



worker status for Petitioner. The approval notice indicated that it was valid from August 5, 2008, to August 4, 2010. The approval notice also indicated that upon being granted L-1B status, Petitioner could work for [REDACTED] – but only as detailed in the petition and for the period authorized – and that changes in employment required a new petition.

On August 7, 2008, Petitioner was issued an L-1B visa with an expiration date of August 4, 2010. The visa indicated Taiwan under the heading “Nationality.”

On April 2, 2009, Petitioner filed an “Application for Registration to Practice before the United States Patent and Trademark Office.”

In a letter, dated April 20, 2009, a staff attorney in the Office of Enrollment and Discipline (OED) informed Petitioner that his application to take the examination for registration had been approved. The letter also indicated that – as a result of the conditions associated with his L-1 visa status – Petitioner was precluded from lawfully accepting employment from any and all applicants for patent, from business enterprises, or law firms needing the services of a registered patent attorney, or acquiring his own clients. The letter went on to explain that as a result, Petitioner had not demonstrated that he could be registered as an agent to represent any and all applicants for patents and to render to applicants and other persons valuable service, advice, and assistance in the presentation and prosecution of their applications. The letter indicated that if Petitioner took and passed the registration examination, he would not be registered as a patent agent but would instead be given – for the period consistent with the terms of his authorized employment – limited recognition pursuant to 37 C.F.R. § 11.9(b) to prosecute U.S.

patent applications in which the assignee of record of the entire right, title, and interest is a client of [REDACTED].

On July 14, 2009, Petitioner took and passed the registration examination. In a notice dated July 16, 2009, the OED Director informed Petitioner that – in the absence of evidence of lack of good moral character and reputation – he would be granted limited recognition to practice before the USPTO in patent cases.

In a letter dated September 10, 2009, the OED Director informed Petitioner that – pursuant to 37 C.F.R. § 11.9(b) – he had been granted limited recognition until the expiration of his visa (August 4, 2010) to prosecute any patent application in which the patent applicant is a client of [REDACTED] and an attorney or agent of record in the application is a registered practitioner who is a member of [REDACTED]. The letter also stated that, if prior to August 4, 2010, Petitioner’s employer changed, his visa status changed, or he ceased to reside in the United States – his limited recognition would automatically expire. The letter further explained that Petitioner would be eligible to apply for registration if his immigration status changed to permanent resident or citizen of the United States.

In a letter dated April 12, 2010, Petitioner informed the OED Director that his employment with [REDACTED] had terminated but that he had obtained an Employment Authorization Card (EAD) – and that he was thus applying for registration to practice before the USPTO pursuant to 37 C.F.R. § 11.6. Petitioner included a copy of his EAD with his letter. The EAD indicates, inter alia, the following: (1) the EAD is valid from April 7, 2010, to April 6, 2012; (2) the EAD was issued as a category C09;<sup>1</sup> (3) there are no terms and conditions; (4) Petitioner is authorized to work in the U.S. for the validity of

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<sup>1</sup> See 8 C.F.R. § 274a.12(c)(9).

the EAD; (5) the EAD is not evidence of U.S. citizenship or permanent residence; and (6) Petitioner's country of birth is Taiwan.

In a letter issued April 22, 2010, an OED staff attorney indicated that if Petitioner were to again be employed by a registered practitioner in the capacity of preparing and prosecuting patent applications for others before the USPTO – he would be eligible for limited recognition pursuant to 37 C.F.R. § 11.9 to prosecute any U.S. patent application in which the applicant is the client of the registered practitioner and the registered practitioner is of record in the patent application. The letter also indicated that Petitioner would be eligible for registration pursuant to 37 C.F.R. § 11.6 if he became a lawful permanent resident of the United States.

In a “Petition Under 37 C.F.R. §§ 11.2 and 11.3,” dated June 4, 2010, Petitioner sought registration as a patent agent pursuant to 37 C.F.R. § 11.6(b) and asserted, *inter alia*, that he had satisfied all of the requirements set forth in 37 C.F.R. § 11.6(b).

In a decision dated June 8, 2010, the OED Director dismissed the petition dated June 4, 2010, for failure to pay the requisite petition fee.<sup>2</sup>

On June 17, 2010, Petitioner filed a petition pursuant to 37 C.F.R. § 11.2 seeking, *inter alia*, “full registration as a patent agent under 37 C.F.R. § 11.6(b).” Petitioner again asserted that he had satisfied all of the requirements set forth in 37 C.F.R. § 11.6(b).

