

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

In Re [REDACTED]

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

MEMORANDUM AND DECISION ON APPEAL

[REDACTED] (Petitioner) seeks review of the July 8, 2009, *Decision on Petition* (Final Decision) of the Director of the Office of Enrollment and Discipline (OED Director) denying his *Petition for Reconsideration* under 37 C.F.R. § 11.2(c) after he was denied admission to the registration examination for failing to demonstrate possession of the requisite scientific and technical qualifications. For the reasons stated below, the OED Director's *Final Decision* is **AFFIRMED**.

I. BACKGROUND

Petitioner has attempted to register for practice before the USPTO on three occasions. The most recent *Application for Registration to Practice Before the United States Patent and Trademark Office* (Application), the denial of which he appeals here, was submitted on January 12, 2009.

The first Application was submitted on July 10, 2006. By letter dated July 18, 2006, the USPTO's OED informed Petitioner that his Application was incomplete and noted that Petitioner had not sufficiently demonstrated possession of the required technical and scientific training. OED determined that Petitioner had only 18 semester hours of acceptable credit in the field of

physics (as shown in his transcript), rather than the required 24 semester hours, for satisfaction of Category B of the *General Requirements Bulletin*. Petitioner was given 60 days to supplement the record with additional evidence of his technical and scientific training.

Petitioner sought reconsideration by letter dated September 12, 2006. On September 27, 2006, OED reevaluated the Application in light of the Petitioner's supplemental information (Petitioner argued that his transcript demonstrated the equivalent of 30 semester hours, not the 18 hours he was credited by OED), and informed Petitioner that he had not submitted sufficient information to qualify for the registration examination under Category B. OED informed Petitioner that he could seek review of the decision by filing a petition to the OED Director pursuant to the provisions of 37 C.F.R. § 11.2(c).

Petitioner sought review by the OED Director on October 5, 2006. On November 29, 2006, OED issued a *Decision on Petition* that determined Petitioner's transcript showed 18 semester hours of qualified training in physics, and denied Petitioner admission to the registration examination for failing to show the required 24 semester hours. The OED Director informed Petitioner that he could seek review of the decision by filing a petition with the USPTO Director within 30 days after November 29, 2006. Instead of filing a petition with the USPTO Director, Petitioner filed a *Petition for Reconsideration* by the OED Director. A *Decision* on the *Petition for Reconsideration* (of the November 29, 2006 *Decision*) issued on January 9, 2007, again denying the *Petition* and setting forth the Petitioner's appeal rights. No appeal was filed.

Petitioner filed a second Application on June 14, 2007. The Application was essentially the same as Petitioner's first Application, except that an additional document had been included in support of his academic transcript. The new document was apparently submitted to support Petitioner's argument that his physics classes should be given more than 18 semester hours of

credit. The official hours in his transcript, however, remained the same and Petitioner did not present any evidence that he had completed additional technical or scientific training justifying credit of more than the 18 semester hours.

On July 11, 2007, OED issued a *Notice of Incompleteness and Denial of Admission* to the Petitioner. OED informed Petitioner that he did not meet the criteria under Categories A, B or C of the *General Requirements Bulletin*, and gave him 60 days to submit additional evidence of technical or scientific training. Petitioner responded to the *Notice of Incompleteness* and asserted that he should be considered for registration under Category B. He further asserted that OED improperly interpreted the term “semester hour.” OED was not persuaded, and on August 27, 2007, it notified Petitioner that he did not meet the requirements for the registration examination.

Petitioner requested reconsideration by OED on August 31, 2007. After reconsideration, OED informed Petitioner on September 17, 2007, that his *Request for Reconsideration* was denied. On October 23, 2007, Petitioner filed a *Petition* with the OED Director, again arguing that he met the requirements of Category B because he had 30 semester hours in physics.

On November 30, 2007, the OED Director found that Petitioner did not possess the scientific and technical training requirements set forth in 37 C.F.R. § 11.7(a)(2)(ii). After finding that Petitioner did not satisfy any of the categories of the *General Requirements Bulletin*, the OED Director conducted an independent review of Petitioner’s Application for compliance with the scientific and technical training requirements. Ultimately, the OED Director concluded that Petitioner had not provided sufficient evidence to demonstrate possession of the necessary qualifications and affirmed the decision denying Petitioner’s Application.

