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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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JAN 5 2001

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 17, 18, 28 and 48 of the morning section, and questions 16, 44 and 48 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 65. On July 17, 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 questions 17, 18, 28 and 48, and afternoon questions 16, 44 and 48. Petitioner's arguments for these questions are addressed individually

below.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice (E). Choice (E) is correct because choices (B) and (C) are correct. Choice (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. Choice (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. Choice (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

Petitioner argues that answer (B) alone is correct. Petitioner contends that answer (C) is improper because there is no support in the specification for the negative limitation "not including an adhesive layer." Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is incorrect for the same reason.

Petitioner's argument has been fully considered but is not persuasive. Contrary to

petitioner's contention, the negative limitation "not including an adhesive layer" of choice (C) is supported in Smith's specification because it **discloses no adhesive layer**. Accordingly, answer (C) is a proper claim, rendering answer (C) correct. 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 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) **Increasing the economic value of a patent by extending the effective term of the patent up to one year.**
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D). Increasing the economic value of a patent by extending the effective term of the patent up to one year is not a policy underlying the public use bar of 35 U.S.C. 102(b).

Petitioner argues that choice (C) is also correct. Petitioner points out that under MPEP 2133.03(e)(1), commercial exploitation must be considered in determinations of whether a use is experimental.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner's comments regarding commercial exploitation and its effect on the experimental use exception to 35 U.S.C. 102(b) are misplaced. While commercial exploitation and its effect on the experimental

use exception are “considerations” under 35 U.S.C. 102(b), the question specifically asks which of the statements is NOT a “policy” underlying the public use bar of 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit has repeatedly stated that one of the policies underlying the public use bar of 35 U.S.C. 102(b) is allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent. Note *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996); *Tone Brothers v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); and *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985). Thus, choice (C) is incorrect. The Federal Circuit lists all of the answer choices, with the exception of choice (D) (i.e., increasing the economic value of a patent by extending the effective term of the patent up to one year) as policies underlying the public use bar of 35 U.S.C. 102(b). Thus, choice (D) 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). Statements (i) and (ii) are true, and statement (iii) is false.

Petitioner argues that choice (C) is correct. Petitioner appears to argue that only statement (i) is true.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (B) is the most correct answer. See 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. Choice (B) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 48 reads as follows:

48. Kevin invents a solar energy device for cooking food having a parabolic reflector with a rod connected along the center axis of the reflector, and a cooking grill connected to the top of the rod. A thorough search of the prior art results in locating Bill's United States patent, issued July 22, 1997. Bill's patent discloses a parabolic reflector having a cut-out portion from the base of the reflector with a rod connected along the center axis of the reflector, and a grill for cooking connected to the top of rod. Figures in Bill's patent show the invention with (Fig. 2) and without (Fig. 1) the cut-out portion, respectively. Bill's patent specifically teaches away from making the device by omitting the cut-out portion because the base portion of the reflector would unnecessarily gather fat and grease when the device is used to cook meat. On July 1, 1998, you, a registered practitioner, discuss the patent with Kevin, who states that his invention would be advantageous, since by leaving out the cut-out portion, the invention could be used to collect fat and grease, which could be sold. On July 20, 1998, you file a patent application for Kevin disclosing the solar energy device and its advantages, and claiming the device. During examination of the application, an examiner finds a publication disclosing a solar energy cooking device having a reflector without a cut-out portion. Which of the following accurately describes the duty to disclose Bill's patent to the PTO?

- (A) Only you have a duty to disclose the patent to the PTO.
- (B) Both you and Kevin have a duty to disclose the patent to the PTO, but the disclosure need not be in writing.
- (C) Both you and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.
- (D) There is no duty to disclose the patent to the PTO, since it is a United States patent, and the examiners already independently have access to electronically search the database with all the United States patents.
- (E) There is no duty to disclose the patent to the PTO, because the patent is not material to patentability since it teaches away from the inventive concept of Kevin's invention.

The model answer is choice is (C). Both the practitioner and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.

Petitioner argues that choice (E) is correct. Petitioner argues that there is not necessarily a duty to disclose the patent to the PTO.

Petitioner's arguments have been fully considered but they are not persuasive. Contrary to petitioner's contention, the patent to Bill is clearly material to patentability based on the statement of facts given in the question. Kevin's invention is a solar energy device for cooking food having a parabolic reflector with a rod connected along the center axis of the reflector, and a cooking grill connected to the top of the rod. Bill's patent discloses a parabolic reflector having a cut-out portion from the base of the reflector with a rod connected along the center axis of the reflector, and a grill for cooking connected to the top of rod. Figures in Bill's patent show the invention with (Fig. 2) and without (Fig. 1) the cut-out portion, respectively. Further, the examiner found a publication disclosing a solar energy cooking device having a reflector without a cut-out portion. Based on the given scenario, Bill's patent is clearly material to patentability regardless of how the claim drawn to the device is drafted in Kevin's application. The patent to Bill may be relied upon for rejections under 35 U.S.C. 102(a) and/or 35 U.S.C. 103, and therefore it is material to

patentability. See 37 CFR 1.56 and MPEP 2001.01. Choice (C) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner argues that the most correct answer is choice (E), because (A), (B), (C) and (D) are each incorrect. Petitioner acknowledges that nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. However, petitioner appears to argue that the independent inventions must have been intentional.

Petitioner's arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. See *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *International Glass Co. v. U.S.*, 159 USPQ 434 (US Cl.Ct. 1968). Further, the statement of facts in the question make it clear that their inventions were intentional. Therefore, choice (B) is correct, and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 44 reads as follows:

44. Which of the following statements best correctly describes current PTO practice and procedure?

(A) Where a patent discloses subject matter being claimed in an application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f).

(B) The fact that a claim recites various components, all of which can be argumentatively assumed to be old, provides a proper basis for a rejection under 35 U.S.C. § 102(f).

(C) A person can be an inventor without having contributed to the conception of the invention.

(D) In arriving at conception, an inventor may not consider and adopt ideas and materials derived from other sources such as an employee or hired consultant.

(E) It is essential for the inventor to be personally involved in reducing the invention to actual practice.

The model answer is choice (A). Where a patent discloses subject matter being claimed in an

application undergoing examination, if the patent's designation of inventorship differs from that of the application, then the patent's designation of inventorship does not raise a presumption of inventorship regarding the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. § 102(f). See MPEP 2137.

Petitioner argues that choice (E) is correct also. Petitioner argues that it may be essential for the inventor to be personally involved in the reduction to practice if it requires inventive skill.

Petitioner's arguments have been fully considered but they are not persuasive. See MPEP 2137.01 (section entitled "The Inventor Is Not Required To Reduce The Invention To Practice"). Note also *In re DeBaun*, 214 USPQ 933, 936 (CCPA 1982) ("there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf"). Clearly, the statement in choice (E) ("It is essential for the inventor to be personally involved in reducing the invention to actual practice") is **not** true. Of course, the inventor may be involved with reduction to practice, but that is not the statement set forth in choice (E). Therefore, choice (A) is correct, and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the

claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D). Choice (D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (“In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification...”); MPEP 2141.02 (section styled, “Disclosed Inherent Properties Art Part of ‘As A Whole’ Inquiry”). Choice (A) is **incorrect**. See MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry **more** weight. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Choice (B) is incorrect. See MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Choice (C) is incorrect. See MPEP 2141.02 (section styled, “Distilling The Invention Down To a ‘Gist’ or ‘Thrust’ Of An Invention Disregards ‘As A Whole’ Requirement”). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). Choice (E) is incorrect. As stated in MPEP 2141.02 (section styled, “Disclosed Inherent Properties Are Part Of ‘As A Whole’ Inquiry”), “Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).”

Petitioner argues that (A) is correct. Petitioner argues that evidence of PTO classification of prior art references is given “some” weight. Petitioner contends that (D) is incomplete because it only lists a portion of the analysis for delineating the invention.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that answer (A) is correct because evidence of PTO classification of prior art is given “some” weight, answer (A) states “PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function

carry **equal weight** as evidence of whether the references are analogous or non-analogous." PTO classification is **some** evidence of analogy/non-analogy, but structure and function carry **more weight**. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) states, "While we find the diverse Patent Office classification of the references to be some evidence of "non-analogy," and likewise find the cross-reference in the official search notes to be some evidence of "analogy," we consider the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight."

As to answer (D), *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977), specifically states that "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the **subject matter which are inherent in the subject matter and are disclosed in the specification...**" (Emphasis added.) Accordingly, answer (D) is correct and answer (A) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

No error in grading has been shown as to morning questions 17, 18, 28 and 48, and afternoon questions 16, 44 and 48. Petitioner's request for credit on these questions is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in

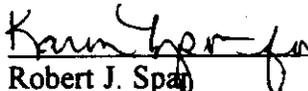
grading and preclude[s] unfair and individually discriminatory grading.” *Id.*, slip opinion at 5. The court concluded that “the decision of the Commissioner of the USPTO not to regrade Mr. Worley’s examination answers as correct when the answers did not conform with the USPTO’s Model Answers was not arbitrary and capricious.” *Id.*, slip opinion at 5-6.).

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score remains 65. 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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Robert J. Spat  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy