



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 3, 22, 30, 34, 42 and 50 of the morning section, and questions 11, 37 and 41 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 May 31, 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 3, 11, 22, 30, 34, 42 and 50, and afternoon questions 11, 37 and 41. Petitioner's arguments for these questions are addressed

individually below. In the petition, petitioner requested regrade of afternoon question 11, however the arguments are directed to morning question 11. Petitioner's request and arguments for both questions have been considered and are also addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E). Choice (E) is correct because both (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. Choices (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (B) is incorrect and therefore answer (D) alone is correct. Petitioner argues that answer (B) is incorrect because it contains an ambiguity as to the payment of the fees. Petitioner contends that answer (B) is ambiguous since it is not clear from the answer whether fees could be paid by a check, credit card, deposit account, or paid after a Notice of Insufficiency, or whether fees already paid cover the cost of the amended claims. Petitioner appears to argue that such ambiguity calls into question whether answer (B) is true.

Petitioner's argument has been fully considered but is not persuasive. MPEP 608.01 (n) (top of p. 600-65) states:

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the amended claims.

Contrary to petitioner's characterization of answer (B), it does not contain an ambiguity.

Choice (B) does not state that a fee must be received with the amendment which adds the multiple dependent claim. Answer (B) only states that the multiple dependent claim should not be entered until the proper fee has been received by the PTO. As petitioner acknowledges in his arguments, the "proper fee" may be paid in a variety of ways (such as by check, credit card, deposit account, or paid after a Notice of Insufficiency, or fees already paid may cover the cost of the amended claims). However, this does not conflict with answer (B), which is a true statement.

The multiple dependent claim should not be entered until the proper fee has been received by the PTO, no matter what form such payment takes. There is no ambiguity in answer (B).

Accordingly, both answers (B) and (D) are correct, rendering answer (E) incorrect. The statement in answer (E) is the most correct for including both answers (B) and (D). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 11 reads as follows:

(Note that this question is addressed here because petitioner's arguments for afternoon question 11 appear to actually be directed to morning question 11.)

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999,

without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in *Moose Jaw Monthly*, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the *Moose Jaw Monthly* article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C)

The model answer is choice (E), which includes (A), (B) and (C). Mario can rely on his activities in both (A) Canada (a NAFTA country) and (B) Germany (a WTO member country) in establishing a date of invention in a priority contest against another inventor. Mario can also rely on his activities in Canada (a NAFTA country) in establishing a date of invention prior to publication of the regional Canadian magazine article (choice (C)).

Petitioner argues that choice (A) is the most correct answer. However, petitioner selected choice (D) on the answer sheet for the morning session of the examination. Petitioner did select choice (A) for question 11 of the afternoon section, which further demonstrates that petitioner's comments are directed at the incorrect question.

Petitioner's arguments have been fully considered but they are not persuasive. The answers only state that Mario may rely on his activities in Canada and Germany in establishing a date of invention, NOT whether such a date of invention could ultimately be established (which

would include evidence of "due diligence"). While the reduction to practice occurred after the date of publication of the article, Mario may rely on his activities in Canada in establishing his date of invention. Note that in order to ultimately establish such date of invention, a showing of conception and due diligence prior to the date of publication of the article would be required.

See 37 CFR 1.131 and MPEP § 715 and § 715.07. However, the answers only state that he may rely on his activities in Canada and Germany, not whether a date of invention will ultimately be established. Since, the article is a publication of Mario's own work and not a statutory bar, he may rely on his activities in Canada. See 35 U.S.C. § 104 and MPEP § 715.01(c) and § 715.07(c). Choice (E) is the most correct answer. No error in grading has been shown.

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

Morning question 22 reads as follows:

22. Which of the following rejections can properly be overcome using a 37 C.F.R. § 1.131 affidavit?

- I. A rejection under 35 U.S.C. § 102(a) based on a journal article that describes the invention as claimed.
- II. A rejection under 35 U.S.C. § 102(b) based on a patent that discloses but does not claim the invention.
- III. A rejection based on statutory double patenting.
- IV. A rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention.

- (A) I.
- (B) II.
- (C) III.
- (D) IV.
- (E) I and IV.

The model answer is choice (E). The rejections described in both I and IV can properly be

overcome using a 37 C.F.R. § 1.131 affidavit. See MPEP 715 abd 804.02.

