

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

HARRY I. MOATZ)	
)	
Director, Office of)	
Enrollment and Discipline,)	
)	Decision on Petition
v.)	Under 37 C.F.R. § 11.2(d)
)	
)	
Petitioner.)	

Memorandum and Decision Upon Appeal

, Petitioner, seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) disapproving Petitioner' petition for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases. The OED Director disapproved Petitioner's petition to be registered as a patent attorney under 37 CFR §11.7(a)(2)(ii) because the Petitioner failed to demonstrate he had the requisite scientific and technical qualifications. For the reasons stated below, the OED Director's decision is **AFFIRMED**.

I. Background

Petitioner has attempted to register for practice before the USPTO on two occasions.

The first application began on July 10, 2006, when Petitioner submitted an *Application for Registration to Practice Before the United States Patent and Trademark*

¹ On October 24, 2007, Mr. _____ became a naturalized United States citizen and changed his name from " _____ " to " _____ ."

Office (Application for Registration). 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. Specifically, the letter stated that Petitioner did not possess a bachelor's degree in one of the Category A subjects listed in the General Requirements Bulletin, or satisfy the requirements of either Category B or Category C. OED determined that Petitioner had only eighteen semester hours of acceptable credit in the field of physics (as shown in his transcript) rather than the required twenty-four, and gave Petitioner sixty days to supplement the record with additional evidence of technical and scientific training.

By letter dated September 12, 2006, Petitioner requested reconsideration. The request for reconsideration included a letter signed by _____, the *Los Angeles City College (LACC) Dean of Student Services – Enrollment*. The letter indicated the following information regarding Petitioner's physics credit: Physics 11, listed as four (4) units of credit on the LACC transcript, involved six (6) hours of work per week for a semester; Physics 1, listed as four (4) units of credit on the LACC transcript, involved six (6) hours of work per week for a semester; Physics 102, listed as five (5) units of credit on the LACC transcript, involved nine (9) hours of work per week for a semester; and Physics 103, listed as five (5) units of credit on the LACC transcript, involved nine (9) hours of work per week for a semester. According to the letter, "LACC acknowledges that the 18 semester units in [Applicant's] official transcript is equivalent to 30 semester hours." As a result, Petitioner again requested admission to the examination under Category B, option 1,

which requires at least twenty-four semester hours of credit in physics for science majors.

On September 27, 2006, OED reevaluated the application in light of the supplemental information, and informed Petitioner that he had not submitted sufficient information to qualify to sit for the examination under Category B.² OED further advised Petitioner that he could seek review of the decision by filing a petition to the Director of OED pursuant to the provisions of 37 CFR § 11.2(c).

Petitioner sought review by the OED Director on October 5, 2006. On November 29, 2006, the OED Director issued a Decision on Petition noting, "The semester hours in Category B refers to the semester hour credits awarded earned and reported by a college or university on that institution's official transcript." Accordingly, OED determined that the official transcript showed that Petitioner received eighteen (18) semester hours of qualified training in physics, and denied Petitioner admission to the registration examination. Further, the OED Director informed Petitioner that he could seek review of the decision by filing a petition with the USPTO Director within thirty days after November 29, 2006.³

However, instead of filing a petition with the USPTO Director, on January 3, 2007, Petitioner filed a petition for reconsideration by the OED Director. A Decision on Petition for Reconsideration ("Reconsideration Decision") issued January 9, 2007.

² OED informed Petitioner that Dean _____'s letter did not override the official transcript and that the assertion of thirty semester hours of credit in physics was not supported by objective evidence.

³ On January 12, 2007, the OED Director amended his Decision on Petition noting that the thirty-day period was erroneous and informed Petitioner that he had sixty days to file an appeal with the USPTO Director.

The OED Director again denied the Decision on Petition, and set forth Petitioner's appeal rights. No appeal was filed.

Petitioner's second application was filed on June 14, 2007. The record on the new application was substantially the same as the previous application with one notable exception; a "Memoranda" had been added to the LACC transcript. The memo indicated: "PHYSICS 011 IS EQUIVALENT TO 6 SEMESTER HOURS;" "PHYSICS 102 IS EQUIVALENT TO 9 SEMESTER HOURS;" "PHYSICS 103 IS EQUIVALENT TO 9 SEMESTER HOURS;" and "PHYSICS 001 IS EQUIVALENT TO 6 SEMESTER HOURS." The official credits awarded by LACC remained the same, and Petitioner did not present any evidence that he had completed additional technical or scientific training.

On July 11, 2007, OED mailed to Petitioner a *Notice of Incompleteness and Denial of Admission*. OED again credited Petitioner with eighteen semester hours of acceptable training in physics. This notice stated that the "Memoranda" added to the transcript was unavailing, observing that the LACC catalog specified the unit of credit awarded for a course corresponds to "[t]he amount of college credit earned by satisfactory completion of a specific course taken for one semester. Each unit represents one hour per week of lecture or recitation, or a longer time in laboratory or other exercises requiring outside preparation." The Notice of Incompleteness went on to state that the official transcript and course descriptions continued to list the hours of official credit as eighteen hours, and that Petitioner had not provided any evidence other California universities would award thirty hours of transfer credit for the

eighteen units of work completed at LACC. OED informed Petitioner that he did not meet the criteria under Categories A, B, or C, and gave him sixty sixty days to submit additional evidence of technical and scientific training.

On July 30, 2007, Petitioner responded to the Notice of Incompleteness. Petitioner asserted that he should be considered for registration under Category B. Briefly, he argued that OED improperly interpreted the term “semester hour,” and that “[o]ne semester unit is rather equivalent to more than one semester hours, especially in science courses.” Petitioner did not persuade OED with this argument, and on August 27, 2007, OED notified Petitioner that he did not meet the requirements for registration.

