

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

In re)
) Decision on Petition
) Under 37 C.F.R. § 10.170
)
)
_____)

MEMORANDUM AND ORDER

(Petitioner) petitions for review of a decision by the Director of the Office of Enrollment and Discipline. The Director's decision denied Petitioner's request for relief relating to the Registration Examination to be held in Washington, D.C., on November 3, 1999. Petitioner seeks to be admitted to take the examination despite his failure to meet the filing deadline of July 23, 1999. The petition is denied.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must take and pass a Registration Examination ("exam") authorized by 35 U.S.C. § 31 and required by 37 C.F.R. § 10.7(b). Petitioner wishes to take the exam which will be administered November 3, 1999.

Petitioner filed his exam application on September 10, 1999. The filing deadline for the November 3 exam, however, was July 23, 1999. Petitioner requested permission to sit for the exam notwithstanding his late application filing. The Director of the Office of Enrollment and Discipline treated Petitioner's request as a petition under 37 C.F.R. § 10.170, and denied the request in a decision dated September 16, 1999.

OPINION

In order to be registered to practice before the PTO in patent cases, with exceptions not relevant here, every patent attorney or agent must take and pass the registration exam. In a bulletin provided to those interested in taking the November 3 exam, entitled “General Requirements for Admission to the Examination for Registration to Practice in Patent Cases Before the U.S. Patent and Trademark Office,” the PTO set out the requirements to be met by applicants in order to take the exam. Among these requirements were: (1) demonstration of the required scientific or technical training; (2) completion of a Registration Application (Form PTO-158) and Oath (Form PTO-1209); (3) submission of an application fee of \$40.00; (4) submission of an examination fee of \$310.00; and (5) submission of all documents and fees by July 23, 1999. In regard to this last requirement, the bulletin states that “**THE DEADLINE FOR FILING ALL APPLICATION PAPERS, ALL APPROPRIATE FEES, AND ALL NECESSARY DOCUMENTATION IS JULY 23, 1999**” (emphases in original).

In his submissions to the Office, Petitioner does not explain why he was unable to comply with the filing deadline, but requests that the deadline be waived based on (1) financial hardship he would suffer if forced to wait until the next exam is administered on April 12, 2000, and (2) his “demonstrated [] ability to successfully prepare and prosecute patent applications.” The proffered bases do not provide a persuasive reason for waiving the filing deadline in this case.

In order to practice before the PTO in patent cases, an applicant must take and pass the registration exam. Since the exam is administered only twice each year, the PTO receives a large number of applications for each exam date. Approximately 2000 timely applications were received for the November 3, 1999 exam. Each of these applications must be individually evaluated to determine whether the applicant meets the qualifications for registration. The

applications must be evaluated to ensure that they are complete, that the required fees have been submitted, that the applicant has the required scientific and technical qualifications, and that no issues of moral character preclude registration.

In addition, the PTO must arrange with the Office of Personnel Management (OPM) to administer the exam simultaneously in multiple sites across the country. The PTO must notify OPM how many examinees will be taking the test at each site and how many at each site require special accommodations. Once they know what facilities are required at each site, OPM personnel must arrange for rental of space appropriate for administering the exam. To allow sufficient time for space rental, PTO must provide OPM with final numbers regarding examinees and special accommodations at least six weeks prior to the examination date.

Thus, although the filing deadlines for the registration exams are set well in advance of the examination dates, those deadlines are not set arbitrarily but are selected to allow sufficient time for individual evaluation of each application and for arrangement of appropriate examination facilities in each test site across the country. Applicants for the November 3, 1999, examination were required to file their completed applications by July 23, 1999, so that their applications could be processed and arrangements made for them to take the exam on November 3, 1999.

Under the terms of 37 C.F.R. § 10.170, “[i]n an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner’s designee ... on petition by any party.” Petitioner argues that he is not seeking waiver of any exam requirements but merely seeks admission to take the exam. This argument is not persuasive because, as explained above, timely filing of all application papers and fees is one of the exam requirements.

Alternatively, Petitioner argues that this case is appropriate for waiver of the filing deadline because (1) he would suffer financial hardship if he had to wait for the next examination, in that income from work as a patent agent would provide income for his newly formed business, and (2) he has already demonstrated his ability to work cooperatively with the PTO during pro se prosecution of several patent applications.

An “extraordinary situation” that merits relief under 37 C.F.R. § 10.170 is one that is not an “oversight that could have been prevented by the exercise of ordinary care and diligence,” Nitto Chemical Ind. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1780 (D.D.C. 1994), or one in which “no meaningful alternatives were available,” Margolis v. Banner, 599 F.2d 435, 443 (CCPA 1979). Here, Petitioner has provided no explanation for his failure to meet the original filing deadline and thus has not shown that he could not have met the deadline through the exercise of ordinary care and diligence. Although Petitioner states that he may suffer some economic loss from waiting an extra five months to take the exam, that loss appears to be due to his own failure to investigate the exam requirements in a timely fashion. Nor is this a situation in which no meaningful alternatives are available, in that the exam will be administered again in April 2000. Thus, Petitioner has not shown that waiver of the filing deadline is merited in this case.

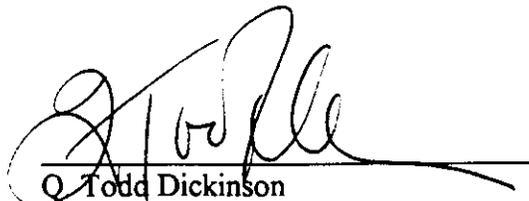
ORDER

For the reasons given above, the requested waiver of the filing deadline for the November 3, 1999, exam is denied.

The checks submitted by Petitioner to pay the application fee and examination fee for the November 3, 1999, exam are being returned with this Decision.

This is a final agency action.

OCT 22 1999



Q Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks