

No. 29,346

DESIGN.

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CASH REGISTER CABINET.
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4 Sheets—Sheet 1

Quick Reference Guide to the Continuing Application Fee (CAF)

1. What is the Continuing Application Fee (CAF)?

Answer: The Continuing Application Fee (CAF) is a new fee set forth in 37 CFR 1.17(w). The CAF is part of the requirements for presenting a benefit claim under § 1.78(d). For more information, see the FY 2025 Patents Fee Setting Rule (hereinafter “Fee Rule”) preamble on pages 91907-13, and the responses to comments on pages 91941-47 at www.govinfo.gov/content/pkg/FR-2024-11-20/pdf/2024-26821.pdf.

The CAF applies to all utility, plant, and design continuing applications, i.e., continuation, divisional, and continuation-in-part applications, which have an actual filing date that is more than six years after their Earliest Benefit Date (EBD). See Fee Rule at 91911-13 and 91942-43 (response to comment 28) for more information.

2. What is the effective date of the CAF rule?

Answer: The CAF set forth in 37 CFR 1.17(w) and the amendments to § 1.78(d) and (e) are effective on January 19, 2025.

3. When is a CAF due?

Answer: For an application filed on or after the effective date of the Fee Rule, payment of the 37 CFR 1.17(w) fees is required at the time a prompting benefit claim (i.e., a benefit claim that causes the Earliest Benefit Date (EBD) of the later-filed application to be more than six or nine years earlier than its actual filing date) is presented in the later-filed application. If the prompting benefit claim is presented at the time of filing, the applicable § 1.17(w) fee will be due at filing. If the prompting benefit claim is presented at a later time, the applicable § 1.17(w) fee will be due concurrently with the presentation of the prompting benefit claim. If the later presentation of the prompting benefit claim is by way of a petition for acceptance of an unintentionally delayed benefit claim under § 1.78(e), the applicable § 1.17(w) fee will be due in addition to the petition fee under § 1.17(m). See Fee Rule at 91911 and the examples in the next section of this document for more information.

4. What is the Earliest Benefit Date, or EBD?

Answer: The EBD is the earliest filing date for which benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c), and 37 CFR 1.78(d). The EBD is determined on an application-by-application basis. The EBD cannot be the filing date of a foreign application or the filing date of a provisional application to which benefit is claimed under 35 U.S.C. 119(e). For utility and plant applications, the EBD is also the “patent term filing date” (the date from which the 20-year patent term is calculated under 35 U.S.C. 154(a)(2)). See Fee Rule at 91909 and 91941 (response to comment 25) for more information.

5. What is the Earliest Benefit Date, or EBD, for a reissue application?

Answer: In accordance with 35 U.S.C. 100(i), the EBD of the reissue application is the earliest filing date for which benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c), and 37 CFR 1.78(d) in the original patent for which reissue is sought.

6. Are applications filed before January 19, 2025, subject to the CAF?

Answer: Yes, but only if a benefit claim is presented on or after the effective date, and the application meets the timing parameters in 37 CFR 1.17(w) as a result of that or any other benefit claim.

As explained in the Fee Rule, an application that is pending prior to the effective date of this final rule will not incur a fee under § 1.17(w) based on any benefit claims that were properly presented prior to the effective date. If no benefit claims are presented in such an application after the CAF rule takes effect, then no CAF will be due.

If a benefit claim is presented in the application on or after the effective date of this final rule, however, the application will incur a fee under § 1.17(w) if the actual filing date of the application is more than six or nine years later than its EBD. The CAF is required in such a situation even if the benefit claim presented on or after the effective date does not change the EBD of the application and thus is not a prompting benefit claim. See Fee Rule at 91912 and Examples 12-14 for more information about applicability of the CAF in applications pending prior to the effective date.

7. Are national stage applications filed under 35 U.S.C. 371 subject to the CAF?

Answer: Yes. The CAF applies to all utility, plant, and design continuing applications, i.e., continuation, divisional, and continuation-in-part applications, which have an actual filing date that is more than six years after their EBD. See Fee Rule at 91911-13 and 91945 (response to comment 33) for more information. See also Examples 5 and 6.

8. Are reissue applications subject to the CAF?

Answer: Yes. The CAF applies to all utility, plant, and design continuing applications, i.e., continuation, divisional, and continuation-in-part applications, which have an actual filing date that is more than six years after their EBD. See Fee Rule at 91911-13.

