

JUL 14 1999

Decision on Request for Reconsideration of Commissioner's Petition Decision and Request for Fee Refund

· ("Petitioner") requests reimbursement of various fees incurred in 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 the notice of results indicating that Petitioner failed the morning and afternoon sections of the examination, receiving scores of 66 and 65, respectively. In March 1998, the Director of the Office of Enrollment and Discipline ("Director") received Petitioner's request under 37 CFR § 10.7(c) for regrade of both sections of the 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 September 4, 1998, the PTO received a petition to the Commissioner under 37 CFR § 10.2(c) for review of the Director's decision as pertaining to the morning section. On September 28, 1998, Petitioner petitioned the Commissioner for review of the afternoon

section. Petitioner was subsequently notified of passing the August 1998 examination. On April 9, 1999, the Commissioner dismissed as moot Petitioner's two petitions for review of the Director's regrade decision.

On April 19, 1999, the Commissioner received the present request for either: (1) refund of the petition fees since the petitions were dismissed as moot; or (2) completion of review and, if successful, refund of 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 first argues that the Commissioner should not have dismissed the petition as moot since Petitioner paid for a "full decision on the merits." Petitioner argues that if the Commissioner does not perform this "full decision on the merits," Petitioner is entitled to a refund of the petition fees. 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 to issue decisions on the petitions, rendered the petitions moot since the relief sought by the petitions 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 fees were properly paid.

Petitioner further argues that if a petitioner is successful on the regrade of the 1997 examination results, he or she is entitled to a refund of the August 1998 examination fee. This argument is also without merit. Petitioner paid for a regrade and received a regrade decision, the Director’s decision that he did not pass, i.e., he had a failing score on both the morning and afternoon sections of the August 1997 examination. Petitioner subsequently petitioned the Commissioner to obtain review of the Director’s regrade decision. Even had the petitions to the Commissioner resulted in a passing grade, there is no basis for a refund of the petition fees or the examination fee for the subsequent exam.

While awaiting the Director’s decision on the petition for regrade, the 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 the score on the August 1998 examination and to preserve Petitioner’s legal rights, Petitioner filed petitions 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 examination. Thus, the Petitioner has received what was sought—admission to practice before the PTO in patent matters.

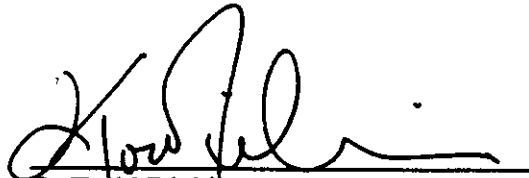
Petitioner's regrade fee, petition fees, and examination fee were not fees paid by mistake or in excess of what was required. *See Miessner v. United States*, 228 F.2d 643, 644, 108 USPQ 6, 7 (D.C. Cir. 1955) (appeal fee paid after examiner's final rejection but prior to examiner's withdrawal of final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

CONCLUSION

Petitioner has failed to show that the relevant fees were paid 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 Dickipson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks

Karen L. Bovard
Director, OED