



submitting an official, original transcript from a college or university. The Bulletin listed three categories that suffice to show sufficient training. Category A accepts a bachelor's degree in any of the thirty-one (31) listed technical fields. Category B provides for persons having a bachelor's degree in a non-technical field to show that they have accumulated sufficient course work to satisfy one of four different listed "options." Category C provides that persons who do not qualify under Category A or B, can show the requisite training with a passing grade on the "Fundamentals of Engineering" test administered by any State Board of Engineering Examiners. The Bulletin set a July 6, 2001, deadline for filing an application to take the October 17, 2001, exam.

On May 4, 2001, Petitioner filed an application to take the October 17, 2001, exam. The application indicated that Petitioner's bachelor's degree is in philosophy, which does not meet the Category A requirement. Petitioner did not allege a passing grade on the Category C "Fundamentals of Engineering" test. Petitioner provided new transcripts for more recent academic work.

On June 26, 2001, an OED Enrollment Administrator sent Petitioner a "Notice of Denial of Admission." The Notice informed Petitioner that she did not qualify under Category B, Option 2 or Option 4. Specifically, the Administrator indicated that Petitioner has not completed 8 semester hours of either chemistry with a lab, or physics with a lab. The Administrator stated that Petitioner's creditable hours under Option 2 total  $16 \frac{2}{3}$ , which is less than the 32 hours specified for Option 2. The Administrator also stated that Petitioner's creditable hours under Option 4 total 26, which is short of the 40 hours specified for Option 4. Thus, the Administrator determined that Petitioner did not qualify for admission to the exam.

On August 1, 2001, Petitioner requested the Director of OED to decide her application. Petitioner argued that the Administrator erred in (1) computing the number of credits, (2) overlooking a qualifying course, and (3) assessing a physics course.

On August 30, 2001, the Director of OED responded to Petitioner's request. The Director of OED considered each of Petitioner's arguments and agreed with her that the evidence showed satisfaction of the 8 semester hours in physics requirement. However, Petitioner's other arguments were rejected by the Director of OED.

On September 15, 2001, Petitioner submitted a follow-up letter with attachments relating to physics courses. On September 25, 2001, Petitioner sent an updated set of course descriptions and a change of address request.

The present petition followed on October 5, 2001. Petitioner argues that she has met the requirements under Category B, Option 2. Pertinent excerpts from Category B follow:

#### **CATEGORY B.**

**Bachelor's Degree in Another Subject:** An applicant with a Bachelor's degree in a subject other than one of those listed in Category A, must establish that he or she possesses scientific and technical training equivalent to that received at an accredited U.S. college or university for a Bachelor's degree in one of the subjects listed in Category A. To establish such equivalence, an applicant can satisfy one of the four options, other training, or other education listed below. The applicant must submit the necessary documentation and objective evidence showing satisfaction of one of the options or other means of qualifying.

\* \* \*

**Option 2:** 32 hours in a combination consisting of the following:

- 8 semester hours of chemistry or 8 semester hours of physics, and
- 24 semester hours in biology, botany, microbiology, or molecular biology.

The 8 semester hours in chemistry or 8 semester hours of physics must be obtained in two sequential semesters, each semester including a lab. Only courses for science or engineering majors will be accepted.

\* \* \*

**Typical Non-Acceptable Course Work:** The following typify courses which are not accepted as demonstrating the necessary scientific and technical training: anthropology, . . . ,

ecology, . . . . Also not accepted are . . . courses which do not provide scientific and technical training in patentable subject matter.

\* \* \* \* \*

### OPINION

The Director of the USPTO has statutory authority to require persons representing other parties before the USPTO 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 before the USPTO. The statutes relating to the character and conduct of agents, attorneys, and other persons representing applicants for patents before the Office “represent[] congressional policy in an important field.” *Kingsland v. Dorsey*, 338 U.S. 318, 319 (1949). “[T]he Commissioner has the discretionary authority to regulate the practice of patent agents before the PTO.” *Premysler v. Lehman*, 71 F.3d 387, 389, 37 U.S.P.Q.2d (BNA) 1057, 1059 (Fed. Cir. 1995).

