

The America Invents Act Changes To U.S. Patent Practice

The America Invents Act which became law on September 16, 2011 will affect our patent practice in a number of ways.

FEE INCREASE

The immediate change was a 15% fee increase, which most are already aware of. However, with this law came a new fee setting authority. At the time of passage, we were not sure where this would lead but on February 8, 2012 the U.S. Patent Office published their proposed fee increases for 2013. A chart showing the proposed increases is enclosed. Note these are not final, and there will be many months before final fees are determined, but the goal used in setting these fees is for the Patent Office to recoup actual costs, and provide a cash reserve, with a dramatic impact on some fees such as ex parte re-examination, rising from \$2520, to \$17,760. The interparty procedure fees are quite staggering. Time will tell if the Patent Office will reconsider implementing this fee schedule.

MICRO-ENTITY

One change related to fees that would assist the smaller inventor and universities is the "Micro-entity" fee reduction. Essentially a micro-entity would receive a discount of 75% on many fees. However, implementing regulations to determine who qualifies to take advantage of that discount are on a 17 month track, and so those who qualify now as micro-entities are many months away from being able to receive that discount.

PRIORITIZED EXAMINATION

Another immediate change has been the implementation of "Prioritized Examination". By paying a fee of \$4800, an applicant can have his case taken out of order and put on a track for allowance or final rejection within 12 months. Unlike "Accelerated Examination", a search report and detailed analysis of the prior art are not required. Also, this procedure is available for

continuations and RCE's, but if you fall off the track, and there are various ways this can happen, you return to the normal queue. At present, the Patent Office has imposed a limit, and will accept only 10,000 Prioritized Examination cases this year.

NEW REVIEW PROCEEDURES

A major group of changes will come into effect on September 16, 2012. These changes include third party submissions after patent publication, an Owner's ability to request supplemental examination of an issued patent, a new inter parties review procedure, a new post grant review and a transitional review program for covered business methods patents.

THIRD PARTY SUBMISSION AFTER PUBLICATION

The third party submission after publication will allow any third party to place before an Examiner printed publications together with an explanation of the relevance of the submitted documents. This is a time sensitive submission, which must be made within 6 months of the publication date and also before the date of first rejection of any claim in the application or a notice of allowance is mailed. The proposed fee for this submission is \$180 for from 1-10 references, \$360 for 11-20 documents. This will be treated by the Examiner the same as an Information Disclosure Statement. Institution of a competitor publication watch may be prudent to take advantage of this low cost submission procedure.

SUPPLEMENTAL EXAMINATION

A Patent Owner's now has the ability to seek Supplemental Examination to "consider, reconsider or correct" information believed to be relevant to an issued patent. Generally, this gives a Patent Owner the option to make corrections before proceeding with patent enforcement. Information is not limited to patents and printed publications so other issues, such as written description errors, or first sale issues may be raised and corrected. An Owner would be limited to 10 items of information per request. The Request would

include a list of items of information, identify the issue raised by each item of information, with an explanation for each identified issue, and as to how the item is relevant to the patent. No amendments or interviews are allowed during the review of the request for supplemental examination.

The Patent Office, within three months of receiving the request, must decide if the request raises a "substantial new question of patentability". If so, the Director must order reexamination. If not, a certificate will issue stating that no such question was raised.

Given that an ex parte reexamination might be ordered, the Patent Owner is required to pay the fees, upfront, for both the Supplemental Examination and the Reexamination, the proposed fee being \$5180 plus \$16,120, total of \$22,100. If no re-examination is ordered, that portion would be refunded.

Ex parte Reexamination not sought via supplemental examination has a proposed fee of \$17,750, a huge increase over the current fee of \$2,520. No small entity or micro entity reductions are available.

POST GRANT REVIEW/INTER PARTIES REVIEW

The proposed rules for the new Post Grant Review, inter parties reexamination, and review of business methods patents were recently released. While a review of those rules is beyond the scope of this paper, it should be mentioned that not only are the official fees quite high, but there seems to be a strong expectation that expert evidence will be submitted, with time in the schedule for experts to be deposed.

While required to reach a decision within 12 months, it is quite clear that costs both in preparing for and proceeding with either the Post Grant Review or Inter parties Reexamination will be quite high for both the Requestor and the Patent Owner. These reviews are actually mini-trials before the Patent Office Board of Patent Appeals which will double in size in the next year. Rules recently published detail how the review process will be conducted.

