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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 his answers to questions 16, 20 and 34 of the morning section and questions 12 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 66. On July 28, 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 points for morning questions 2, 20 and 44. Accordingly, petitioner has been granted additional three points on the Examination. However, no credit has been awarded for morning questions 16 and 34, nor afternoon questions 12 and 41. Petitioner's arguments for these questions are addressed individually below.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than ½ gigabyte of storage.

Which of the following statements is or are true about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice (E). Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

Petitioner argues that the most correct answer is choice (C). Petitioner argues that claim 9 is not supported in the specification and improper under the first paragraph of 35 U.S.C. 112.

Petitioner's arguments have been fully considered but they are not persuasive. Claims 9 and 10 are original claims in the application and constitute part of the original disclosure. Thus, they are self supporting, and satisfy the requirements of the first paragraph of 35 U.S.C. 112.

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 the most correct answer is choice (B). Petitioner argues that the published declassified material can not be applied as a "printed publication" under 35 U.S.C. 102(a) since it was not declassified until its publication after the filing date of the application.

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."

Afternoon question 12 reads as follows:

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

- (A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.
- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.
- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

The model answer is choice (E), which includes both (B) and (C). Both filing of an application listing both coinventors (choice (B)) and filing of a protest indicating coinventorship (choice (C)) are proper advice.

Petitioner argues that the most correct answer is choice (B). Petitioner argues that choice (C) is not proper advice because it does not specifically state that the service requirement should be satisfied when such a protest is filed, and that such a protest would constitute an accusation of fraud on the Patent Office.

Petitioner's arguments have been fully considered but they are not persuasive. In regard to the service requirement being satisfied, the advice to file a protest need not set forth all of the specific procedural steps such a filing should entail in order to be considered proper advice. In regard to the protest constituting an accusation of fraud on the Patent Office, such an assertion is of no consequence. The protest is based on the issue of coinventorship, and the requirement that a patent be applied for in the names of all of the joint inventors (see 35 U.S.C. 116 and 37 CFR 1.45), rather than an accusation of fraud on the Patent Office. Whether a failure to satisfy such requirement could potentially be viewed as a basis for fraud on the Patent Office would not prevent the consideration of the protest on the issue of whether the application lists the proper inventorship information. Further, note that even protests which are based upon charges of fraud on the Patent Office or inequitable conduct are still entered in the application file, but are not commented on by the examiner. Thus, even if the present protest was somehow viewed as constituting an accusation of fraud on the Patent Office, it would at least be entered into the application file, and thus make the challenge to the propriety of the listed inventorship of record in the application.

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 the most correct answer is choice (D). Petitioner admits that the journal article of choice (D) qualifies as prior art under 35 U.S.C. 102(b), but appears to argue that the avoidance of "piecemeal" examination (see MPEP 707.07(g)) would prevent application of the reference under 35 U.S.C. 102(b) after it has previously been applied to the same claim under 35 U.S.C. 103.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner admits that the journal article of choice (D) qualifies as prior art under 35 U.S.C. 102(b).

Whether it could have, or should have, been applied as a 102(b) reference in a previous Office action has no bearing on its proper application under 35 U.S.C. 102(b) at this point.

No error in grading has been shown as to morning questions 16 and 34, and afternoon questions 12 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, three points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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