

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE**

In Re

)
)
)
) Decision on Petitions
) Under 37 C.F.R.
) §§ 11.2(d) and 1.181
)
)
)

MEMORANDUM AND ORDER

(Petitioner) seeks review under 37 C.F.R. § 11.2(d)

of the November 6, 2008, final Decision on Petition of the Director of the Office of Enrollment and Discipline denying Petitioner's requests for 1) reinstatement to the United States Patent and Trademark Office (USPTO or Office) register of patent attorneys without demonstrating that he possesses the qualifications necessary to render applicants valuable service, 2) permission to retake an unlimited number of times the identical examinations that he previously failed after an unlimited opportunity to review his incorrect as well as the model answers to those examinations, and 3) approval for test taking accommodations in addition to those provided by the USPTO Office of Enrollment and Discipline (OED) in the past. Petitioner also seeks review under 37 C.F.R. § 1.181 of the 2008, Notice of Results of the July 23, 2008 Registration Examination informing Petitioner that he did not pass the registration examination given in July of 2008. For the reasons stated below, the final decision of the OED Director and the July 2008 examination results are **AFFIRMED**.

I. BACKGROUND AND PROCEDURAL HISTORY

Petitioner applied for and passed the April 28, 1958, USPTO examination and was thereafter registered to practice before the USPTO.

On _____, 1995, a client of the Petitioner filed a complaint (complaint) against him with OED.

On _____, by Order of the Maryland Court of Appeals, Petitioner was placed on inactive status from the practice of law in Maryland as a result of a petition filed jointly by Petitioner and the Attorney Grievance Commission of Maryland.

On _____, 1996, Petitioner submitted a letter to OED (letter of _____, 1996) indicating that he had voluntarily changed his status from active to inactive in Maryland and that he was "ceasing the practice before the U.S. Patent and Trademark Office".

On _____, 1996, the Director of OED (OED Director) sent a letter (OED letter of _____, 1996) to Petitioner acknowledging receipt of the letter of _____, 1996. The OED letter of _____, 1996, informed Petitioner that OED was: 1) treating his statement as a request to have his name removed from the USPTO register of attorneys (register), 2) in receipt of a letter of complaint from a client of the Practitioner, and 3) in receipt of a letter from the Attorney Grievance Commission of Maryland granting Petitioner's petition for inactive status from the practice of law in Maryland. The OED letter of _____, 1996, gave Petitioner thirty (30) days to inform OED if it was not his intent to have his name removed from the register. The OED letter of _____, 1996, further informed Petitioner that unless he informed OED within thirty (30) days that it was not his intent to have his name removed from the register, OED would hold in

abeyance any investigation with respect to the complaint or any change of status action based upon the Maryland Court Order. The OED letter of _____, 1996, also informed Petitioner that once his name was removed from the register, his reinstatement would be subject to satisfying the requirements for registration set forth in 37 C.F.R. § 10.7 and payment of the fee set forth in 37 C.F.R. § 1.21(a)(3).

On or about _____, 1996, Petitioner's name was removed from the register as evidenced by a handwritten note dated _____, 1996, (handwritten note of _____, 1996) on a copy of the OED letter of _____, 1996.

On _____, 2005, Petitioner sought reinstatement to the register by filing a "Data Sheet – Register of Patent Attorneys and Agents" (Form PTO-107A).

On _____, 2005, OED sent Petitioner a letter (OED letter of _____, 2005) acknowledging his request for reinstatement. The OED letter of _____, 2005, indicates that since it has been over five (5) years since Practitioner was authorized to practice before the USPTO, he must take the registration examination unless he submits a showing to the satisfaction of OED that he continues to possess the legal qualifications necessary to render valuable service to applicants for patents.

On _____, 2005, Petitioner filed a request under 37 C.F.R. § 11.7 for reinstatement without examination.

On _____, 2005, OED issued a denial of Petitioner's request for reinstatement without retaking the registration examination stating that OED determined that Petitioner did not present sufficient objective evidence to show that he continues to possess the legal qualifications necessary to render patent applicants valuable service after his nearly nine-year gap in practicing before the USPTO.

