

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **Patent Fee Proposal**

**Patent Public Advisory Committee Hearing**  
**September 6, 2018**

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# Proposed Targeted Fee Adjustments

# Non-DOCX Filing Surcharge Fee

Fee Code	Description	Historical Cost (2017)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
New	Non-DOCX Filing Surcharge	n/a	--	\$400	+ \$400	--

- This fee will be charged for utility non-provisional filings submitted in a format other than DOCX (Microsoft Word).
- Encouraging applicants to use DOCX will improve examination quality and lower processing costs.
- Applications filed using DOCX will be more accessible in future searches of publication materials.
- Users filing via DOCX will see increased efficiencies and accuracy.

# Maintenance Fee Surcharge – Late Payment within Six Months

Fee Code	Description	Historical Cost (2017)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
1554	Surcharge - 3.5 year - Late payment within 6 months	n/a	\$160	\$1,000	+ \$840	+525%
1555	Surcharge - 7.5 year - Late payment within 6 months	n/a	\$160	\$1,000	+ \$840	+525%
1556	Surcharge - 11.5 year - Late payment within 6 months	n/a	\$160	\$1,000	+ \$840	+525%

- Increasing this fee encourages timely maintenance fee payments and brings the fee more in line with similar fees in other IP offices.

# Request for Expedited Examination of a Design Application Fee

Fee Code	Description	Historical Cost (2017)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
1802	Request for expedited examination of a design application	\$107	\$900	\$2,000	+ \$1,100	+122%

- This fee change will allow the Office to better manage demand for this service, better align the fee with the benefit received from an expedited examination, and will bring the fee more in line with the request for prioritized examination of a utility patent examination (currently \$4,000).

# Utility Patent Issue and Maintenance Fees

Fee Code	Description	Historical Cost (2017)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
1501	Utility Issue Fee	\$309	\$1,000	\$1,200	+ \$200	+20%
1511	Reissue Issue Fee	\$309	\$1,000	\$1,200	+ \$200	+20%
1551	For Maintaining an Original or Any Reissue Patent, Due at 3.5 years	n/a	\$1,600	\$2,000	+ \$400	+25%
1552	For Maintaining an Original or Any Reissue Patent, Due at 7.5 years	n/a	\$3,600	\$3,760	+ \$160	+4%
1553	For Maintaining an Original or Any Reissue Patent, Due at 11.5 years	n/a	\$7,400	\$7,700	+ \$400	+4%

- These changes will allow the Office to recover initial search and examination costs earlier in the patent lifecycle.
- As technology lifecycles grow shorter, it is important that USPTO not rely too heavily on fees paid late in the life of a patent.
- Maintenance fee rates have not changed since 2013.



# Office of Enrollment and Discipline (OED)

## Annual Active Patent Practitioner Fee

Fee Code	Description	Historical Cost (2017)	Current Fee	Proposed Fee	Dollar Change	Percent Change
New	Annual Active Patent Practitioner Fee filed on paper <i>without</i> certifying continuing legal education (CLE) completion	n/a	--	\$410	+\$410	--
New	Annual Active Patent Practitioner Fee filed electronically <i>without</i> certifying continuing legal education (CLE) completion	n/a	--	\$340	+\$340	--
New	Annual Active Patent Practitioner Fee filed on paper <i>with</i> certifying continuing legal education (CLE) completion	n/a	--	\$310	+\$310	--
New	Annual Active Patent Practitioner Fee filed electronically <i>with</i> certifying continuing legal education (CLE) completion	n/a	--	\$240	+\$240	--

- These fee rates are proposed to allow the costs associated with the services OED provides practitioners in administering the disciplinary system, roster maintenance, outreach, and pro bono support to be directly recovered from those practitioners.
- These fees promote the integrity of the patent practitioner roster and eliminate the need for a survey.
- This fee is similar to the annual fee charged by the vast majority of state and territorial bars.
- Encouraging CLE by offering a discount will improve the quality of the bar and therefore of the resulting patents.

# Petition Fee for Pro Hac Vice Admission

Fee Code	Description	Historical Cost (2017)	Current Fee	Proposed Fee	Dollar Change	Percent Change
New	Fee for non-registered practitioners to appear before the Patent Trial and Appeals Board	n/a	--	\$250	+\$250	--

- This fee is for counsel who are not registered practitioners to be granted admission in limited circumstances, e.g., where a practitioner is an experienced litigator who is familiar with the subject matter involved in the proceeding.
- Once the petition is granted, the counsel is admitted for the entire duration of the proceeding, which may extend for several years, e.g., when an *inter partes* review proceeds to final written decision, and, after appeal to the Federal Circuit, is remanded back to PTAB for further proceedings.
- These fees shift the cost of the services PTAB provides in processing petitions by counsel, who are not registered practitioners, from the overall trial fees to the petitioning counsel.



