

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

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

**MEMORANDUM AND ORDER**

(Petitioner) petitions for review of a decision by the Acting Director of the Office of Enrollment and Discipline (Director). The Director's decision denied Petitioner's request to be admitted to the Examination for Registration to practice before the Patent and Trademark Office in patent cases to be held in August 1998, because he did not meet the scientific and technical requirements found in 37 C.F.R. § 10.7(a)(2)(ii). The petition is denied.

**BACKGROUND**

On March 3, 1998, Petitioner applied for the August 1998 registration examination. On May 15, 1998, Petitioner's application was rejected by Staff Attorney, Harry Moatz, for failure to attain the requisite scientific and technical training as described in 37 C.F.R. § 10.7.

On June 26, 1998, Petitioner petitioned the Commissioner under 37 C.F.R. § 1.181 requesting review of Mr. Moatz's decision.<sup>1</sup> In support, Petitioner submitted an "Affidavit of Applicant \_\_\_\_\_" setting forth evidence of his technical qualifications. The affidavit indicated that Petitioner had written the specification, prepared final formal drawings, and drafted

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<sup>1</sup> The petition was treated as a petition under 37 C.F.R. § 10.170 which permits the Commissioner to suspend or waive any requirement of the regulations of this part.

preliminary claims for U.S. Patents (Nos.

) under the supervision of a patent attorney.<sup>2</sup> Petitioner further stated that he machined and constructed working models of apparatus; he designed and reduced

to practice a ; he designed and built

; he designed

; he tested, for UL approval.

; he designed

; he serviced and repaired

; and, in , he prepared a syllabus and taught in association with

another teacher a course for a night school program on He also submitted

the following documents: declarations from

; a transcript from showing

completion of 22 semester hours; and a description of a <sup>3</sup>

On September 15, 1999, the Director denied the petition in a final decision because Petitioner did not meet any of the three categories for admission set out in the bulletin entitled "General Requirements for Admission to the Examination for Registration to Practice in Patent Cases Before the U.S. Patent and Trademark Office" (General Requirements Bulletin). The Director found that Petitioner did not qualify under Category A because Petitioner did not receive

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<sup>2</sup> The Affidavit is actually in the form of a Declaration, which is adequate for present purposes. See 37 C.F.R. § 1.68.

<sup>3</sup>The "Corroborating Statement from Applicant's Employer" filed with the Commissioner on October 15, 1999, was not considered because it was not part of the record made before the Director. See 37 C.F.R. 10.2(c).

a bachelor's degree. (Dir. dec. at 4). Regarding Category B, the Director noted that Petitioner failed to submit the descriptions for courses taken at *Id.* Moreover, even if the courses were accepted, the Director found that Petitioner's transcript from *Id.* would only demonstrate 8 semester hours of creditable chemistry courses and 4 semester hours of creditable physics hours. *Id.* at 5. In addition, the information concerning issued patents, the

®, and the declarations did not satisfy Category B because Petitioner did not present objective evidence which formed a correlation between the work experience or training with any of the acceptable courses. *Id.* at 6. The Director also found that Petitioner did not satisfy Category C because he did not pass the Fundamentals of Engineering (FE) test. *Id.* at 7.

Furthermore, the Director stated that Petitioner did not forward any evidence that would warrant suspension or waiver of the requirements set forth in the PTO regulations or in the General Requirements Bulletin. Therefore, Petitioner's request to be admitted to the registration examination was denied. *Id.* at 8.

On October 15, 1999, Petitioner filed the present petition for review.

### DISCUSSION

The Commissioner has the authority to regulate the recognition of and actions of agents and attorneys who conduct business before the Patent and Trademark Office (PTO). 35 U.S.C. § 31. Prior to being recognized as a representative for applicants or other persons conducting business before the Office, the Commissioner may require such individuals to show that they have the necessary qualifications to render to applicants or others valuable service, advice, and assistance in the presentation or prosecution of their applications before the PTO. *Id.* This

includes establishing to the satisfaction of the Director that he or she possesses the necessary scientific and technical qualifications. 37 C.F.R. § 10.7(a)(2)(ii).

However, not everyone is permitted to sit for the exam. The PTO has promulgated a set of guidelines in the General Requirements Bulletin which informs an applicant of the examination admission criteria. In 1998, an applicant needed to satisfy one of the following three categories. Category A requires a bachelor's degree in a recognized technical subject. (Dir. dec. at 4). Category B allows for a showing of a scientific and technical training equivalent to that received for a bachelor's degree in one of the Category A subjects. *Id.* To establish such equivalence, the applicant must submit a showing satisfying one of four options. *Id.* Option 1 - requires 24 semester hours in physics. *Id.* Option 2 - requires a combination of 24 semester hours in biological sciences and either 8 semester hours in chemistry or 8 semester hours in physics. *Id.* Option 3- requires 30 semester hours in chemistry. *Id.* Option 4- requires a combination of 40 semester hours of chemistry, physics, biological sciences, or engineering. Finally, Category C requires a passing score on the FE test. *Id.* at 5-7.

Although the General Requirements Bulletin assists the Director in determining which individuals are qualified to take the exam, it is not dispositive. *Premysler v. Lehman*, 71 F.3d 387, 390, 37 USPQ2d 1057, 1060 (Fed. Cir. 1995). If an applicant does not satisfy the criteria as outlined in the General Requirements Bulletin, he or she may still qualify for the exam if the Commissioner determines that the applicant possesses sufficient scientific and technical skills. *Id.* Here, Petitioner, admittedly, has not met any of the three enumerated Categories, A, B or C, set forth in the General Requirements Bulletin. Therefore, it is necessary to evaluate whether the

evidence presented by Petitioner established technical credentials equivalent to those set forth in the enumerated categories.