Petitioner argues that the rejection described in IV can not always be overcome using a 37 C.F.R. § 1.131 affidavit, therefore answer (E) is incorrect, and answer (A) alone is correct. Petitioner appears to argue that if a double patenting rejection (commonly owned/same patentable invention) or interference would be proper, then a 37 C.F.R. § 1.131 affidavit would not be proper to overcome a rejection under U.S.C. § 102(e). Petitioner further argues that even if IV is proper, each of choices (A), (D) and (E) should be considered correct and given credit.

Petitioners arguments have been fully considered but are not persuasive. The rejection described in IV is "a rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention." Such a rejection can properly be overcome using a 37 C.F.R. § 1.131 affidavit. Petitioner's arguments include additional assumptions of fact not found in the statement of the rejection. A rejection under U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention is not a "double patenting" or "interference" scenario, as described by petitioner. The patent discloses but does not claim the same patentable invention. Further, even if a "double patenting" rejection or "interference" proceeding were proper (which they are not under the described scenario), a C.F.R. § 1.131 affidavit would still be proper to overcome a rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention. Therefore, both I and IV are proper. Choice (E) the most correct answer, because it includes both I and IV. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 30 reads as follows:

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

- I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) I, II, and III.

The model answer is choice is (C). A reply amending the limitation "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield" would comport with proper PTO rules and procedure, and will overcome the rejection.

Petitioner argues that since guidelines in the specification fully disclose what an "effective voltage" would be for either of at least two functional purposes (defrosting and protecting from cracking), it is not an indefinite recitation in the claim, and therefore (B) is the most correct answer.

Petitioner's arguments have been fully considered but are not persuasive. The claim is indefinite because it does not specify **which of the two** disclosed functions is to be achieved. Petitioner correctly states that guidelines in the specification do not need to be in the claim if the claim can be interpreted by someone of ordinary skill as definite using the standards in the specification. However, claim 1 does not specify **which of the two** types of "effective amount of voltage" the voltage source is to be adjusted to, does render it indefinite under 35 U.S.C. 112, second paragraph. Choice (C) is correct and choice (B) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 34 reads as follows:

34. You have just received an Office action rejecting all of your claims in your patent application as anticipated under 35 U.S.C. § 102(a) using published declassified material as the reference. The examiner explains that the declassified material is being used as *prima facie* evidence of prior knowledge as of the printing date. The published declassified material contains information showing that it was printed six months before the filing date of the application, and that it was published two months after the application's filing date. You correctly note that although the printing date precedes your application filing date by six months, you note that the publication was classified as of its printing date (thus, available only for limited distribution even when the application was filed), and was not declassified until its publication date (when it became available to the general public). Each element of the claimed invention is described in the publication of the declassified material. Which of the following statements is true?

- (A) The rejection is not supported by the reference.
- (B) The publication is not available as a reference because it did not become available to the general public until after the filing date of your patent application.

- (C) The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.
- (D) The publication constitutes an absolute statutory bar.
- (E) It is not possible to use a Rule 131 affidavit or declaration to antedate the printing date of the publication.

The model answer is choice (C). The publication is *prima facie* evidence of prior knowledge even though it was available only for limited distribution as of its printing date.

Petitioner argues that choice (B) is also correct. Petitioner argues that answer (C) is not an absolute since the declassified material is not a publication under 35 U.S.C. 102(a) because it was not "public," and need not be viewed as *prima facie* evidence of prior knowledge.

Petitioner's arguments have been fully considered but they are not persuasive. The question does not indicate that the material is applied as a "printed publication" under 35 U.S.C. 102(a). Rather, the question clearly states that the material is being applied under 35 U.S.C. 102(a) as *prima facie* evidence that the invention was "known or used by others in this country" prior to the filing date of the application (i.e. as evidence of "prior knowledge"). MPEP 707.05(f) clearly points out the distinction between such declassified material being applied as a "publication" (see MPEP 707.05(f), second paragraph) versus being applied as evidence of "prior knowledge" (see MPEP 707.05(f), third paragraph). In the later instance, "declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time." Further, the statement of the question points out that "each element of the claimed invention is described in the publication of the declassified material." Thus the publication clearly constitutes *prima facie* evidence of prior knowledge. Choice (B) is incorrect since the publication is available as a reference. Choice (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

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 (E). A reference authored only by applicant, and published less than one year prior to the effective filing date of applicant's patent application can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a).

Petitioner argues that choice (B) is the most correct answer. Petitioner argues that canceled matter in an application that matured into a U.S. patent where the matter is not published in the patent is not "public" for purposes of U.S.C. § 102(a).

