

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

In re: _____

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) Decision on Petition for Review
) Under 37 C.F.R. § 11.2(d)
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MEMORANDUM AND ORDER

(Petitioner) seeks review of the December 5, 2008, final decision by the Director of the Office of Enrollment and Discipline (OED) of the United States Patent and Trademark Office (USPTO or Office) under 37 C.F.R. § 11.2(d). The OED Director's decision denied Petitioner's request for reconsideration of an OED staff action finding that Petitioner has not demonstrated that he possesses the requisite scientific and technical training under 37 C.F.R. § 11.7(a)(2)(ii), and denying his request for a waiver of those requirements under 37 C.F.R. § 11.3. For the reasons stated below, the Petition for Review (PFR) is **DENIED**, and the OED Director's decision is **AFFIRMED**.

I. BACKGROUND

On June 2, 2008, Petitioner applied to take the registration exam. With his application, Petitioner also filed a Request for Waiver¹ under 37 C.F.R. § 11.3, in which he requested that the scientific and technical qualifications requirements set forth in Section III of the USPTO's General Requirements Bulletin (Bulletin) be waived.

Petitioner also submitted a letter, in which a registered patent attorney (Practitioner)

¹ Petitioner's June 2, 2008, filing was styled Petition to the Director to Waive the Rules Under 37 C.F.R. § 11.3 Regarding the Scientific and Technical Training Requirements for Admission to the Patent Agents Exam. However, for brevity, this filing is referenced herein as a "Request for Waiver."

opined that Petitioner “possesses the necessary qualifications to render applicants or other persons valuable service” In his request, Petitioner admitted that he lacks both “the academic record that would automatically meet the technical requirements as stated in the General Requirements Bulletin” and the “formal training necessary to establish competence as an engineer or scientist.” Request for Waiver at 3. Nevertheless, Petitioner argued that he is competent to provide “valuable service” to patent applicants because of his 19 years of experience as a prior art searcher. *Id.* at 6-9.

On June 24, 2008, OED notified Petitioner that his application was denied because he did not demonstrate that he possessed the required scientific and technical competence under 37 C.F.R. § 11.7(a)(2)(ii) and the Bulletin. The notice did not address Petitioner’s request for a waiver of the scientific and technical requirements.² The notice gave Petitioner until August 23, 2008, to file additional information. Petitioner filed additional information on August 6, 2008, in which he again acknowledged that he lacks the requisite scientific and technical qualifications outlined in the Bulletin, but again requested that the requirements be waived in view of his experience as a prior art searcher. *See* Petitioner’s August 6, 2008, Letter at 2-3.

An OED staff attorney issued an initial decision on October 6, 2008, denying Petitioner’s request to waive the scientific and technical requirements and finding that Petitioner has not demonstrated that he meets the requisite scientific and technical requirements based on his experience as a prior art searcher. The staff attorney found

² The only waiver issue that the notice addressed was a “request under 37 C.F.R. § 11.3 that the OED Director waive the requirements that [Petitioner] receive and respond to a decision of the OED staff” Notice at 3. A review of the record, however, does not demonstrate that Petitioner ever sought such a waiver. Indeed, Petitioner’s letter, submitted on August 6, 2008, points out that “[a]t no time did applicant request the Director of OED to waive the rules regarding applicant’s need to respond to OED requirements.” Petitioner’s August 6, 2008, Letter at 1.

that Petitioner did not qualify under Category A of the Bulletin because he does not have a Bachelor's degree in one of the 32 subjects listed in that category. The staff attorney also determined that Petitioner did not have any classes that met the requirements of Category B, sections (i)-(iv).

