Revision of the Notice of Allowance Form

The Notice of Allowance and Issue Fee Due form (PTOL-85) has been revised, and the revised form is entitled "Notice of Allowance and Fee(s) Due" (PTOL-85). Revision of the form was necessary to include the amount of any required publication fee, as provided in 37 CFR 1.211(e) and 1.311, and to more clearly communicate the amount of any patent term extension or adjustment earned under 35 U.S.C. 154(b).

Beginning in November of 2001, the revised PTOL-85 form will be mailed when an application is allowed. Although the new form for a Notice of Allowance is already being mailed in any application with a positive patent term adjustment (see 35 U.S.C. §154(b), effective May 29, 2000) when the application is allowed, the new form is currently being mailed only to communicate patent term adjustment and does not include any publication fee that may be required. In the interim a separate "Notice of Publication Fee Due" is being mailed. See Interim Practice of Mailing a Notice of Publication Fee Due Separate From the Notice of Allowance, 1248 Off. Gaz. Pat. Office 166 (July 31, 2001).

As revised, the PTOL-85 form is three pages long, with all three pages being mailed to applicant and a duplicate being retained in the application file. Pages 1 and 2 of the revised form now include an indication that the publication fee is due, if the application was subject to publication and the publication fee has not already been paid. The second page (Part B) of the revised form (the PTOL-85B) should be returned to the Office with payment of the issue fee. The PTOL-85B is labeled "TRANSMIT THIS FORM WITH FEE(S)" at the bottom. Applicants are reminded to transmit an extra copy of the PTOL-85B when payment of the issue fee is by way of authorization to debit a Deposit Account, so that the Office does not need to make a photocopy. See Manual of Patent Examining Procedure, Section 509.01.

There are three versions of page three of the revised PTOL-85 form, depending upon the filing date of the application.

(1) For applications filed before June 8, 1995, page three will state that "This application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment is applicable under 35 U.S.C. 154(b)." Utility and Plant applications filed before June 8, 1995 are eligible for a 17 year term and thus are not eligible for patent term extension or adjustment under 35 U.S.C. §154(b).

(2) For applications filed on or after June 8, 1995 and before May 29, 2000, page three will state that "The patent term extension is ___ days. Any patent to issue from the above identified application will include an indication of the ___ day extension on the front page. If a continued prosecution application (CPA) was filed in the above-identified application, the filing date that determines patent term extension is the filing date of the
most recent CPA." Utility and plant applications filed on or after June 8, 1995 and before May 29, 2000 may be eligible for patent term extension. See 35 U.S.C. §154(b), effective June 8, 1995, and 37 CFR 1.701.

(3) For applications filed on or after May 29, 2000, page three will state that: "The patent term adjustment to date is ___ days. If the issue fee is paid on a date that is three months after the mailing date of this notice, and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the term adjustment will be ___ days. If a continued prosecution application (CPA) was filed in the above-identified application, the filing date that determines patent term extension is the filing date of the most recent CPA." Utility and plant applications filed on or after May 29, 2000 may be eligible for patent term adjustment. See 35 U.S.C. §154(b), effective May 29, 2000, and 37 CFR 1.702-1.705, especially 37 CFR 1.705(a).

Sample copies of three different versions of the Notice of Allowance and Fee(s) Due form (PTOL-85) are posted at: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revptol85.htm.

For more information see the many questions and answers about eighteen month publication, publication fees, and patent term adjustment posted on the USPTO's Internet Web site at http://www.uspto.gov/web/offices/dcom/olia/aipa/infoexch.htm.

Specific questions concerning publication of patent applications, or publication or issue fees, including any questions about the PTOL-85, should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 308-6789 or 1-888-786-0101, or by facsimile at (703) 305-5065. Questions regarding patent term extension or adjustment should be directed to Kery Fries or Mark Polutta, Legal Advisors with the Office of Patent Legal Administration. Kery Fries can be reached by e-mail at Kery.Fries@uspto.gov and by telephone at (703)308-0687. Mark Polutta can be reached at Mark.Polutta@uspto.gov and by telephone at (703)308-8122.

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STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy