

BEFORE THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

HARRY I. MOATZ)

Director, Office of)
Enrollment and Discipline,)

v.)

Respondent.)

Decision on Petition
Under 37 C.F.R. § 11.2(d)

Memorandum and Decision Upon Appeal

Respondent, appeals the Decision on Petition disapproving his request to sit for the registration examination. For the reasons stated below, the decision is affirmed.

Background

On May 31, 2006, Respondent submitted an *Application for Registration to Practice Before the United States Patent and Trademark Office*. By letter dated July 11, 2006, the Office of Enrollment and Discipline (OED) informed Respondent that his application was incomplete and specified what additional information was required. Respondent provided additional information by facsimile on August 10, 2006. OED evaluated the application in light of the supplemental information and again informed Respondent that he had not submitted sufficient information to qualify to sit for the examination under any of Categories A, B, or C, and had until September 9, 2006, to file any additional information.

Respondent provided additional written submissions on August 20 and 27, 2006, and on September 4, 2006. OED evaluated the application in light of all information submitted and, in a letter dated September 11, 2006, informed Respondent that he had not demonstrated qualification for admission to the examination and that the time period for doing so had expired.

In Respondent's September 4, 2006, letter, he had timely (although prematurely) also petitioned for review of the OED decision under 37 C.F.R. § 11.2(c) and had paid the applicable fee under 37 C.F.R. § 1.21(a)(5)(ii). On November 9, 2006, the Director of OED made his Decision on Petition by the Respondent, disapproving Respondent's request to sit for the registration examination. The Director found that Respondent had not established his qualifications as required by 37 C.F.R. § 11.7(a)(2) and as stated in the *USPTO General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office* (issued in June 2004, as updated in November 2005) (*General Requirements*). The *General Requirements* is published by USPTO to provide information and requirements to, in part, describe criteria that are generally sufficient to establish scientific and technical competence for admission to the examination. *See Premysler v. Lehman*, 71 F.3d 387, 388 (Fed. Cir. 1995). The *General Requirements* provides that a petitioner may demonstrate the required competence by meeting the criteria of either Category A, B or C. *General Requirements* at 4-8. The Director of OED found that Respondent had not met the requirements for the following reasons:

Category A requires a Bachelor's Degree in one of 32 recognized scientific or technical subjects. *General Requirements* at 4. The OED Director found that Respondent's degree was not in a recognized subject.

Category B requires demonstrated scientific and technical training equivalent to that required by Category A by meeting the criteria of one of four Options. Specifically, under Option 1 and Option 3, respectively, a petitioner must demonstrate that he or she had earned 24 semester hours in physics or 30 semester hours in chemistry. *General Requirements* at 5. Respondent had demonstrated neither. Under Option 2, a petitioner must demonstrate that he or she had earned a total of 32 semester hours consisting of 24 semester hours in biology, botany, microbiology, or molecular biology, and eight semester hours in chemistry (two sequential semesters each semester including a lab) or eight semester hours in physics (two sequential semesters each semester including a lab). *Id.* The OED Director found that Respondent had not demonstrated the required semester hours. Under Option 4, a petitioner must demonstrate that he or she had earned a total of 40 semester hours consisting of eight semester hours in chemistry or physics (two sequential semesters each semester including a lab) and 32 semester hours of chemistry, physics, biology, botany, microbiology, molecular biology, or engineering. *Id.* The OED Director found that Respondent had not demonstrated the required semester hours.

Category C requires that, to rely on practical engineering or scientific experience, a petitioner must take and pass the Fundamentals of Engineering examination. *General Requirements* at 8. The OED Director found that Respondent had submitted no evidence that he had taken and passed that examination.

The Respondent then filed a petition to the USPTO Director, by letter dated January 16, 2007, for review of the OED Director's final decision.¹ In his petition, Respondent did not challenge the OED Director's determinations under Categories A, B or C but, instead, requested that he be permitted to take the additional courses required to qualify under Category B subsequent to his admission to the registration examination.

Legal Standards

Title 35 of the United States Code, section 2(b)(2)(D), states in pertinent part:

[The USPTO] may require [agents, attorneys, or other persons representing applicants or other parties before the USPTO], 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.

In accordance with the statute, and to provide requirements to demonstrate such qualifications, the USPTO Director promulgated 37 C.F.R. § 11.7(a)(2)(ii), which states in pertinent part:

(a) No individual will be registered to practice before the Office unless

he or she has:

(2) Established to the satisfaction of the OED Director that he or

she:

(ii) Possesses the . . . scientific, and technical qualifications necessary for him or her to render applicants valuable service . . .

