No. 06-338

In the Supreme Court of the United States

CATHERINE LACAVERA, PETITIONER

v.

JONATHAN W. DUDAS, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

PAUL D. CLEMENT
Solicitor General
Counsel of Record
PETER D. KEISLER
Assistant Attorney General
ANTHONY J. STEINMEYER
ANNE MURPHY
Attorneys
Department of Justice
Washington, D.C. 20530-0001
(202) 514-2217

QUESTIONS PRESENTED

The United States Patent and Trademark Office (PTO) has issued a regulation that authorizes attorneys who are admitted to the United States as temporary residents, with employment restrictions on their visas, to practice before PTO under terms that incorporate those visa restrictions. The questions presented are:

1. Whether that regulation falls within PTO's statutory authority to issue regulations to "govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. 2(b)(2)(D).

2. Whether that regulation violates the equal protection component of the Due Process Clause.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases:

Constitution, statute and regulations:

Miscellaneous: Page

In the Supreme Court of the United States

No. 06-338

CATHERINE LACAVERA, PETITIONER

v.

JONATHAN W. DUDAS, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 3a-9a) is reported at 441 F.3d 1380. The order and memorandum opinion of the district court (Pet. App. 10a-11a, 12a-27a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on February 6, 2006. A petition for rehearing was denied on June 5, 2006 (Pet. App. 1a-2a). The petition for a writ of certiorari was filed on September 5, 2006. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. Congress has delegated to the United States Patent and Trademark Office (PTO) authority to issue regulations that "govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. 2(b)(2)(D). Congress has further delegated to PTO authority to require such representatives, before being recognized, "to show that they are of good moral character and reputation and 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." *Ibid.*

In the exercise of that statutory authority, and pursuant to notice-and-comment rulemaking procedures, PTO has issued regulations establishing standards for attorneys who practice before it. 37 C.F.R. 11.6-11.9. One of those regulations specifies that "[a]ny citizen of the United States who is an attorney and who fulfills [the applicable] requirements * * * may be registered as a patent attorney to practice before the Office." 37 C.F.R. 11.6(a). That same regulation provides that "[w]hen appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills [the applicable] requirements * * * may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States."

Another PTO regulation specifies that "[a] nonimmigrant alien residing in the United States and fulfilling [the applicable requirements] * * * may be granted

limited recognition if the nonimmigrant alien is authorized by the Bureau of Citizenship and Immigration Services to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application." 37 C.F.R. 11.9(b). Such "[l]imited recognition shall be granted for a period consistent with the terms of authorized employment or training." *Ibid.* The limited-recognition regulation does not otherwise limit the activities that an attorney may undertake. *Ibid.* Accordingly, apart from compliance with his or her visa requirements, an attorney who practices before PTO under limited recognition practices just like any other recognized practitioner. He or she may prosecute patent applications, hold examiner interviews, and represent applicants before the Board of Patent Appeals and Interferences.

2. a. Petitioner is a citizen of Canada. Pet. App. 5a. In 2001, the Immigration and Naturalization Service (INS) granted her a one-year "TN" visa that allowed her to live in the United States and to prepare and prosecute patent applications only at the New York offices of the law firm of White and Case. *Id.* at 6a. After passing PTO's registration examination, petitioner was granted limited recognition to practice before PTO on terms consistent with her visa status. *Ibid.*

In 2003, after obtaining extensions of her TN visa, petitioner obtained an H-1B visa. Pet. App. 6a. That three-year visa identified a new employer, Google, Inc. Petitioner's sole approved employment under her H-1B visa was the preparation and prosecution of patent applications for Google. *Ibid.* PTO adjusted the terms of petitioner's limited recognition as her visa status changed, allowing her to practice before it to the extent permitted by her new visa. *Ibid.*

b. In July 2002, petitioner initiated administrative proceedings against PTO, seeking authorization to practice before PTO without regard to her visa restrictions. Pet. App. 6a. PTO's Office of Enrollment and Discipline denied petitioner's request for full recognition. *Id.* at 38a-51a. The Office Director explained that petitioner's request was inconsistent with the TN status included in her visa. *Id.* at 44a. In particular, full recognition "is not limited in time, or to a particular employer, or to conditions imposed by the INS," whereas petitioner was authorized "to stay in the United States for only [a] limited period of time, cannot be self-employed, and is prohibited from changing or acquiring new employers without first obtaining the consent of the INS." *Ibid.*