On August 23, 2010, Petitioner submitted a copy of a letter from the General Counsel at [REDACTED] indicating that [REDACTED] had hired Petitioner to work on patent matters assigned to [REDACTED]. Petitioner requested resumption of his limited recognition status pursuant to 37 C.F.R. § 11.9(b).

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<sup>2</sup> 37 C.F.R. §§ 11.2(c) and 1.21(a)(5)(i).

On August 31, 2010, the OED Director issued a Final Decision, in response to the petition filed June 17, 2010, denying Petitioner's request for registration as a patent agent pursuant to 37 C.F.R. § 11.6(b). The decision indicated that Petitioner had "failed to demonstrate that his registration would not 'be inconsistent with the terms upon which [Petitioner] continues to lawfully reside in the United States'" pursuant to 37 C.F.R. § 11.6.

On August 31, 2010, the OED Director issued a letter notifying Petitioner that limited recognition pursuant to 37 C.F.R. § 11.9(b) was being granted to him "as an employee of [REDACTED] for a period of time until April 6, 2012, to prepare and prosecute United States patent applications in which [REDACTED] is the assignee of the entire right title and interest in the claimed invention." The letter also indicated that if prior to April 6, 2012, Petitioner's employer changed, his visa status changed, or he ceased to reside in the United States, his limited recognition would automatically expire.

On September 29, 2010, Petitioner filed the present Petition Under 37 C.F.R. § 11.2(d) (Present Petition) seeking review of the August 31, 2010, Final Decision of the OED Director and "full registration as a patent agent under 37 C.F.R. § 11.6(b)."

## **II. LEGAL STANDARD**

The Director of the USPTO has statutory authority to:

. . . establish regulations, not inconsistent with law, which may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them . . . to show that they are of good moral character and reputation and 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. § 2(b)(2)(D).

Pursuant to this statutory authority, the USPTO has issued regulations governing the recognition of attorneys and agents. 37 C.F.R. § 11.7(a)(2) states:

No individual will be registered to practice before the Office unless he or she has established to the satisfaction of the OED Director that he or she:

1. Possesses good moral character and reputation;
2. Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and
3. Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

*Id.* 37 C.F.R. § 11.6(b) governs the registration of patent agents and states, in pertinent part:

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When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further provided that the alien may remain registered only:

1. If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or
2. If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. See also § 11.9(b).

*Id.* 37 C.F.R. § 11.9(b) governs the circumstances under which a nonimmigrant alien may be granted limited recognition and provides, in pertinent part:

A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the Bureau of Citizenship and Immigration Services to be employed . . . in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment . . . If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

*Id.*

8 C.F.R. § 274a.12(c)(9) is directed to aliens who must apply for employment authorization and who have filed an application for adjustment of status to lawful permanent resident. 8 C.F.R. § 274a.12(c)(9) provides, in part:

(c) Aliens who must apply for employment authorization. An alien within a class of aliens described in this section must apply for work authorization. If authorized, such an alien may accept employment subject to any restrictions stated in the regulations or cited on the employment authorization document. . . .

\* \* \* \* \*  
(9) An alien who has filed an application for adjustment of status to lawful permanent resident . . .  
\* \* \* \* \*

*Id.*

The USPTO interprets 37 C.F.R. §§ 11.6 and 11.9(b) to prescribe that “[q]ualifying non-immigrant aliens within the scope of 8 C.F.R. § 274a.12(b) or (c) are not registered upon passing the examination.” But that “[s]uch applicants will be given limited recognition under 37 C.F.R. § 11.9(b) if recognition is consistent with the capacity of employment . . . authorized by the [United States Citizenship and Immigration Services] . . .” *General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office*, January 2008, at 8, available at <http://www.uspto.gov/web/offices/dcom/olia/oed/grb.pdf> (General Requirements Bulletin).