BUSINESS METHODS REVIEW

The transitional review program for covered business methods patents appears to be quite limited in scope. To file a request for a business method post grant review, the petitioner must either be sued for infringement of the business method patent, or been charged with infringement of the business method patent, though review would not be granted for patents for "technological inventions". In other words, the claims must be pure business methods claims. The Patent Office will not allow this review if the claimed subject matter as a whole (1) recites a technological feature that is novel and unobvious over the prior art; and (2) solves a technical problem using a technical solution.

REVIEW FEES

The fee for submitting a request for inter parties reexamination is proposed in a range from \$27,200 to \$95,200, depending on the number of claims to be reviewed. The official fee for Post Grant Review and review of covered business methods patents ranges from \$35,800 to \$125,300 depending on the number of claims to be reviewed. No small entity or micro entity reductions are available.

One can expect that adding attorney fees and expert fees would make these procedures quite expensive and generally beyond the reach of most small and even mid-sized companies.

OTHER CHANGES

Other changes including first to file, derivation procedures, and the associated change in the statutory grace period will be phased in at the 17 and 18 month dates from enactment of the America Invents Act, which will be the subject of another letter.

If you have any questions on the above, please feel free to contact us.

www.cssiplaw.com

email: wspone@cssiplaw.com

TABLE OF PATENT FEE CHANGES

USPTO Patent Fees													Location for Description of Rationale for Changes	
USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description	
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Patent Application Filing Fees														
1011/2011	1.16(a)(1)	41(a)(1)(A)	Basic filing fee - Utility	380.00	190.00	400.00	200.00	100.00	20.00	5%	243.00		Refer to p. 56	
4011	1.16(a)(1)	41(h)(3)	Basic filing fee - Utility (electronic filing for small entities)	n/a	95.00	n/a	100.00	50.00	5.00	5%	243.00		Refer to p. 56	
1051/2051	1.16(f)		Surcharge - Late filing fee, search fee, examination fee or oath or declaration	130.00	65.00	140.00	70.00	35.00	10.00	8%	c		Refer to p. 56	
1012/2012	1.16(b)(1)	41(a)(1)(B)	Basic filing fee - Design	250.00	125.00	260.00	130.00	65.00	10.00	4%	243.00		Refer to p. 56	
1017/2017	1.16(b)(1)	41(a)(1)(B)	Basic filing fee - Design (CPA)	250.00	125.00	260.00	130.00	65.00	10.00	4%	632.00		Refer to p. 56	
1013/2013	1.16(c)(1)	41(a)(1)(C)	Basic filing fee - Plant	250.00	125.00	320.00	160.00	80.00	70.00	28%	243.00	Yes	Refer to p. 56	
1014/2014	1.16(e)(1)	41(a)(1)(E)	Basic filing fee - Reissue	380.00	190.00	400.00	200.00	100.00	20.00	5%	242.00		Refer to p. 56	
1019/2019	1.16(e)(1)	41(a)(1)(E)	Basic filing fee - Design Reissue (CPA)	380.00	190.00	400.00	200.00	100.00	20.00	5%	632.00		Refer to p. 56	
1005/2005	1.16(d)	41(a)(1)(D)	Provisional application filing fee	250.00	125.00	260.00	130.00	65.00	10.00	4%	122.00		Refer to p. 56	
1052/2052	1.16(g)		Surcharge - Late provisional filing fee or cover sheet	50.00	25.00	60.00	30.00	15.00	10.00	20%	c		Refer to p. 56	
1631/2631	1.492(a)	41(a)(1)(F)	Basic National Stage Fee	380.00	190.00	400.00	200.00	100.00	20.00	5%	355.00		Refer to p. 56	
1053	1.17(i)		Non-English specification	130.00		140.00	70.00	35.00	10.00	8%	c		Refer to p. 56	
Patent Search Fees														
1111/2111	1.16(k)	41(d)(1)(B)(i)	Utility Search Fee	620.00	310.00	660.00	330.00	165.00	40.00	6%	1,694.00	Yes	Refer to p. 56	
1112/2112	1.16(l)	41(d)(1)(B)(ii)	Design Search Fee	120.00	60.00	420.00	210.00	105.00	300.00	250%	448.00	Yes	Refer to p. 56	
1113/2113	1.16(m)	41(d)(1)(B)(v)	Plant Search Fee	380.00	190.00	520.00	260.00	130.00	140.00	37%	1,694.00	Yes	Refer to p. 56	
1114/2114	1.16(n)	41(d)(1)(B)(iii)	Reissue Search Fee	620.00	310.00	660.00	330.00	165.00	40.00	6%	1,694.00	Yes	Refer to p. 56	
1640/2640	1.492(b)(1)		National Stage Search Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00	0.00	0.00	0.00	0%	277.00		Refer to p. 56	
1641/2641	1.492(b)(2)		National Stage Search Fee - U.S. was the ISA	120.00	60.00	140.00	70.00	35.00	20.00	17%	277.00	Yes	Refer to p. 56	
1642/2642	1.492(b)(3)		National Stage Search Fee - search report prepared and provided to USPTO	490.00	245.00	640.00	320.00	160.00	150.00	31%	1,694.00	Yes	Refer to p. 56	
1632/2632	1.492(b)(4)	41(d)(1)(B)(iv)	National Stage Search Fee - all other situations	620.00	310.00	660.00	330.00	165.00	40.00	6%	1,694.00	Yes	Refer to p. 56	
Patent Examination Fees														
1311/2311	1.16(o)	41(a)(3)(A)	Utility Examination Fee	250.00	125.00	780.00	390.00	195.00	530.00	212%	1,969.00	Yes	Refer to p. 56	
1312/2312	1.16(p)	41(a)(3)(B)	Design Examination Fee	160.00	80.00	500.00	250.00	125.00	340.00	213%	517.00	Yes	Refer to p. 56	
1313/2313	1.16(q)	41(a)(3)(C)	Plant Examination Fee	200.00	100.00	620.00	310.00	155.00	420.00	210%	1,969.00	Yes	Refer to p. 56	
1314/2314	1.16(r)	41(a)(3)(E)	Reissue Examination Fee	750.00	375.00	780.00	390.00	195.00	30.00	4%	1,969.00		Refer to p. 56	
1643/2643	1.492(c)(1)		National Stage Examination Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00	0.00	0.00	0.00	0%	1,969.00		Refer to p. 56	
1633/2633	1.492(c)(2)	41(a)(3)(D)	National Stage Examination Fee - all other situations	250.00	125.00	780.00	390.00	195.00	530.00	212%	1,969.00	Yes	Refer to p. 56	