c. The Director of PTO affirmed the Office Director's decision. Pet. App. 28a-37a. The PTO Director concluded that full recognition "would provide petitioner with PTO approval of work tha[t] she cannot lawfully do under her TN visa, making that recognition inconsistent with the terms of her visa." *Id.* at 33a. The PTO Director rejected petitioner's argument that PTO lacked authority to take her visa restrictions into account because the restrictions could be enforced by immigration officials. The PTO Director explained that PTO "is not looking for guarantees from other sources" that practitioners will perform only legally authorized work, but instead "must assure that the terms of the recognition itself provide the guarantee." *Ibid.* The PTO Director added that PTO "has a legitimate interest in ensuring that it does not provide Petitioner with the cover to hold herself out as something she truly is not." *Id.* at 34a.

3. Petitioner sought review of PTO's final decision in the United States District Court for the District of Co-

lumbia. Pet. App. 6a. The district court granted summary judgment for PTO. *Id.* at 12a-27a.

The district court first rejected petitioner's contention that PTO lacked authority under the regulations to deny petitioner full recognition. The court noted that the regulations provide that full recognition may not be granted when it is inconsistent with the terms upon which an alien is admitted into the country. Pet. App. 22a. And it agreed with PTO that granting petitioner full recognition would be inconsistent with the terms of her visa. *Ibid.*

The court also rejected petitioner's contention that PTO lacked statutory authority to deny her full recognition. The court concluded that PTO's full-recognition and limited-recognition regulations fell within PTO's statutory authority to establish regulations that govern the recognition and conduct of attorneys who practice before it. Pet. App. 23a-25a.

Finally, the district court rejected petitioner's equal protection claim. Pet. App. 25a-26a. The court explained that PTO has a rational basis for denying full recognition to petitioner and other persons with work restrictions. In particular, "[i]f petitioner were granted full recognition, she would be authorized by the [PTO] to engage in the practice of law beyond that which she can otherwise lawfully do under her visa restrictions." *Id.* at 26a.

4. The court of appeals affirmed. Pet App. 3a-9a. The court rejected petitioner's contention that PTO abused its discretion under the regulations in denying petitioner full recognition. The court explained that "[b]ecause granting [petitioner] full registration would have given her PTO approval to do work in which she could not lawfully engage, * * * granting her full reg-

istration was inconsistent with the terms of her visa." *Id.* at 8a.

The court of appeals next rejected petitioner's contention that PTO lacked statutory authority to deny petitioner full recognition. Pet. App. 8a. The court explained that PTO has statutory authority to require applicants to demonstrate that they possess the "necessary qualifications," and that "[i]t was reasonable for the PTO to interpret legal authority to render service as being a necessary qualification." *Id.* at 9a.

Finally, the court of appeals rejected petitioner's argument that she had been denied equal protection. The court noted that petitioner had "offered no evidence that she was treated unequally as compared to other aliens with visa restrictions." Pet. App. 9a. Applying rational basis review, the court then concluded that there was a rational basis for denying full recognition to aliens with visa restrictions: "minimizing the unauthorized practice of law before the PTO and its attendant public harm." *Ibid.*

5. On October 4, 2006, after her petition for a writ of certiorari was filed, petitioner advised PTO that she had been granted permanent residency status on September 25, 2006. Letter from Catherine Lacavera, IP Litigation Counsel, Google Inc., to Harry I. Moatz, Director of Enrollment and Discipline, U.S. Patent and Trademark Office. As a permanent resident, petitioner became eligible for full recognition. 37 C.F.R. 11.6(a). On December 11, 2006, PTO granted petitioner full recognition. Letter from Shirley A. Martin, Enrollment Program Specialist, Office of Enrollment and Discipline, U.S. Patent and Trademark Office, to Catherine C. Lacavera (Dec. 15, 2006).

ARGUMENT

The court of appeals' decision upholding PTO's limited-recognition regulation is correct. It does not conflict with any decision of this Court or of any other court of appeals. Moreover, because of petitioner's change in status to a permanent resident, the PTO has granted petitioner the full recognition that she seeks. Review by this Court is therefore not warranted.

