

In re _____)
)
) **Decision on Request**
) **for Reconsideration of**
) **Commissioner's Petition Decision**
) **and Request for Fee Refund**
 _____)

(“Petitioner”) sent a facsimile to the Director of the Office of Enrollment and Discipline (“Director”) arguing that his petition for review of the Director’s decision on regrade of the afternoon section of the August 1997 examination is not moot. Petitioner requests reimbursement for the August 1998 examination fee incurred in his efforts to be admitted to practice before the Patent and Trademark Office (PTO) in patent matters. The request is denied.

The August 1997 registration examination required an applicant for registration to practice before the PTO in patent matters to achieve a passing grade of 70 on both the morning and afternoon sections of the registration examination. Petitioner sat for the August 1997 registration examination. In January 1998, Petitioner received a notice of the results informing him that he failed the afternoon section of the examination with a score of 66. On February 19, 1998, the Director received Petitioner's request under 37 CFR § 10.7(c) for regrade of the afternoon section of his examination. Instead of waiting to receive the results of the request for regrade, Petitioner applied and sat for the August 1998 registration examination. In August 1998, the Director issued a decision on the § 10.7(c) request for regrade refusing to award additional points.

On October 7, 1998, the PTO received a petition to the Commissioner under 37 CFR § 10.2(c) for review of the Director's decision. Petitioner was subsequently notified that he passed the August 1998 examination. On April 9, 1999, the Commissioner dismissed as moot Petitioner's petition for review of the Director's regrade decision.

On May 17, 1999, the PTO received the present request for the Commissioner to reconsider his decision dismissing as moot Petitioner's petition--requesting completion of the petition review and, if successful, refund of the examination fee.

DISCUSSION

Title 35 U.S.C. § 42(d) permits the Commissioner to refund "any fee paid by mistake or any amount paid in excess of that required." *See also* 37 CFR § 1.26 ("a mere change of purpose after the payment of money, as when a party desires to withdraw an application [or] an appeal . . . will not entitle a party to demand such a return.").

Petitioner argues that the petition is not moot. This argument is without merit. A petition for regrade seeks a determination that the petitioner possesses one of the "necessary qualifications" needed to render patent applicants valuable assistance. 35 U.S.C. § 31; *see also* 37 CFR § 10.7(b). In this case, such a determination was made when Petitioner successfully sat for the August 1998 examination. Petitioner's intervening act of taking and passing this subsequent exam instead of waiting for the Commissioner's decision on the petition, rendered the petition moot since the relief sought by the petition was granted by passing the exam. *See Brownlow v. Schwartz*, 261 U.S. 216, 217 (1923) (ordering dismissal of a petition because relief sought by Petitioner had already been granted, thereby, rendering the issue moot); *Mills v. Green*, 159 U.S. 651, 654 (1895) (holding that when "intervening event is owing either to the

plaintiff's own act or to a power beyond the control of either party, the court will stay its hand"). Thus, dismissal of the petition as moot was appropriate and the examination fee was properly paid.

Petitioner further argues that if Petitioner was successful in the petition, he would be entitled to a refund of the 1998 examination fee. This premise is misplaced. Petitioner paid for a regrade and received a regrade decision. The Director's decision was that Petitioner did not pass. Petitioner subsequently petitioned the Commissioner to obtain review of the Director's regrade decision. Even had the petition to the Commissioner resulted in a passing grade, there is no basis for a refund of the examination fee for the subsequent examination.

While awaiting the Director's decision on the petition for regrade, Petitioner filed an application for the August 1998 examination. Upon learning that Petitioner was unsuccessful in petitioning for regrade, Petitioner sat for the August 1998 examination. While awaiting his score for the August 1998 examination and to preserve his legal rights, Petitioner filed a petition to the Commissioner for review of the Director's regrade decision for the August 1997 exam. *See* 37 CFR § 10.2(c) (petition for review of Director's decision must be filed within 30 days of the decision). Ultimately, Petitioner passed the August 1998 examination. Thus, Petitioner has received what he sought--admission to practice before the PTO in patent matters.

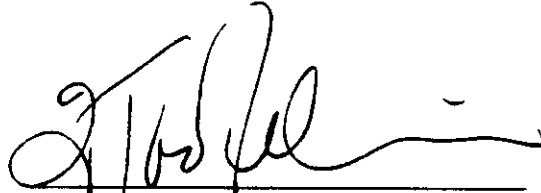
Petitioner's 1998 examination fee was not a fee paid by mistake or in excess of what was required. *See Miessner v. United States*, 228 F.2d 643, 644, 108 USPQ 6, 7 (D.C. Cir. 1955) (appeal fee paid after examiner's final rejection but prior to examiner's withdrawal of final rejection was not fee paid by mistake).

CONCLUSION

Petitioner has failed to show that he paid the relevant fee by mistake. Accordingly, it is ORDERED that the request for reimbursement and/or reconsideration of the petition decision is denied.

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Date



Q. Todd Dickinson

Acting Assistant Secretary of Commerce and

Acting Commissioner of Patents and Trademarks

Karen L. Bovard
Director, OED