

Waiver of the New Requirement to Pay an Appeal Forwarding Fee if the Fee for Filing an Appeal Brief was Filed before March 19, 2013

Waiver: The United States Patent and Trademark Office (USPTO) is, pursuant to 37 CFR 1.183, *sua sponte* waiving new 37 CFR 41.45 (effective March 19, 2013) in any application or *ex parte* reexamination proceeding in which the appellant has filed an appeal brief and the fee for filing the brief by March 18, 2013, under the version of 37 CFR 41.20(b)(2) which remains in effect through March 18, 2013. To promote an effective transition for new fee rules that take effect on March 19, 2013, the USPTO has in its discretion determined that justice requires this waiver. This waiver avoids the payment of extra fees that would otherwise result when an applicant paid both a fee to file an appeal brief by March 18, 2013, and would also be required to pay the fee to forward an appeal on or after March 19, 2013.

Discussion: On January 19, 2013, the USPTO promulgated a final rule that established new 37 CFR 41.45 which requires payment of a fee for forwarding an appeal in any application or *ex parte* reexamination to the Patent Trial and Appeal Board (PTAB). See "Setting and Adjusting Patent Fees" 78 Fed. Reg. 4212, 4291 (January 18, 2013). Under this new rule, any appeal in an application or an *ex parte* reexamination proceeding in which the appellant fails to pay the appeal forwarding fee within the time period set in 37 CFR 41.45(a) stands dismissed. See 37 CFR 41.45(b) in effect on March 19, 2013. New 37 CFR 41.45 is effective on March 19, 2013, and it does not include a transition provision for appellants who have already filed appeal briefs and paid the appeal brief filing fee under 37 CFR 41.20(b)(2) by March 18, 2013. Thus, under new 37 CFR 41.45, the appeal forwarding fee would still have to be paid by such appellants in order to avoid the dismissal of their appeal.

The final rule also adjusts the fee due on submission of an appeal brief in an application or *ex parte* reexamination proceeding to \$0. See 37 CFR 41.20(b)(2)(i) in effect on March 19, 2013.

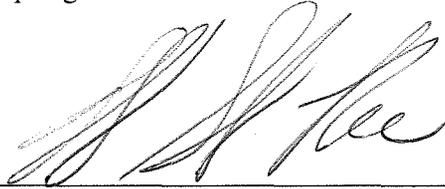
To promote an effective transition for new 37 CFR 41.45, which takes effect March 19, 2013, and under its authority provided for in 37 CFR 1.183, the USPTO has determined in its discretion that justice requires this waiver. This waiver serves to maintain the status quo fees in certain narrow and temporary circumstances. Otherwise, without the waiver, appellants in any application and *ex parte* reexamination proceeding that have paid the fee to file an appeal brief by March 18, 2013, would also have to pay the appeal forwarding fee if the expiration of the time period set by 37 CFR 41.45(a) was on or after March 19, 2013. As a result of this waiver, such appellants will not be required to pay both fees.

The period to file an appeal brief may be extended. See MPEP 1205.01. This waiver, however, only applies in an appeal in which the appeal brief and accompanying fee were filed before March 19, 2013.

The appeal forwarding fee is not required in any appeal to the PTAB in an *inter partes* reexamination proceeding, and therefore, this notice does not apply to such proceedings.

Any inquiries concerning this notice may be directed to Robert Clarke, Office of the Associate Commissioner for Patent Examination Policy, at 571-272-7735, or via e-mail addressed to robert.clarke@uspto.gov.

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