

render applicants for patents valuable service. *See* 37 C.F.R. § 11.7. Petitioner timely petitioned the OED Director to review the OED staff decision on July 18, 2015.

In an August 6, 2015, final decision, the OED Director decided Petitioner had not established to his satisfaction that she possessed the legal qualifications necessary for her to render patent applicants valuable service and denied Petitioner's request for reinstatement. This decision informed Petitioner that she could seek review of this decision by filing a petition pursuant to 37 C.F.R. § 11.2(d) within 60 days after the date of the decision and that she had the alternative available to her of retaking and passing the patent registration examination.

The Petitioner submitted a petition on October 5, 2015 to the USPTO Director. The Petitioner did not petition for a review of the OED Director's August 6, 2015 decision pursuant to 37 C.F.R. § 11.2(d); instead, the Petitioner has requested a suspension of the rules in 37 C.F.R. Part 11 pursuant to 37 C.F.R. § 11.3. In this petition, the Petitioner states that after a medical event she experienced in 1997, she experienced an incapacitating depression that caused her not to realize in a timely fashion that she had been removed from the register. The Petitioner also states that she does not have sufficient money or time to prepare for and retake the patent registration examination. The Petitioner argues that these circumstances represent an extraordinary situation warranting a suspension, pursuant to 37 C.F.R. § 11.3, of the requirement that she retake and pass the patent registration examination, a requirement found in 37 C.F.R. 11.7(b)(1)(ii).

II. Legal Standard

The U.S. Patent and Trademark Office ("USPTO") possesses authority to establish regulations governing the recognition of all practitioners, foreign and domestic, before the Office pursuant to 35 U.S.C. § 2(b)(2)(D). That provision states that the Director may establish

regulations which:

may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and *are possessed of the necessary qualifications to render to applicant or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.* (Emphasis added).

By regulation, the USPTO keeps a register of attorneys and agents on which are entered the names of all individuals recognized as entitled to represent applicants in the preparation and prosecution of patent applications before the USPTO. 37 C.F.R. § 11.5(a).

The OED Director receives and acts on applications for registration. *See* 37 C.F.R. §11.2(b)(2). Requirements for registration to practice before USPTO include filing a complete application for registration and, in relevant part, an applicant establishing to the satisfaction of the OED Director that she “[p]ossesses good moral character and reputation, [p]ossesses the legal, scientific, and technical qualifications necessary for him . . . to render applicants valuable service; and [i]s competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.” *See* 37 C.F.R. §11.7(a)(1) and (a)(2)(i)-(a)(iii). To enable the OED Director to determine whether an individual has the qualifications specified in §11.7(a)(2), a practitioner shall, *inter alia*, pass the registration examination. *See* 37 C.F.R. §11.7(b).

Where, as here, an individual was removed from the register pursuant to 37 C.F.R. § 10.11 for failing to respond to a survey, the individual may be reinstated on the register. That individual, however, must take and pass the examination registration if five or more years have elapsed since removal from the register unless they can demonstrate they continue to possess the legal qualifications necessary to render patent applicants valuable service. *See Reinstatement of*

Patent Attorneys and Agents to Practice Before the U.S. Patent and Trademark Office, 1064 Off. Gaz. Pat. & Trademark Office 12 (March 11, 1986).

Petitioner has asked that the requirement that she sit for and pass the registration examination prior to reinstatement to the active roster of patent practitioners be suspended or waived. Any requirement of the regulations of 37 C.F.R. Part 11 which is not a requirement of statute may be suspended or waived by the USPTO Director or the designee of the USPTO Director, *sua sponte*, or on petition by any party. 37 C.F.R. § 11.3(a). This suspension or waiver may be done in an “extraordinary situation, when justice requires.” *Id.*