### III. ANALYSIS

#### A. *Conditions Associated with Petitioner's Employment Authorization*

Petitioner asserts that he should be granted registration as a patent agent because his registration would not be inconsistent with the terms upon which he was admitted to, and resides in, the United States – as his Employment Authorization Card (EAD) indicates that it imposes no terms and conditions.<sup>3</sup> Petitioner's EAD, however, indicates that it is valid from April 7, 2010, and expires April 6, 2012. Pursuant to the current policy of the United States Citizenship and Immigration Services (USCIS), a "two-year EAD is available to pending adjustment applicants (i.e., those who have filed a Form I-485, Application to . . . Adjust Status) who have filed for an EAD under Section 274.a.12(c)(9) of Title 8, Code of Federal Regulations (8 C.F.R.) and who are currently unable to adjust status because an immigrant visa number is not currently available."<sup>4</sup> Petitioner's EAD also indicates that it was issued as a category C09 – i.e., pursuant to 8 C.F.R. § 274a.12(c)(9). 8 C.F.R. § 274a.12(c)(9) is directed to aliens who must apply for employment authorization and who have filed an application for adjustment of status to lawful permanent resident. The United States Court of Appeals for the Tenth Circuit recently acknowledged that "at the time an EAD is issued, the immigration authorities have made no determination as to the alien's status, but have simply determined that the alien's application is non-frivolous."<sup>5</sup> The Tenth Circuit also indicated that "it would be

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<sup>3</sup> Present Petition at 3.

<sup>4</sup> United States Citizenship and Immigration Services, *Fact Sheet: USCIS to Issue Two-Year Employment Authorization Documents (EADS) New EADS Limited to Certain Individuals Who Have Applied for LPR Status* (August 28, 2008), available at <http://www.uscis.gov/portal/site/uscis/template.PRINT/menuitem.5af9bb95919f35e66f614176543f6d1a/?vgnextoid=62ae15d3ffd7a110VgnVCM1000004718190aRCRD&vgnextchannel=68439c7755cb9010VgnVCM10000045f3d6a1RCRD>

<sup>5</sup> *United States v. Ochoa-Colchado*, 521 F.3d 1292, 1297 (10<sup>th</sup> Cir. 2008) (citing *United States v. Bazargan*, 992 F.2d 844, 848-49 (8<sup>th</sup> Cir. 1993)).

illogical to conclude that *application* for a change in status has the same legal effect as receiving new status. If that were the case, the government would never have to approve an application – a mere filing would be sufficient.”<sup>6</sup> Accordingly, it is not a forgone conclusion that Petitioner’s application for adjustment of status to lawful permanent resident will be granted.

As Petitioner’s EAD is valid for two years and expires April 6, 2012, his continued residence in the United States is dependent on the approval of his application for adjustment of status to lawful permanent resident or an extension of his EAD. Petitioner insists, though, that it was not appropriate for OED to deny him registration as a patent agent just because there is an expiration date on his EAD and, as such, registration might – at a later date – become inconsistent with the terms upon which he continues to reside in the United States.<sup>7</sup>

As of September 2010, the average pendency of a patent application was measured to be 35.3 months (just under three years).<sup>8</sup> Accordingly, it takes approximately three years, on average, to prosecute a patent application before the Office.<sup>9</sup> Further, 37 C.F.R. § 11.6(b) dictates that an alien may be registered as a patent agent if he, inter alia, lawfully resides in the United States – provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in the United States. Since Petitioner’s ability to continue to lawfully reside in the United States – and thereby continue to meet the requirements for registration as a patent

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<sup>6</sup> *United States v. Ochoa-Colchado*, 521 F.3d 1292, 1297 (10<sup>th</sup> Cir. 2008) (quoting the district court Order Den. Mot. To Dismiss, Aplt. Br., App. B, at 6).

<sup>7</sup> Present Petition at 4-6.

<sup>8</sup> United States Patent and Trademark Office; *Data Visualization Center, Your window to the USPTO, Patents Dashboard (2010)*; available at <http://www.uspto.gov/dashboards/patents/main.dashxml>.

<sup>9</sup> This three year time estimation does not include any additional amount of time the practitioner may need to spend in preparation prior to filing the patent application or in providing further assistance to his client after final disposition of the application.

agent - is uncertain, neither the USPTO nor potential clients would be able to confidently rely on Petitioner's continued ability to represent the clients through their patent matters if Petitioner were to be registered as a patent agent under these circumstances.

Petitioner's contingent ability to continue to lawfully reside in the United States, and thereby continue to represent applicants as a patent agent, makes such registration inconsistent with the terms upon which he was admitted to, and resides in, the United States.<sup>10</sup> Thus Petitioner does not satisfy the requirements for registration as a patent agent pursuant to 37 C.F.R. 11.6(b).