For non-continuing reissue applications, 37 CFR 1.17(w) is waived to the following extent: If a benefit claim was properly presented and entered in the original patent, it will not be considered to be presented for purposes of the CAF when it is included in an ADS upon filing of an application for reissue of the original patent. See Example 19 (non-continuing reissue application in which the waiver applies).

However, if any other benefit claim is presented in the reissue application on or after the effective date of this final rule, the application will incur a fee under § 1.17(w) if the actual filing date of the reissue application is more than six years after its EBD. This includes the presentation of a benefit claim to a parent reissue application or other application having a filing date later than that of the original patent. Thus, it is likely that a continuing reissue application will incur a CAF due to the presentation of the benefit claim to the parent reissue application, even if all other benefit claims were properly presented and entered in the original patent. See Examples 20 (non-continuing reissue application in which CAF is due) and 21 (continuing reissue application in which CAF is due). Requiring a CAF in these circumstances is consistent with how the CAF rule is applied in other situations such as requests for certificates of correction. See, e.g., Example 15 addressing addition of a benefit claim in a patent via a certificate of correction.

9. Is a CAF due if I am adding a benefit claim in a patent via a certificate of correction?

Answer: Yes, if the application that issued as the patent had an actual filing date that is more than six years after its EBD. As explained in MPEP 1481.03, correction of a patent with respect to a benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c) requires certain conditions to be met, including the filing of a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(e). As amended by the Fee Rule, petitions under § 1.78(e) now require both the petition fee as set forth in 37 CFR 1.17(m)(1) or (m)(2), and any applicable CAF. See Fee Rule at 91986-87, and Example 15.

10. What happens if I do not pay the CAF when I file an application having a filing date more than six years after its EBD?

Answer: The CAF set forth in 37 CFR 1.17(w) is part of the requirements for presenting a benefit claim under § 1.78(d). If a CAF is not paid when it is due, the consequence of non-payment is the same as for other deficiencies under § 1.78(d), i.e., non-entry of the entire benefit claim. See also Examples 14, 16, and 17. If applicant still desires the benefit claim, applicant must present the benefit claim again with the applicable CAF, as shown in Example 18. See MPEP 211.02(a) for more information on correcting or adding a benefit claim after filing.

11. How will I know if my benefit claim was entered?

Answer: Applicant can verify whether a particular benefit claim was entered by checking the application's Filing Receipt. If a benefit claim has been entered, it will appear on the Filing Receipt in the "Domestic Priority data as claimed by applicant" section. If a benefit claim has not been entered, it will not appear on the Filing Receipt. As explained in MPEP 211.02(a): "applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition (37 CFR 1.78) and the petition fee."

12. If I present multiple benefit claims in the same application, do I have to pay the CAF multiple times?

Answer: It depends. The fees in 37 CFR 1.17(w) are based on the application's EBD, not the number of benefit claims made. Presenting multiple benefit claims at the same time will not incur multiple fees. However, if benefit claims are presented at multiple times during an application's pendency, a second fee may be due if the later-presented benefit claim changes the application's EBD to be more than nine years earlier than the actual filing date. In this situation, the amount due under § 1.17(w)(2) for the later presentation will reflect any prior payment under § 1.17(w)(1) for the earlier presentation. For instance, if the fee under § 1.17(w)(1) was paid at the time of filing and a benefit claim requiring payment of the § 1.17(w)(2) fee is presented at a later time, the additional amount owed is the difference between the current fee amount stated in § 1.17(w)(2) and the amount of the previous payment under § 1.17(w)(1). See Fee Rule at 91911-12 and Examples 9 and 10.

13. Which CAF (if any) do I owe if I previously paid the fee under 37 CFR 1.17(w)(1) and now I am presenting another benefit claim?

Answer: The maximum amount due in a single application or patent is the § 1.17(w)(2) fee.

If the newly-presented benefit claim changes the application's EBD to be more than nine years earlier than the actual filing date, then the § 1.17(w)(2) fee is due. The amount due under § 1.17(w)(2) will reflect the prior payment under § 1.17(w)(1). In this situation, applicant would owe the difference between the current fee amount stated in § 1.17(w)(2) and the amount of the previous payment under § 1.17(w)(1).

