

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re _____

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Decision on Petition for Review
Under 37 C.F.R. § 10.2(c)

MEMORANDUM AND ORDER

(hereafter "Petitioner") seeks review of the decision of the Director of the Office of Enrollment and Discipline (hereafter "Director") denying him admission to the August 1997 patent practitioner's registration examination because he does not meet the scientific and technical training requirements found in 37 C.F.R. § 10.7(a)(2)(ii). For reasons set forth below, the petition is denied.

Background and Facts

The Director denied Petitioner's application to sit for the August 1997 registration examination on the basis that he did not meet the scientific and technical training requirements as set forth in 37 C.F.R. § 10.7(a)(2)(ii). In short, the Director found that Petitioner did not possess sufficient technical expertise to render patent applicants valuable service.

In support of his application, Petitioner submitted evidence that he is a

_____ that he is _____ and that
he is the holder of two patents related to _____ technology, numbers _____ (issued

) and (issued Petitioner submitted letters and/or statements from colleagues and clients indicating that he possesses practical engineering ability. Petitioner also submitted a transcript indicating that his formal training in science and engineering is limited to twelve quarter (eight semester) hours of pre-engineering classes completed in 19 he lacks a bachelor's (or higher) degree. Petitioner also presented evidence that he was admitted to the patent agent registration examination on two previous occasions: and ¹

Opinion

The issue before the Commissioner is whether the Petitioner is “possessed of the necessary qualifications to render to [patent] applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their [patent] applications” and should therefore be admitted to the patent practitioner registration examination. 35 U.S.C. § 31. After full review of the record and Petitioner’s qualifications, the Commissioner finds that the Petitioner fails to meet the requirements of the statute.

Petitioner asserts that he is entitled to be admitted to the registration examination on three separate grounds: (1) that he qualifies under Category A of the Bulletin Outlining General Requirements for Admission to the Patent Registration Examination (1997) (“Bulletin”), possessing a bachelor’s degree in a recognized technical subject; (2) that he qualifies under Category C of the Bulletin, practical engineering or scientific experience; and (3) that the rules should be waived under 37 C.F.R. § 10.170 to permit him to sit for the examination. While the

¹Petitioner did not achieve a passing score on either examination, and has never been registered to practice before the PTO.

Petition nominally sets forth these three separate grounds for reversal of the Director's decision, virtually all of the Petitioner's argument and documentary evidence focuses on Category C, practical engineering or scientific experience.

I. Category A. Bachelor's Degree in a Recognized Technical Subject

Petitioner asserts that he is entitled to be admitted to the registration examination under Category A. However, Petitioner has presented no evidence to the Director of having received a bachelor's degree, in engineering, physical science, or otherwise. The Bulletin provides in pertinent part:

Category A. Bachelor's Degree in a Recognized Technical Subject.

You will be considered to have the necessary scientific and technical training if you show that you received a bachelor's degree in one of the following subjects [primarily engineering or physical science] If you have a bachelor's degree in one of the above identified subjects, you must furnish an original transcript (emphasis added).

P.2, Bulletin. An applicant asserting that he is qualified to sit for the registration examination because he possesses a bachelor's degree in engineering or physical science bears the burden of submitting an original transcript to the Director demonstrating his academic credentials. The record contains only a single transcript reflecting twelve quarter (eight semester) hours of pre-engineering course work completed in 19 There is no transcript in the record showing that Petitioner possesses a bachelor's degree in engineering or physical science, the requirement under Category A. Accordingly, Petitioner has failed to meet his burden.

II. Category C. Practical Engineering or Scientific Experience

Petitioner argues that he should be allowed to sit for the examination based on his practical experience as a : , and he further points out that he was previously

permitted to sit for the examination based on this experience. Petitioner, however, has failed to establish that he meets the current qualifications to sit for the examination.

A. Petitioner's Experience Does Not Satisfy the Requirements of Category C

Petitioner asserts that his experience as _____ should be deemed sufficient under Category C of the Bulletin which provides in pertinent part:

If you are relying on practical engineering or scientific experience or if you cannot qualify under A or B above, you may establish that you possess the required technical training by taking and passing the Fundamentals of Engineering (FE) test. (Emphasis added).

P.4, Bulletin. Petitioner has not, however, submitted any evidence that he has passed the Fundamentals of Engineering (FE) test. Instead, he argues that the language of the Bulletin ("may establish") makes the FE test optional. Even, assuming for the sake of argument, that Category C could be satisfied in ways other than by taking and passing the FE test, Petitioner here has not done so.

