



UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY - 2 2006

GENERAL COUNSEL

Thomas G. Field, Jr.  
Professor of Law  
Franklin Pierce Law Center  
2 White Street  
Concord, NH 03301

Re: Petition concerning eligibility to sit for the USPTO's Registration Exam

Dear Professor Field:

As the official delegated authority to act for the Under Secretary for Intellectual Property and Director of the United States Patent Office (USPTO) concerning attorney enrollment and discipline matters, I have been asked to respond to your February 3, 2006 petition submitted under 5 U.S.C. § 553(e). Your petition requests that the USPTO "conduct . . . notice and comment rulemaking to amplify the legal, scientific, and technical qualifications sufficient to sit for the Examination for Registration to Practice before the PTO."

As an initial matter, we note that your petition lists a number of "signatories," but neither is signed by those persons nor indicates that you have been authorized to petition the USPTO on their behalf. Even assuming, however, that you have been so authorized, or that a law professor with students who may apply for admission to practice before the USPTO is an "interested person" as that term is used in § 553(e), your petition must be denied for the reasons set forth below.

As you are aware, the basic standards for admission to the USPTO's registration examination are established by 37 C.F.R. § 11.7(a) and (b). These basic standards are interpreted by the General Requirement Bulletin (Bulletin), an interpretive rule issued and periodically updated by the USPTO's Office of Enrollment and Discipline. Given this regulatory context, your petition is somewhat difficult to categorize.

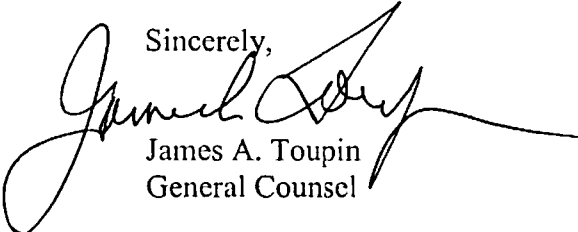
To the extent your petition requests that the USPTO amend the Bulletin, it is not legally cognizable. The requirement of 5 U.S.C. § 553(e) that an agency entertain a petition to issue, amend, or repeal a rule does not apply to interpretive rules. See Atchison, Topeka And Santa Fe Railway Company v. Pena, 44 F.3d 437, 442 (7<sup>th</sup> Cir. 1994); United Transportation Union v. Delaware and Hudson Railway Co., 977 F.Supp 570, 574, n. 2 (N.D.NY 1997); National Wrestling Coaches Association v. Dep't of Education, 263 F.Supp. 82, 128 (D.DC 2003).

To the extent your petition asserts that the USPTO was required to promulgate the General Requirements Bulletin (Bulletin) through notice and comment rulemaking, it fails as a matter of law. The Court of Appeals for the Federal Circuit has held that the USPTO's General Requirement Bulletin is an interpretive rule to which the notice and comment requirements of 5 U.S.C. § 553 do not apply. Premysler v. Lehman, 71 F.3d 387, 390 (1995).

You assert that the Premysler decision should not control consideration of your petition because 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." However, the USPTO's current process for assessing applicants' qualifications is substantially unchanged from that considered in Premysler. In the specific case cited in your petition, it would apply as follows: An applicant with a computer science degree from an accredited program, or whose coursework otherwise satisfies the guidelines set forth in the Bulletin, would ordinarily be considered to satisfy the legal, scientific, and technical qualifications required by 37 C.F.R. § 11.7. An applicant with a computer science degree who does not meet the specific guidelines set forth in the Bulletin could submit an application asserting that he or she nonetheless possesses the requisite legal, scientific and technical qualifications. If, after being given an opportunity to overcome any cited shortcomings, the applicant is denied admission to the examination, the applicant could petition the OED Director to review the decision. The OED Director would consider such a petition on its merits, and if the OED Director's decision were unfavorable, the applicant could petition for review under 37 C.F.R. § 11.2(d).

This process is identical in all material ways to that considered in Premysler, and indeed the Bulletin's description of the process remains essentially unchanged. Accordingly, the USPTO continues to regard the process for developing the bulletin as fully in accordance with existing law. Further, the constantly changing nature of invention points to the USPTO's need, while giving general guidelines through the Bulletin, to conduct individualized assessments of applications for registration, rather than binding itself and its applicants through rigid rules implemented by notice-and-comment rulemaking.

For the above reasons, your February 3, 2006 petition is denied.

Sincerely,  
  
James A. Toupin  
General Counsel