If the newly-presented benefit claim does not change the application's EBD to be more than nine years earlier than the actual filing date, then no additional CAF would be due because the § 1.17(w)(1) was already paid.

14. Which CAF (if any) do I owe if the 6-year anniversary of an application's EBD falls on a weekend or a Federal holiday within the District of Columbia?

Answer: If the 6-year anniversary of the EBD falls on a weekend or a Federal holiday within the District of Columbia, then 35 U.S.C. 21(b) and 37 CFR 1.7 would permit a continuing application to be filed on the next business day without incurring a CAF under § 1.17(w).

15. Which CAF (if any) do I owe if the 9-year anniversary of an application's EBD falls on a weekend or a Federal holiday within the District of Columbia?

Answer: If the 9-year anniversary of the EBD falls on a weekend or a Federal holiday within the District of Columbia, then 35 U.S.C. 21(b) and 37 CFR 1.7 would permit a continuing application to be filed on the next business day without incurring the second tier CAF under § 1.17(w)(2). Instead, the first tier CAF under § 1.17(w)(1) would be due.

Examples

The following examples are not exhaustive but illustrate the most common situations anticipated to raise questions about whether payment of the new fees under 37 CFR 1.17(w) is required. For purposes of these examples, the agency assumes that all requirements for claiming benefit under 35 U.S.C. 119, 120, 121, 365(c), or 386(c) and § 1.78 are satisfied (except as noted), and that all fees are paid at the undiscounted rates. Discounts are available for most patent fees, as shown in the Fee Rule and on the USPTO Fee Schedule. Fee amounts shown below are the fees in effect on January 19, 2025.

Examples 1-13 below are copied from the Fee Rule at pages 91912 and 91913. Example 10 has been corrected to refer to application "J" instead of "I" throughout. Examples 14 through 21 are new.

List of CAF Examples

Example 1	Claiming benefit of a nonprovisional application under 35 U.S.C. 120.
Example 2	Claiming benefit of a provisional application under 35 U.S.C. 119(e).
Example 3	Claiming benefit of a provisional application under 35 U.S.C. 120.
Example 4	Claiming priority to a foreign application under 35 U.S.C. 119(a).
Example 5	National stage of an international application claiming priority to a foreign application under 35 U.S.C. 119(a) and 365(b).

Example 6	National stage of an international application claiming benefit of a nonprovisional application under 35 U.S.C. 120 and 365(c).
Example 7	Bypass continuation of an international application claiming benefit of a nonprovisional application under 35 U.S.C. 120 and 365(c).
Example 8	International design application claiming benefit of a nonprovisional application under 35 U.S.C. 120.
Example 9	Adding timely benefit claims under 35 U.S.C. 120 after filing; single fee due.
Example 10	Adding timely benefit claims under 35 U.S.C. 120 after filing; multiple fees due.
Example 11	Adding delayed benefit claim under 35 U.S.C. 120.
Example 12	Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(1) fee due.
Example 13	Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(2) fee due.
Example 14	Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(2) fee due but not paid.
Example 15	Adding delayed benefit claim under 35 U.S.C. 120 in a patent via a certificate of correction.
Example 16	Multiple benefit claims under 35 U.S.C. 120 presented at filing; fee due but not paid.
Example 17	Multiple benefit claims under 35 U.S.C. 120 presented at filing; § 1.17(w)(2) fee due but only § 1.17(w)(1) fee is paid.
Example 18	Adding timely benefit claim under 35 U.S.C. 120 after filing; § 1.17(w)(2) fee due and paid.
Example 19	Reissue application includes same benefit claim under 35 U.S.C. 120 that was entered in the original patent.
Example 20	Non-continuing reissue application adding benefit claim under 35 U.S.C. 120.
Example 21	Continuing reissue application adding benefit claim under 35 U.S.C. 120.

Note, for purposes of simplicity, the examples below identify certain fee amounts at the rates in effect on January 19, 2025. At the time periods addressed in the examples (e.g., filings made in 2028 and 2029), these fee amounts may have changed. Applicants and patent owners should check the current Fee Schedule posted on the USPTO's website when determining the appropriate amount to pay when a fee is due.

Example 1: Claiming benefit of a nonprovisional application under 35 U.S.C. 120.

