

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

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Decision on Petition for Fee Refund  
and Waiver of Petition Fee

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**MEMORANDUM AND ORDER**

(“Petitioner”) petitions the Director of the United States Patent and Trademark Office (USPTO) to refund the \$310 fee for the April 18, 2001 registration examination. Petitioner also requests a waiver of the petition fee for review of the decision of the Director of the Office of Enrollment and Discipline (“OED”). The petition is denied for the reasons set forth below.

**BACKGROUND**

The October 18, 2000 registration examination (“exam”) required an applicant for registration to practice before the USPTO in patent matters to achieve a passing grade of 70 percent. Petitioner sat for the October 2000 exam. Petitioner received the notice of results indicating that Petitioner did not receive a passing grade on November 29, 2000. On January 11, 2001, Petitioner filed an application for the April 2001 registration exam, including a check for the application fee of \$40 and the exam fee of \$310. On February 12, 2001, OED mailed Petitioner an acceptance to the April 2001 exam.

On February 1, 2001, OED received Petitioner's Petition for Regrade of the October 18, 2000 exam pursuant to 37 CFR 10.7. Two days before the April 18th exam Petitioner was informed that she had attained a passing grade on the October 2000 exam upon regrade.

On April 24, 2001, Petitioner filed a petition to the Director of OED requesting refund of the \$310 exam fee for the April 2001 exam. The request for a refund of the exam fee was denied on April 30, 2001. Petitioner now seeks review of the decision denying a refund.<sup>1</sup>

### DISCUSSION

Under 35 U.S.C. § 42(d), the Director is authorized to refund any fee that is paid in excess of the amount required, or that is paid by mistake. Petitioner did not pay an amount in excess of what was required when she filed her January 2001 application to take the April 2001 exam, and she is therefore not entitled to a refund on the basis of an excess payment.

Likewise, Petitioner cannot claim that she paid the fee by mistake. Petitioner paid the fee after she had been notified that she had failed the previous exam, but before she learned that her request for a regrade of that exam would be acted upon favorably. An applicant who pays a fee in an attempt to overcome an adverse determination will not be found to have paid that fee by mistake if the adverse decision is subsequently overturned. *See Miessner v. United States*, 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)<sup>2</sup>.

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<sup>1</sup> Petitioner also requests a waiver of the fee for filing this petition to the Director. However, under the current rules, there is no fee for a petition seeking review of a decision denying a refund of the registration exam fee.

<sup>2</sup>The *Miessner* case was cited by the OED Director in his decision denying Petitioner's request for a refund. On Petition, Petitioner argues that this case is inapposite, because it involved a request to refund an appeal fee, not an examination fee. In a similar vein, Petitioner

Moreover, the General Requirements Bulletin (“GRB”) issued for the April 2001 exam provides that “THE \$40 APPLICATION FEE AND THE \$310 EXAMINATION FEE ARE NON-REFUNDABLE, except where the applicant does not qualify for admission to the examination.” (GRB at p.11, upper case lettering in original). Hence, the GRB is unambiguous: refunds will only be issued to candidates who do not qualify for admission to the exam.

Petitioner nevertheless argues that the GRB entitles her to a refund. In Petitioner’s view, she became “unqualified” to sit for the exam when, upon regrade, she received a passing grade for the October 2000 exam.

But Petitioner’s earning of a passing grade on the October exam did not render her “unqualified” to sit for the April 2001 exam: at most, this turn of events might have rendered her *ineligible* to sit for the exam. The reference to “unqualified” candidates in the GRB is clearly to persons who do not meet the academic requirements set forth in the “Requirements for Admission to the Examination” section of the GRB, not to persons who, like Petitioner, met the academic requirements, sat for and failed the exam, and then achieved a passing score on regrade.

Petitioner notes that 37 C.F.R. §10.7(b) prohibits the administration of the examination “as a mere academic exercise,” and suggests that the USPTO would have been guilty of engaging

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urges that another case cited by the OED Director, *Commissioner’s Decision E07* (July 20, 1998) is inapplicable, since, that case, according to Petitioner, involved a request to refund a regrade fee. These distinctions are of no consequence. *Miessner* and *E07* both held that a fee paid to overcome an adverse decision will not have been paid in error [footnote continued] merely because the adverse decision is later overturned. That principle is valid whether the adverse decision in question is an examiner’s decision, as was the case in *Miessner*, or an exam result, as is the case here. Moreover, with respect to *E07*, Petitioner is mistaken in her assertion that the refund sought was only for a regrade. The petitioner in that case sought a refund not only of a regrade fee, but of examination and various other fees as well.

in such an exercise had it administered the test to Petitioner. Petitioner reasons that in view of this, the USPTO should refund the exam fee.

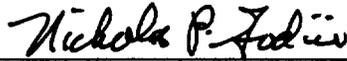
Even if Petitioner's suggestion that she could not have sat for the April 2001 test is correct – and the Director need not reach the question of whether Petitioner could have taken the exam notwithstanding her earning of a passing grade on regrade – it would not follow that Petitioner is entitled to a refund; as noted in the OED Director's decision, the funds and other resources expended by the USPTO for each person registered to sit for the exam are committed long before the exam is administered.

Finally, Petitioner asserts that OED personnel assured her that she would be entitled to the requested refund. Even if such assurances were given, these cannot serve as a basis for refunding the fee. Pursuant to 37 C.F.R. §1.2, “[t]he action of the [Office] will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.”

**CONCLUSION**

Petitioner has failed to show that she paid the exam fee by mistake, or that the payment made was in excess of the required amount. Accordingly, it is ordered that the request for refund of the \$310 registration exam fee is denied.

AUG 27 2001



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Nicholas P. Godici  
Acting Under Secretary of Commerce for Intellectual  
Property and Acting Director of the United States  
Patent and Trademark Office

Harry I. Moatz, Director  
Office of Enrollment and Discipline