The statute assigning powers and duties to the Office, 35 U.S.C. § 2(b)(2)(D), states, in part:

(b) Specific Powers-- The Office . . .  
(2) may establish regulations, not inconsistent with law, which . . .  
(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, 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 before the Office. (Emphasis added).

Pursuant to this authority, the USPTO promulgated 37 C.F.R. § 10.5 which established a register of attorneys and agents entitled to represent patent applicants before the Office. An individual seeking registration must “[a]pply to the Commissioner.” 37 C.F.R. § 10.7(a)(1). The individual must then establish to the satisfaction of the Director of OED that the individual

has sufficient legal, scientific and technical qualifications to render valuable service to patent applicants. 37 C.F.R. § 10.7(b). *Sperry v. Florida*, 373 U.S. 379 (1963) (reaffirming right of PTO to require special technical and other qualifications of its practitioners); *Gager v. Ladd*, 212 F.Supp. 671, 673, 136 U.S.P.Q. (BNA) 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 U.S.P.Q. (BNA) 169, 172 (D.D.C. 1952), *aff’d*, 204 F.2d 58, 97 USPQ 1 (D.C. Cir. 1953)). Representing patent applicants before the USPTO is “a highly specialized and technical position *designed to protect and assist the public.*” *Leeds v. Mosbacher*, 732 F. Supp. 198, 203, 14 U.S.P.Q.2d (BNA) 1455, 1458 (D.D.C.) (emphasis in original), *aff’d mem.*, 918 F.2d 185 (Fed. Cir. 1990).

The Director of OED found that Petitioner satisfied the requirement for 8 semester hours of physics with a lab, but that Petitioner did not meet all the requirements for Option 2. More specifically, the Director of OED found that Petitioner has  $16\frac{2}{3}$  semester hours in biology rather than the 24 required. Petitioner maintains that 3 semester hours in Tropical Ecology ) and 8 semester hours in Organic Chemistry should also be counted in the biology total.

#### The Tropical Ecology Course

The Director’s decision not to count the hours in Tropical Ecology is consistent with the Bulletin. For a number of years the Bulletin has listed ecology among courses which are typically not accepted as demonstrating the necessary scientific and technical training. *See* Bulletin at 5, “Typical Non-Acceptable Course Work.” Candidates for the registration exam have thus been on notice that ecology is typically not accepted. Similarly, the Bulletin has given

notice that courses which do not provide scientific and technical training in patentable subject matter are not typically accepted. *Id.*

The description of Biology Tropical Ecology, in the University of course description bulletin that Petitioner provided reads:

A survey of the distinctive biological characteristics of tropical rain forests. The evolutionary forces thought to be responsible for creating and maintaining these extremely diverse communities will be explored. The impact of anthropogenic forces on these biomes, possible consequences for future generations, and improved management strategies designed to curtail their demise will also be examined.

The course description emphasizes studying natural phenomena, and the Director of OED found no evidence that it provides training in patentable subject matter. The decision of the Director of OED is consistent with the goals of 37 C.F.R. § 10.7 and the interpretive instructions in the Bulletin. *Premysler*, 71 F.3d at 387-89, 37 U.S.P.Q.2d (BNA) at 1059 (the Bulletin interprets 37 C.F.R. § 10.7(a)(ii)). The standard is definite, fair, objective, and the Director did not err when he relied upon it. *Gager*, 212 F.Supp. at 673, 136 U.S.P.Q. (BNA) at 628. *Accord Saxbe v. Bustos*, 419 U.S. 65, 74 (1974) (“[a] longstanding administrative construction is entitled to great weight”).

Petitioner argues that because patent applications for inventions that materially enhance the quality of the environment can receive accelerated examination, it follows that a course on such subject matter provides training in patentable subject matter. *See* 37 C.F.R. § 1.102(c) (an invention that will materially advance the quality of the environment may be advanced for examination out of turn). However, the course description for Tropical Ecology does not say the course concerns inventions that materially enhance the quality of the environment.

Similarly, Petitioner describes the course as providing “training in creating and maintaining tropical rain forests” and being relevant to “better utilization of energy resources.”