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USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change			
Request for Continuing Examination Fees													
1801/2801	1.17(e)		Request for continued examination (RCE) (see 37 CFR 1.114)	930.00	465.00	1,700.00	850.00	425.00	770.00	83%	1,696.00	Yes	Refer to p. 61
Track I Fees													
1817/2817	1.17(c)		Request for prioritized examination ^b	4,800.00	2,400.00	4,000.00	2,000.00	1,000.00	-800.00	-17%	4,000.00	Yes	Refer to p. 57
Pre-Grant Publication Fees													
1504	1.18(d)		Publication fee for early, voluntary, or normal publication	300.00		300.00			0.00	0%	158.00		Refer to p. 62
1505	1.18(d)		Publication fee for republication	300.00		300.00			0.00	0%	122.00		Refer to p. 62
Issue Fees													
1501/2501	1.18(a)	41(a)(4)(A)	Utility issue fee - Through 12/31/2013	1,740.00	870.00	1,780.00	890.00	445.00	40.00	2%	231.00		Refer to p. 62
1502/2502	1.18(b)	41(a)(4)(B)	Design issue fee - Through 12/31/2013	990.00	495.00	1,020.00	510.00	255.00	30.00	3%	231.00		Refer to p. 62
1503/2503	1.18(c)	41(a)(4)(C)	Plant issue fee - Through 12/31/2013	1,370.00	685.00	1,400.00	700.00	350.00	30.00	2%	231.00		Refer to p. 62
1511/2511	1.18(a)	41(a)(4)(D)	Reissue issue fee - Through 12/31/2013	1,740.00	870.00	1,780.00	890.00	445.00	40.00	2%	231.00		Refer to p. 62
XXXX			Utility issue fee (with Pre-Grant Publication) - NEW Effective 1/1/2014			960.00	480.00	240.00	-1,080.00	-53%	389.00	Yes	Refer to p. 62
1502/2502	1.18(b)	41(a)(4)(B)	Design issue fee - Effective 1/1/2014			560.00	280.00	140.00	-430.00	-43%	231.00	Yes	Refer to p. 62
XXXX			Plant issue fee (with Pre-Grant Publication) - NEW Effective 1/1/2014			760.00	380.00	190.00	-910.00	-54%	389.00	Yes	Refer to p. 62
1511/2511	1.18(a)	41(a)(4)(D)	Reissue issue fee - Effective 1/1/2014			960.00	480.00	240.00	-780.00	-45%	231.00	Yes	Refer to p. 62
Patent Maintenance Fees													
1551/2551	1.20(e)	41(b)(1)	Due at 3.5 years	1,130.00	565.00	1,600.00	800.00	400.00	470.00	42%	1.00	Yes	Refer to p. 63
1552/2552	1.20(f)	41(b)(2)	Due at 7.5 years	2,850.00	1,425.00	3,600.00	1,800.00	900.00	750.00	26%	1.00	Yes	Refer to p. 63
1553/2553	1.20(g)	41(b)(3)	Due at 11.5 years	4,730.00	2,365.00	7,600.00	3,800.00	1,900.00	2,870.00	61%	1.00	Yes	Refer to p. 63
1554/2554	1.20(h)		Surcharge - 3.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	c		Refer to p. 63
1555/2555	1.20(h)		Surcharge - 7.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	c		Refer to p. 63
1556/2556	1.20(h)		Surcharge - 11.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	c		Refer to p. 63
1557/2557	1.20(i)(1)		Surcharge after expiration - Late payment is unavoidable	700.00		700.00	350.00	175.00	0.00	0%	68.00		Refer to p. 63
1558/2558	1.20(i)(2)		Surcharge after expiration - Late payment is unintentional	1,640.00		1,640.00	820.00	410.00	0.00	0%	68.00		Refer to p. 63
Patent Appeals Fees													
1405	41.20(a)		Petitions to the Chief Administrative Patent Judge under 37 CFF 41.3	400.00		400.00			0.00	0%	68.00		
1401/2401	41.20(b)(1)	41(a)(6)(A)	Notice of appeal	620.00	310.00	1,500.00	750.00	375.00	880.00	142%		Yes	Refer to p. 64
1402/2402	41.20(b)(2)	41(a)(6)(B)	Filing a brief in support of an appeal	620.00	310.00	0.00	0.00	0.00	-620.00	-100%	4,960.00	Yes	Refer to p. 64
XXXX			Filing an Appeal - NEW			2,500.00	1,250.00	625.00	2,500.00	N/A			Refer to p. 64
XXXX			Patent issue fee (with PG Pub) After Examiner Withdrawal fo Final Rejection - NEW			0.00	0.00	0.00	0.00		389.00	Yes	Refer to p. 64
1403/2403	41.20(b)(3)	41(a)(6)(B)	Request for oral hearing	1,240.00	620.00	1,300.00	650.00	325.00	60.00	5%	361.00		

