

FAQS for the New Practice of Requiring Maintenance Fees for Each Reissued Patent and for Original Utility Patents for which a Reissue Application is Pending

1. What are “multiple reissued patents”?

“Multiple reissued patents” replace a single original patent as provided for in 35 U.S.C. 251(b). As stated in 37 CFR 1.177, the Office may reissue a patent as multiple reissued patents if applicant files more than one application for reissue of a single patent. See MPEP § 1451 for more information.

2. What is the “maintenance fee due date” for a reissued patent?

The “maintenance fee due date” is the last day for paying a maintenance fee without a surcharge as set forth in 35 U.S.C. 41(b)(1) and 37 CFR 1.362(d). The maintenance fee due dates that apply to reissued utility patents are: (1) three years and six months (3½ years), (2) seven years and six months (7½ years), and (3) eleven years and six months (11½ years), after the date of grant for the original patent. The maintenance fee payment schedule established for the original patent continues to apply to each reissued patent such that the maintenance fee due dates are based on the date of the original patent grant.

3. When can a maintenance fee be paid?

Maintenance fees can be paid during a six-month “window period” that precedes the maintenance fee due date without payment of a surcharge. The window periods are (1) 3 years to 3 1/2 years after the date of issue for the first maintenance fee payment, (2) 7 years to 7 1/2 years after the date of issue for the second maintenance fee payment, and (3) 11 years to 11 1/2 years after the date of issue for the third and final maintenance fee payment. If the maintenance fee due date falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee may be paid on the next succeeding business day (e.g., a day that is not a Saturday, Sunday, or federal holiday) without paying the surcharge. See 37 CFR 1.362(f). Maintenance fees can also be paid during a six-month period following the maintenance fee due date with payment of a surcharge under 37 CFR 1.20(h) as set forth in 35 U.S.C. 41(b)(2) and 37 CFR 1.362(e). See MPEP § 2506 for more information.

4. How do I determine if the new practice applies?

For the new practice of more than one maintenance fee being due to apply, the reissue patent family based on an original utility patent will include more than one reissued patent, or at least one reissued patent and at least one pending application for reissue, of the same original utility patent and have maintenance fees due on or after January 16, 2018.

5. Would the new practice apply if the maintenance fee is due on January 13, 2018 (Saturday), January 14, 2018 (Sunday), or January 15, 2018 (federal holiday)?

No, maintenance fees with a due date on January 13, 14, or 15 of 2018 may be paid on Tuesday, January 16, 2018 in accordance with 37 CFR 1.362(f). The procedures that allow payment on January 16, 2018 do not change the maintenance fee due dates from being prior to January 16, 2018. The new practice only applies to maintenance fees with a due date on or after January 16, 2018.

6. Does the new practice apply if the maintenance due date is on or after January 16, 2018 but payment was made prior to January 16, 2018?

Yes, if a maintenance fee, which is due on or after January 16, 2018, is paid prior to January 16, 2018, the new practice applies. In accordance with 37 CFR 1.362(d), a maintenance fee may be paid without a surcharge beginning six months prior to the maintenance fee due date. For example, maintenance fees due on the January 16, 2018 effective date may be paid starting July 16, 2017. If the maintenance fee was paid prior to January 16, 2018 in the latest reissued patent under the former practice, a separate payment of the maintenance fee would still be required in any earlier reissued patent(s) and the original patent if there is a pending reissue application on the maintenance fee due date to maintain all patents in force.

Patentees, who recently paid a maintenance fee that has a due date on or after January 16, 2018 in the latest reissued patent in a reissue patent family, need to consider making additional maintenance fees payments. Specifically, if a patentee wants to maintain all reissued patents, the patentee should make a maintenance fee payment in each of the other reissued patents in the reissue patent family before the 37 CFR 1.362(e) period for paying the maintenance fee with a surcharge ends. In addition, if there is any reissue application in the reissue patent family still pending on the maintenance fee due date, patentee must make a separate payment of the maintenance fee in the original patent, preferably prior to its surrender.

7. Why are maintenance fees due in the original patent when a reissue application is pending?

If the original patent expires during pendency of the reissue application, prosecution of the applications for reissue will be terminated because patents can only be reissued for the unexpired term of the original patent in accordance with 35 U.S.C. 251. An original patent is not surrendered under 35 U.S.C. 252 until a reissue application of the original patent issues as a reissued patent and no other reissue application of the same original patent is still pending. Because it is the granting of the reissued patent – and not the filing of the reissue application - that effectuates surrender of the original patent under 35 U.S.C. 252, maintenance fees remain due in the original patent whenever an application for reissue of the original patent is pending on the maintenance fee due date.

