Changes to Patent Fees Under the Consolidated Appropriations Act (H.R. 4818/P.L. 108-447)

- Effective date: December 8, 2004.
  - The Consolidated Appropriations Act (CAA) (H.R. 4818/P.L. 108-447) is effective on the date it was signed by the President (date of enactment).

- The patent fee structure provided for in CAA is in effect during the remainder of fiscal year 2005 and fiscal year 2006.
Changes to Patent Fees Under CAA
(H.R. 4818/P.L. 108-447)

- CAA (H.R. 4818/P.L. 108-447):
  - Effectively revises patent fees in general; and
  - Provides for separate fees, as follows:
    - Application (basic) filing fee,
    - Search fee,
    - Examination fee, and
    - Application size fee (an additional fee for any patent application whose specification and drawings exceed 100 sheets of paper).
Changes to Patent Fees Under CAA
Final and Interim Rules

Final Rule: revises the patent fees set forth in the rules of practice to conform them to the patent fees set forth in the CAA.


- Effective Date: December 8, 2004.
Changes to Patent Fees Under CAA
Final and Interim Rules

- Reduced search fee and examination fee for certain PCT applications entering the national stage.
    • Effective Date: February 1, 2005.
    • Effective Date: July 1, 2005.
The Consolidated Appropriations Act
Final Rule – Applications filed without appropriate fees

Final Rule (Effective July 1, 2005):

1. Requires a surcharge for applications filed without search fee or examination fee;
2. Establishes a page size equivalent of 3 kilobytes per page for compact disc (CD) submissions;
3. Requires payment of the basic filing fee (by eliminating the processing and retention fee) to permit benefit of the application to be claimed under 35 USC 120;
4. Establishes a paper size equivalent of 75% of the number of sheets of paper when the application is entered into the Office file wrapper for applications submitted via the Office electronic filing system (EFS).

Changes to Patent Fees Under CAA
Fees for Nonprovisional Applications

The following fees are required for applications filed under 35 USC 111(a) on or after December 8, 2004:

- **Basic filing fee** (35 USC 41(a)(1)):
  - $300 for a utility application (non-small entity)
- **Search fee** (35 USC 41(d)(1)):
  - $500 for a utility application (non-small entity)
- **Examination fee** (35 USC 41(a)(3)):
  - $200 for a utility application (non-small entity)
- **Application size fee** (35 USC 41(a)(1)(G)); and
  - If the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.
- **Excess Claims Fees** (35 USC 41(a)(2))
  - $200 (non-small entity) for each independent claim in excess of 3;
  - $50 (non-small entity) for each claim in excess of 20; and
  - $360 (non-small entity) for each application containing a multiple dependent claim.
Changes to Patent Fees Under CAA
Fees for Nonprovisional Applications

The Basic filing fee is reduced by 75% (i.e., $75.00) only if:
1. Small entity status is properly asserted (§1.27(c));
2. The application is filed via the Office’s Electronic Filing System (EFS); and
3. The application is an original utility nonprovisional application filed under 35 USC 111(a).

Note: the 75% reduction does not apply to:
- Any applicant who is not a small entity; or
- Design or plant applications, reissue applications, or provisional applications.
Changes to Patent Fees Under CAA
Fees for Nonprovisional Applications

The following fees apply to applications filed under 35 USC 111(a) before December 8, 2004:

- **Basic filing fee** prior to CAA applies; and
  - E.g., $790 for a utility application (non-small entity)
- **Excess Claims Fees** (35 USC 41(a)(2))
  - $200 (non-small entity) for each independent claim in excess of 3;
  - $50 (non-small entity) for each claim in excess of 20; and
  - $360 (non-small entity) for each application containing a multiple dependent claim

The following fees do **not** apply to applications filed under 35 USC 111(a) before December 8, 2004:

- Search fee
- Examination fee
- Application size fee
Changes to Patent Fees Under CAA
International Applications Entering the National Stage

The following fees are required for international applications for which the basic national fee is paid on or after December 8, 2004:

- **Basic national fee** (35 USC 41(a)(1)(F));
  - $300 (non-small entity)

- **Search fee** (35 USC 41(d)(1));
  - $500 (non-small entity)
  - *$400 (non-small entity) if search report from other office is provided
  - *$100 (non-small entity) if search fee has been paid to USPTO as the ISA
  - **$0.00 if USPTO acted as the IPEA and the criteria under PCT Article 33(1)-(4) were satisfied.

- **Examination fee** (35 USC 41(a)(3)(D));
  - $200 (non-small entity)
  - **$0.00 if USPTO acted as the IPEA and the criteria under PCT Article 33(1)-(4) were satisfied.

- **Application size fee** (35 USC 41(a)(1)(G)); and
  - If the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.

- **Excess Claims Fees** (35 USC 41(a)(2))
  *Effective February 1, 2005
  **Effective July 1, 2005
Changes to Patent Fees Under CAA
Fees for Provisional Applications

For provisional applications in which the filing fee is paid on or after December 8, 2004:

- **Basic filing fee** (35 USC 41(a)(1)(D)) as revised by CAA applies (e.g., $200 for a non-small entity).
  - The filing date of the provisional application is irrelevant.
Changes to Patent Fees Under CAA
Fees for Provisional Applications

For provisional applications **filed on or after** December 8, 2004:

- **Application size fee** (35 USC 41(a)(1)(G)) is required,
  - If the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.

- Application size fee is **not** required for provisional applications **filed before** December 8, 2004.
Changes to Patent Fees Under CAA
Fees for Reissue Applications

The following fees are required for reissue applications filed on or after December 8, 2004:

- **Basic filing fee** (35 USC 41(a)(1));
  - $300 (non-small entity)
- **Examination fee** (35 USC 41(a)(3));
  - $600 (non-small entity)
- **Search fee** (35 USC 41(d)(1)); and
  - $500 (non-small entity)
- **Application size fee** (35 USC 41(a)(1)(G))
  - If the specification and drawings exceed 100 sheets of paper, $250 (non-small entity) for each additional 50 sheets of paper or fraction thereof.
- **Excess Claims Fees** (35 USC 41(a)(2))

The type of reissue application is irrelevant.

- The same fees apply to utility, design, and plant reissue applications.
Changes to Patent Fees Under CAA
Search and Examination Fees

The search and examination fees apply to:
- Nonprovisional applications filed under 35 USC 111(a) on or after December 8, 2004; and
- International applications entering the national stage for which the basic national fee was not paid before December 8, 2004.

The search and examination fees are due:
- On filing of an application filed under 35 USC 111(a); or
- On commencement of the national stage of a PCT international application.
Changes to Patent Fees Under CAA
Search and Examination Fees

Effective July 1, 2005, the surcharge is required if the search fee or examination fee is paid on a date later than:

- The filing date of an application under 35 USC 111(a) filed on or after July 1, 2005; or

- Thirty months from the priority date for an international application entering the national stage in which the basic national fee is paid on or after July 1, 2005.
Changes to Patent Fees Under CAA
Search and Examination Fees

For example, if any of the following items is missing upon filing an application under 35 USC 111(a), the USPTO will issue a notice requiring the missing item and the surcharge within a specified period of time in order to avoid abandonment:

- The basic filing fee;
- The executed oath or declaration;
- The search fee*; or
- The examination fee*.

*Effective July 1, 2005, see the prior slide.
Changes to Patent Fees Under CAA
Search and Examination Fees

- Search and examination fees are **not** required for filing a request for continued examination (RCE) under §1.114.
  - The fee set forth in §1.17(e) for filing an RCE remains the same (e.g., $790 for a non-small entity).
- Search and examination fees are required when applicant files a design continued prosecution application (CPA) under §1.53(d).
  - A CPA is a new application and can only be filed in a design application.
Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

Application size fee applies to:

- Nonprovisional applications (including reissue applications) filed under 35 USC 111(a) on or after December 8, 2004;
- Provisional applications filed under 35 USC 111(b) on or after December 8, 2004; and
- International applications entering the national stage in which the basic national fee was paid on or after December 8, 2004.
Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

- Application size fee is $250.00 ($125.00 for a small entity) for each additional 50 sheets or fraction thereof.

- Application size fee applies to applications whose,
  - Specification and drawings exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) with a few exceptions.
Changes to Patent Fees Under CAA
Application Size Fee – 35 USC 41(a)(1)(G)

For purposes of application size fee, the Office will count:

- Applications filed via EFS
  - Effective July 1, 2005, the paper size equivalent is 75% of the number of sheets of paper present in the specification and drawings when entered into the file wrapper after being rendered by EFS.

- Substitute specification
  - The Office will count the sheets of paper of the substitute specification instead of the original specification, if the original specification is not legible (e.g., the font size is too small) or does not comply with other requirements set forth in §1.52.

- Tables filed on compact discs (CDs)
  - The paper size equivalent is 3 kilobytes per sheet of paper.
For purposes of application size fee, the Office will not count:

- Any sequence listing under §1.821(c) or (e), or computer program listing under §1.96

  - The listing must be:
    - Submitted on a compact disc in compliance with §1.52(e); or
    - Submitted via the Office’s electronic filing system (EFS) in ASCII text as part of an associated file of the application. See §1.52(f).

- Note: any listing submitted via EFS in PDF as part of the specification or as TIFF drawing files would not be excluded when determining the application size fee.
Changes to Patent Fees Under CAA
Excess Claims Fees – 35 USC 41(a)(2)

The revised excess claims fees (35 USC 41(a)(2)) are:

- $200 ($100 for small entity) for each claim in independent form in excess of 3;
- $50 ($25 for small entity) for each claim (whether dependent or independent) in excess of 20; and
- $360 ($180 for small entity) for each application containing a multiple dependent claim.
Changes to Patent Fees Under CAA
Excess Claims Fees – 35 USC 41(a)(2)

- The revised excess claims fees apply to those excess claims that are in excess of the number of claims that were previously paid for, after taking into account claims that have been canceled.

- For example, in an application that contains 6 independent claims and 30 total claims for which the excess claims fees were previously paid,
  - If the applicant cancels 10 claims, 2 of which are independent, and adds 11 claims, 3 of which are independent,
  - Revised excess claims fees for a 7th independent claim ($200) and a 31st claim ($50) are due.

- Note: the revised excess claims fees also apply to excess claims submitted before December 8, 2004, if the fee for the excess claims was not paid before December 8, 2004.
Changes to Patent Fees Under CAA
Excess Claims Fees – 35 USC 41(a)(2)

- The revised excess claims fees also apply to reissue applications pending on or after December 8, 2004.
- Under 35 USC 41(a)(2) as amended by the CAA, the claims in the original patent are not taken into account in determining the excess claims fee for a reissue application.
- Under “former” 35 USC 41, excess claims fees were required in reissue applications for:
  - Each independent claim in excess of the number of independent claims of the original patent; and
  - Each claim (whether independent or dependent) in excess of twenty and the number of claims of the original patent.
Changes to Patent Fees Under CAA
Excess Claims Fees – 35 USC 41(a)(2)

- The revised excess claims fees also apply to excess claims that are *presented* in a reexamination proceeding *on or after* December 8, 2004.
- See 35 USC 41(a)(2) which provides that an excess claims fee is due “on filing or on presentation at any other time” of an independent claim in excess of 3 or of a claim (whether independent or dependent) in excess of twenty.
- No excess claims fee is due for any claim presented during a reexamination proceeding *before* December 8, 2004.
The Office will apply a payment submitted for the fees due on filing in a **nonprovisional application** filed under 35 USC 111(a) in the following order (in absence of any instructions from the applicant) until the payment is expended:

1. Basic filing fee (§§1.16(a), (b), (c) or (e));
2. Application size fee (§1.16(s));
3. Late filing surcharge (§1.16(f));
4. Processing fee for an application filed in a language other than English (§1.17(i));
5. Search fee (§1.16(k)-(n));
6. Examination fee (§1.16(o)-(r)); and
7. Excess claims fees (§1.16(h)-(j)).
The Office will apply a payment submitted for the fees due on filing in a **provisional application** filed under 35 USC 111(b) in the following order (in absence of any instructions from the applicant) until the payment is expended:

1. Basic filing fee (§1.16(d));
2. Application size fee (§1.16(s)); and
3. Late filing surcharge (§1.16(g)).
The Office will treat a deposit account authorization to charge the filing fee as an authorization to charge the following applicable fees under §1.16 to the deposit account:

- Basic filing fee;
- Search fee;
- Examination fee;
- Any excess claims fees; and
- Any application size fee.
Changes to Patent Fees Under CAA
Payment of Fees

The Office will treat a deposit account authorization to charge the basic filing fee as an authorization to charge the following applicable fees under §1.16 to the deposit account:

- Basic filing fee;
- Search fee; and
- Examination fee.

Note: any deposit account authorization to charge the filing fee but not the search fee or examination fee must specifically limit the authorization by reference to one or more of paragraphs (a)-(e) of §1.16.
Changes to Patent Fees Under CAA
Elimination of Processing and Retention Fee Practice

- Effective July 1, 2005*, applicant must pay the basic filing fee during the pendency of the application (rather than just the processing and retention fee) in order for the benefit of the application to be claimed under 35 USC 120 and 37 CFR 1.78(a).

- Under the revised patent fee structure under CAA, the basic filing fee covers only the cost of the initial processing of an application.

- The Office must retain a prior-filed nonprovisional application to permit benefit of the application to be claimed under 35 USC 120 in a later-filed application.

*The final rule applies to applications filed under 35 USC 111(a) in which the processing and retention fee was not paid before July 1, 2005.
The CAA provides that the Office may, by regulation, provide for a refund of any part of:

1. The excess claim fee for any claim that is canceled before an examination on the merits;
2. The search fee for any applicant who files a written declaration of express abandonment as prescribed by the Director before an examination; and
3. The search fee for any applicant who provides a search report that meets the conditions prescribed by the Director.

To obtain a refund of any search fee paid in an application filed under 35 USC 111(a), it is proposed that applicant would have to submit:

- A petition and declaration of express abandonment in sufficient time to permit the appropriate officials to recognize the abandonment before the application has been taken up for examination (i.e., when the application is placed on the examiner’s docket for action*); and

- A request for refund within two months from the date on which the declaration of express abandonment was filed.

See proposed §1.138(d).

*The Office system would show that the status of the application is “Case Docketed to Examiner in GAU” (a status code of 030 or higher).
Changes to Patent Fees Under CAA

The CAA did not revise the fees for:

- A request for continued examination (RCE) under §1.114 (remains at $790 for a non-small entity);
- A submission after final rejection under §1.129(a) (remains at $790 for a non-small entity); or
- Each additional invention to be examined under §1.129(b) (remains at $790 for a non-small entity).
Changes to Patent Fees Under CAA

- Other revised patent fees include:
  - Issue fees – 35 USC 41(a)(4);
  - Disclaimer fee – 35 USC 41(a)(5);
  - Appeal fees – 35 USC 41(a)(6);
  - Revival fees – 35 USC 41(a)(7);
  - Extension of time fees – 35 USC 41(a)(8); and
  - Patent maintenance fees – 35 USC 41(b).

- Any payments of these fees made on or after December 8, 2004 must be made in the revised fee amounts.
Changes to Patent Fees Under CAA
Issue Fee – 35 USC 41(a)(4)

- The revised issue fees apply to issue fees paid on or after December 8, 2004:
  - A utility or reissue patent
    - $1,400 for a non-small entity (pre-CAA $1,370)
  - A design patent
    - $800 for a non-small entity (pre-CAA $490)
  - A plant patent
    - $1,100 for a non-small entity (pre-CAA $660)
Changes to Patent Fees Under CAA
Issue Fee – 35 USC 41(a)(4)

A Notice of Balance of Issue Fee Due will be mailed to applicant if:

- Applicant paid the issue fee on or after December 8, 2004; and
- Applicant paid the amount set forth in a notice of allowance mailed prior to December 8, 2004 (i.e., the pre-CAA amount of issue fee) instead of the amount set forth in CAA.
Changes to Patent Fees Under CAA
Disclaimer Fee – 35 USC 41(a)(5)

The revised disclaimer fee under §1.20(d) applies to filing a disclaimer under 35 USC 253 in a patent application or patent on or after December 8, 2004.

- $130 for a non-small entity (pre-CAA $110)
The following appeal fees apply to any appeal fee payments made on or after December 8, 2004:

- **Fee for filing a notice of appeal**
  - $500 for a non-small entity (pre-CAA $340)

- **Fee for filing an appeal brief**
  - $500 for a non-small entity (pre-CAA $340)

- **Fee for filing a request for oral hearing**
  - $1,000 for a non-small entity (pre-CAA $340)

See §41.20(b).
Changes to Patent Fees Under CAA
Revival Fees – 35 USC 41(a)(7)

The revised petition fee under §1.17(l) applies to any petition under §1.137(a) filed on or after December 8, 2004 for:

- The revival of an **unavoidably** abandoned application;
- The unavoidably delayed payment of the issue fee; or
- The revival of an unavoidably terminated reexamination proceeding.

The revised petition fee under §1.17(l) is $500 for a non-small entity (pre-CAA was $110).
Changes to Patent Fees Under CAA
Revival Fees – 35 USC 41(a)(7)

- The revised petition fee under §1.17(m) applies to any petition under §1.137(b) filed on or after December 8, 2004 for:
  - The revival of an *unintentionally* abandoned application;
  - The unintentionally delayed payment of the issue fee; or
  - The revival of an unintentionally terminated reexamination proceeding.

- The revised petition fee under §1.17(m) is $1,500 for a non-small entity (pre-CAA was $1,370).
The revised extension fees apply to any petitions for extension of time under §1.136(a) filed on or after December 8, 2004 (§1.17(a)).

- For reply within first month
  - $120 for a non-small entity (pre-CAA $110)

- For reply within second month
  - $450 for a non-small entity (pre-CAA $430)

- For reply within third month
  - $1,020 for a non-small entity (pre-CAA $980)

- For reply within fourth month
  - $1,590 for a non-small entity (pre-CAA $1,530)

- For reply within fifth month
  - $2,160 for a non-small entity (pre-CAA $2,080)
Changes to Patent Fees Under CAA
Patent Maintenance Fees - 35 USC 41(b)

- The revised maintenance fees are effective on the date that CAA (H.R. 4818) was signed by the President.

- Note: Fee deficiency would occur if the payment was made in the pre-CAA amount on the date of enactment, even when the payment was made (e.g., in the morning) prior to the President signing CAA (H.R. 4818) (e.g., in the afternoon).

- Maintenance fees must be timely paid in the appropriate amount to avoid expiration of a patent.
First maintenance fee under §1.20(e) has been decreased (due at 3.5 years after grant)
- $900 for a non-small entity (pre-CAA $940)

Second maintenance fee under §1.20(f) has been increased (due at 7.5 years after grant)
- $2,300 for a non-small entity (pre-CAA $2,150)

Third maintenance fee under §1.20(g) has been increased (due at 11.5 years after grant)
- $3,800 for a non-small entity (pre-CAA $3,320)
Changes to Patent Fees Under CAA
Additional Information

- Additional information is posted on the USPTO’s Internet Web at: http://www.uspto.gov/web/patents/hr4818/index.html
- For more information, please contact the Office of Patent Legal Administration at (571) 272-7701 or e-mail to PatentPractice@USPTO.gov, or contact one of the following legal advisors:
  - Robert A. Clarke (571) 272-7735
  - Eugenia A. Jones (571) 272-7727
  - Joni Y. Chang (571) 272-7720
Changes to Patent Fees Under CAA

Additional Information -
http://www.uspto.gov/web/patents/hr4818/index.html
Thank You