On December 28, 2007, Petitioner filed an *Appeal Petition* with the USPTO Director for review of the OED Director’s *Final Decision*. In a *Memorandum and Decision on Appeal* dated

April 16, 2008, the OED Director's *Final Decision* was affirmed and the *Appeal Petition* was denied. The *Appeal Decision* held that the OED *Final Decision* properly determined that Petitioner does not possess the scientific and technical requirements to practice before the USPTO and that the evidence in the record demonstrated that he did not have 24 semester hours of physics.

On January 12, 2009, Petitioner submitted a third Application seeking admission to the registration examination. In a January 23, 2009 *Notice of Incomplete Application*, OED informed Petitioner that his Application to take the registration examination was incomplete and disapproved because he did not have a Bachelor's Degree in one of the subjects listed in Category A, and he had not demonstrated that he had completed 24 hours in physics to qualify under Category B. Petitioner was given until March 24, 2009, to file additional information. On March 18, 2009, Petitioner filed a *Response* to the *Notice of Incomplete Application*. In his *Response*, Petitioner asserted that his transcript supported additional semester hours in physics sufficient to qualify him for admission under Category B.

On April 13, 2009, OED informed Petitioner that the information he submitted was insufficient to demonstrate that he possessed the necessary scientific and technical qualifications. Only 18 of his class units were accepted as semester hours under Category B. On June 11, 2009, Petitioner submitted a *Petition* to the OED Director requesting a review of the academic transcript he supplied in support of his Application.

In response to the June 11, 2009 *Petition*, the OED Director investigated Petitioner's Application and concluded, in a July 8, 2009 *Decision on Petition*, that the Petitioner's Application remained disapproved. The OED Director determined that the Application for admission to take the registration examination provided no further evidence that Petitioner

possessed the requisite scientific and technical qualifications. Thus, Petitioner was credited 18 semester hours under Category B.

The July 8, 2009 *Decision* informed Petitioner that he had 30 days to file a *Petition* to the USPTO Director appealing the OED Director's *Final Decision*. In response, Petitioner filed the *Instant Appeal* to the USPTO Director dated August 8, 2009 (Instant Appeal).

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 rests with the USPTO Director. *See Leeds v. Mosbacher*, 732 F. Supp 198, 200 (D.D.C. 1990). 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 *General Requirements Bulletin* sets forth the types of credentials that typically demonstrate the requisite scientific and technical qualifications. The *General Requirements 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).

Under Category A, an applicant must have a Bachelor's Degree in one of the recognized technical subjects listed. *See Gen'l Req. Bulletin* at 4. Under Categories B and C, an applicant

must have a Bachelor's Degree in another subject. Under Category B, however, an applicant must also have scientific and technical training equivalent to a Bachelor's Degree in one of the subjects listed in Category A. *See Gen'l Req. Bulletin* at 5. Under Category C, the applicant must have passed the Fundamentals of Engineering test. *See Gen'l Req. Bulletin* at 8.

If an applicant does not qualify under any of the 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 v. Lehman*, 71 F.3d 387, 390 (Fed. Cir. 1995) (USPTO Director's decision upheld based on independent review). Applicants bear the burden of showing the requisite scientific and technical training. *See Gen'l Req. Bulletin* at 4.

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 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 the petition for review. *Id.*

III. ANALYSIS

Petitioner bears the burden of proving his scientific and technical qualifications, and has not done so. Petitioner has not demonstrated that he qualifies under Categories A, B or C, as specifically provided in the *General Requirements Bulletin*.

Petitioner's arguments warrant little additional discussion on appeal. 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 Bulletin* and include a variety of scientific and engineering degrees. Petitioner, however, has a Bachelor of Arts Degree from [REDACTED] University in Chinese Language & Literature (which is not a recognized subject in the

General Requirements Bulletin). The OED Director correctly found that Petitioner does not have a technical degree as required in Category A.

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. *See Gen'l Req. Bulletin* at 5. A petitioner may do this by meeting the requirements of either Option 1, 2, 3 or 4 of Category B. *Id.*

The OED Director correctly determined that Petitioner was attempting to qualify under Category B, Option 1, requiring 24 semester hours in physics for which only physics courses for physics majors will be accepted. In support of his qualifications, Petitioner submitted an original official transcript from the [REDACTED] College reflecting 24 semester units in physics. The OED Director, however, accepted only 18 semester hours toward qualification for the registration examination under Category B, Option 1.