Applicants without a technical degree have a "high burden to show sufficient expertise and professionalism in science and/or engineering." Premysler v. Lehman, 71 F.3d 387, 389, 37 USPQ2d 1057, 1059 (Fed. Cir. 1995). This burden may be met by sitting for and passing the FE test which is an appropriate objective measure to demonstrate technical competence. Accord Id. The FE test is produced and graded by the National Council of Examiners for Engineering and Surveying (NCEES), and is administered through State engineer examination boards. It is an eight hour examination covering general engineering principles, and represents the minimum level of knowledge and technical expertise that those desiring to sit for the patent registration examination should possess. Achieving a passing score on the FE test is by no means a pro forma

exercise, but is rather an arduous undertaking, requiring extensive preparation and a substantial background in applied engineering principles.

The materials submitted by the Petitioner do not show that the knowledge and expertise he has gained as _____ compare to that evinced by one who has studied for and passed the FE test. Therefore, Petitioner has not made an adequate showing that he has the practical engineering experience to qualify under Category C.

B. Previous Admission to the Examination is not Dispositive Where Standards Have Changed.

Petitioner argues that because his qualifications were once deemed sufficient to sit for the registration examination, they should now also be deemed sufficient. He further asserts, in essence, that changes in the Bulletin regarding the technical training requirements should not be controlling because the underlying regulations have not changed.

The Commissioner agrees that the Bulletin is not dispositive in determining whether an applicant has sufficient technical expertise to sit for the registration examination. See Premysler v. Lehman, 71 F.3d 387, 37 USPQ2d 1057 (Fed. Cir. 1995) (irrespective of informational guidance and illustrative examples as set forth in the Bulletin, “[t]he Commissioner may, at his discretion, determine if an applicant possesses sufficient technical skills to take the examination.”). Whether a person possesses the technical qualifications necessary to sit for the registration examination is a matter for the Commissioner’s discretion, based on a review of all the evidence of record. Id.

The standards that appear in the Bulletin reflect examples of the technical requirements that are currently acceptable. These standards necessarily evolve because of changes in

technology and the law. The fact that the Petitioner, years ago, was once deemed to have sufficient technical expertise to sit for the registration examination does not necessarily mean that his practical experience would be deemed sufficient today given the increased sophistication in this field, both technically and legally. It should be noted that when Petitioner presented evidence of his practical experience years ago, he had recently been awarded two patents. In support of his latest application to sit for the examination, Petitioner has presented little, if any, evidence reflecting that his practical engineering knowledge and technical skills are current. Upon a review of all the evidence of record, and considering that Petitioner is seeking to qualify under Category C, practical engineering experience, I conclude that Petitioner does not meet the current scientific and technical training requirements found in 37 C.F.R. § 10.7(a)(2)(ii).

III. Waiver under 37 C.F.R. § 10.170

Petitioner asks that the rules be waived to permit him to sit for the registration examination, but he is unclear as to the basis for any such waiver. He has not specifically listed any particular regulation that should be waived. Instead, the Petitioner appears to be arguing in favor of a general waiver of the technical qualification requirements based on his experience as a

 . . . In other words, Petitioner's waiver argument overlaps with his argument set forth and addressed above in the section on Category C, Practical Engineering or Scientific Experience.

The Commissioner has the authority to waive any of the PTO regulations pursuant to 37 C.F.R. § 10.170 which provides in pertinent part:

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of the statutes may be suspended or waived by the Commissioner

The waiver regulation is only invoked “in an extraordinary situation, when justice requires” In the past, the Commissioner has indicated that an “extraordinary situation,” for purposes of the waiver regulation, is one which could not have been prevented by the exercise of ordinary care or diligence. See Nitto Chemical Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (case in which patent applications purportedly filed by Express Mail were not received by Patent and Trademark Office does not present “extraordinary circumstances” warranting waiver of rules since there was evidence that mail delivery procedures of applicant’s law firm were not strictly followed). Waiver is ordinarily pertinent only when the strict enforcement of an administrative regulation would operate to impose an injustice -- it is not intended to subvert a broad policy objective such as requiring a practitioner to be technically qualified to represent members of the public applying for patent protection. Therefore, it would seem that Petitioner’s waiver argument is somewhat misplaced.

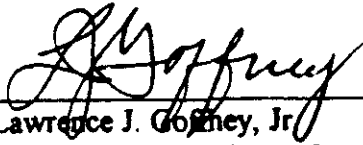
Moreover, under the traditional waiver analysis, Petitioner has the burden to show that his circumstances rise to the level of an “extraordinary situation” in which “justice requires” a waiver of the regulations. Since Petitioner has failed to adduce sufficient evidence to meet this burden, no waiver is available.

Conclusion

Petitioner failed to present evidence to the Director that he had sufficient technical expertise, either by formal education or practical experience, to qualify for admission to the patent practitioner’s registration examination. Upon a careful review of the evidence of record, and independent from the information provided in the Bulletin, I conclude that the Petitioner lacks the

legal, scientific, and technical qualifications necessary to enable him to render patent applicants valuable service. The petition is hereby denied.

3/27/98
Date



Lawrence J. Goffney, Jr.
Acting Deputy Assistant Secretary of
Commerce and Deputy Commissioner of
Patents and Trademarks