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USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description	
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Post Grant Review Fees														
XXXX			Covered business method patent and post grant review, 20 or fewer claims ^b	35,800.00		35,800.00				0.00	0%	35,800.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, 21 - 30 claims ^b	44,750.00		44,750.00				0.00	0%	44,750.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, 31 - 40 claims ^b	53,700.00		53,700.00				0.00	0%	53,700.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, 41 - 50 claims ^b	71,600.00		71,600.00				0.00	0%	71,600.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, 51 - 60 claims ^b	89,500.00		89,500.00				0.00	0%	89,500.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, 61 - 70 claims ^b	125,300.00		125,300.00				0.00	0%	125,300.00		Refer to NPRM (RIN - 0651-AC72/AC73)
XXXX			Covered business method patent and post grant review, each additional group of 10 claims ^b	35,800.00		35,800.00				0.00	0%	35,800.00		Refer to NPRM (RIN - 0651-AC72/AC73)
Re-exam Ex Partes Fees														
1812	1.20(c)(1)		Request for ex parte reexamination	2,520.00		17,760.00	8,880.00	4,440.00	15,240.00	605%		16,648.00	Yes	Refer to NPRM (RIN - 0651-AC69)
XXXX			Petition in an ex parte or inter partes reexamination proceeding	1,930.00		1,940.00	970.00	485.00	10.00	1%		1,812.00		Refer to NPRM (RIN - 0651-AC69)
Excess Claims Fees														
1201/2201	1.16(h)	41(a)(2)(A)	Independent claims in excess of three	250.00	125.00	460.00	230.00	115.00	210.00	84%	a		Yes	Refer to p. 59
1202/2202	1.16(i)	41(a)(2)(B)	Claims in excess of 20	60.00	30.00	100.00	50.00	25.00	40.00	67%	a		Yes	Refer to p. 59
1203/2203	1.16(j)	41(a)(2)(C)	Multiple dependent claim	450.00	225.00	860.00	430.00	215.00	410.00	91%	a		Yes	Refer to p. 59
1204/2204	1.16(h)	41(a)(2)(A)	Reissue independent claims in excess of three	250.00	125.00	460.00	230.00	115.00	210.00	84%	a		Yes	Refer to p. 59
1205/2205	1.16(i)	41(a)(2)(B)	Reissue claims in excess of 20	60.00	30.00	100.00	50.00	25.00	40.00	67%	a		Yes	Refer to p. 59
1614/2614	1.492(d)	41(a)(2)(A)	[PCT National Stage] Claims - extra independent (over three)	250.00	125.00	460.00	230.00	115.00	210.00	84%	a		Yes	Refer to p. 59
1615/2615	1.492(e)	41(a)(2)(B)	[PCT National Stage] Claims - extra total (over 20)	60.00	30.00	100.00	50.00	25.00	40.00	67%	a		Yes	Refer to p. 59
1616/2616	1.492(f)	41(a)(2)(C)	[PCT National Stage] Claims - multiple dependent	450.00	225.00	860.00	430.00	215.00	410.00	91%	a		Yes	Refer to p. 59

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				Large	Small	Large	Small	Micro	Dollar Change	Percent Change			
Patent Extension of Time Fees													
1251/2251	1.17(a)(1)	41(a)(8)	Extension for response within first month	150.00	75.00	200.00	100.00	50.00	50.00	33%	c	Yes	Refer to p. 60
1252/2252	1.17(a)(2)	41(a)(8)	Extension for response within second month	560.00	280.00	600.00	300.00	150.00	40.00	7%	c	Yes	Refer to p. 60
1253/2253	1.17(a)(3)	41(a)(8)	Extension for response within third month	1,270.00	635.00	1,400.00	700.00	350.00	130.00	10%	c	Yes	Refer to p. 60
1254/2254	1.17(a)(4)	41(a)(8)	Extension for response within fourth month	1,980.00	990.00	2,200.00	1,100.00	550.00	220.00	11%	c	Yes	Refer to p. 60
1255/2255	1.17(a)(5)	41(a)(8)	Extension for response within fifth month	2,690.00	1,345.00	3,000.00	1,500.00	750.00	310.00	12%	c	Yes	Refer to p. 60
Application Size Fees													
1081/2081	1.16(s)	41(a)(1)(G)	Utility Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
1082/2082	1.16(s)	41(a)(1)(G)	Design Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
1083/2083	1.16(s)	41(a)(1)(G)	Plant Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
1084/2084	1.16(s)	41(a)(1)(G)	Reissue Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
1085/2085	1.16(s)	41(a)(1)(G)	Provisional Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
1681/2681	1.492(j)	41(a)(1)(G)	National Stage Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%	a	Yes	Refer to p. 58
Revival Fees													
1452/2452	1.17(l)	41(a)(7)	Petition to revive unavoidably abandoned application	620.00	310.00	640.00	320.00	160.00	20.00	3%			
1453/2453	1.17(m)	41(a)(7)	Petition to revive unintentionally abandoned application	1,860.00	930.00	1,900.00	950.00	475.00	40.00	2%			
Miscellaneous Patent Fees													
1808	1.17(i)		Processing fee, except in provisional applications	130.00		130.00			0.00	0%			
1803	1.17(j)		Request for voluntary publication or republication	130.00		130.00			0.00	0%			
1802	1.17(k)		Request for expedited examination of a design application	900.00		900.00	450.00	225.00	0.00	0%			
1804	1.17(n)		Request for publication of SIR - Prior to examiner's action	920.00		920.00			0.00	0%			
1805	1.17(o)		Request for publication of SIR - After examiner's action	1,840.00		1,840.00			0.00	0%			
1806	1.17(p)		Submission of an Information Disclosure Statement	180.00		180.00	90.00	45.00	0.00	0%	d		
1807	1.17(q)		Processing fee for provisional applications	50.00		50.00			0.00	0%			
1809/2809	1.17(r)		Filing a submission after final rejection (see 37 CFR 1.129(a))	810.00	405.00	840.00	420.00	210.00	30.00	4%			
1810/2810	1.17(s)		For each additional invention to be examined (see 37 CFR 1.129(b))	810.00	405.00	840.00	420.00	210.00	30.00	4%			
XXXX			Supplemental Examination Request [†]	5,180.00		7,000.00	3,500.00	1,750.00	1,820.00	35%		Yes	Refer to NPRM (RIN - 0651-AC69) & p. 65
XXXX			Supplemental Examination Reexamination [‡]	16,120.00		20,000.00	10,000.00	5,000.00	3,880.00	24%		Yes	Refer to NPRM (RIN - 0651-AC69) & p. 65
XXXX			Supplemental examination document size fees; 21-5 [§]	170.00		180.00	90.00	45.00	10.00	6%		Yes	Refer to NPRM (RIN - 0651-AC69) & p. 65

