The United States Patent and Trademark Office (USPTO) hereby provides notice that in the situation in which an applicant files a request for continued examination (RCE) after a Notice of Allowance is mailed (but before the publication fee is due), the USPTO will suspend the due date for the publication fee until three months from the mail date of the new Notice of Allowance for the application (if and when a new Notice of Allowance is mailed).

The USPTO has indicated that if an application is subject to publication under 37 CFR 1.211 (eighteen-month publication), the Notice of Allowance will require both the issue fee and the publication fee. See 37 CFR 1.211(e). The USPTO is in the process of revising the Notice of Allowance to add the publication fee requirement. Until a revised Notice of Allowance is available, the USPTO is separately mailing a Notice of Publication Fee Due after a Notice of Allowance has been mailed in any application subject to publication under 37 CFR 1.211.

The USPTO has also indicated that if an applicant files a request for continued examination (RCE) in compliance with 37 CFR 1.114 after a Notice of Allowance is mailed, but before the issue fee is due, the applicant is not required to pay the issue fee. See Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 Fed. Reg. 50091, 50097 (Aug. 16, 2000), 1238 Off. Gaz. Pat. Office 13, 18 (Sept. 5, 2000). This has resulted in some confusion as to whether the publication fee must be timely paid to avoid abandonment in the situation in which an RCE is filed after a Notice of Allowance (or Notice of Publication Fee Due) is mailed.

Section 4506 of the American Inventors Protection Act of 1999 provides that the Office shall recover the cost of early publication required by 35 U.S.C. § 122(b) by charging a separate publication fee after a Notice of Allowance is given under 35 U.S.C. § 151. See Pub. L. 106-113, 113 Stat. 1501, 1501A-565 (1999). While the USPTO plans to charge the issue fee and the publication fee together in the Notice of Allowance, the requirement to pay the publication fee is otherwise unrelated to the requirement to pay the issue fee. Thus, filing an RCE after a Notice of Allowance is mailed (but before the issue fee is due) does not mean that the applicant is no longer required to pay the publication fee.

Nevertheless, the USPTO wishes to avoid confusion as to when the publication fee is due in the situation in which an applicant files an RCE after a Notice of Allowance is mailed (but before the publication fee is due). Therefore, the USPTO hereby sua sponte suspends and resets the time period set in the Notice of Allowance (or Notice of Publication Fee Due) for payment of the publication fee in the situation in which an applicant files an RCE in compliance with 37 CFR 1.114 after a Notice of Allowance (or Notice of Publication Fee Due) has been mailed (but before the publication fee is due). The reset
period will be set forth in a new Notice of Allowance (or new Notice of Publication Fee Due), if and when a new Notice of Allowance is mailed. Thus, the publication fee will be due three months from the mail date of the new Notice of Allowance (or new Notice of Publication Fee Due).

Questions concerning this notice should be directed to Joni Chang at (703)-308-3858 (or joni.chang@uspto.gov) or Robert Clarke at (703)-305-9177 (or robert.clarke@uspto.gov).

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Patent Examination Policy