1. Petitioner contends (Pet. 10-13) that PTO lacks statutory authority to deny full recognition to an attorney based on the work limitations in her visa. That contention is without merit and does not warrant review.

Congress has given PTO authority to "govern the recognition" and establish the "necessary qualifications" of the professionals who practice before it. 35 U.S.C. 2(b)(2)(D). Pursuant to that authority, PTO has decided that an attorney does not possess the "necessary qualifications" for full recognition when such recognition would allow the attorney to exceed the limitations in the attorney's work visa. In that circumstance, PTO does not exclude the attorney from practicing before the agency. Instead, it affords the attorney limited recognition that allows the attorney to practice before PTO to the extent consistent with the limitations in the attorney's visa.

The facts of this case illustrate how that standard is applied. Petitioner's visa limited her to practicing law for a particular employer for a specified period. Rather than give petitioner full recognition, which would have allowed her to practice before the agency on her own, and for an undefined period, PTO instead gave petitioner limited recognition, which allowed petitioner to practice before it as long as she was performing work in accordance with the limitations in her visa.

Under *Chevron U.S.A. Inc.* v. *NRDC*, 467 U.S. 837, 844 (1984), PTO's approach to implementing its statutory authority must be upheld as long as it is reasonable. That standard was satisfied here. As the court of appeals explained, "it was reasonable for the PTO to interpret legal authority to render service as being a necessary qualification," and "it was reasonable for the PTO to enact regulations that limit an alien's ability to practice before it to those activities in which the alien may lawfully engage." Pet. App. 9a.

Petitioner errs in contending (Pet. 11-12) that PTO's regulation encroaches on the authority of the Department of Homeland Security (DHS) to enforce visa restrictions. When PTO takes into account an attorney's visa restrictions, it neither interprets nor enforces the immigration laws. Rather, PTO accepts DHS's determinations of the attorney's work restrictions. PTO merely conforms the scope of the applicant's recognition to those restrictions.

Moreover, in limiting an attorney's recognition to the activities in which the attorney may lawfully engage, PTO is furthering its own legitimate interests in regulating the practice of attorneys who appear before it. As PTO has explained, "the [PTO] has a legitimate interest in ensuring that it does not provide Petitioner with the cover to hold herself out as something she truly is not." Pet. App. 34a. The court of appeals therefore correctly concluded that, in limiting nonimmigrant-alien attorneys to the activities in which they may lawfully engage, PTO acted within its statutory authority.

2. Petitioner contends (Pet. 13-16) that PTO's limited-recognition rule violates equal protection. That contention is likewise without merit and does not warrant review.

a. There is no merit to petitioner's contention (Pet. 14) that heightened scrutiny applies to PTO's rule limiting nonimmigrant aliens to lawful work activities. Under *Mathews* v. *Diaz*, 426 U.S. 67 (1976), alienage classifications imposed by the federal government are not subject to heightened scrutiny. Instead, such restrictions are reviewed under a standard that is akin to rational basis review. *Id.* at 81-84.

Heightened scrutiny is particularly unwarranted here. PTO's limited recognition of petitioner simply tracks the work limitations on petitioner's visa, and petitioner does not challenge the constitutionality of the visa restrictions. There cannot possibly be anything constitutionally suspect about a rule that limits an attorney to the activities that the attorney may lawfully perform.

Petitioner contends (Pet. 15-16) that heightened scrutiny is required under *Hampton* v. *Mow Sun Wong*, 426 U.S. 88 (1976). In that case, the Court held that a Civil Service Commission regulation that barred all aliens from federal employment violated due process. *Id.* at 116-117. The Court reasoned that the Civil Service Commission's only concern was in "the promotion of an efficient federal service," that "it is fair to assume that its goal would be best served by removing unnecessary restrictions on the eligibility of qualified applicants for employment," and that "administrative convenience" did not provide a sufficient "rational basis" for the rule in light of the "wholesale deprivation of employment opportunities caused by the Commission's indiscriminate policy." *Id.* at 114-116.

That analysis has no application here. The regulation at issue in this case does not create a wholesale deprivation of employment opportunities through an indiscriminate policy aimed at all aliens. Instead, it allows

nonimmigrant aliens to practice before PTO; it simply does so through a tailored policy that limits the attorneys to the activities that they may lawfully perform under their visas. The circumstances that led to the invalidation of the rule in *Hampton* are therefore entirely absent here.

Petitioner also errs in contending (Pet. 16) that the heightened scrutiny question presented in this case is "analogous" to the question presented *Leclerc* v. *Webb*, No. 06-11 (filed June 22, 2006), and *Wallace* v. *Calogero* No. 05-1645 (filed June 23, 2006). The petitions in those cases pose the question presented as whether strict scrutiny applies to a *state law* rule that denies nonimmigrant aliens admission to the state bar. This case involves a *federal law* rule, not a state law rule. And while the rule at issue in *Leclerc* and *Wallace* effects a complete denial of the opportunity to obtain a license to practice law in the State, the rule at issue here merely limits an attorney's activities before PTO to those the attorney may lawfully perform under his or her visa. There is therefore no reason to hold the petition in this case pending the disposition of the petitions in *Leclerc* and *Wallace*.[1]

b. Petitioner's remaining equal protection arguments are also without merit. Petitioner contends (Pet. 17) that the court of appeals erred in holding that PTO's limited-recognition rule does not violate equal protection because it treats all nonimmigrants the same. That contention rests on a mischaracterization of the court of appeals' decision. The court of appeals noted that petitioner offered no evidence that she was treated any dif-

[1] The Court has issued an order inviting the Solicitor General to file a response to the petitions in *Leclerc* and *Wallace*. That response has not yet been filed.

ferently from other nonimmigrant attorneys with work restrictions. Pet. App. 9a. But it did not reject petitioner's equal protection claim solely on that basis. Instead, the court of appeals rejected petitioner's equal protection claim only after applying rational basis review and concluding that PTO's rule is rationally related to a legitimate government interest. *Ibid.*

Petitioner contends (Pet. 18) that there is no rational basis for PTO's rule. But as the court of appeals explained, PTO's rule is rationally related to the legitimate government interest of "minimizing the unauthorized practice of law before the PTO and its attendant public harm." Pet. App. 9a.

Petitioner argues (Pet. 18-19) that there is "no evidence" to support the conclusion that PTO's rule serves to minimize the unauthorized practice of law. That argument misunderstands the nature of rational basis review. Under the rational basis standard, PTO was not required to supply evidence to support its rule. It is enough that PTO could reasonably presume that its rule would help to achieve its desired goal. *Mathews*, 426 U.S. at 83. That standard was satisfied here. PTO could reasonably presume that its rule would help to ensure that nonimmigrant attorneys would confine their activities on matters before the agency to those that the attorneys may lawfully pursue under their visas. The court of appeals therefore correctly rejected petitioner's equal protection claim, and review of that issue is not warranted.

3. Review is also not warranted in this case because of events that have transpired since the decision below. On October 4, 2006, petitioner informed PTO that she had been granted permanent residency on September 25, 2006. Letter of Oct. 4, 2006, *supra*. As a permanent

resident, petitioner became eligible for full recognition. 37 C.F.R. 11.6(a). On December 11, 2006, PTO granted petitioner full recognition. Letter of Dec. 15, 2006, *supra*. Whether or not petitioner's change in status and her receipt of full recognition make her challenge to the limited-recognition rule at issue in this case moot, it eliminates the rule's practical effect on her and makes this case a particularly inappropriate vehicle for resolving the challenges to the rule that petitioner seeks to present.[2]

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

PAUL D. CLEMENT
Solicitor General

PETER D. KEISLER
Assistant Attorney General

ANTHONY J. STEINMEYER
ANNE MURPHY
Attorneys

JANUARY 2007

---

[2] For the reasons explained in text, this case is not worthy of review regardless of whether the case is now moot. Accordingly, there would be no reason for this Court to grant the petition for a writ of certiorari and vacate the judgment below even if the Court were to conclude that the case is moot. Compare, *e.g.*, *Velsicol Chem. Corp.* v. *United States*, 435 U.S. 942 (1978) (denying certiorari), with, *e.g.*, *United States* v. *Munsingwear, Inc.*, 340 U.S. 36, 39-41 (1950) (discussing vacatur on grounds of mootness); see U.S. Br. in Opp. at 4-11, Velsicol, *supra* (No. 77-900); Robert L. Stern et al., *Supreme Court Practice* 327, 830 & n.30 (8th ed. 2002).