



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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R3000-116

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 her answers to questions 20, 25, and 28 of the morning section and questions 1, 10, 23, and 29 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 67. 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 one additional point on the Examination. However, no credit has been awarded for morning questions 25 and 28 and afternoon questions 1, 10, 23 and 29. Petitioner's arguments for these questions are addressed individually below.

Morning question 25 reads as follows:

25. GMD Corp. files a patent application on a computer with a display screen which powers itself by solar panels. The examiner restricts the claims into two groups. Group 1 contains claims 1-5 directed to the combination of the computer and display screen. Group 2 contains claims 6-10 directed solely to the display screen. Practitioner Sam advises GMD Corp. that (a) the restriction requirement could be traversed since the inventions are not separate and distinct and (b) the restriction requirement may be traversed by adding patentable claims linking the two inventions. Nonetheless, GMD instructs Sam to delete claims 6-10 and file a divisional application incorporating claims 6-10. Sam deletes the claims 6-10, and the patent is granted on May 4, 1999 for claims 1-5. However, Sam inadvertently failed to file a divisional application. Today, April 12, 2000, GMD's president comes to you for advice as to how they can obtain patent protection for the subject matter in claims 6-10. Which of the following is the best advice you can offer in accordance with proper PTO practice and procedure?

- (A) GMD is barred from filing an application for claims 6-10 since during the original prosecution they deleted the very same claims following a restriction requirement.
- (B) Since GMD instructed Sam to file a divisional application and because his failure to do so was inadvertent, GMD may file a reissue application to obtain patent protection for those claims based upon inadvertent error without deceptive intent.
- (C) Since the restriction was made in the original case and not contested, a divisional reissue and appropriate fees must be filed to obtain patent coverage for claims 6-10.
- (D) Since the inventions were not separate and distinct, a reissue application and appropriate fees may be filed in which the restriction requirement may be traversed, and if successful, claims 6-10 can be added and entered.
- (E) Before one year transpires from the issuance of the patent, GMD should file a patent application containing claims directed to the same subject matter as deleted claims 6-10, and the appropriate fee.

The model answer is choice (E).

(E) is correct because the patent does not become a statutory bar against the subject matter of claims 6-10 until the one year from the issuance of the patent. 35 U.S.C. § 102(b). As to (B) and (D), the deliberately canceled claims cannot be recaptured by reissue. See *In re Watkinson*, 14 USPQ2d 1407 (Fed. Cir. 1990), and MPEP §§ 1412.02 and 1450. (A) is incorrect because (E) is correct. (C) is incorrect because there is no provision in 35 U.S.C. § 251 for filing a reissue application as a divisional application of an issued patent.

Petitioner argues that none of the answers is correct and answer (C) is the best answer among the five incorrect answers. Petitioner contends that (E) is incorrect because answer (E) fails to preserve the effective filing date of the parent case and (C) is a better answer because answer (C) at least attempts to preserve the effective filing date of the parent case. Petitioner concludes that answer (E) is incorrect and maintains that answer (C) is the better answer for the attempting to correct what answer (E) does not.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (C) at least attempts to preserve the effective filing date of the parent case, 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 §§ 1412.02 and 1450, canceled claims cannot be recaptured by reissue and therefore answer (C) would offer no patent protection at all, compared to the protection offered by answer (E) which precludes the advantage of the parent's filing date. Accordingly, answer (C) is worse advice than answer (E) according to PTO practice and policy, rendering answer (C) incorrect. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 28 reads as follows:

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

(i) An applicant cannot use a patent to prove the state of the art for the purpose of satisfying the enablement requirement if the patent has an issue date later than the effective filing date of the applicant's application.

(ii) A publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application's effective filing date.

(iii) The state of the art existing at the issue date of the patent is used to determine whether a particular disclosure in the patent is enabling.

(A) (i), (ii) and (iii).

(B) (i) and (ii).

(C) (i).

(D) (ii) and (iii).

(E) None of the above.

The model answer is choice (B).

(B) is the most correct answer as per MPEP 2164.05(a). Statement (i) is true because a later dated publication cannot be used to enable an earlier dated application. Statement (ii) is true since an examiner can look to later dated art if the art discloses the state of the art at the time of the invention. Statement (iii) is false since enablement is judged at the date of filing and later dated references cannot be used to establish enablement.

Petitioner argues that none of the answers (A) through (D) are correct and therefore answer (E) is correct. Petitioner contends that (i) is false because an applicant can use their own co-pending application, i.e, incorporation by reference, to prove the state of the art for purposes of satisfying the enablement requirement. Petitioner also states that (iii) is false because it is the state of the art at the date of filing not at the issue date of the patent. Petitioner's statement regarding (iii) is in agreement with the model answer. The model answer is choice (B) which

includes (i) and (ii), but not (iii). Petitioner did not argue that (ii) is false. Petitioner concludes that answers (A) through (D) are incorrect because all such answers indicate that either (i), (iii), or both are true and maintains that answer (E) is correct for the same reason.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that (i) is false for the case where an application incorporates a later issued patent by reference, the question specifically states that (i) an applicant cannot use a patent to prove the state of the art for the purpose of satisfying the enablement requirement if the patent has an issue date later than the effective filing date of the applicant's application. As explained in the instructions, do not assume any additional facts not presented in the questions.

