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Rule-Making Petition Concerning Eligibility, under 37 C.F.R. § 11.7 to Sit for the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Administrative Procedure Act
Rule-Making Petition**

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property and
Director, United States Patent and Trademark Office
Alexandria, Virginia 22313-1450

Concerning Eligibility, under 37 C.F.R. § 11.7 }
to Sit for the Examination for Registration }
to Practice in Patent Cases Before the }
United States Patent and Trademark Office }

This Petition under 5 U.S.C. § 553(e)¹ is filed on behalf of Petitioner and other parties with legally-cognizable interest (hereafter “Signatories”)² in the specification of credentials under guidelines promulgated by the PTO Office of Enrollment and Discipline (“OED”)³ and amended from time without public notice or opportunity to comment. Signatories include individuals likely to be unfairly refused permission to sit, individuals whose status is uncertain, and professors with an interest in whether their students may or may not be permitted to sit. Signatories hereby request that the PTO, in accordance with 35 U.S.C. § 2(b)(2)(D), amplify the qualifications sufficient to sit for the Examination for Registration to Practice Before the PTO (37 C.F.R. § 11.7(a)(2)(ii)).

This petition is accompanied by the declaration of Professor Stanley C. Eisenstat, pointing out the serious shortcomings of the standards applicable to candidates trained in computer science.

¹ This and other cited statutory and regulatory materials are quoted in Appendix A.

² Signatories are listed and briefly identified in Appendix B.

³ 2005 General Requirements Bulletin (quoted in part *infra*, and in Appendix A).

Reasons for Submitting this Petition

Specifically

On July 5, 1989, the Chair of the American Bar Association, Section of Patent, Trademark and Copyright Law, Subcommittee on Software Patent Protection to the Computer Law Committee made a request of the PTO.⁴ The Chair requested that patent attorneys having earned a Bachelors Degree, or the equivalent, in computer science be permitted to sit for the Registration Examination (hereafter “PTO Exam”). Despite what were, even then, compelling reasons, Commissioner Donald J. Quigg only six days later denied that informal request.⁵

Since that time, however, and as reflected in the General Requirements Bulletin (hereafter “Bulletin”) published by OED, the PTO has acknowledged the need for examiners, agents, and attorneys schooled in computer science. Nonetheless, for reasons that are unclear because the OED seems not to have published its rationale, computer science graduates may now sit for the PTO Exam only if their program has been:

accredited by the Computer Science Accreditation Commission (CSAC) of the Computing Sciences Accreditation Board (CSAB), or by the Computing Accreditation Commission (CAC) of the Accreditation Board for Engineering and Technology (ABET), on or before the date the degree was awarded.⁶

Petitioner submits that under 5 U.S.C. § 553, the rulemaking provision of the Administrative Procedure Act (hereafter “APA”), the public has a right to be afforded an

⁴ David Bender, Current Developments in Software Patents, Appendix 2 (PLI 1990), *reprinted in* Michelle J. Burke & Thomas G. Field, Jr., *Promulgating Requirements for Admission to Prosecute Patent Applications*, 36 *Idea* 145, 157 (1995) — revised online at <http://www.piercelaw.edu/tfield/ptoexam.htm> (visited Dec. 5, 2005).

⁵ *Id.*

⁶ 2005 General Requirements Bulletin, 6.

opportunity for public comment and to know the reasons supporting such criteria before rules of that kind are adopted. Also, although it would seem to be unnecessary, 35 U.S.C. § 2(b)(2)(D) states that the aforesaid APA rulemaking provision is applicable to the PTO. This matter is particularly compelling because institutions that confer “approved” degrees other than in computer science, most remarkably including those conferring degrees in computer engineering, appear to be subject to no such accreditation requirements.

Generally

Since adoption of the APA, the PTO has often conducted notice and comment rule making even for exempt rules.⁷ The PTO also recently conducted APA-compliant rule making before changing rules regarding the computerized administration of the PTO Exam.⁸ It is surprising, therefore, that the PTO does not regard rules regarding the requirements sufficient to sit for the PTO Exam as warranting notice and comment rule making. These are far more significant from the perspective of the Signatories. The need for close attention to rules applicable to sitting for the PTO Exam was made even more compelling by *Ex parte Lundgren*.⁹ That decision, and the Federal Circuit decisions cited therein, have substantially revised the rules applicable to the patentability of computer-based inventions.

Petitioner recognizes that the PTO may regard its methodology for establishing criteria for sitting for the PTO Exam as having been endorsed by the *Premysler* decision.¹⁰ Close

⁷ See generally, Herbert C. Wamsley, *The Rulemaking Power of the Commissioner of Patents and Trademarks*, 64 J.P.O.Soc’y 490, 539 and 604 (in three parts) (1982).

⁸ 69 F.R. 35428 (2004). As stated, *id.* at 35429, however, “The new rules do not change the scientific and technical training for registration.”

⁹ 76 U.S.P.Q.2d 1385, 1388 (BPAI 2005) (expanded panel) (“[T]here is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under §101.”).

¹⁰ *Premysler v. Lehman*, 71 F.3d 387 (Fed. Cir. 1995).

reading of that and the decision it affirms reveals, however, that the Federal Circuit upheld the admissions practice of the PTO in that case precisely because the Commissioner's review was more probing than that of the OED.¹¹ Indeed, the Federal Circuit upheld the Commissioner's decision only because Premysler's credentials were reviewed by a process starkly different from that described by the OED in the Bulletin. It is also significant that Premysler's credentials were reviewed by a process far more probing than any candidate could reasonably expect from anything suggested there.¹²

The PTO has been granted under 5 U.S.C. § 500(e) and 35 U.S.C. § 2(b)(2)(B) authority to administer its own PTO Exam before practitioners may appear before it—and then only in matters of patent prosecution. That authority is unique among federal agencies as revealed by the remainder of 5 U.S.C. § 500. That makes it all the more important that such authority be exercised with full regard to its effects on the Signatories and others affected by it. Moreover, § 2(b)(2)(B) is arguably unique in conferring substantive authority otherwise generally denied to the PTO.¹³ That procedural rules are exempt from APA rulemaking requirements does not justify an enduring failure to satisfy obligations for substantive rules recently reinforced by enactment of 35 U.S.C. § 2(b)(2)(D).