Application A is a nonprovisional application filed on July 1, 2026. The Application Data Sheet (ADS) present upon A's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application N filed on March 2,

2020, which is the only benefit claim in the application. A's EBD is March 2, 2020, which is more than six but not more than nine years earlier than A's actual filing date of July 1, 2026. In this example, the § 1.17(w)(1) fee of \$2,700 is due upon A's filing.

Example 2: Claiming benefit of a provisional application under 35 U.S.C. 119(e).

Application B is a nonprovisional application filed on July 1, 2026. The ADS present upon B's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021, and a benefit claim under 35 U.S.C. 119(e) to provisional application P filed on March 3, 2020. The USPTO's records indicate that O also contains a benefit claim under 35 U.S.C. 119(e) to provisional application P. In this situation, P's filing date is not the EBD, because § 1.17(w) does not encompass benefit claims under 35 U.S.C. 119(e). Instead, B's EBD is February 2, 2021, which is less than six years earlier than B's actual filing date of July 1, 2026. In this example, no fee would be due under § 1.17(w).

Example 3: Claiming benefit of a provisional application under 35 U.S.C. 120.

Application C is a nonprovisional application filed on July 1, 2026. The ADS present upon C's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021, and a benefit claim under 35 U.S.C. 120 to provisional application P filed on March 3, 2020. The USPTO's records indicate that O also contains a benefit claim under 35 U.S.C. 120 to provisional application P. In this situation, P's filing date is the EBD, because § 1.17(w) encompasses benefit claims under 35 U.S.C. 120. C's EBD is March 3, 2020, which is more than six but not more than nine years earlier than C's actual filing date of July 1, 2026. In this example, the § 1.17(w)(1) fee of \$2,700 is due upon C's filing. Note, it is not recommended that applicants claim the benefit to a provisional application under 35 U.S.C. 120 since such a claim could have the effect of reducing the patent term. See MPEP 211.02, subsection III.

Example 4: Claiming priority to a foreign application under 35 U.S.C. 119(a).

Application D is a nonprovisional application filed on July 1, 2026. The ADS present upon D's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021, and a priority claim under 35 U.S.C. 119(a) to foreign application Q filed on March 3, 2020. The USPTO's records indicate that O also contains a priority claim under 35 U.S.C. 119(a) to foreign application Q. In this situation, Q's filing date is not the EBD, because § 1.17(w) does not encompass priority claims to foreign applications under 35 U.S.C. 119. Instead, D's EBD is February 2, 2021, which is less than six years earlier than D's actual filing date of July 1, 2026. In this example, no fee would be due under § 1.17(w).

Example 5: National stage of an international application claiming priority to a foreign application under 35 U.S.C. 119(a) and 365(b).

Application E is an international application filed under the Patent Cooperation Treaty (PCT) on July 1, 2026. The PCT Request form present upon E's filing contains a priority claim under 35 U.S.C. 119(a) and 365(b) to foreign application R filed on July 7, 2025. When the national stage of E is commenced in the United States under 35 U.S.C. 371, the USPTO will determine the EBD of the national stage application to evaluate whether any continuing application fees are due. In this situation, R's filing date is not the EBD, because § 1.17(w) does not encompass priority claims to foreign applications. Instead, E's EBD is July 1, 2026, which is the same as its actual filing date. In this example, no fee would be due under § 1.17(w).

Example 6: National stage of an international application claiming benefit of a nonprovisional application under 35 U.S.C. 120 and 365(c).

Application F is an international application designating the United States that is filed under the PCT on July 1, 2026. The PCT request form present upon F's filing contains a benefit claim under 35 U.S.C. 120 and 365(c) to nonprovisional application N filed on March 2, 2020. When the national stage of F is commenced in the United States under 35 U.S.C. 371, the USPTO will determine the EBD of the national stage application to evaluate whether any continuing application fees are due. In this situation, N's filing date of March 2, 2020, is the EBD, because § 1.17(w) encompasses benefit claims under 35 U.S.C. 120 and 365(c). Thus, F's EBD is March 2, 2020, which is more than six years, and no more than nine years, earlier than F's actual filing date of July 1, 2026. In this example, the § 1.17(w)(1) fee of \$2,700 is due when F commences the U.S. national stage under 35 U.S.C. 371.

Example 7: Bypass continuation of an international application claiming benefit of a nonprovisional application under 35 U.S.C. 120 and 365(c).