TABLE OF PATENT FEE CHANGES

USPTO Patent Fees												Location for Description of Rationale for Changes	
USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change			
XXXX			Supplemental examination document size fees; each additional 50 pages ^b	280.00		280.00	140.00	70.00	0.00	0%	280.00	Yes	Refer to NPRM (RIN - 0651-AC69) & p. 65
XXXX			Derivation proceeding	400.00		400.00	200.00	100.00	0.00	0%	400.00	Yes	Refer to NPRM (RIN - 0651-AC74)
1814/2814	1.20(d)	41(a)(2)(B)	Statutory disclaimer, including terminal disclaimer	160.00	80.00	160.00			0.00	0%	d		
XXXX			File and oath/declaration up to the notice of allowance - NEW	0.00		3,000.00	1,500.00	750.00	3,000.00			Yes	Refer to p. 66
XXXX			Correct inventorship during examination where the oath/declaration was not provided before examination - NEW	0.00		1,700.00	850.00	425.00	1,700.00			Yes	Refer to p. 66
Post Issuance Fees													
1811	1.20(a)		Certificate of correction	100.00		100.00			0.00	0%	68.00		
1816	1.20(b)		Processing fee for correcting inventorship in a patent	130.00		130.00			0.00	0%	d		
1813	1.20(c)(2)		Request for inter partes reexamination	8,800.00					-8,800.00	-100%	31,688.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 20 or fewer claims ^b	27,200.00		27,200.00			0.00	0%	35,800.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 21 - 30 claims ^b	34,000.00		34,000.00			0.00	0%	44,750.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 31 - 40 claims ^b	40,800.00		40,800.00			0.00	0%	53,700.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 41 - 50 claims ^b	54,400.00		54,400.00			0.00	0%	71,600.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 51 - 60 claims ^b	68,000.00		68,000.00			0.00	0%	89,500.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, 61 - 70 claims ^b	95,200.00		95,200.00			0.00	0%	89,500.00		Refer to NPRM (RIN - 0651-AC71)
XXXX			Petition for inter partes review, each additional group of 10 claims ^b	27,200.00		27,200.00			0.00	0%	35,800.00		Refer to NPRM (RIN - 0651-AC71)
1821/2821	1.20(c)(3)	41(a)(2)(A)	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination	250.00	125.00	460.00	230.00	115.00	210.00	84%	a	Yes	Refer to p. 59
1822/2822	1.20(c)(4)	41(a)(5)	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination	60.00	30.00	100.00	50.00	25.00	40.00	67%	a	Yes	Refer to p. 59

TABLE OF PATENT FEE CHANGES

USPTO Patent Fees											Location for Description of Rationale for Changes		
USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change			
Patent Petition Fees													
1462	1.17(f)		Petitions requiring the petition fee set forth in 37 CFR 1.17(f) (Group I)	400.00		400.00	200.00	100.00	0.00	0%	68.00		
1463	1.17(g)		Petitions requiring the petition fee set forth in 37 CFR 1.17(g) (Group II)	200.00		200.00	100.00	50.00	0.00	0%	68.00		
1464	1.17(h)		Petitions requiring the petition fee set forth in 37 CFR 1.17(h) (Group III)	130.00		140.00	70.00	35.00	10.00	8%	68.00		
1451	1.17(j)		Petition to institute a public use proceeding	1,510.00		1,520.00	760.00	380.00	10.00	1%	68.00		
1454	1.17(t)		Acceptance of an unintentionally delayed claim for priority, or for filling a request for the restoration of the right of priority	1,410.00		1,420.00	710.00	355.00	10.00	1%	68.00		
1455	1.18(e)		Filing an application for patent term adjustment	200.00		200.00			0.00	0%	68.00		
1456	1.18(f)		Request for reinstatement of term reduced	400.00		400.00			0.00	0%	68.00		
1457	1.20(j)(1)		Extension of term of patent	1,120.00		1,120.00			0.00	0%	68.00		
1458	1.20(j)(2)		Initial application for interim extension (see 37 CFR 1.790)	420.00		420.00			0.00	0%	68.00		
1459	1.20(j)(3)		Subsequent application for interim extension (see 37 CFR 1.790)	220.00		220.00			0.00	0%	68.00		
PCT Fees - National Stage													
1617/2617	1.492(h)		Search fee, examination fee or oath or declaration after thirty months from priority date	130.00	65.00	140.00	70.00	35.00	10.00	8%	c		
1618/2618	1.492(i)		English translation after thirty months from priority date	130.00		140.00	70.00	35.00	10.00	8%	c		
PCT Fees - International Stage													
1601	1.445(a)(1)		Transmittal fee	240.00		240.00	120.00	60.00	0.00	0%	424.00		
1602	1.445(a)(2)		Search fee - regardless of whether there is a corresponding application (see 35 U.S.C. 361(d) and PCT Rule 16)	2,080.00		2,080.00	1,040.00	520.00	0.00	0%	1,889.00		
1604	1.445(a)(3)		Supplemental search fee when required, per additional inventor	2,080.00		2,080.00	1,040.00	520.00	0.00	0%	1,889.00		
1605	1.482(a)(1)		Preliminary examination fee - U.S. was the ISA	600.00		600.00	300.00	150.00	0.00	0%	710.00		
1606	1.482(a)(1)		Preliminary examination fee - U.S. was not the ISA	750.00		760.00	380.00	190.00	10.00	1%	710.00		
1607	1.482(a)(2)		Supplemental examination fee per additional invention	600.00		600.00	300.00	150.00	0.00	0%	710.00		
1619			Late payment fee	variable		variable	variable	variable			c		
1621	1.445(a)(4)		Transmitting application to Intl. Bureau to act as receiving office	240.00		240.00	120.00	60.00	0.00	0%	9.00		
Patent Service Fees													
8001	1.19(a)(1)		Printed copy of patent w/o color, delivery by USPS, USPTO Box, or electronic means	3.00		3.00			0.00	0%	d		
8003	1.19(a)(2)		Printed copy of plant patent in color	15.00		15.00			0.00	0%	d		