On 2005, Petitioner filed an "Application for Registration to Practice before the United States Patent and Trademark Office" (Form PTO-158) in which he checked, inter alia, the box stating, in part:

Reinstatement: I am applying for reinstatement

On 2005, OED mailed Petitioner a letter informing him that he did not pass the registration examination given on July 11, 2005.

On 2006, Petitioner filed a Form PTO-158 in which he requested USPTO test administration. He also included a request for a large print examination.

On 2006, Petitioner filed, inter alia, a doctor's note indicating that due to , Petitioner "would benefit from larger print material when reading."

On .006, OED sent Petitioner a letter granting his request for a large print examination.

On 2006, OED notified Petitioner that he did not attain a passing grade on the July 12, 2006 registration examination.

On 2006, Petitioner filed, inter alia, a Form PTO-158 requesting USPTO test administration and reinstatement. Petitioner also included a doctor's note stating "please use large text print materials."

On 2006, OED sent Petitioner a letter noting that the answer sheet and the Manual of Patent Examining Procedure (MPEP), provided at the July 12, 2006, examination, were in a standard print size. Accordingly, the letter included an offer for a one-time opportunity to sit for the registration examination without the payment of additional government fees. The letter also indicated that: 1) the examination and answer

sheets would be presented in fourteen (14) point Arial font, 2) several _____ would be provided for use by the Petitioner in _____ the MPEP, 3) Petitioner would be permitted to bring his own _____ device, and 4) a desk lamp would be provided for supplemental light.

Or _____ 2007, OED sent a letter to Petitioner indicating that, pursuant to a telephone conversation between Petitioner and an OED employee, Petitioner had been registered to sit for a USPTO administered registration examination on July 16-17, 2007. The letter also states that Petitioner would be refunded the application and examination fees submitted with his most recent application. In addition, the letter indicates that approval had been granted for the following accommodations:

- Two (2) four (4) hour examination sessions, with the first session being administered on July 16, and the second session being administered on July 17;
- Fourteen (14) point font on the examination booklet and answer sheet;
- _____ provided to assist reading the MPEP;
- Additional lighting; and
- A testing room separate from the main testing room.

On _____ 2007, OED notified Petitioner that he did not attain a passing grade on the registration examination administered in July 2007.

On _____ 2008, Petitioner filed a Form PTO-158 requesting USPTO test administration. Petitioner attached, inter alia, three doctors' notes. The first note indicates that due to Petitioner's "_____ impairments he is unable to read small print and even with large print needs more than the usual amount of time to complete reading tasks." The doctor then recommends "large print and increasing the amount of time

given to perform reading tasks.” The second note requests that the Petitioner be given “extra time for his exam” as he “must frequently, often every 15 min.” The third note indicates that Petitioner “requires frequent visits to ” and requests that he be accommodated accordingly. In addition, Petitioner included a request for various specific examination accommodations including:

- An enlarged print MPEP with a closed circuit TV for enlarging the print of the MPEP;
- A human reader;
- A separate well heated room with extra light for Petitioner and his reader only;
- Access to and copies of Petitioner’s corrected 2005, 2006, and 2007 examinations and the answers thereto;
- Two successive eight hour examination sessions in a room alone except for a reader with a one hour break for lunch on two successive days.

On . . . 2008, OED sent Petitioner a letter informing him that he was scheduled to sit for the 2008 USPTO administered registration examination to be given on July 23-24. The letter indicates that the Petitioner is approved for the following accommodations:

- Two (2) four and one half (4.5) hour examination sessions, with the first session administered on July 23, 2008, and the second session administered on July 24, 2008;
- Fourteen (14) point font on the examination booklet and answer sheet;
- provided to assist reading the MPEP;
- Additional lighting;
- A testing room separate from the main testing room.

On _____, 2008, Petitioner filed a petition with the OED Director requesting: 1) reinstatement to the register without demonstrating that he possesses the legal qualifications necessary for him to render applicants valuable service and 2) recognition that Petitioner is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office. Alternatively, Petitioner requested that he be permitted to retake the identical examinations that he had previously failed an unlimited number of times after having an unlimited opportunity to review those identical examinations as well as his incorrect answers.

On _____ 2008, OED mailed Petitioner a letter informing him that he did not pass the registration examination given on July 23, 2008.

