

**BEFORE THE DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

In re

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

JAN 2 2002

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision by the Director of the Office of Enrollment and Discipline (OED) denying her admission to the patent practitioner registration examination. The petition is denied.

BACKGROUND

Applicants for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must take and pass an examination administered pursuant to 37 C.F.R. § 10.7(b). Individuals seeking registration must also submit evidence of “sufficient basic training in scientific and technical matters” to enable them to render patent applicants valuable service. *Id.* In recent years, the Director of OED has given the registration exam twice a year, in April and in October.

On April 10, 2001, the Director of OED published the “General Requirements Bulletin” (Bulletin) for the registration exam scheduled for October 17, 2001. The Bulletin explained that individuals applying for the exam must demonstrate the requisite scientific and technical training by submitting an official, original transcript from a college or university. The Bulletin listed three categories of course work that suffice to show sufficient training. Category A lists Bachelor’s degrees in certain technical fields. Category B provides for persons having a Bachelor’s degree in a non-technical field to show that they have accumulated sufficient course

work to satisfy one of four different listed "options." Category C provides that persons who do not qualify under Category A or B, can show the requisite training with a passing grade on the "Fundamentals of Engineering" test administered by any State Board of Engineering Examiners. The Bulletin set a July 6, 2001, deadline for filing an application, including transcripts and fees.

In January, 2001, Petitioner applied to take the April 18, 2001, exam. On February 15, 2001, OED found that Petitioner failed to demonstrate that she possessed the requisite scientific and technical training, and therefore did not admit her to the April exam. More specifically, OED stated that (1) Petitioner did not show evidence of having a bachelor's degree or the equivalent; and (2) Petitioner did not establish that her completion of technician degree training was equivalent to the training provided at an accredited U.S. college or university. The OED letter advised Petitioner that the Bulletin indicates that OED may consider foreign education for equivalence when a private organization specializing in interpreting foreign educational credentials deems the education equivalent to conventional U.S. programs.

On July 6, 2001, Petitioner applied to take the October 17, 2001, exam. In her application letter, Petitioner indicated that she sought qualification under Category B, Option 4, relying on her foreign education work. Category B, Option 4, requires a Bachelor's degree and 40 semester hours in certain areas of science or engineering. Petitioner included a "Credential Evaluation Report" of relevant education prepared by World Education Services, Inc., dated July 3, 2001. Petitioner's letter indicated that the Report evaluated "36 US semester credits." Petitioner indicated that she would send "a reviewed corrected evaluation in a few days in which I will demonstrate that I have the necessary 40 semester credits (under category b option 4)." On July 25, 2001, Petitioner supplemented her application with another Credential Evaluation Report from World Education Services, Inc., dated July 24, 2001.

On August 13, 2001, an OED Staff Attorney sent Petitioner a "Notice of Denial of Admission" to the exam. OED found that Petitioner's submitted information did not demonstrate the necessary scientific and technical qualifications. More specifically, OED found that the Credential Evaluation Report stated Petitioner's training was the U.S. equivalent of a high school diploma and one year of undergraduate study in computer study. OED concluded this did not demonstrate education equivalent to that received at an accredited U.S. college or university in one of the subjects listed in Category A. The OED Notice indicated that Petitioner's revised report submitted July 25, 2001, was not considered because it was filed after the deadline. The Notice acknowledged that the U.S. Equivalency Summary in the July 24th report remained at "high school diploma, one year of undergraduate study in computer study" with the addition of "short-term training programs in computer programming."

On August 22, 2001, Petitioner requested reconsideration of the denial of admission, and based the request on the number of training hours and on the timeliness of the application. On September 14, 2001, the Director of OED treated Petitioner's request as a petition under 37 C.F.R. § 10.7, and denied entry to the exam. On September 25, 2001, Petitioner filed the present petition for review of the Director of OED's decision.

OPINION

The Director of the USPTO has statutory authority to require persons representing other parties before the USPTO 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 before the USPTO. The statutes relating to the character and conduct of agents, attorneys, and other persons representing applicants for patents before the USPTO "represent[] congressional policy in an important field." *Kingsland v. Dorsey*, 338 U.S.

318, 319 (1949); *Leeds v. Mosbacher*, 732 F. Supp. 198, 203, 14 USPQ2d 1455, 1458 (D.D.C.) (representing applicants before the USPTO is “a highly specialized and technical position designed to protect and assist the public”) (emphasis in original), *aff’d mem.*, 918 F.2d 185 (Fed. Cir. 1990).

The statute assigning powers and duties to the USPTO, 35 U.S.C. § 2(b)(2)(D), states in pertinent part:

(b) Specific Powers-- The Office . . .

(2) may establish regulations, not inconsistent with law, which . . .

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, 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 before the Office. (Emphasis added).

