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**QUESTIONS AND ANSWERS
CONCERNING THE PATENT FEE RELATED PROVISIONS OF
THE CONSOLIDATED APPROPRIATIONS ACT, 2005**

- A. Filing Fees
- B. Application Size Fees
- C. Excess Claims Fees
- D. Extension of Time Fees

A. Filing Fees, Including Search and Examination Fees

- A1. If an application does not include the basic filing fee on filing, would the applicant be given an opportunity to pay later?**

Yes, the Office will continue the practice under 37 CFR 1.53(f). Applicant will be notified and given a period of time within which to pay the basic filing fee and the surcharge required to avoid abandonment.

Nonprovisional Applications Filed Under 35 U.S.C. 111(a)

- A2. What fees are due for a nonprovisional application filed under 35 U.S.C. 111(a) on or after December 8, 2004, the effective date of the Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act)?**

The following fees are required:

- a. The **basic filing fee**;
 - b. The **search fee**;
 - c. The **examination fee**;
 - d. The **application size fee** for any application whose specification and drawings exceed 100 sheets of paper (excluding any sequence listing or computer program listing submitted either: (1) in an electronic medium in compliance with § 1.52(e), *e.g.*, compact discs, or (2) via the Office's electronic filing system (EFS) in ASCII text as part of an associated file of the application (see § 1.52(f)));
 - e. The **excess claims fee** for any application that includes more than 3 independent claims, more than 20 total claims, and/or a multiple dependent claim;
 - f. The **late filing surcharge**, if the basic filing fee, or oath or declaration, is filed later than the filing date of the application; and
 - g. The **processing fee** (§ 1.17(i)) if the application is filed in a language other than English (§ 1.52(d)).
- A3. If applicant filed a utility nonprovisional application under 35 U.S.C. 111(a) prior to December 8, 2004, the effective date of the Consolidated Appropriation Act (CAA), but did not pay the basic filing fee before December 8, 2004, can the applicant pay the revised basic filing fee as set forth in CAA?**

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No, the basic filing fee, \$790.00 (\$395.00 for a small entity), applies to utility nonprovisional applications filed under 35 U.S.C. 111(a) before December 8, 2004. Applicant, however, is not required to pay the search fee, examination fee, and the application size fee.

- A4. 35 U.S.C. 41(h)(3) (relating to small entity fees) as set forth in the Consolidated Appropriation Act (CAA) provides that the basic filing fee for a utility nonprovisional application is reduced by seventy-five percent if the application is filed by electronic means as prescribed by the Director. What electronic means is permitted for filing an application for the purpose of getting the 75% reduction in the basic filing fee?**

The 75 % reduction applies only to the basic filing fee of an original utility nonprovisional application filed under 35 U.S.C. 111(a) on or after December 8, 2004, in compliance with the Office electronic filing system (EFS) by an applicant who has properly asserted entitlement to small entity status under 37 CFR 1.27(c).

- A5. If a nonprovisional application was filed under 35 U.S.C. 111(a) before December 8, 2004, the effective date of the Consolidated Appropriations Act, but the basic filing fee is being paid after the effective date, would the search fee (35 U.S.C. 41(d)(1)), the examination fee (35 U.S.C. 41(a)(3)), and the application size fee (35 U.S.C. 41(a)(1)(G)) be required?**

No, the effective date provisions of the Consolidated Appropriations Act provide that 35 U.S.C. 41(a)(1)(G), 41(a)(3), and 41(d)(1) apply to applications filed under 35 U.S.C. 111(a) only if the application is filed on or after the effective date of the Consolidated Appropriations Act.

- A6. If applicant files a request for continued examination under 37 CFR 1.114 on or after December 8, 2004, would the revised basic filing fee, the search fee, and the examination fee be required?**

No, the fee for filing a request for continued examination (RCE) under 37 CFR 1.114 remains the same at \$790.00 (\$395.00 for a small entity) as set forth in 37 CFR 1.17(e). No search and examination fees are required when applicant files an RCE because an RCE is not a filing of a new application. The revised basic filing fee (e.g., \$300 for a utility application) does not apply to an RCE. Also, note that the fee for an RCE must be paid at the time of filing the RCE.