On _____ 2008, Petitioner filed the present petition for review under 37 C.F.R. § 1.181 of the result of the examination reported in the OED letter of _____ 2008.

On _____ 2008, the OED Director issued a final decision (final decision of the OED Director) denying the petition of _____ 2008.

On _____ 2009, Petitioner filed the present petition for review under 37 C.F.R. § 11.2(d) of the final decision of the OED Director.

II. LEGAL STANDARD

The Director of the USPTO is given statutory authority in accordance with 35 U.S.C. § 2(b)(2)(D) to require patent practitioners to show that they:

are 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

Pursuant to that statutory authority, 37 C.F.R. § 11.7(a) states, in part:

No individual will be registered to practice before the Office unless he or she has:

* * * * *

- (2) Established to the satisfaction of the OED Director that he or she:
 - (i) Possesses good moral character and reputation;
 - (ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and
 - (iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

Further, 37 C.F.R. § 10.160(c) provides, that as a condition for reinstatement, the Director may require an individual to meet the requirements of 37 C.F.R. § 11.7, including taking and passing the registration examination in accordance with 37 C.F.R. § 11.7(b).

III. ANALYSIS

Much of the present petition under 37 C.F.R. § 1.181 filed 2008, and the present petition under 37 C.F.R. § 11.2(d) filed 2009, (present petitions) are difficult to parse. However, the present petitions seem to make similar and

somewhat overlapping allegations and requests for relief and thus, to the extent understood, are treated concurrently below.

Specifically, the present petitions either assert or intimate the following allegations:

1. The USPTO took Petitioner's registration without due process.
2. OED improperly denied Petitioner's requests i) for unlimited access to the prior USPTO registration examinations he failed and ii) to retake those prior registration examinations an unlimited number of times.
3. OED denied Petitioner reasonable accommodations when he sat for the last USPTO registration examination.
4. Petitioner is being improperly disallowed from prosecuting his own application as a pro se inventor.

Each of Petitioner's allegations is addressed separately below.

1. The USPTO took Petitioner's registration without due process.

Petitioner makes the following assertions:

- There is no reasonable basis for the final decision of the OED Director that Petitioner's name was removed from the register on or about 1996.
- The investigation of the complaint was held in abeyance by the OED letter of 1996. As a result, no evidentiary record was developed with regard to the complaint.
- The OED letter of 1996, resolved the complaint and Petitioner relied on this resolution to continue to practice before the USPTO for twelve (12) years.

- The final decision of the OED Director improperly relied on the OED letter of _____, 1996, and the handwritten note of _____, 1996, as a basis for taking away Petitioner's registration retroactive to _____ 1996, without due process as the evidentiary record was never developed and Petitioner was not sufficiently notified of the complaint or of his removal from the register until twelve (12) years later by way of the final decision of the OED Director on _____ 2008.

Petitioner blames OED for 1) the removal of his name from the register and 2) the fact that complaint has never been investigated. Specifically, he points to i) the OED letter of _____ 1996, ii) the handwritten note of _____ 1996, and iii) the final decision of the OED Director as causing the improper removal of his name from the register. This blame is misdirected. The removal of Petitioner's name from the register as well as the cessation of the investigation of the complaint are the direct results of Petitioner's own action.

In his letter of _____ 1996, Petitioner included the statement that he is "ceasing the practice before" the USPTO. The OED letter of _____ 1996, acknowledged Petitioner's letter of _____, 1996, and informed Petitioner that OED is treating his statement as a request to have his name removed from the register. In addition, the OED letter of _____ 1996, gave Petitioner thirty (30) days to inform OED if it is not his intent to remove his name from the register. The OED letter of _____ 1996, also stated that unless Petitioner informs OED within thirty (30) days that it is not his intent to have his name removed from the register, OED would hold in abeyance any investigation of the complaint. As Petitioner did not provide OED with an indication of a contrary

intention, Petitioner's name was subsequently removed from the register on or about 1996, and the investigation of the complaint was accordingly held in abeyance. Thus, it was Petitioner's letter of 1996, in combination with his failure to respond to the OED letter of 1996, that directly caused 1) Petitioner's name to be removed from the register and 2) the investigation of the complaint to be held in abeyance.

