



UNITED STATES PATENT AND TRADEMARK OFFICE

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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R-2000-125

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 7 and 12 of the morning section and questions 20 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 July 18, 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 granted no additional point on the Examination. No credit has been awarded for morning questions 7 and 12 and afternoon questions 20 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally

secured to each other by a connector; and”

(E) “said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points; and”

The model answer is choice (B).

Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

Petitioner argues that answer (D) is the most correct answer. Petitioner contends that the question asks for an answer that most broadly completes the missing paragraph (iii) of claim 1 and it does not require the answer to be the source of antecedent basis for the other claims. Since answer (D) has fewer limitations than (B), answer (D) is the correct answer.

Petitioner’s argument has been fully considered but is not persuasive. The examination instructions specifically provide that “[t]he 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*.” Answer (D) is incorrect because claims 1 and 2 would be rejected under 37 U.S.C. 112, second paragraph for lack of antecedent basis. Also see MPEP 706.03(d). It does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. No error in grading has been shown. Petitioner’s request for

credit on this question is denied.

Morning question 12 reads as follows:

12. Which of the following documents, if any, must also contain a separate verification statement?

- (A) Small entity statements.
- (B) A petition to make an application special.
- (C) A claim for foreign priority.
- (D) An English translation of a non-English language document.
- (E) None of the above.

The model answer is choice (E).

Answer (E) is correct. MPEP § 410 makes clear that the certification requirement set forth in 37 C.F.R. § 10.18(b) “has permitted the PTO to eliminate the separate verification requirement previously contained in 37 C.F.R. ...1.27 [small entity statements], ...1.52 [English translations of non-English documents], ...1.55 [claim for foreign priority], [and] ...1.102 [petition to make an application special].”

Petitioner argues that answer (D) is the correct answer. Petitioner contends that a translation should include a separate statement stating that the document is a the translation in addition to a statement that the translation of the certified copy is accurate.

Petitioner’s argument has been fully considered but is not persuasive. The question asks which of the following documents **must** also contain a **separate verification statement**. Applicants may submit other statements along with an English translation, however a separate verification statement is not required as stated in MPEP 410. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 20 reads as follows:

20. Which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000?

- I. The examiner set a shortened statutory period of three months for replying to the Office action, and three months from September 25, 2000 falls on Christmas Day, December 25, 2000, a federal holiday, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
 - II. The examiner's interpretation of the prior art in rejecting certain claims, as set forth in the Office action, is believed by a registered practitioner to be contrary to the interpretation given by one of ordinary skill in the art, and the practitioner calls this alone to the examiner's attention within one month of the mail date of the office action.
 - III. The examiner incorrectly cited one of the references, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.
- (A) I.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (E) None of the above.

The model answer is choice (C).

(C) is the most correct answer. MPEP § 710.06. (I) is incorrect since this does not constitute error by the examiner. (II) is incorrect, since a reply would be due by the reply date, regardless of whether the rejection was traversed. Thus (A), (B), and (D) are incorrect. (E) is incorrect because C is correct.

Petitioner argues that (E) is correct because none of the other answers is correct. Petitioner contends that statement in answer (C) is incorrect because it would lead to additional time for responding to the complete Office action. Petitioner further argues that the response period never stops therefore it cannot be started again.

Petitioner's argument has been fully considered but is not persuasive. According to MPEP 710.06, "[w]here the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the

action, the Office will **restart** the previously set period for reply to run from the date the error is corrected," (emphasis added). Therefore, statement in answer (C) is correct. 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 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 (A) is correct. Petitioner contends that the final deadline for reply is actually six months after the Office action (i.e., October 20, 1999), therefore copendency

exist between the applications. Petitioner concludes that E could get the benefit of B's filing date of October 21, 1993.

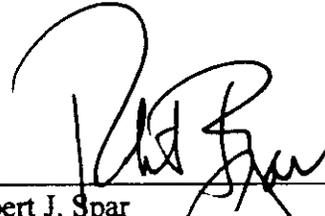
Petitioner's argument has been fully considered but is not persuasive. The examination instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and 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 USC § 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. That same MPEP section also states that such shortened period is 3 months to reply to any Office action on the merits. Accordingly, the Office actions that were mailed on April 20, 1999 for applications C and D were assigned shortened periods according to the PTO rules of practice and procedure, rendering C and D abandoned at the time of E's filing and making the correct answer (E). No error in grading has been shown. Petitioner's request for credit on this question 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 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