TABLE OF PATENT FEE CHANGES

USPTO Patent Fees												Location for Description of Rationale for Changes	
USPTO Large/Small Fee Codes	37 CFR	35 USC	Description	Current (Alternative) Fees		Proposed Fees			Change in Large Entity Fees		FY 2010 Unit Cost ^e	Change is >\$10 AND >5%	See Appendix G - Rationale for Specific Fee Changes for Description
				Large	Small	Large	Small	Micro	Dollar Change	Percent Change			
8004	1.19(a)(3)		Color copy of patent (other than plant patent) or SIR containing a color drawing	25.00		25.00			0.00	0%	d		
8005	1.19(a)(1)		Patent Application Publication (PAP)	3.00		3.00			0.00	0%	d		
8007	1.19(b)(1)(i)(A)		Copy of patent application as filed	20.00		20.00			0.00	0%	d		
8008	1.19(b)(1)(i)(B)		Copy of patent-related file wrapper and contents of 400 or fewer pages, if provided on paper	200.00		200.00			0.00	0%	d		
8009	1.19(b)(1)(i)(C)		Additional fee for each additional 100 pages of patent-related file wrapper and (paper) contents, or portion thereof	40.00		40.00			0.00	0%	d		
8010	1.19(b)(1)(i)(D)		Individual application documents, other than application as filed, per document	25.00		25.00			0.00	0%	d		
8011	1.19(b)(1)(ii)(B)		Copy of patent-related file wrapper and contents if provided electronically or on a physical electronic medium as specified in 1.19(b)(1)(ii)	55.00		55.00			0.00	0%	d		
8012	1.19(b)(1)(ii)(C)		Additional fee for each continuing physical electronic medium in single order of 1.19(b)(1)(ii)(B)	15.00		15.00			0.00	0%	d		
8041	1.19(b)(2)(i)(A)		Copy of patent-related file wrapper contents that were submitted and are stored on compact disk or other electronic form (e.g., compact disks stored in Artifact folder), other than as available in 1.19(b)(1); first physical electronic medium in a single order	55.00		55.00			0.00	0%	d		
8042	1.19(b)(2)(i)(B)		Additional fee for each continuing copy of patent-related file wrapper contents as specified in 1.19(b)(2)(i)(A)	15.00		15.00			0.00	0%	d		
8043	1.19(b)(2)(ii)		Copy of patent-related file wrapper contents that were submitted and are stored on compact disk, or other electronic form, other than as available in 1.19(b)(1); if provided electronically other than on a physical electronic medium, per order	55.00		55.00			0.00	0%	d		
8013	1.19(b)(3)		Copy of office records, except copies of applications as filed	25.00		25.00			0.00	0%	d		
8014	1.19(b)(4)		For assignment records, abstract of title and certification, per patent	25.00		25.00			0.00	0%	d		
8904	1.19(c)		Library service	50.00		50.00			0.00	0%	d		
8015	1.19(d)		List of U.S. patents and SIRs in subclass	3.00		3.00			0.00	0%	d		
8016	1.19(e)		Uncertified statement re status of maintenance fee payments	10.00		10.00			0.00	0%	d		
8017	1.19(f)		Copy of non-U.S. document	25.00		25.00			0.00	0%	d		
8050	1.19(g)		Petitions for documents in form other than that provided by this part, or in form other than that generally provided by Director, to be decided in accordance with merits	AT COST		AT COST					d		
8020	1.21(e)		International type search report	40.00		40.00			0.00	0%	d		
8902	1.21(g)	41(d)(2)(B)	Self-service copy charge, per page	0.25		0.25			0.00	0%	d		
8021	1.21(h)	41(d)(2)(A)	Recording each patent assignment, agreement or other paper, per property	40.00		40.00			0.00	0%	d		
8022	1.21(i)		Publication in Official Gazette	25.00		25.00			0.00	0%	d		
8023	1.21(j)		Labor charges for services, per hour or fraction thereof	40.00		40.00			0.00	0%	d		
8024	1.21(k)		Unspecified other services, excluding labor	AT COST		AT COST					d		
8026	1.21(n)		Handling fee for incomplete or improper application	130.00		130.00			0.00	0%	d		
8027		1.296	Handling fee for withdrawal of SIR	130.00		130.00			0.00	0%	d		