III. Analysis

Petitioner has identified two matters which she claims represent an extraordinary situation warranting suspension of the rule requiring she retake the patent registration examination: 1) she experienced an incapacitating depression which caused her not to realize she had been removed from the register, and 2) she does not have the time and financial resources to retake the patent registration examination. Pursuant to 37 C.F.R. § 11.3, the USPTO Director, or her designee, has the authority to suspend or waive “[i]n an extraordinary situation, when justice requires, any requirement of the regulations of this Part which is not a requirement of statute. The word “extraordinary” means “very unusual.” *Merriam-Webster Dictionary* (2001). An “extraordinary situation” for the purposes of a regulation such as 37 C.F.R. § 11.3 allowing for the suspension or waiver of an otherwise applicable rule would be one that is “unique or exceptional.” *See Fetrow-Fix*, 2011 WL 2313650 at *3. An extraordinary situation does not include one that could have been prevented by the exercise of ordinary care or diligence. *See, e.g., Nitto Chemical Indus. Co. v. Comer*, 1994 WL 872610 (D.D.C. 1994). Petitioner has not demonstrated the

existence of an extraordinary situation that would warrant the suspension of the rules requiring her to retake and pass the patent registration examination.

Here, Petitioner's name was removed from the register on March 26, 2004. While Petitioner states that she suffered from an incapacitating depression that resulted in her not realizing she had been removed from the register, Petitioner has not explained why she could not have contacted OED for reinstatement within five years of her removal, particularly as she engaged in other activities during this time, such as commencing work with the State of New Hampshire in 2005. If she had done so, she could have been reinstated to the register without needing to retake and pass the patent registration examination exam. This five year time period for being readmitted to the register without having to retake and pass the patent registration examination provides ample time for a practitioner, through the exercise of ordinary care or diligence, to verify their registration status and contact OED to request reinstatement if necessary. Petitioner's failure to notice her removal from the register and to request reinstatement from OED within those five years does not constitute an extraordinary situation.

Petitioner also states that she lacks the time and money to retake the patent examination. All applicants who want to be registered by OED so that they can represent patent applicants before the USPTO must, with very limited exceptions, take the patent registration examination. *See, e.g.,* 37 C.F.R. § 11.7(b). Many applicants undoubtedly have work and family-related commitments that factor into and subtract from the time they have available to prepare for the patent registration examination. An applicant having significant competing demands on his or her time is not an unusual or exceptional occurrence and does not represent an extraordinary situation.

As for the expense associated with taking the patent registration examination, the Petitioner notes it would be a hardship for her because she would need to take a review class and pay fees. The USPTO does not, however, require an applicant to take a review class and an applicant's decision to pay for such a class is not an extraordinary situation. The fee for administration of the examination by the USPTO is \$450. *See* 37 C.F.R. 1.21(a)(1)(ii)(B). Petitioner may have competing financial demands or limited funds, but the requirement to pay this fee to be administered the patent registration examination does not represent an extraordinary situation. Rather, it reflects a requirement imposed on all applicants who take the patent registration examination. In addition, as previously noted, if the Petitioner had exercised ordinary care or diligence by applying for reinstatement to the register within five years of her removal from it, the need to pay for the administration of the patent registration examination could have been avoided.

Moreover, Petitioner has not demonstrated that justice requires the suspension of the rules, pursuant to 37 C.F.R. § 11.3, requiring her to retake and pass the patent registration examination. The underlying purpose of this examination is the protection of the public by enabling the OED Director to determine whether an individual possesses the legal qualifications necessary to render patent applicants valuable service. The Petitioner, by asking to be readmitted to the register eleven years after she was removed from it without having to retake and pass the examination so as to demonstrate she still has the requisite legal qualifications, is asking for her interests as a practitioner to be given priority over the protection of the public. Granting Petitioner's request, to the potential detriment of the public, would not be required by, or in the interest of, justice.

IV. Conclusion

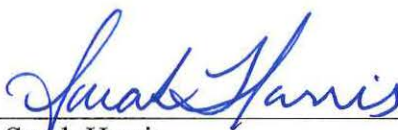
For the reasons stated above, Petitioner has not demonstrated that an “extraordinary situation” exists wherein “justice requires” the suspension or waiver of the requirement in 37 C.F.R. 11.7 that she retake and pass the patent registration examination to be reinstated in the register. Accordingly, Petitioner’s request under 37 C.F.R. 11.3 is denied.

ORDER

Upon Petition to the USPTO Director for suspension of certain rules under 37 C.F.R. 11.3, it is ORDERED that the petition is DENIED.

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Date



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On behalf of

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
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