

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

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

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (Director) denying her admission to the August 26, 1998, patent practitioner's examination because she does not meet the scientific and technical training requirement found in 37 C.F.R. § 10.7(a)(2)(ii). For the reasons set forth below, the petition is denied.

Background

The Director denied Petitioner's application for admission to the August 26, 1998, patent practitioner's examination on the basis that, in view of the submitted materials, she did not meet the scientific and technical training requirement set forth in 37 C.F.R. § 10.7(a)(2)(ii). The Director found that Petitioner does not possess sufficient technical expertise to render valuable service to patent applicants.

Prior to being admitted to the patent practitioner's examination, an applicant must show the "scientific and technical qualifications necessary to enable him or her to render applicants for patents valuable service." 37 C.F.R. § 10.7(a)(2)(ii). In support of her application, Petitioner submitted evidence that she has received a Juris Doctor degree

that she has been admitted to the State Bar, and that she has worked in technical fields and on patent applications. The extent of Petitioner's submitted evidence to show the required technical background is the following:

- (1) letter from , dated
- (2) letter from , dated (unsigned);
- (3) letter from , dated
- (4) letter from (undated); and
- (5) letter from , dated

See Petition at 1 ("Applicant submitted her own statement to the OED and statements were also submitted by . . . There is no official transcript in Applicant's record from any college or university, including There is a statement from

1. Accordingly, Petitioner admits that she has not submitted any college transcript for the present application. Petitioner argues that the evidence and her patent law experience show that she is technically qualified. She was admitted to the patent practitioner's examinations held in

Petitioner did not achieve a passing score on any of these examinations, and she has never been registered to practice before the Patent and Trademark Office in patent cases.

Opinion

Pursuant to 35 U.S.C. § 31, the Commissioner of Patents and Trademarks:

“may require [agents and attorneys], before being recognized as representatives of applicants or other persons, 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. § 31 (emphasis added). Under his statutory authority, the Commissioner promulgated 37 C.F.R. § 10.7 which reads in pertinent part:

“(a) No individual will be registered to practice before the Office unless he or she shall:

....:

(2) Establish to the satisfaction of the Director that he or she is:

....:

(ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants for patents valuable service.”

37 C.F.R. §10.7 (Emphasis added).

Accordingly, the issue before the Commissioner of Patents and Trademarks is whether Petitioner has shown that she possesses the scientific and technical qualifications necessary to enable her to render applicants for patents valuable service in order to be admitted to the patent practitioner’s examination. As set forth above, the extent of Petitioner’s evidence on the matter includes five letters (one unsigned).² The Commissioner has considered the submitted evidence and finds that it fails to show the necessary scientific and technical qualifications.

² Petitioner’s Juris Doctorate degree and admission to the State Bar do not show technical qualifications, but rather her legal background.

More specifically, prior to the August 26, 1998, patent practitioner's examination, the PTO published a bulletin entitled "GENERAL REQUIREMENTS FOR ADMISSION TO THE EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES BEFORE THE U.S. PATENT AND TRADEMARK OFFICE" ("bulletin"). The bulletin sets forth "the kinds of credentials that typically demonstrate technical competence under 37 C.F.R. § 10.7(a)(2)(ii)." Premysler v. Lehman, 71 F.3d 387, 390, 37 USPQ2d 1057, 1059 (Fed. Cir. 1995). Pages 2-4 of the bulletin set forth three categories, A-C, for showing the required technical background.

Category A concerns possession of a Bachelor's degree in one of thirty-one historically recognized technical subjects, which Petitioner has not shown. See bulletin at 2. Category B concerns taking a substantial number of college semester hours in various scientific fields. See bulletin at 2-3 (Options 1-4). Petitioner has also not shown that she satisfies the subject areas set forth in detail in Category B. Finally, Category C concerns taking and passing a State Fundamentals of Engineering test administered by a State Board of Engineering Examiners, which Petitioner has also not shown.

If an applicant for admission does not meet one of the credentials set forth in the bulletin, the PTO will conduct an independent review for compliance with the technical background requirement set forth in 37 C.F.R. § 10.7(a)(2)(ii). Premysler, 71 F.3d at 390, 37 USPQ2d at 1060.