Petitioner's arguments have been fully considered but they are not persuasive. Canceled matter in the application file of a U.S. patent becomes available as prior art as of the date the application issues as patent. See MPEP 2127 and *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966). Although not "published" in the patent itself, such material is "public" knowledge. The question asks, "Which of the following can never properly be available as prior art for purposes of a rejection under 35 U.S.C. § 102(a)?" The question does **not** ask which of the following are **always** available. The portion of the *Stalego* decision which petitioner point to in his arguments

is merely stating the rule that the canceled material only becomes available as prior art as of the **issue date of the patent**, not as of the filing date of the application. While such canceled material is not prior art relative to applications having an effective filing date prior to the patent issue date, it is prior art relative to applications having an effective filing date after the patent issue date. Choice (E) is correct, and choice (B) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 50 reads as follows:

50. On Saturday, February 6, 1999, in Texas, inventor Smith successfully tested a wireless telephone. On Sunday, February 7, 1999, Smith began testing the market place by offering to sell the wireless telephone in a variety of urban and rural regions, throughout Texas. On Tuesday, February 8, 2000, registered practitioner Bill filed a patent application for inventor Smith fully disclosing and claiming the same wireless telephone he tested on February 6, 1999, and offered for sale on February 7, 1999. Bill received a non-final Office action rejection of the claim under 35 U.S.C. § 102(b) based on Smith's activities in testing the wireless telephone, and testing the market place. Which, if any, of the following actions taken by Bill comport with proper PTO rules and procedure, and will overcome the rejection?

- (A) Filing a timely reply traversing the rejection on the grounds that February 7, 1999 was a Sunday, that Smith could not file an application on the one-year anniversary Sunday because the PTO is closed, so Smith's activities must be measured from Monday, February 8, 1999, which is not more than one year prior to the application date.
- (B) Filing a timely reply traversing the rejection on the grounds that Smith's activities were experimental only and therefore excepted from 35 U.S.C. § 102(b).
- (C) Filing a timely reply with an affidavit under 37 C.F.R. § 1.131 presenting statements by Smith that the activities were by Smith, himself, as opposed to another, and the activities were experimental.
- (D) Filing a timely reply with an affidavit under 37 C.F.R. § 1.132 demonstrating by objective evidence of the commercial success of the wireless telephone.
- (E) None of the above.

The model answer is choice (E). None of the listed actions comport with proper PTO rules and procedure, and will overcome the rejection.

Petitioner argues that choice (B) is the most correct answer. Petitioner argues that February 7, 1999 activities were continued "testing" which constitute "experimental use."

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner's explanation for why the Smith's action on February 7, 1999 constitutes further "testing" which constitutes "experimental use" is filled with unwarranted assumptions of fact, and is contrary to the statement of facts in the question. The question states: "On Saturday, February 6, 1999, in Texas, inventor Smith successfully tested a wireless telephone. On Sunday, February 7, 1999, Smith began testing the market place by offering to sell the wireless telephone in a variety of urban and rural regions, throughout Texas." Contrary to petitioner's contention, the invention was successfully tested on February 6, 1999, and there was no activity that would qualify as "experimental use" after this point. Further, the activities which commenced on February 7, 1999, were testing the market place by offering to sell the wireless telephone. Contrary to petitioner's contention, such "market testing" was not "experimental use." See MPEP 2133.03(e)(6). Choice (E) is correct, and choice (B) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 11 reads as follows:

11. Which of the following is true?

- (A) The differences between a continuation application and a continuation-in-part (C-I-P) application include: (1) new matter can be added when a C-I-P is filed and (2) the inventive entity in an original application and continuation application must be the same, whereas only one common inventor is necessary between an original application and a CIP application.
- (B) A reissue applicant's failure to timely file a divisional application is error and proper grounds for filing a reissue application.
- (C) A patent claiming a process is shown to be inoperative by showing no more than that it is possible to operate within the disclosure of the patent without obtaining the alleged product.

- (D) Where appeal to the Board of Patent Appeals and Interferences is dismissed for failure to argue a ground of rejection involving all the appealed claims, but allowed claimed remain in the application, the application becomes abandoned.
- (E) None of the above.

The model answer is choice (E). None of the listed statements is true.

