Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE APPLICATION OF JOHN DOE
December 4, 1992

Edward R. Kazenske

Executive Assistant to the Commissioner and Director of Interdisciplinary Programs

DECISION ON PETITION FOR REVIEW OF DIRECTOR'S DECISION ON APPLICATION TO TAKE
REGISTRATION EXAMINATION

I

***1** Petitioner requests review of the decision of the Director of the Office of Enrollment and Discipline (OED) dated August 25, 1992, on his application to take the registration examination. For the reasons stated below, the petition is denied.

II

Petitioner applied to sit for the registration examination held in October 1992. Petitioner's application was disapproved by OED. OED credited petitioner with 16.7 of the required minimum 40 semester hours of basic scientific and technical training. Petitioner requested reconsideration of OED's decision. On reconsideration, the Director disapproved petitioner's application, stating that petitioner had not demonstrated that he possesses the scientific and technical training required under 37 CFR § 10.7(a). Petitioner requests review of the Director's disapproval of his application to sit for the registration examination.

III

To qualify for admission to the registration examination, petitioner must establish to the satisfaction of the Director that he possesses the necessary scientific and technical qualifications. 37 CFR § 10.7(a)(2)(ii). Petitioner must establish the requisite scientific and technical training by satisfying one of Categories A, B, or C set forth in the General Requirements bulletin for the October 1992 examination. See "General Requirements for Admission to the Examination for Registration to Practice in Patent Cases Before the U.S. Patent and Trademark Office, October 1992 Examination" (hereinafter "General Requirements") at 2-3.

IV

Petitioner holds a bachelor's degree in social science from * * * University * * *. Social science is not recognized by the Patent and Trademark Office (PTO) as a technical subject. See "General Requirements," Category A at 2. Therefore, to qualify for admission to the examination, petitioner must establish that he possesses scientific and technical training equivalent to that received for a bachelor's degree in one of the recognized technical subjects. See "General Requirements," Category B at 2.

Under Option 4 in Category B, a combination of 40 semester hours of chemistry, physics, the biological sciences, or engineering will be accepted to establish the requisite scientific and technical training. See "General Requirements," Category B, Option 4 at 2. Furthermore, under Option 4, up to 16 of the minimum required 40 semester hours may be credited based upon a showing of scientific and technical training gained through a long apprenticeship with a registered patent attorney or patent agent. See "General Requirements," Category B, Option 4 at 3.

***2** Petitioner seeks reconsideration of the Director's failure to credit petitioner with 28 quarter hours or 18.7 semester hours for his mathematics coursework and 6 quarter hours or 4 semester hours for his computer science coursework. Petitioner further seeks reconsideration of the Director's failure to award him up to 16 semester hours of credit for his apprenticeship training.

Even if the Director had awarded petitioner credit for his computer science coursework and apprenticeship training, petitioner would still not meet the 40 semester hour requirement unless he received credit for at least some of his mathematics coursework. However, the Director did not accept petitioner's mathematics coursework as demonstrating the requisite scientific and technical training. Petitioner's mathematics coursework consists of 5 courses in mathematics and a course in statistics which is a branch of mathematics.

V

The Commissioner of Patents and Trademarks has the authority to establish regulations governing the recognition of agents and attorneys entitled to practice before the PTO. 35 U.S.C. § 31. Included in these regulations is a requirement that applicants to the registration examination establish that they are "[p]ossessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants for patents valuable service...." 37 CFR § 10.7(a)(2)(ii). Accordingly, to be admitted to the registration examination, applicants must demonstrate that they possess the requisite scientific and technical training which must be established by satisfying one of categories A, B, or C set forth in the General Requirements bulletin. See "General Requirements" at 2.

Applicants to the registration examination may establish the requisite scientific and technical training by receiving a bachelor's degree in one of the recognized technical subjects set forth in Category A or by satisfying one of the options set forth in Category B. See "General Requirements" at 2-3. The recognized technical subjects in

Category A are in the areas of chemistry, physics, the biological sciences, and engineering. See "General Requirements," Category A at 2. The areas of study which establish the requisite scientific and technical training in Option 4 of Category B are also chemistry, physics, the biological sciences, and engineering. See "General Requirements," Category B at 2. Thus, the areas of study which establish the requisite training are of the same general nature in both Category A and Option 4 of Category B.

Mathematics appears nowhere in either of these lists. In fact, the bulletin clearly states that mathematics courses "are not accepted as demonstrating scientific and technical training...." See "General Requirements," Category B, Option 4 at 3. It would be inconsistent to give credit for courses in mathematics under Option 4 of Category B when a degree in mathematics is not recognized as establishing the requisite scientific and technical training in Category A. Accordingly, the Director was correct in not accepting petitioner's mathematics and statistics courses as demonstrating the requisite training under 37 CFR § 10.7(a)(2)(ii).

***3** Without credit for these courses, petitioner's remaining courses and apprenticeship training do not satisfy the 40 semester hour requirement of Option 4. On that basis alone, the Director was correct in disapproving petitioner's application to take the registration examination.

VI

However, the Director also did not accept petitioner's computer science courses as demonstrating the requisite scientific and technical training under 37 CFR § 10.7(a)(2)(ii). OED indicated in a letter dated July 2, 1992, that computer programming courses are only acceptable as providing the requisite scientific and technical training if they include a laboratory. In his petition, petitioner states for the first time that ComputerScience Courses Nos. 120 and 300 each includes a laboratory (Petition at 2-3). However, no new evidence is considered on appeal from the Director. 37 CFR § 10.2(c). The time to demonstrate that the computer science courses include a laboratory was when the case was before the Director, not on appeal.

Moreover, the U course descriptions for Computer Science Courses Nos. 120 and 300 do not indicate that either of these courses includes a laboratory. Petitioner's statement is unsupported by any factual evidence that contradicts the U course descriptions for Computer Science Courses Nos. 120 and 300.

VII

Also, the Director did not accept petitioner's apprenticeship training as demonstrating the requisite scientific and technical training under 37 CFR § 10.7(a)(2)(ii). Petitioner, in a letter dated July 16, 1992, submitted a statement reflecting his apprenticeship training. The Director stated that petitioner's apprenticeship training

could not be properly evaluated since the statement failed to reflect whether the identified applications and amendments were filed in the PTO and the extent to which the applications and amendments filed in the PTO represented petitioner's own work product. In his petition, petitioner states for the first time that all of the applications and amendments identified in the apprenticeship training statement were filed in the PTO (Petition at 2). As pointed out above, no new evidence will be considered at this time. 37 CFR § 10.2(c). The Director cannot have erred by failing to consider evidence that was not given to him. Compare Keebler Co. v. Murray Baking Products, 866 F.2d 1386, 1388, 9 U.S.P.Q.2d 1736, 1738 (Fed.Cir.1989) ("Prescience is not a required characteristic of the board").

Moreover, the apprenticeship training statement identifies those patent applications and amendments drafted solely by petitioner and those patent applications "co-authored" by petitioner. The term "co-authored" is subject to many meanings and used alone, without other information, does not identify the contribution of each author. Petitioner has failed to identify the portion of each identified "co-authored" patent application which represents his own work product.

***4** Petitioner has also failed to indicate when he worked on the identified applications and amendments. It is noted that 8 hours is the maximum which may be credited in one year based upon a showing of scientific and technical training gained through an apprenticeship. See "General Requirements," Category B, Option 4 at 3.

Furthermore, to the extent that petitioner is relying on practical engineering or scientific experience obtained through his apprenticeship training to establish the requisite scientific and technical qualifications, OED will not evaluate and award credit for such practical experience. See "General Requirements," Category B, Option 4 at 3. If petitioner intends to rely on his practical experience to establish the requisite scientific and technical qualifications, petitioner may establish the requisite scientific and technical qualifications by taking and passing the Engineer-in-Training (EIT) test. See "General Requirements," Category C at 3.

Petitioner has pointed to no error on the Director's part in failing to award 16 semester hours for his apprenticeship training or 4 semester hours for his computer science courses.

VIII

For the reasons stated above, the petition is denied.

26 U.S.P.Q.2d 1235

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