- A7. If applicant files a continued prosecution application (CPA) under 37 CFR 1.53(d) on or after December 8, 2004 in an original design application, would the revised basic filing fee, the search fee, and the examination fee be required?**

Yes, a CPA under 37 CFR 1.53(d) is a new application. A CPA can only be filed in a design application. The basic filing fee is \$200 (\$100 for a small entity), the search fee is \$100.00 (\$50.00 for a small entity), and the examination fee is \$130.00 (\$65.00 for a small entity) for a CPA filed in an original design application.

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A8. If applicant files a reissue application on or after December 8, 2004, what basic filing fee, search fee, and examination fee are due?

For any reissue application filed on or after December 8, 2004, the basic filing fee is \$300.00 (\$150.00 for a small entity), the search fee is \$500.00 (\$250.00 for a small entity), and the examination fee is \$600.00 (\$300.00 for a small entity), regardless of whether it is a utility, design, or plant reissue application).

Provisional Applications Filed Under 35 U.S.C. 111(a)

A9. What fees are required for filing a provisional application under 35 U.S.C. 111(b) filed on or after December 8, 2004, the effective date of the Consolidated Appropriations Act?

The following fees are required:

- a. The **provisional basic filing fee**;
- b. The **application size fee** for any application whose specification and drawings exceed 100 sheets of paper (excluding any sequence listing or computer program listing submitted either: (1) in an electronic medium in compliance with § 1.52(e), *e.g.*, compact discs, or (2) via the Office's electronic filing system (EFS) in ASCII text as part of an associated file of the application (see § 1.52(f))); and
- c. The **late filing surcharge** if the basic filing fee or cover sheet (§1.51(c)(1)) is filed later than the filing date of the provisional application.

A10. What is the basic filing fee for a provisional application filed before December 8, 2004, the effective date of the Consolidated Appropriations Act, if the applicant is paying the provisional basic filing fee on or after December 8, 2004?

The revised provisional basic filing fee, \$200.00 (\$100.00 for a small entity), applies to provisional applications filed before December 8, 2004 if the provisional basic filing fee is paid on or after December 8, 2004. The application size fee, however, is not required in a provisional application filed before December 8, 2004.

International Applications Entering the National Stage Under 35 U.S.C. 371

A11. What fees are required for international applications entering the national stage under 35 U.S.C. 371 for which the basic national fee was not paid before the effective date of the Consolidated Appropriations Act?

The following fees are required:

- a. The **basic national fee**;
- b. The **search fee**;
- c. The **examination fee**;
- d. The **application size fee** for applications whose specification and drawings together exceed 100 pages (excluding any sequence listing or computer program listing submitted in an electronic medium in compliance with § 1.52(e), *e.g.*, compact discs);

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- e. The **excess claims fee** if the application includes more than 3 independent claims, more than 20 total claims, and/or a multiple dependent claim;
- f. The **late filing surcharge**, if the oath or declaration is filed later than thirty months from the priority date pursuant to § 1.495(c); and
- h. The **processing fee** (§ 1.492(i), formerly § 1.492(f)), for filing an English translation of an international application or of any annexes to an international preliminary examination report later than thirty months after the priority date (§§ 1.495(c) and (e)).

A12. In an international application entering the national stage under 35 U.S.C. 371 for which the basic national fee was not paid before December 8, 2004, the effective date of the Consolidated Appropriations Act, would the search fee (35 U.S.C. 41(d)(1)), the examination fee (35 U.S.C. 41(a)(3)), and the application size fee (35 U.S.C. 41(a)(1)(G)) under the Consolidated Appropriations Act be required?

Yes, the effective date provisions of the Consolidated Appropriations Act provide that 35 U.S.C. 41(a)(1)(G), 41(a)(3), and 41(d)(1) apply to international applications entering the national stage under 35 U.S.C. 371 for which the basic national fee specified in 35 U.S.C. 41 was not paid before the effective date of the Consolidated Appropriations Act.

B. Application Size Fee

B1. What is the application size fee (35 U.S.C. 41(a)(1)(G))?