Accordingly, the facts do not present a case of incorporation by reference, rendering statement (i) true, consistent with MPEP 2164.05(a). MPEP 2164.05(a) also states that a publication dated after the effective filing date of an application may be properly used to demonstrate that an application is nonenabling if the publication provides evidence of what one skilled in the art would have known on or before the application's effective filing date. The statement in answer (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

(A) In a utility case, gross sales figures accompanied by evidence as to market share.

(B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.

(C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.

(D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.

(E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice (D).

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).

Petitioner argues that both answers (A) and (D) are correct, but answer (A) is the better answer. Petitioner contends that market share is not probative evidence where the owner has 100% market share before and after the invention. Petitioner concludes that answer (A) is the best answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that market share is not probative evidence where the owner has 100% market share before and after the invention, the question specifically states which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness; (A) In a utility case, gross sales figures accompanied by evidence as to market share. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, answer (A) must be interpreted in view of any potential market share, not just 100%, rendering answer (A) probative evidence of commercial success in general.

The statement in answer (D) is correct because it is the only answer that is not probative evidence of commercial success. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that none of the answers is correct, but answer (E) is a better answer than (B). Petitioner contends that answer (B) is incorrect because claims 2-10 would remain rejected because of their dependence from claim 1. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is the best answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (B) is incorrect because claims 2-10 would remain rejected because of their dependence from claim 1, the question specifically states that a reexamination is the object of the question. As explained in MPEP 2260.01, dependent claims are not objected to or rejected merely because they depend from rejected or canceled claims. Accordingly, answer (B) is correct, rendering answer (B) the best answer. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using

larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advise on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advise Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

The model answer is choice (C).

As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. Cf. MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is

by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

Petitioner argues that none of the answers is correct and answer (B) is the best among the five incorrect answers. Petitioner contends that answer (C) is incorrect because obviousness-type double patenting will prevent Chris from obtaining a second patent. Petitioner argues that (B), although incorrect, is a better answer than (C) because Chris could argue that the breadth of language used in the disclosure covered trucks. Petitioner concludes that answer (C) is incorrect and maintains that answer (B) is the best alternative.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (C) is incorrect because obviousness-type double patenting will prevent Chris from obtaining a second patent, the question specifically states that Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment. Obviousness type double patenting is not a statutory bar and obviousness type double patenting can be overcome by a terminal disclaimer. 35 U.S.C. § 102; MPEP 804.02. Accordingly, obviousness-type double patenting will not prevent Chris from obtaining a second patent, rendering the statement in answer (C) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 29 reads as follows:

29. Which of the following is not a requirement of 35 U.S.C. § 102(d) to bar the granting of a patent in this country?

- (A) The foreign patent or inventor's certificate must have been published prior to the date of the application for patent in the United States.
- (B) The foreign application must have been filed more than 12 months before the effective filing of the application in the United States.
- (C) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns.
- (D) The foreign patent or inventor's certificate must be actually granted before the U.S. filing date.
- (E) The same invention must be involved.

The model answer is choice (A).

(A) is the most correct answer. 35 U.S.C. § 102(d), and MPEP § 2135 expressly list (B), (C), (D) and (E) as the four conditions which, if all are present, establish a bar against the granting of a patent in this country. The foreign patent or inventor's certificate described in (A) need not be published to establish a 35 U.S.C. § 102(d) bar. MPEP § 2135.01(III)(E).

Petitioner argues that answer (B) is correct because it is not a requirement for a bar for design applications, for which the bar is 6 months. Petitioner contends that answer (A) is incorrect because it asks whether the publication of a foreign patent is a bar and publication implies issuance, which is a requirement for a bar. Petitioner concludes that answer (A) is incorrect and maintains that answer (B) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (A) asks whether the issuance of a foreign patent as implied by publication is a bar, the question specifically states "Which of the following is not a requirement

of 35 U.S.C. § 102(d) to bar the granting of a patent in this country? (A) The foreign patent or inventor's certificate must have been published prior to the date of the application for patent in the United States. (B) The foreign application must have been filed more than 12 months before the effective filing of the application in the United States." As explained in MPEP 2135, there is no requirement for publication of a patent for a statutory bar under 35 U.S.C. § 102(d), and therefore the foreign patent or inventor's certificate need not have been published prior to the date of the application for patent in the United States, rendering answer (A) correct as not necessary to a bar.

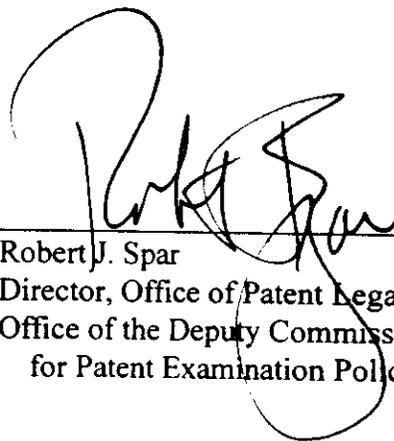
As to the period for a bar for a design patent, the instructions state that unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Accordingly, a foreign application must have been filed more than 12 months before the effective filing of the application in the United States to present a bar, rendering the statement in answer (B) incorrect as not necessary to a bar. No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

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



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