Application G is a nonprovisional application filed on December 28, 2028. The ADS present upon G's filing contains benefit claims under 35 U.S.C. 120 and 365(c) to international application F filed on July 1, 2026, and nonprovisional application N filed on March 2, 2020. As noted in Example 6, supra, F also contains a benefit claim under 35 U.S.C. 120 and 365(c) to N. In this situation, N's filing date of March 2, 2020, is the EBD because § 1.17(w) encompasses benefit claims under 35 U.S.C. 120 and 365(c). Thus, G's EBD is March 2, 2020, which is more than six but not more than nine years earlier than G's actual filing date of December 28, 2028. In this example, the § 1.17(w)(1) fee of \$2,700 is due upon G's filing.

Example 8: International design application claiming benefit of a nonprovisional application under 35 U.S.C. 120.

Application H is an international design application designating the United States that is filed under the Hague Agreement Concerning the International Registration of Industrial Designs, July 2, 1999 ("Hague Agreement"), on July 1, 2026. The DM/1 form titled "Application for International Registration" present upon H's filing does not contain any priority or benefit claims. Thus, at the time of H's filing, H's EBD is the same as its actual filing date, and no fee would be due under § 1.17(w). Shortly after the international registration is published by the International Bureau and a U.S. application number (35/series) is established, the applicant files a corrected ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application N filed on March 2, 2020. Because this newly added benefit claim causes H's EBD to become March 2, 2020, which is more than six but not more than nine years earlier than H's actual filing date of July 1, 2026, the § 1.17(w)(1) fee of \$2,700 is due upon filing of the corrected ADS.

Example 9: Adding timely benefit claims under 35 U.S.C. 120 after filing; single fee due.

Application I is a nonprovisional application filed on July 3, 2028. The ADS present upon I's filing does not contain any benefit claims, and thus no fee would be due under § 1.17(w) upon I's filing. Two months after I's filing, the applicant files a second ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021. Because this newly added benefit claim causes I's EBD to become February 2, 2021, which is more than six but not more than nine years earlier than I's actual filing date of July 3, 2028, the § 1.17(w)(1) fee of \$2,700 is due upon filing of the second ADS. The applicant pays the

fee. One month later (three months after I's filing), the applicant files a third ADS containing the previously added benefit claim to O and a new benefit claim under 35 U.S.C. 120 to nonprovisional application N filed on March 2, 2020. This newly added benefit claim causes I's EBD to become March 2, 2020, which is more than six but not more than nine years earlier than I's actual filing date of July 3, 2028. However, because the applicant already paid the § 1.17(w)(1) fee, no additional fee is due upon filing of the third ADS.

Example 10: Adding timely benefit claims under 35 U.S.C. 120 after filing; multiple fees due.

Application J is a nonprovisional application filed on July 5, 2029. The ADS present upon J's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021, which is the only benefit claim in the application. J's EBD is February 2, 2021, which is more than six but not more than nine years, earlier than J's actual filing date of July 5, 2029. In this example, the § 1.17(w)(1) fee of \$2,700 is due upon J's filing. The applicant pays the fee. Two months after J's filing, the applicant files a second ADS containing the previously added benefit claim to O and a new benefit claim under 35 U.S.C. 120 to nonprovisional application N filed on March 2, 2020. This newly added benefit claim causes J's EBD to become March 2, 2020, which is more than nine years earlier than J's actual filing date of July 5, 2029, and thus prompts the fee in § 1.17(w)(2). Because the fee in § 1.17(w)(1) was previously paid, the previous payment is subtracted from the amount now due under § 1.17(w)(2). Accordingly, the amount due upon filing of the second ADS is \$1,300 (the current fee amount of \$4,000 set forth in § 1.17(w)(2) less the \$2,700 previously paid under § 1.17(w)(1)).

Example 11: Adding delayed benefit claim under 35 U.S.C. 120.

Application K is a nonprovisional application filed on July 5, 2029. The ADS present upon K's filing does not contain any benefit claims. Eighteen months after K's filing, the applicant files a second ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application N filed on March 2, 2020. Because this newly added benefit claim causes K's EBD to become March 2, 2020, which is more than nine years earlier than K's actual filing date of July 5, 2029, the § 1.17(w)(2) fee of \$4,000 is due upon filing of the second ADS. In addition, because this benefit claim is delayed (not submitted within the required time period in § 1.78(d)), a petition for acceptance of an unintentionally delayed benefit claim under § 1.78(e) and the petition fee under § 1.17(m) are also required.