# AIA Trial Fees

Fee Code	Description	Historical Cost (2017)	Current Fee	Proposed Fee	Dollar Change	Percent Change
1406	Inter Partes Review Request Fee-Up to 20 Claims	\$15,922	\$15,500	\$19,500	\$4,000	+26%
1414	Inter Partes Review Post-Institution Fee—Up to <u>20</u> Claims*	\$16,206	\$15,000	\$18,750	\$3,750	+25%
1407	Inter Partes Review Request of Each Claim in Excess of 20	n/a	\$300	\$375	\$75	+25%
1415	Inter Partes Post-Institution Request of Each Claim in Excess of <u>20</u> *	n/a	\$600	\$750	\$150	+25%
1408	Post-Grant or Covered Business Method Review Request Fee - Up to 20 Claims	\$18,824	\$16,000	\$20,000	\$4,000	+25%
1416	Post-Grant or Covered Business Method Review Post-Institution Fee—Up to <u>20</u> Claims*	\$30,163	\$22,000	\$27,500	\$5,500	+25%
1409	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	n/a	\$375	\$475	\$100	+27%
1417	Post-Grant or Covered Business Method Review Post-Institution Request of Each Claim in Excess of <u>20</u> *	n/a	\$825	\$1,050	\$225	+27%

\* Threshold for post-institution excess claims fees is currently 15 claims.

- These fee increases will allow PTAB to continue high quality, timely, and efficient proceedings with the expected increase in work following the Supreme Court decision in SAS Institute Inc. v. Iancu.
- The post-institutional threshold for paying claims fees will increase from 15 to 20 claims, bringing it in sync with PTAB's request threshold, reflecting the fact that PTAB is required to institute all claims or none.



# Patent Service Fees

Fee Code	Description	Historical Cost (2017)	Current Fee	Proposed Fee	Dollar Change	Percent Change
8057	Copy of Patent Technology Monitoring Team (PTMT) patent bibliographic extract and other DVD (optical disc)	n/a	\$50	Discontinue	n/a	n/a
8058	Copy of U.S. patent custom data extracts	n/a	\$100	Discontinue	n/a	n/a
8059	Copy of selected technology reports, miscellaneous technology areas	n/a	\$30	Discontinue	n/a	n/a

- In January 2018 the other computer service fees were discontinued and these services were made free. These proposed changes follow that trend.
  - 8055 - Copy of Patent Grant Single-Page TIFF Images (52 week subscription)
  - 8056 - Copy of Patent Grant Full-Text W/Embedded Images, Patent Application Publication Single-Page TIFF Images, or Patent Application Publication Full-Text W/Embedded Images (52 week subscription)
- These service fees will be eliminated and the Office will instead provide these services, in a slightly modified form (i.e. electronic), for free.

# Other Fees

- The Patent and PTAB fees not mentioned previously will be increased by roughly five percent.
  - The proposed amounts are subject to USPTO fee rounding conventions, meaning that some fees will not change while others will be increasing slightly more or slightly less than five percent.
- Additional revenue generated from the proposed increases will allow USPTO to identify and advance policies that enhance the country's innovation ecosystem and provide strong, reliable, and predictable IP rights.
- Given the nearly three-year gap between the implementation of the last fee adjustments and the anticipated effective date of this fee setting effort, a five percent increase to fees is similar to fees rising by 1.6 percent annually, in order to help USPTO keep up with inflationary costs increases.
- For the detailed list of these increases as well as the targeted increases please see **Table of Patent Fees – Current, Proposed and Unit Cost** at <https://www.uspto.gov/about-us/performance-and-planning/fee-setting-and-adjusting>

# Path Forward

- September 2018 – PPAC hearing
- Fall 2018 – PPAC Report will be posted for public review
- Late summer 2019 – Publish Notice of Proposed Rulemaking (NPRM)
- Fall 2019 – 60-day public comment period
- Summer/Fall 2020 – Publish Final Rule
- January 2021 – Anticipated effective date of fee changes

# Closing

# Additional Information

Fee Setting Proposals and Materials:

<http://www.uspto.gov/about-us/performance-and-planning/fee-setting-and-adjusting>

Comments may be sent by email to: [fee.setting@uspto.gov](mailto:fee.setting@uspto.gov) by September 13, 2018

**Thank You**