Petitioner also implies that his letter of 1996, was merely the expression of an intention to temporarily remove his name from the register and that he should be allowed to freely add his name back on to the register at will. This argument is not persuasive. The Official Gazette Notice *Reinstatement of Patent Attorneys and Agents to Practice Before the U.S. Patent and Trademark Office*, 1064 Off. Gaz. Pat. Office 12 (March 11, 1986) states, in part:

Any person whose name has been removed from the register of attorneys and agents . . . or whose name has been endorsed as inactive on the register . . . may request reinstatement on the register. However, where the person seeks reinstatement to the register five (5) or more years after his or her name was either removed . . . or endorsed as inactive . . . , that person will be required to again meet the requirements of 37 C.F.R. 10.7 . . . including taking and passing the examination . . . before reinstatement is granted.

Accordingly, as it has been over twelve (12) years since Petitioner's name was removed from the USPTO register, it is appropriate for OED to require Petitioner to take and pass the USPTO registration examination before his reinstatement is granted. Further, as a general rule, when a practitioner resigns from a bar with disciplinary charges

pending, he gives up his right to practice. *See Benninghoff v. Superior Court* (2006) 136 Cal. App. 4th 61, 69. Petitioner's argument that he was not aware of the outstanding complaint against him is spurious as the OED letter of .996, clearly indicates that OED had received a letter of complaint against him.

The decision of the OED Director that Petitioner's name was properly removed from the register on or about , 1996, and that as a condition to reinstatement Petitioner is required to meet the requirements of 37 C.F.R. § 11.7 is **AFFIRMED**.

2) OED improperly denied Petitioner's requests i) for unlimited access to the prior USPTO registration examinations that he failed and ii) to retake those prior registration examinations an unlimited number of times.

Petitioner asserts that OED improperly denied his request for unlimited access to inspect and review the USPTO registration examinations he failed in 2005 through 2008 along with the model answers thereto.

37 C.F.R. § 11.7(e) titled "Examination results" states, in part:

Within sixty days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. Review will be under supervision. No notes may be taken during such review. . . . An individual who failed the examination has the right to retake the examination an unlimited number of times . . .

Further, the Federal Register notice in which 37 C.F.R. § 11.7 was published as a final rule (Federal Register notice) explains, in part:

The questions and answers will be maintained in confidence. This is consistent with confidentiality with which the Multistate Bar Examination is maintained. Maintaining the registration examination in confidence supports the integrity of the examination inasmuch as the questions can appear in following months or years. By maintaining confidentiality, no candidate has the advantage of memorizing questions and answers. The multiple choice, computer-based examination will use questions selected from a large database of questions and answers that will not be publicly available. This will assure that passing the examination depends upon the ability to spot issues and determine a substantively sound result, rather than upon the ability to memorize questions and answers.

69 FR 35428, 35440 (June 24, 2004). The Federal Register notice also explains:

Limiting access to the questions will not deny the unsuccessful applicant equal protection of the laws. The Multistate Bar Examination (MBE), like the registration examination, is a multiple choice examination. Questions on the MBE are reused in later years. Inasmuch as some of the questions appear in following years, the questions must be kept secret in order to preserve the fairness of the test for later applicants. *See Fields v. Kelly*, 986 F.2d 225, 227 (8th Cir. 1993). An unsuccessful candidate also is not deprived of a property right without due process by limiting access to the questions. The provision of § 11.7(e) of providing an opportunity to review the examination under supervision without taking notes affords the applicant a hearing at the administrative level.

69 FR 35428, 35439 (June 24, 2004).

The explanation in the Federal Register notice makes clear that the questions and answers associated with the USPTO registration examination are to be maintained in confidence and, as such, failed test takers will only be allowed limited access thereto.

Specifically, a failed test taker is entitled to inspect, but not copy, the questions and answers he incorrectly answered within sixty days of the mailing date of a notice of failure. Further, any review will be under supervision and no notes may be taken during the review. 37 C.F.R. § 11.7(e).

This policy appropriately balances the interests of the parties. By providing a failed test taker with a limited ability to review the examination under supervision without taking notes, the policy effectively allows OED to maintain a database of questions that can be used to create an effective examination yet still ensure that test takers are tested on their ability to spot and successfully analyze substantive issues rather than memorize questions and answers. 37 C.F.R. § 11.7(e).

Petitioner also asserts that OED improperly denied his request to take the previous USPTO registration examinations that he failed in 2005 through 2008, an unlimited number of times. Petitioner contends that 37 C.F.R. § 11.7(e) permits him to do so.

Petitioner's request to take the previous USPTO registration examinations he failed in 2005 through 2008, an unlimited number of times is inconsistent with the sound established policy described above. If a failed test taker were allowed to retake the identical test an unlimited number of times, the test would no longer assess the test taker's substantive ability to spot and analyze issues but would instead merely confirm his ability to memorize questions and answers. Accordingly, if a failed test taker were allowed to retake the identical examination an unlimited number of times, the examination would no longer be an effective tool in determining whether the test taker possesses the necessary qualifications to render to patent applicants valuable service, advice, and assistance.

Accordingly, the OED decision denying Petitioner's requests 1) to retake the identical 2005 through 2008 USPTO registration examinations an unlimited number of times and 2) for unlimited access to those examinations and the model answers is **AFFIRMED.**

3) OED denied Petitioner reasonable accommodations when he sat for the last USPTO registration examination.

Petitioner asserts that the final decision of the OED Director improperly denies his request for the following accommodations for the July 23, 2008 registration examination: 1) a human reader, 2) a closed circuit TV for enlarging the print on the MPEP, and 3) two (2) successive eight (8) hour examination sessions with a one (1) hour break for lunch on two (2) successive days.¹

On 2008, Petitioner filed a Form PTO-158 requesting USPTO test administration. Petitioner attached, *inter alia*, three doctors' notes. The first note indicates that due to Petitioner's " impairments he is unable to read small print and even with large print needs more than the usual amount of time to complete reading tasks." The doctor then recommends "large print and increasing the amount of time given to perform reading tasks." The second note requests that the Petitioner be given "extra time for his exam" as he "must use frequently, often every 15 min." The third note indicates that Petitioner "requires frequent visits to " and

¹ Petitioner also asserts that OED improperly denied his request for other additional accommodations including enlarged print question and answer sheets in at least 18 point font, a reduction in fees for test administration by the USPTO, and open shades for full daylight illumination on the left side of the Petitioner. However, Petitioner's request for these other additional accommodations were first made in the present petition for review under 37 C.F.R. § 1.181 filed , 2008 and thus were not before OED prior to the date of the registration exam given on July 23, 2008. Accordingly, Petitioner's request for these other additional accommodations is not further considered herein.

requests that he be accommodated accordingly. In addition, Petitioner included a request for various specific examination accommodations including:

- An enlarged print MPEP with a closed circuit TV for enlarging the print of the MPEP;
- A human reader;
- A separate room with extra light for Petitioner and his reader only;
- Two successive eight hour examination sessions in a room alone except for a reader with a one hour break for lunch on two successive days.

OED scheduled Petitioner to sit for the 2008 USPTO administered registration examination given on July 23-24, 2008, and approved him for the following accommodations:

- Two (2) four and one half (4.5) hour examination sessions, with the first session administered on July 23, 2008, and the second session administered on July 24, 2008;
- Fourteen point font on the examination booklet and answer sheet;
- Magnifiers provided to assist reading the MPEP;
- Additional lighting;
- A testing room separate from the main testing room.

Section 504 of the Rehabilitation Act prohibits discrimination in programs conducted by Federal agencies on the basis of disability, including a failure to grant a reasonable accommodation in order to have access to such a program. 29 U.S.C. § 794. While, the

USPTO is obligated to provide a reasonable accommodation, an individual is not entitled to accommodations of his choice, but rather is entitled to effective accommodation.

Mennen v. U.S. Postal Service, 2002 WL 31232232, at *2 (Sept. 25, 2002).

In his 2008, petition, Petitioner requested two successive eight (8) hour examination sessions with a one hour break for lunch on two successive days. Petitioner is an individual with a disability. See 29 C.F.R. §1630.2(g)(1). Specifically, his problems impact his ability to read standard print without magnification. This is supported by the medical documentation provided by his physician.