Petitioner requested reconsideration by OED on August 31, 2007. After reconsideration, on September 19, 2007, OED informed Petitioner that his request for reconsideration was denied.

On October 23, 2007, Petitioner filed a petition to the OED Director again arguing that he met the requirement of Category B because he had 30 semesters hours in physics. On November 30, 2007, the OED Director found that Petitioner had not qualified under the *USPTO General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office* (issued in June 2004, as updated in November 2005) (*General Requirements Bulletin*) and with the scientific and technical training requirements set forth in 37 C.F.R. § 11.7(a)(2).

The *General Requirements Bulletin* is published by USPTO to provide information and requirements to, in part, describe criteria that are generally sufficient to establish scientific and technical competence for admission to the examination. See *Premysler v. Lehman*, 71 F.3d 387, 388 (Fed. Cir. 1995). The *General Requirements Bulletin* provides that a petitioner may demonstrate the required competence by meeting the criteria of either Category A, B, or C. *General Requirements Bulletin* at 4-8. The OED Director found that Petitioner had not met the requirements for the following reasons:

Category A requires a Bachelor's Degree in one of thirty-two recognized scientific or technical subjects. *General Requirements Bulletin* at 3-4. The OED Director found that Petitioner's degree was not in a recognized subject.

Category B requires demonstrated scientific and technical training equivalent to that required by Category A by meeting the criteria of one of four Options. Specifically, under Option 1 a petitioner must demonstrate that he or she had earned twenty-four semester hours in physics. *General Requirements Bulletin* at 4. The OED Director found that Petitioner had not demonstrated the required semester hours.

Category C requires that, to rely on practical engineering or scientific experience, a petitioner must take and pass the Fundamentals of Engineering examination. *General Requirements Bulletin* at 7. The OED Director found that Petitioner had submitted no evidence that he had taken and passed that examination.

Because Petitioner did not meet any of the categories of the General Requirements Bulletin, the OED Director conducted an independent review for compliance with the scientific and technical training requirement set forth in 37 C.F.R.

§ 11.7(b)(2)(ii) and concluded that Petitioner had not provided sufficient evidence to demonstrate possession of the necessary qualifications.

Petitioner then filed this petition to the USPTO Director, by letter dated December 28, 2007, for review of the OED Director's final decision. In his petition, Petitioner did not challenge the OED Director's determinations under Categories A or C, but instead, reiterated his position that he had met the requirements under Category B.

II. LEGAL STANDARDS

35 U.S.C. § 2(b)(2)(D) states in pertinent part that the USPTO:

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 or other business before the Office. *Id.*

Pursuant to the statute, an applicant for registration to practice in patent cases before the USPTO bears the burden of showing that he possesses the necessary technical and scientific qualifications necessary to render patent applicants valuable service.⁴

These requirements are detailed in the *General Requirements Bulletin*.

OED staff initially evaluate applications for registration. At the applicant's request, these decisions may be reviewed by the OED Director.⁵ An individual dissatisfied with the final decision of the OED Director may petition the USPTO Director

⁴ "No individual will be registered to practice before the Office unless he or she has:....(2) Established to the satisfaction of the OED Director that he or she:...(ii) Possesses the ... scientific, and technical qualifications necessary for him to render applicants valuable service ..." 37 C.F.R. § 11.7(a)(2)(ii). See also *General Requirements Bulletin* at 3.

⁵ 37 C.F.R. § 11.2(c).

for review.⁶ The USPTO Director will consider no new evidence in deciding a petition for review.⁷

III. DISCUSSION

Petitioner's arguments warrant little discussion. He bears the burden of proving his qualifications, and he has not done so. In fact, Petitioner acknowledges that he does not qualify under Categories A or C. Erroneously, he asserts that he qualifies under Category B and does not argue that he otherwise qualifies. However, in order to qualify under Category B, he must have twenty-four semester hours in physics. *General Requirements Bulletin* at 4. The evidence in the record is ample that Petitioner does not meet that criterion.⁸

The statement from Mr. [redacted] saying that Petitioner had the equivalent of thirty hours in physics did not change the credit hours on Petitioner's transcript. Further, Mr. [redacted]'s statement is inconsistent with the description of credit hours in the LACC transcript. Based on this, the OED Director properly concluded Petitioner had eighteen hours of physics credit.

The OED Director properly determined that Petitioner does not currently possess the *scientific and technical qualifications to practice before the USPTO*. Petitioner's arguments otherwise are unpersuasive. Petitioner's appeal from the final decision of the OED Director should be denied.

⁶ 37 C.F.R. § 11.2(d).

⁷ *Id.*

⁸ Notably, Petitioner states in his petition to the USPTO Director that, "securing 24 hours semester units in physics only belongs to a four year university physics major." This statement appears to be a concession on his part that he does not meet the required criteria.

IV. CONCLUSION

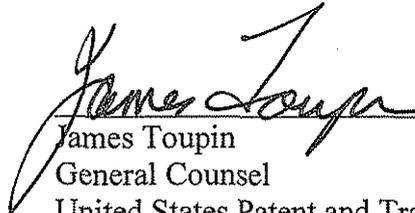
The OED Director properly determined that Petitioner has not established that he possesses the requisite technical and scientific qualifications for admission to examination. The OED Director's decision is hereby **AFFIRMED**.

ORDER

Upon consideration of the Petition to the USPTO Director for registration to practice before the USPTO in patent cases under 37 CFR § 10.6(a), 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

April 16, 2008
Date


James Toupin
General Counsel
United States Patent and Trademark Office

cc:

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