The course description does not include any mention of creating rain forests or using energy resources. Instead, the description says “[t]he impact of anthropogenic forces on these biomes, possible consequences for future generations, and improved management strategies designed to curtail their demise will also be examined.” Thus, the course focuses on examining “the impact of anthropogenic forces.” There is no objective evidence that “management strategies” includes any training in patentable subject matter.

Petitioner urges that a distinction between botany and ecology is semantic, and that since Tropical Ecology is a “survey of the biological characteristics of tropical rain forests,” much of it was devoted to the study of tropical plants. First, the distinction between botany and ecology is substantive, not semantic. A degree in botany is accepted under Category A of the Bulletin, and may provide training in the subject matter of plant patents issued under § 161 or utility patents involving botanical materials. Second, the course description for Tropical Ecology does not mention plants and there is no objective evidence that the course provided training in patentable subject matter in botany.

While Petitioner’s explanation of the course content is more detailed than the University’s course description, the Director of OED did not have any objective evidence concerning this supplemental information. The Director’s decision to rely on the University course description evidence was reasonable and will not be overruled.

#### The Organic Chemistry Courses

The Director of OED did not count Petitioner’s 8 hours of Organic Chemistry in the biology category. Petitioner reads the July 28, 2000, letter from OED to indicate that the organic chemistry would be counted toward the biology requirement. The Director of OED says the letter indicated only that OED accepted organic chemistry as acceptable scientific and technical

training, but that Petitioner's total 18 hours did not meet the 32 hours required under Option 2. Thus, Petitioner misread the July 28, 2000, letter to say more than it does.

Petitioner also misconstrues another part of the July 28, 2000, letter. Mr. Hanson of OED wrote: "[t]he transcripts submitted do not show you have completed the 8 requisite semester hours of chemistry or physics with a lab." Petitioner writes: "[t]he last quoted sentence makes clear that Mr. Hanson does not view the organic chemistry courses as counting towards the eight semester hours of chemistry or physics with a lab, since he states the transcripts do not show this requirement has been met. The organic chemistry credits must, therefore, be countable under the biology requirement." This is an unreasonable interpretation.

The goal is 32 semester hours, including 24 hours of biology. Organic chemistry courses that do not include a lab can count "toward" the 8-hour chemistry total if an applicant can show evidence of associated lab work. The Hanson letter correctly stated that the requirement had not been met. There is no need to interpret Mr. Hanson's statement to mean that chemistry is biology. Further, the course descriptions provided do not evidence that the University of Cincinnati considers that organic chemistry is biology. Contrary to Petitioner's view, Petitioner's interpretation is not "the plain interpretation" of the Hanson letter.

Petitioner argues that "organic chemistry is a required part of acquiring a Bachelor's degree in biology, a qualifying credential to take the Patent Bar Exam" and that "Category B, Option 2 is an equivalent to such a biology degree." Petitioner then states "[i]t is illogical that the very courses required for the qualifying degree are 'uncountable' when taken by a non-matriculating student." Assuming Petitioner's premise that organic chemistry is a required part of acquiring a Bachelor's degree in biology, it does not follow that colleges or the USPTO should "count" organic chemistry as biology. Petitioner's credits have been reviewed, and



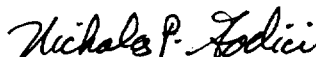
Petitioner's physics courses with lab satisfy the requirement for 8 hours of chemistry or physics with a lab. However, Petitioner's total course work is not equivalent to a Bachelor's degree in biology because petitioner has insufficient credits in biology.

### **CONCLUSION**

The Director of the USPTO has the responsibility to protect the public from unqualified patent practitioners. A person wishing to take the patent practitioner registration exam has the burden of showing that he or she has the scientific and technical qualifications necessary to render valuable service to applicants for patents. Petitioner has not yet shown the minimum equivalence to a Bachelor's degree in a technical field and needs only a few courses to complete the required showing. Petitioner may take additional courses or training and present the transcripts for evaluation in an application to sit for a future exam.

### **ORDER**

Upon consideration of the petition for review to the Director, it is ORDERED that the petition is denied.



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