The staff attorney assessed Petitioner's experience as a prior art searcher under Category B, sections (xii) and (xiii) of the Bulletin, which allow the USPTO to consider other factors and other education, such as life experience, "on a case-by-case basis with respect to scientific and technical training" to determine whether an applicant has "sufficient training and expertise in science and engineering to be equivalent to that of a Bachelor's degree in a subject listed in Category A." Initial Decision at 3. The staff attorney found that Petitioner failed to submit "any objective evidence" demonstrating that his training was "equivalent to training received in courses accepted under Category A or that an accredited college or university" had given him credit for his experience as a prior art searcher. *Id.* Therefore, the staff attorney concluded that Petitioner failed to demonstrate that he possessed the requisite scientific and technical qualifications necessary to render applicants valuable service, consistent with the regulation and Bulletin. Finally, the staff attorney found that Petitioner did not qualify under Category C because he did not present any evidence that he has taken and passed the Fundamentals of Engineering test.

Petitioner appealed the initial decision to the OED Director on October 24, 2008, arguing that the initial decision "fail[ed] to address all questions raised by the applicant . . ." Initial Decision Appeal at 1. In his appeal, Petitioner again admitted that he "does not have the academic background that would qualify under the rules" but insisted that

his “atypical qualifications . . . fit within the parameters established by the Regulation and the Statute.” *Id.* The OED Director denied the appeal on December 5, 2008. In his decision, the OED Director conducted an independent review of Petitioner’s qualifications as a prior art searcher. He explained that “[a]pplicants without a technical degree have a ‘high burden to show sufficient expertise and professionalism in science and/or engineering.’” OED Director’s Decision at 4 (citing *Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1995)). The OED Director also acknowledged that the Bulletin’s requirements are not dispositive, and that the Director of the USPTO has discretion to determine whether an applicant has sufficient technical expertise to sit for the registration examination, based on all the evidence of record. *See id.* at 5 (citing *Premysler*).

In conducting his independent review of Petitioner’s qualifications, the OED Director found, consistent with the staff attorney’s findings and Petitioner’s admissions, that Petitioner did not qualify under Category A, B, or C of the Bulletin. The OED Director found that Petitioner’s experience as a prior art searcher was insufficient to demonstrate that he possessed the requisite technical expertise because “[t]here are no educational, training, or licensing requirements necessary to become a prior art searcher.” *Id.* Furthermore, the OED Director found that Petitioner failed to offer “any objective evidence that he is actually capable of technically analyzing a prior art reference in the same way as a scientist or engineer” or that he “has the length and breadth of training that a person would receive for a [B]achelor’s degree in one of the subjects listed in Category A.” *Id.* at 6-7. In this regard, the OED Director found Petitioner’s experience searching “across multiple unrelated technologies” unpersuasive, explaining that “an applicant

should have core competencies within well defined and clearly identified technologies . . .” *Id.* at 7 (quoting Petitioner’s Request for Waiver at 6). The OED Director gave “no credence or weight to [Petitioner’s] assertions that he routinely analyzes and interprets patent claims for patentability, infringement and validity purposes[,]” because they did not demonstrate “scientific and technical training.” *Id.* at 8.

The OED Director considered, but rejected, the Practitioner’s letter, submitted with Petitioner’s initial application, because it did not show that Petitioner’s scientific and technical training is equivalent to that required for a Bachelor’s degree in any of the subjects listed in Category A. *See id.* Finally, the OED Director denied Petitioner’s request for a waiver of the scientific and technical training requirements, under 37 C.F.R. § 11.3, because he found that Petitioner failed to meet his burden to show that his circumstances amount to “an extraordinary situation” in which “justice requires” a waiver of the regulations. *Id.* at 10.

Petitioner filed a timely PFR of the OED Director’s Decision on December 22, 2008. For the reasons set forth below, the PFR is **DENIED**.

II. LEGAL STANDARDS

The Director of the USPTO is given statutory authority to require a showing by patent practitioners that they are “possessed of the necessary qualifications to render 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. § 2(b)(2)(D). Thus, the primary responsibility for protection of the public from unqualified practitioners before the USPTO rests with the Director of the USPTO. *See Leeds v. Mosbacher*, 732 F. Supp. 198, 200 (D.D.C. 1990) (*Leeds*). Consistent with this

authority and responsibility, USPTO regulations provide that applicants for registration to practice before the USPTO must take and pass an examination administered pursuant to 37 C.F.R. § 11.7(b). Among other things, applicants for the exam must provide satisfactory proof of their scientific and technical qualifications that enable them to render patent applicants valuable service. *See* 37 C.F.R. §§ 11.7(a)(2)(ii) and (b)(1)(i)(C).

