur in line 4 of the claim. Furthermore, petitioner assumes additional facts not given in the question, specifically, "the insertion should be made where the deletion is made."

Afternoon question 42 reads as follows:

42. Assuming that each of the following claims is in a different utility patent application, and each claim is fully supported by the disclosure in preceding claims or in the application wherein the claim appears, which of the claims properly presents a process claim?

(A) A process of utilizing a filter having electrical components, said process comprising placing a plurality of electrodes on the human body, receiving electrical signals from the electrodes and passing the signals through said filter.

(B) A process of polymerizing an organic compound comprising combining a catalyst, organic compound reactants, and solvent in a reaction vessel, heating the combination in the vessel to a high temperature to start the reaction, separating the organic layer from the remaining materials, and evaporating the solvent.

(C) The use of a water repellant paint as a sealant for wooden patio furniture.

(D) (A), (B) and (C).

(E) (A) and (B).

The model answer is choice is (E). Answers A and B both properly present a process claim.

Petitioner selected answer (B). Petitioner argues that an attempt to claim a process without setting forth any steps in the process should be rejected under 35 U.S.C. § 112.

Petitioner argues that answer A does not set forth any steps involved in the process and is therefore indefinite.

Petitioner's arguments have been fully considered but they are not persuasive. The claim in (A) recites sufficient acts performed on subject matter, e.g., passing the signals through the filter. See MPEP 2173.05(q), and *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) cited therein. Thus, (A) is a proper process claim. Claim A claims "[a] process of utilizing a filter having electrical components" wherein electrical signals are passed through the filter, thus there is a process step involving the filter.

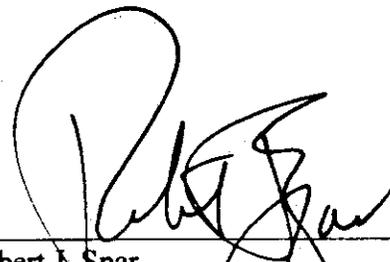
No error in grading has been shown as to morning questions 38 and 42 and afternoon question 6, 10, 27 and 42. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 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