The new practice will be a change in procedure for original patents that are the basis for reissued patents and are also the basis for pending reissue application(s). Under the former practice, when a maintenance fee was paid in the latest issued reissue patent and a reissue application(s) of the original patent was still pending, the original patent was also maintained in force.

8. Is a maintenance fee payment required in the original patent if the only remaining application for reissue is pending on the maintenance fee due date but is scheduled to issue as a reissued patent within the grace period defined in 37 CFR 1.362(e)?

Yes, 35 U.S.C. 251 permits reissue only for “the unexpired part of the term of the original patent.” Therefore, the maintenance fee must be paid to maintain the last reissued patent, which takes the place of the original patent upon its surrender, in force beyond the end of the applicable grace period defined in 37 CFR 1.362(e). To avoid any uncertainty in the record about payment of the maintenance fee, payment should be made in the original patent at least a day prior to the issue date

of the last pending reissue application because when that reissue application issues as a reissued patent, the original patent is surrendered and ceases to exist. If the maintenance fee is not paid before the issue date of the last pending reissue application, payment of the maintenance fee during the grace period must be made to avoid expiration of the last reissue patent. Payment of the maintenance fee should be made in the original patent because the maintenance fee was due before surrender of the original patent. In addition, the maintenance fee payment must include the surcharge under 37 CFR 1.20(h) if the maintenance fee is paid during the grace period (excluding any later payment authorized by 37 CFR 1.362(f)).

9. If maintenance fees were not due in the original patent, does this new practice now require payment of maintenance fees?

No, not if the original patent was not subject to maintenance fees. Design patents and plant patents are not subject to maintenance fees. Also, utility patents based on applications filed before December 12, 1980 are not subject to maintenance fees. The new practice is only applicable to original utility patents based on applications filed on or after December 12, 1980 and reissued patents of original utility patents based on applications filed on or after December 12, 1980.

10. Can you provide an example of how the new practice will be applied?

EXAMPLE: A total of three applications were filed for reissue of the same original utility patent, which issued on August 27, 2010. The reissue applications result in first and second reissued patents granted on June 18, 2013 and June 25, 2013, respectively. The third reissue application based on the original patent is scheduled to issue as the third reissued patent on March 20, 2018 (after the February 27, 2018 due date for the 7½ year maintenance fee). The 3½ year maintenance fee, which was due on February 27, 2014, was paid in the second reissued patent on December 6, 2013, under the former practice that required only one set of maintenance fees in the latest issued reissued patent. The 7½ year maintenance fee due date is Tuesday, February 27, 2018, which is 7½ years after the August 27, 2010 issue date of the original patent.

The following steps are used to determine which patents in the patent family (i.e., the original patent and all reissued patents from the original patent) require payment of the 7½ year maintenance fee:

1. Determine whether the new practice applies. For the new practice of more than one maintenance fee being due to apply, the reissue patent family based on an original utility patent will include more than one reissued patent, or at least one reissued patent and at least one pending application for reissue, of the same original utility patent and have maintenance fees due on or after January 16, 2018.

In this example, the patent family has two reissued patents and a pending reissue application. The 7½ year maintenance fee due date is February 27, 2018, which is after the January 16, 2018 effective date of the new practice set forth in this notice. Therefore, the new practice applies.

2. Determine which of the reissued patents in the patent family require separate payment of the maintenance fee.

In this example, the first and second reissued patents were granted in June 2013 and remain in force on January 16, 2018. Therefore, to avoid expiration of the first and second reissued patents, the 7½ year maintenance fee must be separately paid in both the first and second reissued patents, regardless of whether the maintenance fee(s) are paid before, on, or after January 16, 2018. Note that if any of the required maintenance fee payments are made during the grace period between February 28, 2018 and August 27, 2018, the surcharge under 37 CFR 1.20(h) must be included with each maintenance fee payment made during the grace period.

3. Determine whether the original utility patent requires separate payment of the maintenance fee.

The maintenance fee must be paid if the maintenance fee due date is before the date the original patent is surrendered (i.e., the date the last remaining application for reissue of the original patent issues as a reissued patent or becomes abandoned). Any time an application for reissue of the original patent is still pending on the maintenance fee due date, the maintenance fee must be paid in the original patent.