Section III of the Bulletin sets forth the kinds of credentials that typically demonstrate the requisite scientific and technical qualifications. The Bulletin provides three categories (A, B, and C) by which an applicant may establish that he or she meets the requirements of 37 C.F.R. § 11.7(a)(2)(ii).³ If an applicant does not qualify under any of these three categories, the USPTO conducts an independent review for compliance with the scientific and technical training requirements set forth in 37 C.F.R. § 11.7(a)(2)(ii). *See Premysler*, 71 F.3d at 390 (upholding USPTO Director's decision denying admission to the examination, based on an independent review of the applicant's experience). Applicants bear the burden of showing the requisite scientific and technical training. *See* Bulletin at 4. In an extraordinary situation, when justice requires, any requirement of the regulations, which is not a requirement of statute, may be suspended or waived by the Director of the USPTO. *See* 37 C.F.R. § 11.3.

OED staff members initially evaluate applications for registration. At the applicant's request, the staff members' decisions are reviewable by the OED Director. *See* 37 C.F.R. § 11.2(c). An individual dissatisfied with the final decision of the OED

³ Under Category A, an applicant must have a Bachelor's degree in one of the recognized technical subjects listed therein. *See* Bulletin at 4. Under Categories B and C, an applicant must have a Bachelor's degree in another subject. However, under Category B, an applicant also must have scientific and technical training equivalent to a Bachelor's degree in one of the subjects listed in Category A. Under Category C, the applicant also must have passed the Fundamentals of Engineering test.

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.*

III. ANALYSIS

Petitioner bears the burden of proving that he possesses the required scientific and technical competence under 37 C.F.R. § 11.7(a)(2)(ii). Petitioner may meet this burden by proving that he has satisfied the requirements under Category A, B, or C of the Bulletin. Petitioner, as he admits, does not meet the requirements of either of these categories. Rather, Petitioner urges that the scientific and technical requirements set forth in the Bulletin should be waived, and the USPTO Director should instead determine that he possesses the scientific and technical qualifications necessary to render “valuable service” to patent applicants, within the meaning of 37 C.F.R. § 11.7(a)(2)(ii), based on his experience as a prior art searcher. PFR at 2.

The regulation permits waiver of non-statutory, regulatory requirements only in “an extraordinary situation, when justice requires” 37 C.F.R. § 11.3. However, Petitioner has not established that an extraordinary situation warrants a waiver of the scientific and technical requirements of the Bulletin in his case. He has not demonstrated that he possesses the scientific and technical qualifications necessary to render “valuable service” to patent applicants, within the meaning of the 37 C.F.R. § 11.7(a)(2)(ii). While the regulation does not specifically define “valuable service,” it is clear that valuable service encompasses a certain level of expertise within a scientific and technical field to enable a practitioner before the Office to prepare and prosecute patent applications and draft specifications or claims of patent applications, among other things. As such, Petitioner has the burden of proving that his experience as a prior art searcher has

equipped him scientifically and technically to enable him to provide these valuable services to patent applicants. *See* 37 C.F.R. § 11.7(b)(1)(i)(C). For the following reasons, Petitioner's explanation of his experience as a prior art searcher and other evidence are insufficient to meet his burden of proof.