The application size fee is a fee for filing any application whose specification and drawings together exceed 100 sheets of paper (excluding any sequence listing or computer program listing filed either: (1) in an electronic medium in compliance with § 1.52(e), *e.g.*, compact discs, or (2) via the Office's electronic filing system (EFS) in ASCII text as part of an associated file of the application (see § 1.52(f))). See 35 U.S.C. 41(a)(1)(G).

B2. When is the application size fee due?

If the application includes a specification and drawings that together exceed 100 pages, the application size fee is due upon filing of the application. If the required application size fee is not paid on filing, the Office will issue a notice for the fee deficiency. The applicant must pay the required fee prior to the expiration of the time period for reply set forth in the notice to avoid the abandonment of the application.

B3. Is the surcharge set forth in 37 CFR 1.16(f) or (g) (formerly 37 CFR 1.16(e) and (l), respectively) required if the application size fee is not paid upon filing of the application?

No, the surcharge set forth in 37 CFR 1.16(f) or (g) does not apply to the application size fee.

B4. What types of applications require the application size fee?

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The application size fee applies to the following applications that include a specification and drawings that together exceed 100 pages (excluding any sequence listing or computer program listing submitted either: (1) in an electronic medium in compliance with § 1.52(e), *e.g.*, compact discs, or (2) via the Office's electronic filing system (EFS) in ASCII text as part of an associated file of the application (see § 1.52(f))):

- (1) Nonprovisional applications filed under 35 U.S.C. 111(a) (including utility, plant, design, and reissue applications) on or after December 8, 2004, the effective date of the Consolidated Appropriations Act;
- (2) Provisional applications filed under 35 U.S.C. 111(b) on or after December 8, 2004; and
- (3) International applications entering the national stage under 35 U.S.C. 371 for which the basic national fee specified in 35 U.S.C. 41 was not paid before December 8, 2004.

B5. Does the application size fee apply to a reexamination proceeding?

No.

B6. Would sheets of paper making up the English translation of a non-English language specification be counted for the purpose of determining the amount of application size fee due?

No, the Office will not count the sheets of paper making up any English translation of a non-English language specification.

B7. For the purpose of determining the amount of application size fee due, would the Office count the sheets of paper making up a preliminary amendment present on the filing date that only cancels claims?

Yes, the Office will count the pages of any preliminary amendment present on the filing date of the application even if the amendment only cancels claims. For example, if the preliminary amendment includes a transmittal letter that is on one sheet of paper and a complete claim listing that is on ten sheets of paper, the Office will count the ten sheets of paper when determining the amount of application size fee due in addition to the pages of the original claim listing.

B8. If the specification and drawings include blank pages to separate sections, will the Office count these blank pages when determining the amount of application size fee due?

Yes, the Office will use an automatic page counter and will not take out any blank pages that are placed between the pages of the specification and drawings.

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B9. If an application includes tables on a compact disc, would the Office count the tables in the calculation of the amount of application size fee due?

Yes, the Office will prescribe the paper size equivalent of an application filed in whole or in part in an electronic medium for purpose of the application size fee in a rule making. Once the Office makes the determination of the paper size equivalent, the Office will determine the paper size equivalent of the tables and notify the applicant of any additional application size fee due.

B10. If applicant submits paper copies of a sequence listing, will the Office count the sequence listing in the calculation of the application size fee?

Yes, the sequence listing submitted on paper will be counted with the specification and drawings of the application. The Office will not count any sequence listing or computer program listing filed in compliance with 37 CFR 1.52(e) on a compact disc in the calculation of the application size fee.

B11. If applicant electronically files an application under 35 U.S.C. 111(a) in compliance with the Office's electronic filing system (EFS) requirements, how would the Office count the pages of the specification and drawings for the purpose of determining the amount of application size fee due?

The Office will count the sheets of paper present in the specification and drawings when entered into the Office image file wrapper system after being rendered by the Office electronic filing system for purposes of computing the application size fee. Applicant may check private PAIR system for the number of sheets.

B12. 35 U.S.C. 41(a)(1)(G) as set forth in the Consolidated Appropriation Act provides that any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director will be excluded when determining the amount of application size fee due. What electronic medium is permitted under the exception?

