

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

In re)
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_____)

DECISION ON PETITION
Under 37 C.F.R. §§ 10.170, 10.2 (c)

MEMORANDUM AND ORDER

(Petitioner) petitions for review of a decision by the Director of the Office of Enrollment and Discipline (Director). The Director’s decision denied Petitioner’s request to be admitted to the Registration Examination (exam) on November 3, 1999, because he failed 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 an exam authorized by 35 U.S.C. § 31 and required by 37 C.F.R. § 10.7(b). Petitioner wishes to take the exam that will be administered November 3, 1999.

Petitioner filed his exam application on August 9, 1999. The filing deadline for the November 3, 1999, exam, however, was July 23, 1999. Petitioner requested permission to sit for the exam notwithstanding his late application filing. The Director treated Petitioner’s request as a petition under 37 C.F.R. § 10.170 and denied the request in a decision dated September 2, 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 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 Application for Registration (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" (emphasis in original).

In his submissions to the PTO, Petitioner seeks a waiver of the exam deadline to allow him admission to the November 3, 1999, exam although he missed the application filing deadline. Petitioner provides two reasons why the deadline should be waived: (1) because the record reflects that an "extraordinary situation" occurred when his mailing was returned with insufficient postage; and (2) denying his request for waiver of the rules would be unjust because he would be treated differently than other applicants who have proven an "extraordinary situation" and are given a waiver pursuant to 37 C.F.R. § 10.170.

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 2,000 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 of how many examinees will be taking the test at each site. 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 at least six weeks prior to the examination date.

Thus, although the filing deadlines 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 his mailed application was returned with insufficient

postage and that this was apparently due to postage “falling off” his envelope in transit. As a result, Petitioner failed to meet his filing deadline. Petitioner argues that the “dislodging of postage” was caused by factors completely outside his control and this constitutes an “extraordinary situation” justifying a waiver of the rules under 37 C.F.R. § 10.170. Petitioner further asserts that his conduct does not fall within the scope of an “avoidable mistake” as defined in *Nitto Chemical Industry Co. v. Comer*, 39 USPQ 2d 1778, 1782 (D.D.C. 1994) (holding that “circumstances are not extraordinary, and do not require waiver of the rules, when the party attempting to file an application makes an avoidable mistake when depositing the papers”).

Petitioner’s argument is not persuasive, however, because he indeed had control over the act of securing postage to his envelope. Petitioner has not established that the lack of proper postage was not a matter under his control. Improper securement of postage is a mistake that was avoidable by the Petitioner.

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 or diligence,” *Nitto Chemical Ind. Co., Ltd.*, 39 USPQ 2d at 1780, or one in which “no meaningful alternatives are available,” *Margolis v. Banner*, 599 F.2d 435, 443 (CCPA 1979). Here, Petitioner asserts that postage “fell off” his application envelope which resulted in his application being returned for insufficient postage and ultimately an untimely filed application. Petitioner had the duty to apply ordinary care and diligence to assure that postage was properly secured, yet failed to do so. Additionally, there were other meaningful alternatives available to Petitioner to ensure timely filing of the application that he failed to access (e.g., Express Mail pursuant to 37 C.F.R. § 1.10

as indicated on page 6 of the November 3, 1999, exam bulletin). Further, Petitioner has provided no evidence that the postage “fell off.” There is no evidence of damage to the envelope or mishandling of the mailed application. Petitioner has not presented any facts or demonstrated unavoidable circumstances that led to the lost postage and ultimately to the untimely filing of his application. Therefore, Petitioner has not made a convincing showing of an “extraordinary situation” that would qualify for a waiver of the rules under 37 C.F.R. § 10.170.

Secondly, Petitioner argues a refusal of his request would be unjust because he would be treated differently than other similarly situated applicants who have shown an “extraordinary situation” and have been granted a waiver. This argument is also unpersuasive. As discussed above, Petitioner has not made a convincing showing of an “extraordinary situation” and therefore cannot be compared to any who might have made such a showing. Thus, the Petitioner is not being treated in an unequal or unjust manner.

Finally, Petitioner seeks to have factual evidence, that was not before the Director, considered on review. The Petitioner did not present any evidence to the Director manifesting a date when his application was returned with insufficient postage. Petitioner states the return date in his petition and now seeks to have it considered as factual evidence. The petition must be decided on the basis of the record made before the Director, and no new evidence will be considered. *See* 37 C.F.R. § 10.2 (c). There is no basis to waive the rule and consider facts not before the Director.

Petitioner also states that he may be unable to obtain employment in his chosen field due to the delay in taking the registration exam and therefore justice requires a rule waiver. The delay is not viewed as significant in that the exam will be administered again in April 2000. Moreover,

rule 10.170 provides for a waiver “[i]n an extraordinary situation, when justice requires...on petition by any party.” As discussed above, Petitioner has not demonstrated the requisite “extraordinary situation.”


In view of the foregoing reasons, the 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.

A refund in the amount of \$350.00 to cover the application fee and examination fee submitted by Petitioner for the November 3, 1999, exam will be returned to Petitioner by the Office of Finance.

This is a final agency action.



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

NOV 15 1999

Encl: General Requirements Bulletin for April 12, 2000, registration exam