The Agency accommodated Petitioner by providing additional testing time, specifically, four and one-half (4½) hours per examination session for each of the two examination days. The standard testing time is two three-hour sessions with a one hour lunch break. Additionally, OED provided Petitioner with a 14 point font examination booklet and answer sheet, a separate testing room, and magnifiers to assist in reading the MPEP.

Petitioner has failed to establish a nexus between his disabilities and his accommodation request of 2008, for two successive eight (8) hour examination sessions with a one hour break for lunch on two successive days. Specifically, Petitioner has not provided a showing as to why eight hours for each examination session will reasonably accommodate his vision impairment. Petitioner is not entitled to the accommodation of his choice as long as an effective accommodation is offered by the agency. Sipolo v. Dep't of the Navy, 2008 WL 3890469 (Aug. 14, 2008). Here Petitioner has not shown that the accommodations provided to him were ineffective for him. Madison v. Dep't of Defense, 2007 WL 2161704 at *2 (July 20, 2007).

The accommodations approved by OED for the July 2008 registration examination were commensurate with the doctors' recommendations submitted by Petitioner on 2008. The doctors' notes recommended enlarged print and increased time for performing reading tasks and for breaks. Not only did OED approve the provision of enlarged font and increased time for taking the test, OED also approved the provision of additional lighting, and a separate testing room. To the extent that OED did not approve the remaining accommodations requested, Petitioner did not provide any medical or other evidence supporting the necessity of those additional accommodations. Accordingly, provision of the requested human reader and closed circuit TV for enlarging the print of the MPEP would have been superfluous in view of the accommodations that were provided.

Finally, there is no evidence that Petitioner indicated to the examination proctor, at the time of the examination, that he was having trouble with the examination or the MPEP. If Petitioner was having trouble with the examination or MPEP, he should have notified or informed the examination proctor promptly at the beginning of the examination rather than waiting until after he received the negative test results to inform OED of his difficulties.

The decision of the OED Director that Petitioner was provided with reasonable accommodations in view of his specific disabilities is **AFFIRMED**.

4) Petitioner is being improperly disallowed from prosecuting his own application as a pro se inventor.

Petitioner alleges that OED is preventing him from handling his own applications for invention, such as his design application number . as a pro se inventor.

Petitioner's allegation is without merit. The USPTO has in no way prohibited Petitioner from proceeding pro se for patent applications in which he is the sole inventor.

5) Additional Allegations

Petitioner's remaining intelligible allegations are frivolous or outside the purview of this proceeding and do not relate to the record made before the OED Director. They are thus are not further addressed herein.

IV. CONCLUSION

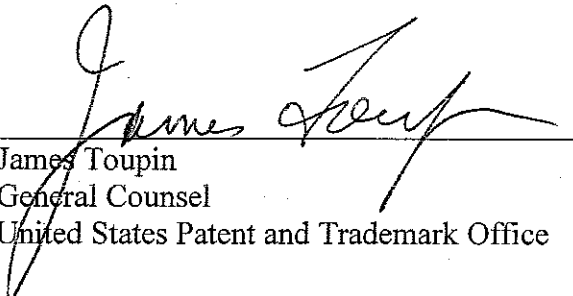
The final decision of the OED Director correctly denied Petitioner's requests for 1) reinstatement to the USPTO register of patent attorneys without demonstrating that he possesses the qualifications necessary to render applicants valuable service, 2) permission to retake an unlimited number of times the identical applications that he previously failed after an unlimited opportunity to review his incorrect as well as the model answers to those examinations, and 3) approval for test taking accommodations in addition to those provided by OED in the past. Further, since OED provided Petitioner with reasonable accommodations during the July 2008, registration examination, the test results set out in the , 2008, Notice of Results of the July 23, 2008 Registration Examination indicating that Petitioner did not pass the registration examination given in July of 2008 were properly obtained.

ORDER

Upon consideration of the Petitioner's requests for review of 1) the final decision of the OED Director under 37 CFR § 11.2(d) and 2) the 2008, Notice of Results of the July 23, 2008 Registration Examination under 37 C.F.R. § 1.181, it is **ORDERED** that the final decision of the OED Director and the July 2008 examination results are **AFFIRMED**.

On behalf of
John Doll
Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the
United States Patent and Trademark Office

MAR 31 2009
Date


James Toupin
General Counsel
United States Patent and Trademark Office

cc:

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