The _____, letter by _____ (letter) states that Petitioner worked in technical fields and participated in the prosecution of patent applications. The letter, however, does not concretely show that Petitioner has studied extensively in several technical fields. For example, official transcripts issued by a college showing course work in several of the

technical subjects listed in Category A would be probative for individuals not qualifying under Categories A, B, or C. The [redacted] letter is simply not entitled to the kind of weight that is accorded to evidence issued by an institution or state that concretely shows extensive study in several of the historically recognized technical fields. See Premysler, 71 F.3d at 390, 37 USPQ2d at 1060 (working on several patent applications and submitting statements from a patent attorney and colleagues did not support admission to the examination).

Similarly, the [redacted] unsigned letter with the name [redacted] appearing on it is also entitled to little, if any, weight. It has no signature and sets forth effectively the same subject matter as that in the [redacted], letter signed by [redacted].

The [redacted] letter by [redacted] discusses his particular background and then states that Petitioner worked in the areas of technology and patent law. However, as with the other letters in the record submitted as evidence, this letter does not concretely show extensive study in several of the historically recognized fields.

The one-paragraph undated letter by [redacted] states that Petitioner has worked in the chemical and patent law fields for a company. This letter fails to provide any specific information regarding Petitioner's technical expertise.

The [redacted] letter states that Petitioner completed a "Manpower Development Training program [redacted] for forty hours per week, [redacted]. This letter shows that Petitioner received some technical training in a course. This training, however, does not rise to a level that is equivalent to any of the options set forth in the bulletin for complying with 37 C.F.R. § 10.7(a)(2)(ii), e.g., a bachelor's degree in one of the specified

thirty-one technical fields. significant semester hours of course work in various technical fields substantiated by official transcripts and course descriptions, or passing a State Fundamentals of Engineering test administered by a State Board of Engineering Examiners.

With regard to admission to the patent practitioner's examination, "the primary responsibility for protection of the public from unqualified practitioners before the Patent [and Trademark] Office rests in the Commissioner of Patents [and Trademarks]." Gager v. Ladd, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963) (quoting with approval Cupples v. Marzall, 101 F. Supp. 579, 583, 92 USPQ 169, 172 (D.D.C. 1952), aff'd, 204 F.2d 58, 97 USPQ 1 (D.C. Cir. 1953)). Representing patent applicants before the Patent and Trademark Office is "a highly specialized and technical position designed to protect and assist the public." Leeds v. Mosbacher, 732 F. Supp. 198, 203, 14 USPQ2d 1455, 1458 (D.D.C.) (emphasis in original), aff'd mem., 918 F.2d 185 (Fed. Cir.), cert. denied, 498 U.S. 983 (1990). Applicants without a technical degree have a "high burden to show sufficient expertise and professionalism in science or engineering." Premysler, 71 F.3d at 389, 37 USPQ2d at 1059. In sum, the submitted letters simply do not meet this burden.

As noted above, Petitioner was admitted to the _____ examinations. However, even though Petitioner was previously admitted, this does not mean that she must be admitted to this examination. Each determination is made on the basis of the record at the time the application is submitted. See 37 C.F.R. § 10.2(c) ("The petition will be decided on the basis of the record made before the Director . . ."). It is not known whether similar materials led to her earlier admission to the examination, or if the earlier records differed from the present one since the earlier applications materials are not in this record. However, review of the record for

this application does not show that Petitioner has the necessary scientific and technical training required by 37 C.F.R. § 10.7(a)(2)(ii).

The Commissioner has considered all of Petitioner's arguments and finds them to be unpersuasive.

Conclusion

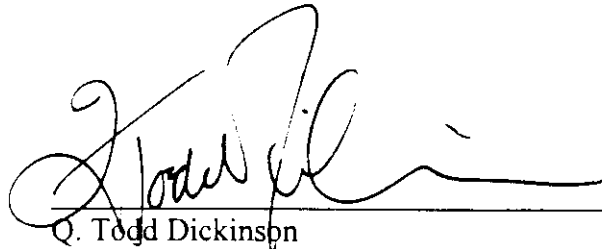
Petitioner has failed to present evidence to the Director that she has sufficient technical training to render valuable service to patent applicants, and thereby qualifies for admission to the patent practitioner's examination. Upon a careful review of the evidence of record, and independent from the information provided in the bulletin, the Commissioner finds that Petitioner lacks the scientific and technical training required by 37 C.F.R. § 10.7(a)(2)(ii).

ORDER

Upon consideration of the petition to the Commissioner for admission to the patent practitioner's examination, it is ORDERED that the petition is denied.

This is a final agency action.

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Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks