

## USPTO Proposes Fees Changes

By Donald Zuhn -- March 01, 2012



Last month, the U.S. Patent and Trademark Office, exercising the new fee setting authority conferred upon the Office by § 10 of the Leahy-Smith America Invents Act, submitted a [table of patent fee changes](#) to the Patent Public Advisory Committee (PPAC). The proposed fee changes were submitted to the PPAC in advance of two public hearings that were held on February 15 and February 23.

AIA § 10 allows the Director to set or adjust any fee established, authorized, or charged under Title 35 (but "only to recover the aggregate estimated costs to the Office for processing, activities, services, and materials relating to patents").

Pursuant to that section, the Director must submit proposed fee changes to the PPAC not less than 45 days before publishing the proposed fees in the Federal Register, after which the PPAC shall have 30 days to deliberate, consider, and comment on the proposal as well as hold a public hearing on the proposal. (The proposed fee changes were submitted to the PPAC on February 7, so the Committee has at least until March 8 to consider the changes and the Director must wait until March 23 before publishing a notice regarding the changes.) The Director shall then consider and analyze PPAC's comments, advice, or recommendations before setting or adjusting the fee. AIA § 10 also requires that the Director provide the public with a 45-day period in which to comment on any fee change, and specifies that fee changes shall not become effective until 45 days after the final rule regarding such change is published in the Federal Register (in order to give Congress an opportunity to enact a law disapproving of the fee change).

Along with the table of proposed changes, the Office has also made the following materials available on its AIA implementation webpage:

- A 4-page [letter](#) from Director Kappos to PPAC regarding the proposed changes;
- A 34-slide [executive summary](#) of the proposed changes that was submitted to PPAC;
- An 85-slide collection of [detailed appendices](#) regarding the proposed changes that was submitted to PPAC;
- An attachment providing [aggregate revenue calculations](#) that was submitted to PPAC; and
- A 5-page [memorandum](#) from USPTO General Counsel Bernard J. Knight, Jr. regarding patent fee setting.

A listing of the twenty highest patent fees\* under the Office's proposal is shown below:

Fee Description	37 CFR	Proposed Fee
Petition for <i>inter partes</i> review (61-70 claims)		\$95,200
Petition for <i>inter partes</i> review (51-60 claims)		\$68,000
Petition for <i>inter partes</i> review (41-50 claims)		\$54,400
Petition for <i>inter partes</i> review (31-40 claims)		\$40,800
Petition for <i>inter partes</i> review (21-30 claims)		\$34,000
Petition for <i>inter partes</i> review (20 or fewer claims)		\$27,200
Petition for <i>inter partes</i> review (each group of 10 claims over 70)		\$27,200
Supplemental Examination Reexamination		\$20,000
Request for <i>ex parte</i> reexamination	1.20(c)(1)	\$17,760
Patent maintenance fee -- due at 11.5 years	1.20(g)	\$7,600
Supplemental Examination Request		\$7,000
Request for prioritized examination	1.17(c)	\$4,000
Patent maintenance fee -- due at 7.5 years	1.20(f)	\$3,600
Extension for response within fifth month	1.17(a)(5)	\$3,000
File and oath/declaration up to the notice of allowance		\$3,000
Filing an appeal		\$2,500
Extension for response within fourth month	1.17(a)(4)	\$2,200
Petition in an <i>ex parte</i> or <i>inter partes</i> reexamination proceeding		\$1,940
Petition to revive unintentionally abandoned application	1.17(m)	\$1,900
Utility issue fee (through 12/31/2013)	1.18(a)	\$1,780

As measured in dollars, the twenty patent fees\* that would increase the most under the Office's proposal are as follows:

Fee Description	37 CFR	\$ Increase
Request for <i>ex parte</i> reexamination	1.20(c)(1)	\$15,240
Supplemental Examination Reexamination		\$3,880
File oath/declaration up to notice of allowance		\$3,000
Patent maintenance fee -- due at 11.5 years	1.20(g)	\$2,870
Filing an appeal		\$2,500
Supplemental Examination Request		\$1,820
Correct inventorship during examination where oath/declaration not provided before examination		\$1,700
Utility issue fee with pre-grant publication (effective 1/1/2014)		\$960
Notice of appeal	41.20(b)(1)	\$880
Request for continued examination (RCE)	1.17(e)	\$770
Patent maintenance fee -- due at 7.5 years	1.20(f)	\$750
Utility examination fee	1.16(o)	\$530
National Stage examination fee (US not ISA or IPEA; search report not prepared and provided to USPTO)	1.492(c)(2)	\$530
Patent maintenance fee -- due at 3.5 years	1.20(e)	\$470
Multiple dependent claim	1.16(j)	\$410
Multiple dependent claim in PCT National Stage application	1.492(f)	\$410
Extension for response within fifth month	1.17(a)(5)	\$310
Extension for response within fourth month	1.17(a)(4)	\$220
Independent claims in excess of three	1.16(h)	\$210
Independent claims in excess of three in PCT National Stage application	1.492(d)	\$210
National Stage search fee (search report prepared and provided to USPTO)	1.492(b)(3)	\$150
Extension for response within third month	1.17(a)(3)	\$130
Utility application size fee (each additional 50 sheets in excess of 100 sheets)	1.16(s)	\$90
Provisional application size fee (each additional 50 sheets in excess of 100 sheets)	1.16(s)	\$90

Finally, as measured by percentage, the twenty patent fees\* that would increase the most under the Office's proposal are as follows:

Fee Description	37 CFR	% Increase
Request for <i>ex parte</i> reexamination	1.20(c)(1)	704.8%
Utility Examination Fee	1.16(o)	312.0%
National Stage examination fee (US not ISA or IPEA; search report not prepared and provided to USPTO)	1.492(c)(2)	312.0%
Notice of appeal	41.20(b)(1)	241.9%
Multiple dependent claim	1.16(j)	191.1%
Multiple dependent claim in PCT National Stage application	1.492(f)	191.1%
Independent claims in excess of three	1.16(h)	184.0%
Independent claims in excess of three in PCT National Stage application	1.492(d)	184.0%
Request for continued examination (RCE)	1.17(e)	182.8%
Claims in excess of 20	1.16(i)	166.7%
Claims in excess of 20 in PCT National Stage application	1.492(e)	166.7%
Patent maintenance fee -- due at 11.5 years	1.20(g)	160.7%
Patent maintenance fee -- due at 3.5 years	1.20(e)	141.6%
Supplemental Examination Request		135.1%
Extension for response within first month	1.17(a)(1)	133.3%
National Stage search fee (search report prepared and provided to USPTO)	1.492(b)(3)	130.6%
Utility application size fee (each additional 50 sheets in excess of 100 sheets)	1.16(s)	129.0%
Provisional application size fee (each additional 50 sheets in excess of 100 sheets)	1.16(s)	129.0%
National Stage application size fee (each additional 50 sheets in excess of 100 sheets)	1.16(s)	129.0%
Patent maintenance fee -- due at 7.5 years	1.20(f)	126.3%

The Office's rationale for each of its proposed changes can be found by cross-referencing the [table of patent fee changes](#) with the [detailed appendices](#).

\*Patent fees for design, plant, and reissue applications were excluded.

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