¹ A minor error in the OED Director's Decision on Petition, section IV, merits correction herein for accuracy. The decision states that a petition for review may be filed pursuant to 37 C.F.R. § 10.2(c), although the correct citation should read 37 C.F.R. § 11.2(d). This clerical error had no effect on Respondent.

Petitioners have the burden to prove they have the necessary qualifications. 35 U.S.C. § 2(b)(2)(D); 37 C.F.R. § 11.7(b)(1)(i)(C); *General Requirements* at 4 (“*Applicants bear the burden of showing the requisite scientific and technical training.*” (italics in original)). Petitioners must submit a complete application for registration which includes “[s]atisfactory proof of scientific and technical qualifications.” 17 C.F.R. § 11.7(b)(1)(i)(C). Finally, “[a]n individual failing to file a complete application for registration will not be admitted to the examination and will be notified of the incompleteness.” 17 C.F.R. § 11.7(b)(2).

Applications are initially evaluated by OED staff and, at the applicant’s request, are reviewable by the OED Director. 37 C.F.R. § 11.2(c). An individual dissatisfied with the final decision of the OED Director may petition the USPTO Director for review. 37 C.F.R. § 11.2(d). The USPTO Director will consider no new evidence in deciding a petition for review. *Id.*

Decision

Respondent’s arguments warrant little additional discussion. Respondent must qualify under Category A, B, or C, as specifically provided in the *General Requirements*, and bears the burden of proving his qualifications. He has not done so. Under Category A, a petitioner may qualify by his or her receipt of a Bachelor’s Degree in a specific recognized subject. Those subjects are listed in the *General Requirements* and include a variety of scientific and engineering areas. Respondent, however, has a Bachelor of Science degree in Government which is not a recognized subject. The OED Director correctly found that Respondent does not have the technical degree required.

In order to qualify under Category B, a petitioner must establish to the satisfaction of the OED Director that he or she possesses scientific and technical training equivalent to that required in Category A. *General Requirements* at 5. The petitioner may do this by meeting the requirements of either Option 1, 2, 3 or 4 of Category B. Respondent has not asserted, nor do the records he provided demonstrate, that he meets the requirements of Option 1 or 3. Option 2 requires that a petitioner demonstrate a total of 32 semester hours in a combination consisting of eight semester hours in chemistry or physics, and 24 semester hours in biology, botany, microbiology or molecular biology. *Id.* The OED Director, after review of the coursework Respondent alleges qualify him under Option 2, correctly found that he demonstrated that he had, at most, 24 semester hours in required coursework but not the additional eight semester hours in specific chemistry or physics, as is required under Option 2.² Option 4 requires that a petitioner demonstrate a total of 40 semester hours consisting of eight semester hours in either specific chemistry or physics courses, plus 32 semester hours in chemistry, physics, biology, botany, microbiology, molecular biology or engineering. Following a review of Respondent's coursework, the OED Director correctly found that Respondent had not shown that his chemistry coursework satisfied the requirement that the eight semester hours consist of two sequential courses each with a lab. The OED Director further correctly found that, at most, Respondent had demonstrated only a total of 16 semester hours of the 32 semester hours of required courses.

² Respondent, in his January 16, 2007, letter to the OED Director did not dispute the Director's conclusion that he did not possess the necessary qualifications and suggests only that he be permitted to take the examination prior to completing the additional eight credit hours. A promise of the subsequent completion of requirements does not constitute the satisfactory proof of scientific and technical qualifications required for admission to the examination. 37 C.F.R. § 11.7(b)(1)(i)(C); (b)(2),

Finally, under Category C a petitioner may qualify with practical engineering or scientific experience as demonstrated by a passing grade on the Fundamentals of Engineering test. *General Requirements* at 8. The OED Director correctly found that Respondent submitted no documentation demonstrating successful completion of this test.

Conclusion

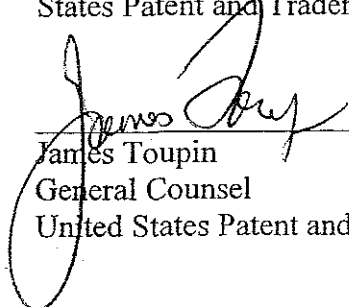
The OED Director properly determined that Respondent did not establish that he possesses the requisite technical and scientific qualifications for admission to the examination. The Director's conclusion was based upon documentation of record and is supported by that record.

Order

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

On behalf of the Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office:

July 2, 2007
Date


James Toupin
General Counsel
United States Patent and Trademark Office

cc:

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