Pursuant to this authority, the USPTO adopted 37 C.F.R. § 10.5, establishing a register of attorneys and agents entitled to represent patent applicants before the USPTO. An individual seeking to be registered must “furnish all requested materials and information.” 37 C.F.R. § 10.7(a)(1). The information must establish to the satisfaction of the Director of OED that the individual has sufficient scientific and technical qualifications to render valuable service to patent applicants. 37 C.F.R. § 10.7(b). *Sperry v. Florida*, 373 U.S. 379 (1963) (reaffirming right of USPTO to require special technical and other qualifications of its practitioners); *Premysler v. Lehman*, 71 F.3d 387, 389, 37 USPQ2d 1057, 1059 (Fed. Cir. 1995) (“[T]he Commissioner has the discretionary authority to regulate the practice of patent agents before the PTO”); *Leeds*, 732 F. Supp. at 200, 14 USPQ2d at 1456 (the Commissioner has the responsibility to protect USPTO proceedings from unqualified practitioners).

The USPTO publishes the General Requirements Bulletin to interpret 37 C.F.R.

§ 10.7(a)(2)(ii). See *Premysler*, 71 F.3d at 387-89, 37 U.S.P.Q.2d at 1059. The Bulletin, in part,

reads:

CATEGORY B.

Bachelor's Degree in Another Subject: An applicant with a Bachelor's degree in a subject other than one of those listed in Category A, must establish that he or she possesses scientific and technical training equivalent to that received at an accredited U.S. college or university for a Bachelor's degree in one of the subjects listed in Category A. To establish such equivalence, an applicant can satisfy one of the four options, other training, or other education listed below. The applicant must submit the necessary documentation and objective evidence showing satisfaction of one of the options or other means of qualifying.

* * *

Option 4: 40 semester hours in a combination consisting of the following:

- 8 semester hours of chemistry or 8 semester hours of physics, and
- 32 semester hours of chemistry, physics, biology, botany, microbiology, molecular biology or engineering.

The 8 semester hours of chemistry or 8 semester hours of physics must be obtained in two sequential semesters, each semester including a lab. Only courses for science or engineering majors will be accepted.

* * *

Transcripts: Official original transcripts are required to establish both the award of a Bachelor's degree and completion of each course relied on to establish scientific and technical training in Category B.

* * *

Other Acceptable Course Work: Under Option 4, up to four semester hours will be accepted for courses in design engineering or drafting. Also, under Option 4, computer science courses that stress theoretical foundations, analysis, and design, and include substantial laboratory work, including software development will be accepted. Such courses include the representation and transformation of information structures, the theoretical models for such representations and transformations, courses that provide basic coverage of algorithms, data structures, software design with a laboratory, programming languages with a laboratory, and computer organization and architecture. Other acceptable courses in computer science include artificial intelligence and robotics, networking, linear circuits, logic circuits, operating systems, and software methodology and engineering.

Typical Non-Acceptable Course Work: The following typify courses which are not accepted as demonstrating the necessary scientific and technical training: . . . courses on how to use computer software; courses directed to data management and management

information systems; . . . mathematics courses Also not accepted are courses . . . which do not provide scientific and technical training in patentable subject matter.

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Bulletin at 3-5.

Petitioner Did Not Qualify Under The General Requirements Bulletin

The Director of OED identified the following deficiencies in Petitioner's application:

(1) Petitioner has not submitted any official transcripts as required in the Bulletin; (2) Petitioner has not submitted any official course descriptions as required in the Bulletin; (3) on the basis of the materials that were submitted, Petitioner did not provide satisfactory proof that she possesses scientific and technical training equivalent to that received from an accredited U.S. college or university for a Bachelor's degree in one of the subjects listed in Category A as required in the Bulletin; and (4) Petitioner did not provide "documentation showing that the INS has authorized the applicant to be employed in the capacity of representing patent applicants before the USPTO by preparing and prosecuting their patent applications" as required in the Bulletin.

Petitioner does not contest the Director of OED's first two findings, that she provided no official transcripts or course descriptions. Petitioner's application form filed July 6, 2001, indicates that she received an LLB from ' in law. However, rather than provide the required official transcript as evidence of a Bachelor's degree, Petitioner states "since I noted in my application that I am an attorney at the law firm of , and I also sent the correspondence on the firm's letter [sic] with my signature, a bachelor in law is obvious." Petitioner's conclusion does not follow from the premise because it is a non sequitur. The requirement for an official transcript is objective, definite and fair. The argument is not a good reason to make an exception to the requirement, and the Director of OED's decision will not be reversed on this ground.

Petitioner writes that there are no official course descriptions and there is no practical way to provide an official set of original transcripts for courses taken more than ten years ago in the . However, it is routine for schools and organizations to maintain records and provide transcripts over periods extending many decades.

Petitioner's statement that no official course descriptions or transcripts are available, without any confirmation from even one of the various named organizations or offices, is not a good reason to make an exception to the Bulletin requirements. Petitioner has not even asserted that she requested official documents from any of the pertinent institutions or offices and that the requests were denied. For example, Petitioner gives no indication that she requested an official transcript of her Bachelor's degree work from . Good cause for an exception might be made, e.g., with correspondence from an appropriate official explaining that official transcripts or course descriptions cannot be provided. Further, Petitioner's statement that no course descriptions are available undermines the reliability of the Credential Evaluation Report by World Education Services. Under these circumstances, the Director of OED was correct in not making an exception to the General Requirements Bulletin.

