

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re \_\_\_\_\_ )  
  )     Decision on  
  )     Petition for Review  
  )     Under 37 C.F.R. § 10.2(c)  
  )

**MEMORANDUM AND ORDER**

  (“petitioner”) seeks review of the decision of the Director of the Office of Enrollment and Discipline (“Director”) denying petitioner’s request for a waiver of the patent practitioner’s enrollment examination. The petition is denied.

**Background**

  On \_\_\_\_\_, petitioner began employment as a patent examiner at the Patent and Trademark Office (“PTO”) and held that position for approximately nine and one-half years. On \_\_\_\_\_ petitioner was notified by her supervisor, in a mid-fiscal year progress review, that her work was “unacceptable” in the following two performance areas: Production Goal Achievement and Workflow Management. Petitioner’s evaluations in these areas did not improve and on \_\_\_\_\_ her supervisor rated her performance in these areas for the rating period \_\_\_\_\_ as unacceptable. Petitioner’s performance in the primary performance element entitled “Patent Examining Functions” was also rated as unacceptable for this same rating period. With regard to Patent Examining Functions, petitioner’s final evaluation states:

In a total of 151 office actions, allowing for 10 clear errors. In FY had 12 clear errors, which is an error rate greater than [sic: than] 7%. (See Attachment).

Based upon these facts, and the criteria for evaluation of this element, the rating for this element is **UNACCEPTABLE**.

(Emphasis in original). The two-page attachment to this performance evaluation identifies nine patent applications containing petitioner's errors and specifically discusses these clear errors committed by her. The record does not indicate that petitioner has challenged this evaluation.

Shortly after this final evaluation, petitioner resigned from her patent examiner position. effective On , she applied, under 35 U.S.C. § 31 and 37 C.F.R. §§ 10.6 and 10.7, for registration to practice before the PTO in patent cases. To be registered, an applicant must show, *inter alia*, legal competence. 37 C.F.R. §§ 10.7(a)(2)(ii) and (b). In an attempt to make this showing, petitioner advised the Director of her more than four years as a patent examiner and requested the Director to waive the examination requirement under 37 C.F.R. § 10.7(b).

Pursuant to PTO procedure, the Director was informed of the above-discussed unacceptable final performance reviews concerning petitioner and, on June 11, 1998, denied petitioner's request for a waiver of the examination scheduled for August 26, 1998. Pursuant to 37 C.F.R. § 10.2(c), petitioner seeks review of the Director's denial.

#### Opinion

Pursuant to 35 U.S.C. § 31, the Commissioner of Patents and Trademarks:

may require [agents and attorneys], before being recognized as representatives of applicants or other persons, to show that they . . . are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or

prosecution of their applications or other business before the Office.

35 U.S.C. § 31 (emphasis added). Under this authority:

(a) No individual will be registered to practice before the Office unless he or she shall:

.....  
(2) Establish to the satisfaction of the Director that he or she is:

.....  
(ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants for patents valuable service.

37 C.F.R. § 10.7 (emphasis added). A candidate for registration may demonstrate the necessary legal qualifications by taking and passing the patent practitioner's enrollment examination.

37 C.F.R. § 10.7(b). This examination requirement "may" be waived for those who worked more than four years as a PTO patent examiner. Id.

As noted above, petitioner's last formal patent examiner performance review resulted in "unacceptable" ratings in all three of her performance areas for the period covering

. The final rating records for "Patent Examining Functions" state that she had "an error rate greater then [sic] 7%." The two-page attachment to the final rating shows that petitioner made patent prosecution errors in the following patent law substantive matters: new matter; application amendments; fee processing; information disclosure statements; written description; definiteness; obviousness; double patenting; and cancellation of claims. The record does not indicate that she challenged this evaluation or its specifics. Moreover, petitioner had been notified of performance difficulties at her mid-year review, but failed to remedy these deficiencies.

The Supreme Court has noted that "the drafting of the specification and claims of [a]

patent application . . . ‘constitute[s] one of the most difficult legal instruments to draw with accuracy.’” Sperry v. Florida ex rel. Florida Bar, 373 U.S. 379, 383, 137 USPQ 578, 580 (1963) (quoting Topliff v. Topliff, 145 U.S. 156, 171 (1892)). In addition, being a registered patent practitioner, and thereby representing applicants before the PTO in patent cases, is “a highly specialized and technical position designed to protect and assist the public.” Leeds v. Mosbacher, 732 F. Supp. 198, 203, 14 USPQ2d 1455, 1458 (D.D.C. 1990) (emphasis in original), aff’d mem., 918 F.2d 185 (Fed. Cir. 1990). In Leeds, the applicant for registration received an unsatisfactory rating in the performance of “Patent Examining Functions.” 732 F. Supp. at 202, 14 USPQ2d at 1458. In view of that rating, the courts upheld the decision of the Commissioner, and the Director, to not waive the patent practitioner’s examination requirement. 732 F. Supp. at 204, 14 USPQ2d at 1459.

As in Leeds, petitioner received an unacceptable rating in “Patent Examining Functions” at her last PTO rating in that performance element. Thus, for at least six months prior to and including \_\_\_\_\_ i.e., the ending date of her last rating period, she had not been adequately performing patent examining functions. Since that date, she has not shown that her patent prosecution skills improved from the unacceptable level. Instead, petitioner resigned as a patent examiner, effective \_\_\_\_\_ In sum, she has simply not shown satisfactory patent prosecution skills after the unacceptable ratings she received more than a year ago.

Accordingly, given the performance problems occurring prior to petitioner’s resignation and her failure to cure such problems, the Director was reasonable in requiring petitioner to prepare for, take, and pass the patent practitioner’s enrollment examination, prior to being registered to represent others before the PTO in patent cases. As noted above, drafting a patent

application “constitute[s] one of the most difficult legal instruments to draw with accuracy.” Sperry, 373 U.S. at 383, 137 USPQ at 580. See also Leeds, 732 F. Supp. at 203, 14 USPQ2d at 1458. The Director was fully within her discretion in deciding not to waive the patent practitioner’s examination requirement for petitioner. See Gager v. Ladd, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963) (“the primary responsibility for protection of the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents”) (quoting with approval Cupples v. Marzall, 101 F. Supp. 579, 583, 92 USPQ 169, 172 (D.D.C. 1952), aff’d, 204 F.2d 58, 97 USPQ 1 (D.C. Cir. 1953)).

While petitioner argues that, with regard to \_\_\_\_\_ caused her poor patent examination performance (Petition at 3), no evidence supports this statement.

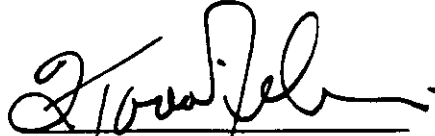
#### ORDER

Upon consideration of the petition to the Commissioner for a waiver of the patent practitioner’s enrollment examination, it is

ORDERED that the petition is denied, and it is

FURTHER ORDERED that petitioner may apply for admission to the April 21, 1999, patent practitioner's enrollment examination within one month after the date of this decision without the need to show good cause for a delay in applying.

JAN 14 1999



Q. TODD DICKINSON  
Acting Assistant Secretary of Commerce  
and Acting Commissioner of Patents and Trademarks

Date Recorded:

JAN 28 1999