When considering an applicant's skills in the field of science and technology, the Commissioner will consider a list of factors including: (1) length of training with a patent attorney; (2) nature of supervision given by the patent attorney; (3) amount of supervision provided by the patent attorney; and (4) whether a summary of the applicant's experience is corroborated by any objective evidence. *Id.*

In the instant case, as evidence of his experience, Petitioner offered a number of documents. First, he submitted a personal affidavit indicating that he has prepared the specification, preliminary claims and drawings for nine pending or issued patents under the supervision of patent attorneys. Although Petitioner stated that he was under the supervision of a patent attorney when he drafted the pending or issued patents, he did not disclose whether he received any training. He also did not mention the nature and amount of any supervision given by the patent attorney.

Second, he has offered materials regarding devices he worked on. However, these documents are given little weight because they are not supported by objective evidence. Here again, there is no indication of the amount of training or supervision, if any, Petitioner received in putting the equipment together. Also, it cannot be determined what instruction or resources were given to Petitioner to assist in the development of his work. For example, the Director noted regarding , that it is unclear whether the schematic drawing was the result of independent development, or was "a straightforward application of information received from a semiconductor chip manufacturer in data sheets, application notes, or the like." (Dir. dec. at 6).

What Petitioner worked on could have been produced by selecting parts from an electronics catalog or manual. Creating electrical equipment in such a manner would require mere machine shop skills and not scientific or technical knowledge. Without a detailed explanation of where Petitioner learned about his field of work, what was required of him during his training, the amount of time spent on the training, the amount of supervision given, the title of the supervisor, the nature of the supervision, and what he learned from his training, it cannot be concluded that he possesses sufficient scientific and technical background to sit for the exam.

Furthermore, other evidence of record makes it appear that Petitioner did not receive any training for the work that he performed. According to \_\_\_\_\_ declaration, Petitioner learned his skills "without the benefit of formal training." Although it is commendable for Petitioner to have become acquainted with his work through self-study, the PTO selection criteria for admission to the examination requires individuals to demonstrate through corroborated objective evidence that they have basic scientific skills and technical training equivalent to one of the categories enumerated in the General Requirements Bulletin. Since Petitioner has failed to provide any corroborative evidence of such training, he cannot successfully assert that he has satisfied this requirement.

Third, Petitioner has furnished declarations from five individuals that Practitioner worked with in the past. These statements present the same difficulties noted above. None of these statements mentions any of these declarants supervising or training Petitioner in the relevant areas. Hence, the five declarations are conclusory and are not corroborated by any objective evidence.

Last, Petitioner has provided a transcript from \_\_\_\_\_ When enrolled as a student, it would appear that Petitioner completed 22 semester hours.<sup>4</sup> However, not all 22 semester hours are in the science or technical field. As noted by the Director, at most, Petitioner would receive "eight semester hours of creditable chemistry courses, and four semester hours of creditable physics hours." (Dir. dec. at 5). Having a total of 12 creditable semester hours is not sufficient to prove training equivalent to a bachelor's degree in one of the acceptable subject areas of Categories A or B. Under current PTO standards, an individual would need more credits to be able to prove that he or she can render valuable service to patent applicants based on such training. Further, the transcript indicates that Petitioner was on scholastic probation during his first year and second year, withdrew from classes towards the end of his second year, and was suspended for academic reasons during his third year.

Therefore, Petitioner has not shown that the knowledge he gleaned from his work, his interactions with others, or his schooling came from any scientific and technical training sufficient to be considered equivalent to a showing of one of the accepted categories set forth in the General Requirements Bulletin. As a result, Petitioner has failed to establish that he is qualified to sit for the registration examination, and that the Director's final decision should be reversed.

Moreover, on this record, Petitioner has not established circumstances amounting to an "extraordinary situation" when justice would require waiver of the admissions requirements for the examination set forth in the PTO regulations or the General Requirements Bulletin.

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<sup>4</sup>The transcript provided by Petitioner is difficult to decipher. More specifically, based upon the numerical grading system in effect at the time, it is unclear how the University arrived at the conclusion that Petitioner earned 22 semester hours of credit. However, since the University made that determination, the 22 semester hours will be accepted.

See 37 C.F.R. § 10.170. An extraordinary situation is generally one where "no meaningful alternatives are available." See *Margolis v. Banner*, 599 F.2d 435, 443, 202 USPQ 365, 373 (CCPA 1979). Here, Petitioner has alternatives of qualifying under Category C by taking and passing the FE test or by completing additional training sufficient to meet Categories A or B or their equivalent. Accordingly, there has been no showing that Petitioner should not be required to meet the same requirements for admission to the examination that other applicants must meet.

### **CONCLUSION**

Petitioner has not demonstrated any reversible error in the Director's decision that he does not meet any of the enumerated categories for admission to the exam set forth in the General Requirements Bulletin and that he has not established technical qualifications equivalent to such enumerated categories to warrant admission to the exam.

### **ORDER**

For the reasons given above, the petition requesting admission to the examination is denied.

This is a final agency action.

DEC 9 1999



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

Harry I. Moatz, Acting Director  
Office of Enrollment and Discipline