For the purpose of determining the application size fee, the Office will not count any sequence listing or computer program listing filed: (1) on a compact disc in compliance with 37 CFR 1.52(e), or (2) via the Office electronic filing system (EFS) if the listing is submitted in American Standard Code for Information Interchange (ASCII) text as part of an associated file of the application (see § 1.52(f)). Note: any sequence listing must be filed in compliance with 1.821(c) or (e) and any computer program listing must be filed in compliance with 1.96.

B13. If applicant filed application papers that used such a small font size that the writing is not legible (or single-spaced pages which is not permitted under 37 CFR 1.52(b)(2)(i) or papers with improper margins), and the Office requires a substitute specification (including a new claim listing), will the pages of the substitute specification (and claim listing) be counted for the purpose of determining the amount of application size fee due?

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Yes, if the originally-filed application papers did not comply with 37 CFR 1.52, especially the legibility requirement of 37 CFR 1.52(a)(1)(iv), any papers filed to comply with 37 CFR 1.52(a)(1) will be counted for the purpose of determining the application size fee due, in place of the originally-filed specification and drawings. Applicants are encouraged to submit applications with the appropriate margins, and 12-point font to ensure legibility.

Excess Claims Fees

- C1. If applicant submitted 4 independent claims and 30 total claims prior to December 8, 2004, but did not pay for the excess claims fees until on or after December 8, 2004, would the revised excess claims fees set forth in CAA apply?**

Yes, the revised excess claims fees apply to any excess claims fee payments paid on or after December 8, 2004. The revised excess claims fees apply to those claims that, after taking into account the claims that have been canceled, are in excess of the number of claims for which the excess claims fee was previously paid for.

- C2. If applicant filed several multiple dependent claims, what multiple dependent claim fees are due?**

The fee for an application that contains at least one multiple dependent claim is \$360.00 (\$180.00 for a small entity) if applicant pays the multiple dependent claim fee on or after December 8, 2004. The Consolidated Appropriations Act did not change the way the multiple dependent claim fee applies. The multiple dependent claim fee is still due only once in an application at the time of the presentation of the first multiple dependent claim. A multiple dependent claim is a dependent claim that refers back in the alternative to more than one preceding independent or dependent claim. For fee calculation purposes, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein and any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. See MPEP 608.01(n) and 37 CFR 1.75(c). To assist in the computation of the fees for multiple dependent claims, applicant may use Form PTO-1360 or PTO/SB/07.

- C3. If applicant filed a provisional application with claims in excess of twenty and did not pay the excess claims fees, can a later-filed nonprovisional application claim the benefit of the provisional application?**

Yes, a nonprovisional application (other than for a design patent) may claim the benefit of the prior filed provisional application in compliance with 37 CFR 1.78(a) (e.g., the prior-filed provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c), and the basic filing fee must be paid within the time period set forth in 37 CFR 1.53(g)).

- C4. If applicant filed an application with numerous excess claims but failed to pay the excess claim fee(s) prior to December 8, 2004, what actions can the applicant take in place of paying the excess claim fee(s) for all the excess claims?**

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The applicant can either: (1) abandon the application in favor of a continuing application, assuming the prior-filed application meets the conditions of 37 CFR 1.78(a)(1) (see MPEP 201.11 for more information on continuing applications); or (2) file a preliminary amendment that is compliant with 37 CFR 1.115 and 1.121 which cancels all or some of the excess claims and pay any excess claim fee(s) that might be due after taking into account the claims that have been canceled by the preliminary amendment.

Excess Claims Fees for Reissue Application

- C5. Applicant filed a reissue application before December 8, 2004, with the same number of claims as in the patent. The patent has more than three independent claims and more than twenty total claims. If applicant added one more independent claim in the reissue application by filing an amendment before December 8, 2004, but did not pay for the excess claims fees, how much excess claims fees are required?**

The excess claims fees as set forth in Consolidated Appropriations Act apply to claims that are not paid for prior to December 8, 2004. Since applicant did not pay for the additional independent claim under the former 35 U.S.C. 41 in the reissue application, the excess claims fees, \$250.00 (\$200.00 plus \$50.00) for the additional independent claim are due if the applicant is a non-small entity.