Petitioner argues that choice (A) is the most correct answer. However, petitioner's comments appear to be directed to morning question 11, rather than afternoon question 11. Such comments are addressed above in regard to morning question 11.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (A) is not true because the inventive entity in an original application and continuation application do not have to be the same. Only one common inventor is required. See MPEP 201.07. Choice (A) is incorrect, and choice (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 37 reads as follows:

37. Today, April 12, 2000, is the last day of a three month shortened statutory period for reply to a non-final rejection over references under 35 U.S.C. § 103. Today, your client, located overseas, requests in a facsimile that you cancel all of the current claims in the application, and advises that a new set of claims to replace the current claims will be sent to you no later than April 29, 2000. There is no deposit account. The client pays all fees in a timely manner. In accordance with proper PTO practice and procedure, which of the following is the most appropriate course of action to take regarding the non-final rejection?

- (A) Await receipt of the new claims and necessary fees, and then file the amendment, request for reconsideration, and appropriate fee for an extension of time, no more than six months from the date of the non-final rejection.
- (B) File a request for a one month extension of time today and pay the fee when you file the amendment.
- (C) File an amendment today canceling all claims in accordance with your client's instructions.
- (D) File a request for reconsideration today, stating only that "[t]he rejection is in

error because the claims define a patentable invention.”

(E) File a request for reconsideration today, and state that a supplemental amendment will be forthcoming.

The model answer is choice (A). The most appropriate course of action to take regarding the non-final rejection is to await receipt of the new claims and necessary fees, and then file the amendment, request for reconsideration, and appropriate fee for an extension of time, no more than six months from the date of the non-final rejection.

Petitioner argues that choice (C) is the most correct answer. Petitioner argues that the clients instructions require the filing of an amendment today canceling all claims in accordance with your client’s instructions. Petitioner contends that while such a response is clearly non-responsive, it will be viewed as *bona fide*.

Petitioner’s arguments have been fully considered but they are not persuasive. Contrary to petitioner’s contention, the client did not give instructions to file the amendment today. Therefore, petitioner’s perceived conflict with professional responsibility does not exist in the statement of the question as set forth. Further, contrary to petitioner’s characterization, such an intentionally prepared and filed non-responsive paper is the antithesis of a *bona fide* response under 37 CFR 1.135(c). Such a filing would admittedly be filed for the purpose of delay rather than advancing prosecution. The proper action is to await receipt of the new claims and necessary fees, and then file the amendment, request for reconsideration, and appropriate fee for an extension of time, no more than six months from the date of the non-final rejection. Choice (A) is correct, and choice (C) is incorrect. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Which of the following may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999?

- (A) A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed.
- (B) A foreign patent, published March 3, 1998, which applicant referenced in the application when claiming foreign priority based on the foreign application date, and applicant submitted a certified copy of the original foreign application.
- (C) Applicant's statement in a declaration under 37 C.F.R. § 1.132 that although the invention as claimed had been offered for sale in department stores in New York during 1997, this was done only to analyze consumer acceptance of the packaging in which the invention is marketed.
- (D) A journal article, published May 1, 1997, disclosing all the elements of the claim and teaching how to make and use the claimed invention. The examiner used the article in combination with another journal article in a previous non-final Office action to reject the same claim under 35 U.S.C. § 103.
- (E) All of the above.

The model answer is choice (A). A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed, may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999. See MPEP 706.02(a).

Petitioner argues that choice (C) is the most correct answer. Petitioner appears to argue that even though applicant admitted in his affidavit that the product was offered for sale two years before his filing date, there was no evidence that actual sales took place. Petitioner appears to argue that choice (A) is incorrect because people necessarily read the article in preparation for its publication.

Petitioner's arguments have been fully considered but they are not persuasive. Contrary to

petitioner's contention, an "offer for sale" is enough for anticipation under 35 U.S.C. § 102(b). An actual "sale" is not required. See MPEP 2133.03(b) ("On Sale"). Applicant's affidavit states that the invention as claimed had been offered for sale more than a year prior to his filing date. Further, market testing is not an exception to a bar under 35 U.S.C. § 102(b). Note also that only the packaging was being market tested in the current case. Choice (C) is incorrect.

In regard to choice (A), the reference is only being considered under 35 U.S.C. § 102(b) as of its publication date, not as evidence that people read the material prior to publication. A journal article, published Saturday, May 2, 1998, disclosing all the claimed elements and fully teaching how to make and use the invention as claimed, may not be properly used as prior art for purposes of rejecting a claim under 35 U.S.C. § 102(b) in an application having an effective filing date of Monday, May 3, 1999. See MPEP 706.02(a). Choice (A) is correct, and choice (C) 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 3, 11, 22, 30, 34, 42 and 50, and afternoon questions 11, 37 and 41. 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 at 67. 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