Conclusion

Petitioner asks, on behalf of all the Signatories, that the PTO grant this Petition. Petitioner urges the PTO to conduct now, and hereafter, notice and comment rulemaking to

¹¹ See, e.g., *Premysler v. Lehman*, 33 U.S.P.Q.2d 1859, 1860 (D.D.C. 1994):

By letter, the Director of the Office of Enrollment and Discipline ("Director") rejected his appeal because Premysler failed to qualify under any of the categories listed in the General Requirements for the April 1993 examination. Premysler appealed the Director's decision to the Commissioner of the PTO. Before making a final ruling, the Commissioner issued an interlocutory decision rejecting the Director's reasons for not accepting Premysler's application, but accepting the Director's result. (Citations omitted.)

¹² *Id.*

¹³ See, e.g., *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930-31 (Fed. Cir. 1991) (referring to provisions equivalent to current 35 U.S.C. § 6).

amplify the legal, scientific, and technical qualifications sufficient to sit for the Examination for Registration to Practice Before the PTO.

Respectfully submitted.

Feb. 3, 2006

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Appendix A — Referenced statutory and administrative provisions.

5 U.S.C. § 500 Administrative practice; general provisions

...

(b) An individual who is a member in good standing of the bar of the highest court of a State may represent a person before an agency on filing with the agency a written declaration that he is currently qualified as provided by this subsection and is authorized to represent the particular person in whose behalf he acts.

(c) An individual who is duly qualified to practice as a certified public accountant in a State may represent a person before the Internal Revenue Service....

(d) This section does not—

(1) grant or deny to an individual who is not qualified as provided by subsection (b) or (c) of this section the right to appear for or represent a person before an agency or in an agency proceeding;

(2) authorize or limit the discipline, including disbarment, of individuals who appear in a representative capacity before an agency;

(3) authorize an individual who is a former employee of an agency to represent a person before an agency when the representation is prohibited by statute or regulation; or

(4) prevent an agency from requiring a power of attorney as a condition to the settlement of a controversy involving the payment of money.

(e) Subsections (b)-(d) of this section do not apply to practice before the United States Patent and Trademark Office with respect to patent matters that continue to be covered by chapter 3 (sections 31-33) of title 35.

5 U.S.C. § 553 Rule making

....

(b) General notice of proposed rule making shall be published in the Federal Register, unless persons subject thereto are named and either personally served or otherwise have actual notice thereof in accordance with law. The notice shall include —

- (1) a statement of the time, place, and nature of public rule making proceedings;
- (2) reference to the legal authority under which the rule is proposed; and
- (3) either the terms or substance of the proposed rule or a description of the subjects and issues involved.

Except when notice or hearing is required by statute, this subsection does not apply —

(A) to interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice; or....

(c) After notice required by this section, the agency shall give interested persons an opportunity to participate in the rule making through submission of written data, views, or arguments with or without opportunity for oral presentation.

(e) Each agency shall give an interested person the right to petition for the issuance, amendment, or repeal of a rule.

35 U.S.C. § 2(b) Specific powers. The Office—

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

(B) shall be made in accordance with section 553 of title 5;

(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 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....

37 C.F.R. § 11.7 Requirements for registration.

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

(1) Applied to the PTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

- (i) Possesses good moral character and reputation;
- (ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service;

General Requirements Bulletin,.6 (2005)

A. CATEGORY A: Bachelor's Degree in a Recognized Technical Subject.

An applicant will be considered to have the necessary scientific and technical training if he or she provides an official transcript showing that a Bachelor's degree was awarded in one of the following subjects by an accredited United States college or university, or that the equivalent to a Bachelor's degree was awarded by a foreign university in one of the following subjects:

Biology[,] Biochemistry[,] Botany[,] Computer Science*[,] Electronics Technology[,] Food Technology... Textile Technology[,] Aeronautical Engineering[,] Agricultural Engineering[,] Biomedical Engineering[,] Ceramic Engineering[,] Chemical Engineering[,] Civil Engineering[,] Computer Engineering....

*Acceptable Computer Science degrees must be accredited by the Computer Science Accreditation Commission (CSAC) of the Computing Sciences Accreditation Board (CSAB), or by the Computing Accreditation Commission (CAC) of the Accreditation Board for Engineering and Technology (ABET), on or before the date the degree was awarded. Computer science degrees that are accredited may be found on the Internet (<http://www.abet.org>).

Appendix B — Signatories to the petition.

Professors

Stanley C. Eisenstat, Computer Science Department, Yale University

Thomas G. Field, Jr., Franklin Pierce Law Center

Llewellen J. Gibbons, University of Toledo College of Law

Craig S. Jepson, Franklin Pierce Law Center

David Hricik, Mercer University School of Law

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Katherine J. Strandburg, DePaul University College of Law

Law students and lawyers

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Nicholas Barnes
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Rebecca Crandall
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Ryan Hawkins
Justin Kee
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Eric Martineau
Thomas McGinnis
Jakub Michna
Alicia Novi
Anthony Poleski
Eugene R. Quinn, Jr.
Christopher Reed
Evan Simon
Sarah Small
Adam Ullman
Matthew Winterroth
Kate Winstanley