In this example, the third reissue application is still pending on the February 27, 2018 maintenance fee due date and is not scheduled to issue as a reissued patent until March 20, 2018. Therefore, the 7½ year maintenance fee must be paid in the original patent to avoid expiration of the third reissue patent. To avoid any uncertainty in the record about payment of the maintenance fee, payment should be made prior to March 20, 2018 because when the third reissue application issues as a reissued patent, the original patent is surrendered and ceases to exist. If the maintenance fee is paid on or after March 20, 2018, payment must still be made in the original patent because the maintenance fee was due before surrender of the original patent. In addition, if the 7½ year maintenance fee is paid during the grace period beginning on February 28, 2018 and ending on August 27, 2018, the maintenance fee payment must include the surcharge under 37 CFR 1.20(h).

In the example above, note that the 7½ year maintenance fee would be the first maintenance fee ever paid in both the original patent and the first reissue patent because the 3½ year maintenance fee was paid (four years ago) in only the second reissue patent under the former practice that required maintenance fee payment in only the latest issued reissued patent. Also, note that if the original utility patent, which issued on August 27, 2010 in the example, was instead issued on June 15, 2010, the 7½ year maintenance fee would be due prior to the January 16, 2018 effective date. In this situation, the 7½ year maintenance fee would only be due in the latest issued reissued patent under the former practice, even if the 7½ year maintenance fee and surcharge under 37 CFR 1.20(h) are paid after the January 16, 2018 effective date during the grace period.

11. What maintenance fee payments are eligible for the request for refund of the surcharge under 37 CFR 1.20(h)?

The request for refund is limited to the surcharge accompanying the maintenance fee payments submitted January 17, 2018 through July 16, 2018 that are newly required by this change in practice (e.g., for patents in reissue patent families except for the latest reissued patent). In other words, the new practice did not alter the requirement to pay the maintenance fees within the 37 CFR 1.362(d) or (e) time periods to avoid the expiration of a single reissued patent, the latest reissued patent in a reissue patent family, or the original patent when no reissued patent has issued. For these patents, any request for refund should not be made and will not be favorably considered if made.

12. What is the deadline to request a refund for the surcharge under 37 CFR 1.20(h) for eligible payments?

A request for refund must be made by (i.e., on or before) January 16, 2019.

13. What should be included in an eligible request for refund of the surcharge under 37 CFR 1.20(h)?

To request a refund for the surcharge under 37 CFR 1.20(h), patentee must submit a letter that states the patent number(s) for which the maintenance fee(s) and surcharge(s) were made, the maintenance fee due date(s), the original payment date(s), the fee amount(s), the fee codes(s), and a brief explanation of why a refund is appropriate. In the brief explanation, patentees must explain why the maintenance fee payment is newly required by the change in practice and should make reference to the notice, *Original Utility Patents Not Surrendered by Reissue and All Reissue Patents in the Reissue Patent Family Require Separate Maintenance Fee Payments*. For example, the brief explanation should identify the original patent, the reissued patents and any pending application(s) for reissue in the reissue patent family, any previously paid maintenance fees, and for which patents the maintenance fees were already paid, if applicable.

14. How do I file a request for a refund of the surcharge under 37 CFR 1.20(h)?

The request for refund may be submitted via EFS-Web using document code PET.OP or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

15. Under what authority does the Office establish this new practice for maintenance fees in reissued patents and original patents?

Section 10 of the Leahy-Smith America Invents Act (AIA), Public Law 112-29 (2011) authorizes the USPTO to set by rule patent fees charged under Title 35, United States Code. This fee setting authority was recently exercised on November 14, 2017 and included changes to maintenance fee payments in reissued patents. See *Setting and Adjusting Patent Fees during Fiscal Year 2017*, 82 Fed. Reg. 52780 (November 14, 2017). Consistent with the USPTO's fee setting authority, effective January 16, 2018, the USPTO will require payment of maintenance fees in each reissued patent, including each multiple reissued patent, of original patents that issued from utility patent applications filed on or after December 12, 1980 to maintain the reissued patent in force. MPEP §§ 1415.01 and 2504 will be revised to reflect policies and procedures consistent with the notice, *Original Utility*

Patents Not Surrendered by Reissue and All Reissue Patents in the Reissue Patent Family Require Separate Maintenance Fee Payments.