

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re

Decision on Request
For Fee Refund

MEMORANDUM AND ORDER

(“Petitioner”) petitions the Commissioner for refund of the \$230 fee Petitioner paid for regrade of the August 1998 registration examination. The request is denied because the \$230 fee was not paid by mistake nor was the fee in excess of what was required for the regrade.

BACKGROUND

In August 1998, applicants seeking registration to practice before the U.S. Patent and Trademark Office (“PTO”) examination were required to achieve a passing grade of 70 on both the morning and afternoon sections of the registration examination. Petitioner sat for the August 1998 registration examination. Petitioner was notified on October 26, 1998, that Petitioner failed the morning section of the examination with a score of 60. On December 10, 1998, the PTO received Petitioner’s request under 37 CFR § 10.7(c) for regrade of the morning section of the examination as well as the required \$230 regrade fee. Instead of waiting to receive the results of the request for regrade, Petitioner applied and sat for the April 1999 registration examination. On June 4, 1999, Petitioner was notified that Petitioner passed the April 1999 registration examination. On July 14, 1999, the Commissioner dismissed as moot Petitioner’s request for regrade of the August 1998 examination.

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.”).

A request for regrade under 37 CFR § 10.7(c) 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 April 1999 examination. Petitioner’s intervening act of taking and passing a subsequent examination instead of waiting for the Commissioner’s decision on the regrade request, rendered the regrade request moot since the relief sought was granted by passing the examination. *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 regrade request as moot was appropriate and the \$230 regrade fee was properly paid.

Petitioner argues that the letter to applicants who failed the August 26, 1998, was misleading. The letter states that since the deadline for filing a request for regrade (December 28, 1998) and the deadline for filing an application for the April 1999 examination (January 8, 1999) is very close, the applicant “may wish to consider filing an application as well as a request for a

regrade.” The last paragraph of this letter simply suggests that the regrade decision will not be rendered prior to the examination application filing deadline. Therefore, this letter notes that in order to preserve applicant’s regrade appeal rights and to timely file an application for the April examination, the petitioner/applicant may wish to consider filing both at the same time. This letter does not suggest that Petitioner is entitled to a refund of a regrade fee.

Petitioner’s regrade 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 the relevant fees were paid by mistake. Accordingly, it is ORDERED that the request for refund of the \$230 regrade fee is denied.

SEP 29 1999

Date



Q. Todd Dickinson

Acting Assistant Secretary of Commerce and

Acting Commissioner of Patents and Trademarks

Harry I. Moatz
Acting Director, OED