



On July 23, 1999, Petitioner filed an application for admission to the November 3, 1999, registration examination and submitted the fees required by 37 C.F.R. § 1.21(a)(1), namely \$310 (examination fee) and \$40 (application fee). OED initially considered Petitioner's application to be incomplete (see OED letter dated September 8, 1999), but later admitted Petitioner to the examination, as indicated in its September 13, 1999, notice of admission issued to Petitioner.

On September 13, 1999, and October 22, 1999, OED received letters from Petitioner stating that he did not wish to sit for the November 3, 1999, registration examination. Petitioner requested that the \$310 examination fee be deferred to a later examination. Alternatively, Petitioner requested that the fee be refunded to him. On November 5, 1999, the Acting Director of OED denied Petitioner's request that his examination fee be deferred or refunded.

Petitioner seeks review of the Acting Director's decision denying the request for a refund and also requests that the \$130 fee accompanying the subject petition be refunded.

### **DISCUSSION**

Section 42(d) of 35 U.S.C. permits the Commissioner to refund "any fee paid by mistake or any amount paid in excess of that required." *See also* 37 C.F.R. § 1.26(a) ("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").

Applicants for the registration examination are required to pay a \$310 examination fee. 37 C.F.R. § 1.21(a) (establishing the required examination fee of \$310 and application fee of \$40). *See also* 35 U.S.C. § 41(d) ("[t]he Commissioner shall establish fees for all other

processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials”).

Petitioner does not assert that he paid his examination fee by mistake. As a matter of fact, he applied for and was admitted to the registration examination. See September 13, 1999, OED Notice of Admission to Petitioner. Also, Petitioner paid the precise amount required by 37 C.F.R. § 1.21(a), and no more. Accordingly, Petitioner, without mistake, paid the required examination fee of \$310 for the correct amount, and he is therefore not entitled to a refund of the fee. See 35 U.S.C. § 42(d); 37 C.F.R. § 1.26(a) (withdrawing an application does not entitle the payor to a refund); 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 paid by mistake).

Neither is Petitioner entitled to have his examination fee applied to a future registration examination because he failed to meet the deadline for seeking such a deferment. More specifically, since the registration examination is administered only twice each year, the PTO receives a large number of applications for each exam (approximately 2,000 applications were submitted for the November 3, 1999, exam). Accordingly, for administrative purposes, any refund or deferment request concerning examination fees for the November 3, 1999, examination had to be “FILED WITH OED PRIOR TO AUGUST 16, 1999.” Bulletin at 6, col. 1. This deadline was not set arbitrarily but was selected in order to cease, in a timely and efficient manner, the processing of any applications corresponding to refund or deferment requests and to arrange for such refunds or deferments. The PTO must make arrangements with the Office of Personnel Management, the agency administering the exam, based on the number of applicants

sitting for the exam. Therefore, cancellations must be timely received so that OED has an accurate count when arrangements are made for the upcoming examination.

The record shows that Petitioner's requests for refund or deferment were filed with OED on September 13, 1999, and October 22, 1999. No other filed requests appear in the administrative record.\* Accordingly, Petitioner's requests were both filed with OED after the August 16, 1999, deadline. As discussed above, the deadline was imposed for administrative and cost reasons. Additionally, Petitioner has not shown that any cause for his delay in filing a written request with OED should result in waiver of the deadline for requesting a refund.

Petitioner refers to telephone conversations he had with OED personnel on the matter, and argues that in view of these conversations, his examination fee should be refunded or deferred. Petition at 1-2. However, the registration examination bulletin was clear on this point, *i.e.*, any refund or deferment request had to be "FILED WITH OED PRIOR TO AUGUST 16, 1999." Bulletin at 6, col. 1 (emphasis added). Consistent with this requirement to file the request in writing with OED is the PTO rule that "[a]ll business with the Patent and Trademark Office should be transacted in writing . . . [n]o attention will be paid to any alleged oral promise . . . ." 37 C.F.R. § 1.2. Accordingly, this argument is not persuasive.

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\* Petitioner alleges he sent a cancellation letter on August 14, 1999. However, OED does not have a record of receipt of any correspondence until September 13, 1999.

Petitioner additionally argues that he was not qualified to be admitted to the exam and therefore the bulletin language regarding refunds for cancellation or deferral of the examination does not pertain to him. Petition at 2-6.

The bulletin states:

PLEASE NOTE: IF YOU QUALIFY TO BE ADMITTED TO THE EXAMINATION, AND LATER NOTIFY THE OFFICE THAT YOU WILL NOT BE TAKING THE EXAMINATION, THE \$310.00 EXAMINATION FEE WILL NOT BE REFUNDED OR DEFERRED TO ANOTHER EXAMINATION UNLESS YOUR NOTIFICATION IS FILED WITH OED PRIOR TO AUGUST 16, 1999. 35 U.S.C. § 42(d),

To support this argument, Petitioner relies on OED's September 8, 1999, notice of incomplete application. The notice identifies three items on the application that were not answered by him, items 2, 3, and 13. However, OED decided shortly after mailing the September 8, 1999, notice that Petitioner would not be precluded from sitting for the exam based on his failure to answer the three items. See September 13, 1999, OED Notice of Admission to Petitioner. Moreover, the September 8th notice was issued before OED received written notice that Petitioner wanted to withdraw from the exam. Thus, for examination purposes, the notice of incomplete application was not used to disqualify Petitioner from being admitted to the examination within the meaning of the above bulletin language. Whether Petitioner could ultimately be registered in light of the missing information, should he pass the exam, is a separate and distinct question from whether he was qualified to sit for the exam, which OED decided he was, as reflected in the notice of admission. Petitioner's argument that he was not qualified to sit for the exam is simply unpersuasive in view of OED's September 13, 1999, determination on the matter.

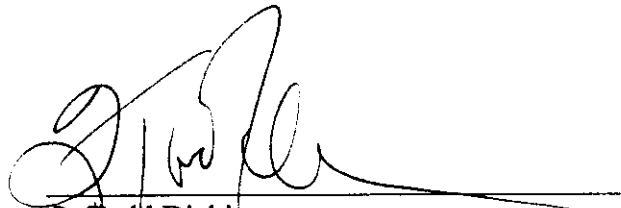
Finally, Petitioner argues that his petition fee should be refunded. Petitioner contends that the rule identified by OED for an appeal of a decision denying a fee refund, 37 C.F.R. § 1.21(a)(5), only applies to the categories of Director's decisions set forth in 37 C.F.R. § 10.2(c)--and that these categories do not include a Director's decision denying a refund of the examination fee. Since 37 C.F.R. § 10.2(c) does not specifically include petitions to the Commissioner for examination fee refunds, the petition fee will be refunded.

### CONCLUSION

Petitioner has failed to show that the examination fee was paid by mistake or in excess of that required. Accordingly, it is ORDERED that the request for refund of the \$310 examination fee is denied. The \$130 petition fee will be refunded in due course.

This is a final agency action.

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