Example 12: Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(1) fee due.

Application L is a nonprovisional application filed on January 2, 2025, which is prior to the effective date of this final rule. The ADS present upon L's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application S filed on February 5, 2018, which is the only benefit claim in the application. L's EBD is February 5, 2018, which is more than six but not more than nine years earlier than L's actual filing date of January 2, 2025. Because L was filed prior to the effective date of this final rule, no fee under § 1.17(w)(1) was due upon L's filing or upon the effective date of the final rule. Two months after L's filing and after the effective date of this final rule, the applicant files a second ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021. While the newly added benefit claim does not change L's EBD, its presentation in an application having an EBD more than six but not more than nine years earlier than its actual filing date prompts the fee in § 1.17(w)(1). Accordingly, the § 1.17(w)(1) fee of \$2,700 is due upon filing of the second ADS.

Example 13: Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(2) fee due.

Application M is a nonprovisional application filed on January 2, 2025, which is prior to the effective date of this final rule. The ADS present upon M's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application S filed on February 5, 2018, which is the only benefit claim in the application. M's EBD is February 5, 2018, which is more than six but not more than nine years earlier than M's actual filing date of January 2, 2025. Because M was filed prior to the effective date of this final rule, no fee under § 1.17(w)(1) was due upon M's filing or upon the effective date of the final rule. Two months after M's filing and after the effective date of this final rule, the applicant files a second ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application T filed on March 6, 2015. This newly added benefit claim causes M's EBD to become March 6, 2015, which is more than nine years earlier than M's actual filing date of January 2, 2025, and thus prompts the fee in § 1.17(w)(2). Accordingly, the § 1.17(w)(2) fee of \$4,000 is due upon filing of the second ADS.

Example 14: Adding timely benefit claim under 35 U.S.C. 120 in an application that predates the effective date of the final rule; § 1.17(w)(2) fee due but not paid.

In application M from Example 13, applicant does not pay the § 1.17(w)(2) fee, and does not authorize this fee to be charged to a deposit account. When the second ADS is processed, the USPTO will not enter the benefit claim to T because it was not presented with the applicable § 1.17(w) fee as required by § 1.78(d). However, the failure to pay the fee for presenting the new benefit claim to T does not affect the existing benefit claim to S, because the benefit claim to S was properly presented prior to the effective date of the Fee Rule. See the Fee Rule at 91912, where it indicates that “[a]n application that is pending prior to the effective date of this final rule will not incur a fee under § 1.17(w) based on any benefit claims that were properly presented prior to the effective date.” Accordingly, M will retain its benefit claim to S, and its EBD will still be S's filing date (February 5, 2018).

Example 15: Adding delayed benefit claim under 35 U.S.C. 120 in a patent via a certificate of correction.

In application M from Example 14, the application issues as patent M in February 2026 with the benefit claim to S as the only benefit claim. Two weeks after issuance, the patentee files a third ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application T filed on March 6, 2015, along with a request for a certificate of correction identifying the addition of the benefit claim to T as an error to be corrected in M. Because this newly added benefit claim causes M's EBD to become March 6, 2015, which is more than nine years earlier than M's actual filing date of January 2, 2025, the § 1.17(w)(2) fee of \$4,000 is due upon filing of the third ADS. Because this benefit claim is delayed (not submitted within the required time period in § 1.78(d)), a petition for acceptance of an unintentionally delayed benefit claim under § 1.78(e) and the petition fee under § 1.17(m) are also required. In addition, because the patentee is requesting correction of an error (the failure to properly present the benefit claim to T) that is not the fault of the Office, the certificate of correction fee under § 1.20(a) is also required.

Example 16: Multiple benefit claims under 35 U.S.C. 120 presented at filing; fee due but not paid.

Application U is a nonprovisional application filed on July 5, 2029. The ADS present upon U's filing contains three benefit claims under 35 U.S.C. 120: a benefit claim to nonprovisional application E filed on July 1,

2026; a benefit claim to nonprovisional application O filed on February 2, 2021; and a benefit claim to nonprovisional application N filed on March 2, 2020. As a result of these benefit claims, U's EBD is March 2, 2020, which is more than nine years earlier than U's actual filing date of July 5, 2029. In this example, the § 1.17(w)(2) fee of \$4,000 is due upon U's filing.