Petitioner disputes the OED Director's conclusion that he failed to provide "any objective evidence that he is actually capable of technically analyzing a prior art reference in the same way as a scientist or engineer[.]" and Petitioner argues that the OED Director dismissed his "patent based skills" and expressed "only a rudimentary understanding of the prior art activity." Appeal at 2-3. Nevertheless, Petitioner points to no evidence that the OED Director failed to consider or fully appreciate in reaching his conclusion. Moreover, Petitioner asserts that "[t]his is not the proper venue for a discussion on the activities and work product of the prior art specialist[.]" *Id.* By declining to enter into such a discussion, Petitioner declines to elaborate on his experience as a prior art searcher in any meaningful way that might provide objective evidence of his scientific and technical qualifications. Instead, Petitioner retorts that "the analyst better provide technical material that addresses the legal questions or the analyst will fail" and again reiterates that "this is not the proper venue" for further elaboration on this issue. *Id.* at 3. As a result, Petitioner does not seek to establish that his experience in any technical area might have built up the kind of expertise that would be the equivalent of the background that qualifies applicants through formal education. Petitioner has, in effect, declined to attempt to present objective evidence that would substantiate his claim of scientific and technical qualifications.

Petitioner also claims the OED Director did not give proper consideration to the Practitioner's letter, which he submitted with his application. However, the OED Director fully considered the practitioner's letter and correctly found that it did not provide objective evidence that Petitioner possesses the requisite scientific and technical qualifications within the meaning of 37 C.F.R. § 11.7(a)(2)(ii). The Practitioner's letter does not provide any objective evidence of Petitioner's scientific and technical qualifications. Rather, in a conclusory fashion, the Practitioner states that Petitioner has an understanding of mechanical technologies "because only by doing so could he have discovered the highly pertinent prior art or other technical information that often resulted from his search efforts." Practitioner's Letter at ¶ 2. Longstanding legal precedent demonstrates that an applicant without scientific and technical qualifications must establish that he or she possesses more than "mere patent searching" experience in order to demonstrate that he or she is qualified to sit for the examination. *Gager v. Ladd*, 212 F.Supp 671, 673 (1963) (upholding denial of admission to the exam where applicant's primary experience was patent searching and not preparation and prosecution of patent applications). This decision need not reach the question of whether or how evidence about the knowledge that a patent searcher may have acquired might demonstrate that he possesses the scientific and technical knowledge to independently prepare and prosecute patent applications and draft specifications or claims of patent applications. The Practitioner's letter provides no objective evidence that he can independently perform these tasks. Rather, with respect to preparing and prosecuting patent applications, the Practitioner states that he would "personally rank" Petitioner's technical knowledge "with at least some persons I have known holding a bachelor's degree in mechanical

engineering.” *Id.* at ¶ 3. The Practitioner gives no information about his own scientific and technical background to qualify his opinion or the background of others holding a bachelor’s degree to whom he compares Petitioner. This information is insufficient to show that Petitioner possesses the requisite scientific and technical qualifications necessary to provide valuable service, within the meaning of 37 C.F.R. § 11.7(a)(2)(ii). Consequently, Petitioner again has failed to establish an extraordinary situation in which justice requires waiving the Bulletin’s requirements.

IV. CONCLUSION

The OED Director’s Decision correctly determined that Petitioner failed to demonstrate that he possesses the required scientific and technical qualifications to provide valuable service to patent applicants, within the meaning of 37 C.F.R. §§ 11.7 (a)(2)(ii) and (b)(1)(i)(C). Accordingly, the OED Director properly denied his petition for admission. Petitioner has failed to demonstrate an extraordinary situation in which justice requires a waiver of the Bulletin’s requirements. Therefore, Petitioner’s request for a waiver under 37 C.F.R. § 11.3 is denied.

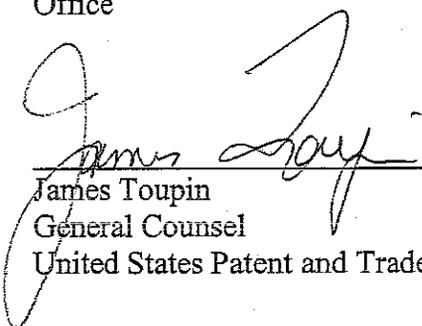
ORDER

Upon consideration of the Petitioner's PFR of the OED Director's Decision under 37 CFR § 11.2(d), it is **ORDERED** that the Petitioner's Request is **DENIED**.

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

APR 30 2009

Date


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