The OED Director's July 8, 2009 *Final Decision* goes into extensive detail of the reasoning behind assigning Petitioner 18 semester hours instead of 24 semester hours, and that reasoning will not be repeated here. Upon an independent review of the entire record, it is concluded that the OED Director correctly determined that the Petitioner possesses 18 semester hours under Category B, Option 1 toward qualification for the registration examination.¹ Accordingly, Petitioner does not qualify to sit for the registration examination.

¹ Petitioner was not awarded credit for the semester hours attributable to two courses on his transcript – Physics 7 (6 hours) and Physics 285 (2 hours). As stated in the *Final Decision*, no credit was given for Physics 7 because it was a lesser-included course in comparison to Physics 102 and Physics 103 (for which Petitioner had already been credited 5 hours for each class). *Decision* at 7, 9-11. As the *Final Decision* further stated, no credit was given for Physics 285 because it is a Directed Study class and Petitioner did not provide any course description of the course content or requirements. *Id.* at 9; *see also Gen'l Req. Bulletin* at 6. The fact that the course name and number are listed in the course catalogue does not satisfy the requirements of Category B, Option 1. It is the lack of description of the course contents or requirements that prevented consideration for credit toward satisfying Category B, Option 1. Despite explaining this in the *Final Decision*, Petitioner again failed to supply any additional support for giving him credit for Physics 285. Accordingly, Petitioner did not receive credit of 4 semester hours for Physics 7 because he had already received credit through other classes (Physics 102 and 103) and he did not receive credit of 2

In the Instant Appeal, Petitioner argues that: 1) it is nonsense to require a non-science degree holder to secure enough training in physics to be equivalent to a physics degree from a College or University in order to qualify to take the patent examination under Category B, Option 1 of the *General Requirements Bulletin*; and 2) he possesses the requisite scientific and technical qualifications for admission despite the fact that he does not meet any one of the standards for examination admission in Categories A, B, or C of the *General Requirements Bulletin*. See *Instant Appeal* at 2. These arguments are not persuasive.

Applicants to the patent bar bear the burden of showing that they have the requisite scientific and technical training to render valuable service to patent applicants. 37 C.F.R. § 11.7(a)(2)(ii). It is reasonable to require a non-science degree holder to obtain scientific and technical training equivalent to a Degree from an accredited U.S. College or University in one of the numerous technical subjects listed in Category A (to qualify for admission to the registration examination under Category B). *Gen'l Req. Bulletin* at 5. This sound policy ensures that those registered to practice before the USPTO possess a certain level of expertise within a scientific and technical field sufficient to render applicants valuable service, advice, and assistance in prosecuting patent applications. 35 U.S.C. § 2(b)(2)(D). See also *Tech_12* at 7 (April 30, 2009) (OED Reading Room).² This policy also serves to maintain public confidence in those registered to practice before the USPTO because practitioners are held to a recognizable standard of expertise.

Petitioner presented no argument concerning Category C, so no discussion is warranted here.

semester hours for Physics 285 because it is a Directed Study class and he provided no course catalogue description of the course content and requirements.

² *Tech_12* is accessible at the following web address:
http://des.uspto.gov/Foia/RetrievePdf?system=OED&fNm=0552_TEC_2009-04-30.

IV. CONCLUSION

The OED Director properly determined that Petitioner has not established that he possesses the requisite technical and scientific qualifications for admission to the registration examination. The OED Director's *Final Decision* is hereby **AFFIRMED**.

ORDER

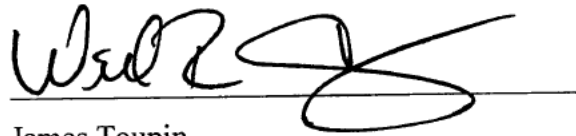
Upon consideration of the Petitioner's *Request For Review* of the OED Director's *Final Decision* under 37 CFR § 11.2(d), it is **ORDERED** that the *Petition* is **DENIED**.

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

23 DEC 09

Date

for



James Toupin
General Counsel
United States Patent and Trademark Office

cc:

Director
Office of Enrollment and Discipline
Mailstop OED
USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