***B. No mechanism for revoking registration upon loss of lawful residence***

Petitioner argues that 37 C.F.R. § 11.6(b) recognizes the temporary nature of an alien's lawful residence in the United States and as such it is inappropriate for the Office to deny Petitioner registration as a patent agent simply because his continued residence in the United States is dependent on the approval of his application for adjustment of status to lawful permanent resident or an extension of his EAD.<sup>11</sup> This argument is not persuasive.

The USPTO does not have a reciprocal relationship with Taiwan for the registration of patent agents pursuant to 37 C.F.R. § 11.6(c). So, if Petitioner were to be registered as a patent agent and then ceased to reside in the United States – he could not appropriately continue to be registered before the Office.<sup>12</sup>

Pursuant to 35 U.S.C. § 32 a patent agent must be provided with notice and opportunity for a hearing prior to being excluded from further practice before the Office. The procedures to be utilized by the Office for providing a patent agent with notice and

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<sup>10</sup> 37 C.F.R. § 11.6(b).

<sup>11</sup> Present Petition at 6.

<sup>12</sup> 37 C.F.R. § 11.6(b).

opportunity for a hearing prior to excluding the agent from registration are codified in Parts 10 and 11 of the Patent Rules set out in Chapter I of Title 37 of the Code of Federal Regulations (Parts 10 and 11). The procedures for providing such notice and opportunity for a hearing set out in Parts 10 and 11, however, are not applicable to a situation in which a registered patent agent, who is a nonimmigrant alien, ceases to meet the requirements for registration because he no longer lawfully resides in the United States.<sup>13</sup> The procedure for instituting a disciplinary proceeding pursuant to 37 C.F.R. § 11.32, for example, is predicated on the existence of grounds for discipline such as the violation of a Mandatory Disciplinary Rule.<sup>14</sup> As such, there is no mechanism for revoking Petitioner's registration in the event he is granted registration and subsequently his application for adjustment of status is denied and he ceases to lawfully reside in the United States and thus ceases to meet the requirements for registration.<sup>15</sup> Accordingly, if Petitioner were registered as a patent agent, it would – contrary to 37 C.F.R. § 11.6(b)(1) - be possible for him to remain registered in the event he ceased to lawfully reside in the United States. For this reason too, Petitioner does not satisfy the requirements for registration as a patent agent pursuant to 37 C.F.R. § 11.6(b).

### ***C. Application of Regulations***

Petitioner argues, at length, that by denying him registration as a patent agent, OED improperly reads additional limitations into 37 C.F.R. § 11.6(b) that go beyond the plain language of the regulation.<sup>16</sup> This argument is not persuasive.

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<sup>13</sup> *Id.*

<sup>14</sup> 37 C.F.R. § 11.19(b).

<sup>15</sup> 37 C.F.R. § 11.6(b).

<sup>16</sup> Present Petition at 2-3 and 5-8.

The USPTO Director is vested with the authority<sup>17</sup> to establish regulations governing the recognition and conduct of agents and attorneys representing applicants before the Office, and requiring them to show that they are, inter alia, possessed of the necessary qualifications to render to applicants valuable service in the presentation or prosecution of their applications before the Office.<sup>18</sup> Thus, the USPTO Director is responsible for protecting USPTO proceedings from unqualified practitioners.<sup>19</sup>

The Court of Appeals for the Federal Circuit recognizes that “an agency’s interpretation of its own regulations is entitled to substantial deference and will be accepted unless it is plainly erroneous or inconsistent with the regulation.”<sup>20</sup> Interpretive rules – such as those found in the General Requirements Bulletin interpreting, inter alia, 37 C.F.R. §§ 11.6 and 11.9 – enable an agency “to explain ambiguous terms in legislative enactments without having to undertake cumbersome proceedings.” *Premysler v. Lehman*, 71 F.3d 387, 390 (Fed. Cir. 1995) (citing *American Hosp. Ass’n v. Bowen*, 834 F.2d 1037, 1045(D.C. Cir. 1987)). The Federal Circuit, in *Premysler*, found that the promulgation of the General Requirements Bulletin by the Commissioner of Patents and Trademarks does not amount to an abuse of discretion.<sup>21</sup> The Federal Circuit further found that USPTO’s interpretation of 37 C.F.R. § 10.9(b)<sup>22</sup> in the General Requirements Bulletin – stating that the regulation dictates that nonimmigrant aliens are not registered upon passing the patent examination, but rather are given limited recognition if such limited recognition is consistent with the capacity of employment

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<sup>17</sup> 35 U.S.C. § 3.