- C6. Applicant filed a reissue application on or after December 8, 2004, with same number of claims as in the patent. If the patent has more than three independent claims and more than twenty total claims, would any excess claims fees be required?**

Yes, excess claims fees for each independent claim in excess of three and for each claim (whether independent or dependent) in excess of twenty are required. For example, in a reissue application filed on or after December 8, 2004 that contains four independent claims and twenty one total claims, excess claims fees for the fourth independent claim (\$200.00) and the twenty-first claim (\$50.00) are required if the applicant is a non-small entity. Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, the claims in the original patent are not taken into account in determining the excess claims fee for a reissue application.

- C7. A patent includes 6 independent claims and 30 total claims. If applicant filed a reissue application prior to December 8, 2004 with 3 independent claims and 20 total claims, and then the applicant subsequently presented 7 independent claims and 31 total claims on or after December 8, 2004, how much excess claims fees are due?**

The excess claims fees for the four independent claims in excess of three (e.g., 4 x \$200.00 = \$800.00) and the eleven claims in excess of twenty (e.g., 11 x \$50.00 = \$550.00) are due. Note: prior to CAA, the excess claims fees only apply to the 7th independent claim and the 31st claim.

- C8. A patent includes 6 independent claims and 30 total claims. Applicant filed 7 independent claims and 31 total claims before December 8, 2004 in a reissue**

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application of the patent, and paid the required excess claims fee for the 7th independent claim and the 31st claim.

(1) If applicant cancels 10 claims, 2 of which are independent, and adds 10 ten claims, 2 of which are independent, on or after December 8, 2004, how much excess claims fees are due?

No excess claims fee is due because after taking into account the claims that have been canceled, there is no claim in excess of the number of claims (independent or total) previously paid for.

(2) If applicant cancels 10 claims, 2 of which are independent, and adds 10 claims, 3 of which are independent, on or after December 8, 2004, how much excess claims fees are due?

The excess claims fee for the 8th independent claim (\$200.00) is due.

(3) If applicant cancels 10 claims, 2 of which are independent, and adds 11 claims, 2 of which are independent, on or after December 8, 2004, how much excess claims fees are due?

The excess claims fee for the 32nd claim (\$50.00) is due.

(4) If applicant cancels 10 claims, 2 of which are independent, and adds 11 claims, 3 of which are independent, on or after December 8, 2004, how much excess claims fees are due?

The excess claims fees for the 8th independent claim (\$200.00) and the 32nd claim (\$50.00) are due.

Excess Claims Fees for Reexamination Proceedings

C9. Do the excess claims fees set forth in CAA apply to the claims presented on or after December 8, 2004 in a reexamination proceeding?

Yes, the revised excess claims fees apply to claims presented on or after December 8, 2004 during a reexamination proceeding. The excess claims fees apply to all patents, whenever granted, for each independent claim in excess of three and also in excess of the number of independent claims in the patent, or for each claim (whether independent or dependent) in excess of twenty and also in excess of the number of claims in the patent that is presented in a reexamination proceeding on or after December 8, 2004. Note: No excess claims fee was due for any claim presented during a reexamination proceeding before December 8, 2004.

D. Extension of Time Fees

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D1. An Office action was mailed on June 8, 2004 that set forth a three-month shortened statutory time period extendable under 37 CFR 1.136(a). If applicant files a reply to the Office action on December 8, 2004, how much is the extension of time fee that would be due?

\$1,020.00 (\$510.00 for a small entity) because applicant would need to petition for a three-month extension of time. The revised extension of time fees apply because the payment is made on or after December 8, 2004, the effective date of CAA.

D2. How much is the extension of time fee that would be required for extending five months beyond the two-month time period for reply set forth in a preexamination notice if the payment is made on or after December 8, 2004?

35 U.S.C. 41(a)(8) as revised by the CAA provides that the fees for petitions for extensions of time to take actions required by the Director in an application are as follows: on filing a first petition, \$ 120; on filing a second petition, \$330; on filing a third or subsequent petition, \$570. Therefore, \$2,160.00 ($\$120 + \$330 + \$570 + \$570 + \$570 = \$2,160.00$) is due for extending five months beyond the set time period (\$1,080.00 for a small entity).