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				Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Patent Enrollment Fees														
9001	1.21(a)(1)(i)		Application fee (non-refundable)	40.00		40.00				0.00	0%	d		
9003	1.21(a)(2)		Registration to practice or grant of limited recognition under §11.9(b) or (c)	100.00		100.00				0.00	0%	d		
9004	1.21(a)(9)(ii)		Reinstatement to practice	100.00		100.00				0.00	0%	d		
9005	1.21(a)(4)		Certificate of good standing as an attorney or agent	10.00		10.00				0.00	0%	d		
9006	1.21(a)(4)		Certificate of good standing as an attorney or agent, suitable for framing	20.00		20.00				0.00	0%	d		
9010	1.21(a)(1)(ii)(A)		For test administration by commercial entity	200.00		200.00				0.00	0%	d		
9011	1.21(a)(1)(ii)(B)		For test administration by the USPTO	450.00		450.00				0.00	0%	d		
9012	1.21(a)(5)(i)		Review of decision by the Director of Enrollment and Discipline under §11.2(c)	130.00		130.00				0.00	0%	d		
9013	1.21(a)(5)(ii)		Review of decision of the Director of Enrollment and Discipline under §11.2(d)	130.00		130.00				0.00	0%	d		
9014	1.21(a)(10)		Application fee for person disciplined, convicted of a felony or certain misdemeanors under §11.7(h)	1,600.00		1,600.00				0.00	0%	d		
9015	1.21(a)(7)(i)		Annual fee for registered attorney or agent in active status	118.00		120.00				2.00	2%	d		
9016	1.21(a)(7)(ii)		Annual fee for registered attorney or agent in voluntary inactive status	25.00		25.00				0.00	0%	d		
9017	1.21(a)(7)(iii)		Requesting restoration to active status from voluntary inactive status	50.00		50.00				0.00	0%	d		
9018	1.21(a)(7)(iv)		Balance of annual fee due upon restoration to active status from voluntary inactive status	93.00		100.00				7.00	8%	d		
9019	1.21(a)(8)		Annual fee for individual granted limited recognition	118.00		120.00				2.00	2%	d		
9020	1.21(a)(9)(i)		Delinquency fee for annual fee	50.00		50.00				0.00	0%	d		
9024	1.21(k)		Unspecified other services, excluding labor	AT COST		AT COST						d		
9025	1.21(a)(2)		Registration to practice for change of practitioner type	100.00		100.00				0.00	0%	d		

a - Included within the average unit cost of search and exam.

b - Cost was not derived from FY 2010 historical ABI cost, but from like historical data used as a foundation to calculate cost of a new program or activity.

c - Unit cost was not calculated for these fees because there are no significant, specific activities supporting them, other than collecting and depositing the fee.

d - FY 2010 unit costs were not calculated for these fees and the Office is therefore, not proposing changes to these fees until we are able to evaluate them against their respective cost (with one exception, three enrollment fees are adjusted to correct rounding errors).

e - See Appendix C - Background on Activity Based Information costing methodology for calculation descriptions.