<sup>18</sup> 35 U.S.C. § 2(b)(2)(D).

<sup>19</sup> *Cf. Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1995).

<sup>20</sup> *Lacavera v. Dudas*, 441 F.3d 1380, 1383 (Fed. Cir. 2006) (citing *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1282 (Fed. Cir. 2005)).

<sup>21</sup> *Premysler v. Lehman*, 71 F.3d 387, 389-90 (Fed. Cir. 1995).

<sup>22</sup> 37 C.F.R. § 10.9(b) is the predecessor to 37 C.F.R. § 11.9(b).

authorized by the Immigration and Naturalization Service<sup>23</sup> – is a reasonable interpretation of the regulation.<sup>24</sup> The current version of the General Requirements

Bulletin states, in part:

Qualifying non-immigrant aliens within the scope of 8 C.F.R. § 274a.12(b) or (c) are not registered upon passing the examination. Such applicants will be given limited recognition under 37 C.F.R. § 11.9(b) if recognition is consistent with the capacity of employment or training authorized by the USCIS.<sup>25</sup>

Petitioner is a nonimmigrant alien within the scope of 8 C.F.R. § 274a.12(c) who has passed the registration examination. Petitioner’s ability to continue to lawfully reside in the United States – and thereby continue to meet the requirements for registration as a patent agent - is uncertain. Thus, as discussed above, neither the USPTO nor potential clients would be able to confidently rely on Petitioner’s continued ability to represent the clients through their patent matters if Petitioner were to be registered as a patent agent. As such, registration of Petitioner as a patent agent is inconsistent with the terms upon which he was admitted to, and resides, in the United States – so he fails to meet the requirements for registration.<sup>26</sup> As further discussed above – if Petitioner were to be registered – there is no regulatory mechanism for revoking his registration in the event his application for adjustment of status is denied and he ceases to meet the requirements for registration by ceasing to lawfully reside in the United States.<sup>27</sup> For this reason too, Petitioner does not meet the requirements for registration pursuant to 37 C.F.R. § 11.6(b).<sup>28</sup>

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<sup>23</sup> The former Immigration and Naturalization Service is now United States Citizenship and Immigration Services.

<sup>24</sup> *Lacavera v. Dudas*, 441 F.3d 1380, 1382-83 (Fed. Cir. 2006).

<sup>25</sup> General Requirements Bulletin at 8.

<sup>26</sup> 37 C.F.R. § 11.6(b).

<sup>27</sup> *Id.*

<sup>28</sup> *See* 37 C.F.R. § 11.6(b)(1).

The General Requirements Bulletin reasonably interprets 37 C.F.R. §§ 11.6 and 11.9 to dictate that Petitioner – a nonimmigrant alien within the scope of 8 C.F.R. § 274a.12(c) – will not be registered but will rather be given limited recognition pursuant to 37 C.F.R. § 11.9(b). The Supreme Court has indicated that particular deference is normally accorded to an agency interpretation of longstanding duration.<sup>29</sup> The USPTO interpretation of 37 C.F.R. §§ 11.6 and 11.9 regarding nonimmigrant aliens in the General Requirements Bulletin is a reasonable agency interpretation of longstanding duration and thus should be accorded deference. Petitioner’s assertion that the OED Director acted improperly in applying this interpretation set out in the General Requirements Bulletin, is not persuasive.

#### **IV. CONCLUSION**

For the foregoing reasons, Petitioner’s request to change his status from limited recognition pursuant to 37 C.F.R. § 11.9(b) to registration as a patent agent pursuant to 37 C.F.R. § 11.6(b) is **DENIED**.

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<sup>29</sup> *Alaska Dep’t of Envtl. Conservation v. EPA*, 540 U.S. 461, 487 (2004).

**ORDER**

Upon consideration of the Petitioner's Present Petition for review of the OED Director's Final Decision pursuant to 37 CFR § 11.2(d), it is **ORDERED** that the Final Decision of the OED Director is **AFFIRMED** and that Petitioner's request to change his status before the Office from one of limited recognition to registration as a patent agent is **DENIED**.

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



WILLIAM R. COVEY  
Acting General Counsel  
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NOV 23 2010

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