The Director of OED found that Petitioner did not demonstrate sufficient required scientific and technical training. Petitioner argues that "[t]he language of option B-4 should be interpreted to include all 40 credits in computer science." Assuming that an applicant establishes that he or she has a Bachelor's degree, the applicant must also establish that he or she "possesses scientific and technical training equivalent to that received at an accredited U.S. college or university for a Bachelor's degree in one of the subjects listed in Category A." Bulletin at 3. The Bulletin standard is definite, fair, and objective. *See Gager v. Ladd*, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963) ("[T]he Commissioner established a standard of what

constitutes sufficient basic training. That standard is definite, fair, and objective”) (emphasis added).

The Credential Evaluation Report states that Petitioner’s “Technician’s Diploma” is equivalent to high school plus one year of U.S. undergraduate study. The Credential Evaluation Report submitted on the July 6, 2001, deadline accounted for 36 semester hours, which do not include the required 8 semester hours of chemistry or 8 semester hours of physics obtained in two sequential semesters, each semester including a lab. Petitioner advances no good reason to disregard the requirement for 8 hours of chemistry or physics.

Although Petitioner argues that 40 hours in computer study should satisfy the Option 4 requirements, Petitioner does not have 40 hours in computer study even if the July 24, 2001, submission is considered. That is, several courses in mathematics and unspecified electives are included in Petitioner’s 40 credits, but mathematics courses are not typically accepted as demonstrating the necessary scientific and technical training in patentable subject matter. Bulletin at 5. For example, Linear Algebra, Boolean Algebra and Logic, and Statistics appear to be mathematics courses. Further, the report lists 3.0 semester hours in unspecified “Elective Courses.” The list of credits is insufficient to show scientific and technical training equivalent to a Bachelor’s degree in a Category A subject. Given the lack of evidence showing sufficient scientific and technical training in patentable subject matter, the decision by the Director of OED will not be reversed on this ground.

Finally, the Director of OED noted that Petitioner did not provide “documentation showing that the INS has authorized the applicant to be employed in the capacity of representing patent applicants before the USPTO by preparing and prosecuting their patent applications.”

Petitioner does not address this deficiency in her application record, and there is no apparent reason to waive the requirement.

Petitioner's Request for Reconsideration as a Special Case

According to Petitioner, there are "procedural aspects of my application" indicating that it "should be reconsidered as a special case due to the nature of the military computer training and courses and due to the fact they were not addressed in my previous application." Petitioner argues that "other training and life experience (pages 5 of the bulletin) in computer science qualify me to take the patent bar," referring to five years' experience as a computer programmer. Petitioner provides no description or details of this experience, and no job description from an employer is provided as objective evidence. Even if Petitioner had made this claim by the July 6, 2001, deadline, the vague reference to life experience does not establish that Petitioner has the necessary scientific and technical training because it provides no definite and objective information.

In order to fairly evaluate Petitioner's training or work experience, whether in the military or in the private sector, Petitioner must provide objective and definite information for evaluation. On the basis of Petitioner's application and letters, there do not appear to be any "procedural aspects" suggesting that official transcripts could not be provided as objective sources of definite information. For example, there is no evidence that refused to provide an official transcript showing Petitioner's Bachelor's degree studies, nor is there any reason to expect such a refusal. Further, the translated records said to show Petitioner's military training refer variously to

The copies include signature lines for officials whose titles and offices

include

There is no evidence that any of these organizations or offices refused to provide official transcripts or course descriptions, nor is there any evidence that Petitioner requested records from these organizations.

As noted above, Petitioner's argument that official course descriptions are not available suggests that the Credential Evaluation Report prepared by World Education Services, Inc., has no foundation. Thus, Petitioner's position undercuts the reliability of the Credential Evaluation Report. On the other hand, if World Education Services, Inc., has the pertinent official course descriptions, Petitioner may be able to obtain appropriate objective evidence from that source. Given these at least two options apparently available to Petitioner for obtaining official course descriptions, and the lack of any showing by Petitioner that pursuit of any options failed, a departure from the fair requirement of objective evidence is not warranted. Further, Petitioner has presented no evidence establishing five years as a computer programmer, and no evidence showing how that experience constituted scientific or technical training in patentable subject matter.

CONCLUSION

The requirement for objective evidence in the form of official transcripts and official course descriptions is a fair and reasonable burden to place on persons who wish to take the patent practitioner's registration exam. Petitioner has not set forth a sufficient basis to make an exception from that requirement. A candidate who wishes to take the registration exam has the burden to establish that he or she has sufficient scientific and technical qualifications to render valuable service to applicants for patents. Petitioner has not met that burden for the reasons

discussed above. If Petitioner arranges for official course descriptions, an assessment can be made as to the sufficiency of the courses. Petitioner also could supplement her qualifications for a future exam by taking appropriate course work in patentable subject matter. Finally, when applying for a future exam, Petitioner should provide the necessary INS documentation that was referred to by the Director of OED.

ORDER

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



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