Applicant does not pay the § 1.17(w)(2) fee, and does not authorize this fee to be charged to a deposit account. When the application is processed, the USPTO will not enter the benefit claims to O and N because they were not presented with the applicable § 1.17(w) fee as required by § 1.78(d). However, because the benefit claim to E does not require any fee under § 1.17(w), the benefit claim to E will be entered. The Filing Receipt mailed in U will reflect non-entry of the benefit claims to O and N, because the "Domestic Priority data as claimed by applicant" section will contain only the benefit claim to E. As a result of non-entry of the benefit claims to O and N, U's EBD is now E's filing date of July 1, 2026.

Example 17: Multiple benefit claims under 35 U.S.C. 120 presented at filing; § 1.17(w)(2) fee due but only § 1.17(w)(1) fee is paid.

Application V is a nonprovisional application filed on July 5, 2029. The ADS present upon V's filing contains two benefit claims under 35 U.S.C. 120: a benefit claim to nonprovisional application O filed on February 2, 2021; and a benefit claim to nonprovisional application N filed on March 2, 2020. As a result of these benefit claims, V's EBD is March 2, 2020, which is more than nine years earlier than V's actual filing date of July 5, 2029. In this example, the § 1.17(w)(2) fee of \$4,000 is due upon V's filing.

Applicant does not pay the § 1.17(w)(2) fee, and does not authorize this fee to be charged to a deposit account. Instead, applicant pays the § 1.17(w)(1) fee of \$2,700. When the application is processed, the USPTO will not enter the benefit claim to N, because it was not presented with the applicable § 1.17(w)(2) fee as required by § 1.78(d). However, because the benefit claim to O requires only the § 1.17(w)(1) fee, which was paid, the benefit claim to O will be entered. The Filing Receipt mailed in V will reflect non-entry of the benefit claim to N, because the "Domestic Priority data as claimed by applicant" section will contain only the benefit claim to O. As a result of non-entry of the benefit claim to N, V's EBD is now O's filing date (February 2, 2021).

Example 18: Adding timely benefit claim under 35 U.S.C. 120 after filing; § 1.17(w)(2) fee due and paid.

Two months after the filing of application V from Example 17, applicant files a second ADS in V presenting a benefit claim to nonprovisional application N filed on March 2, 2020, and requests a corrected Filing Receipt. This newly added benefit claim causes V's EBD to become March 2, 2020, which is more than nine years earlier than V's actual filing date of July 5, 2029, and thus prompts the fee in § 1.17(w)(2). Because the fee in § 1.17(w)(1) was previously paid, the previous payment is subtracted from the amount now due under § 1.17(w)(2). Accordingly, the amount due upon filing of the second ADS is \$1,300 (the current fee amount of \$4,000 set forth in § 1.17(w)(2) less the \$2,700 previously paid under § 1.17(w)(1)). Because the fee required for entry of the benefit claim to N has been paid, the benefit claim will be entered. The corrected Filing Receipt mailed in V will reflect entry of the benefit claim, because the "Domestic Priority data as claimed by applicant" section now will contain the benefit claim to O and the benefit claim to N.

Example 19: Reissue application includes same benefit claim under 35 U.S.C. 120 that was entered in the original patent.

Application W is a nonprovisional application filed on January 2, 2025, which is prior to the effective date of this final rule. The ADS present upon W's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application S filed on February 5, 2018, which is the only benefit claim in the application. W's EBD is February 5, 2018, which is more than six but not more than nine years earlier than W's actual filing date of January 2, 2025. Because W was filed prior to the effective date of this final rule, no fee under § 1.17(w)(1) was due upon W's filing or upon the effective date of the final rule. W issues as patent W on February 2, 2026 with the benefit claim to S as the only benefit claim.

On February 1, 2028, patentee files application WA for reissue of patent W. The ADS present upon WA's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application S filed on February 5, 2018, which is the only benefit claim in the reissue application. WA's EBD is February 5, 2018, which is more than nine years earlier than WA's actual filing date of February 1, 2028. However, WA is a non-continuing reissue application, and the benefit claim to S was properly presented and entered in original patent W. As noted in the answer to Question 8 in this guide, the USPTO has waived § 1.17(w) in these circumstances. In accordance with this waiver, the benefit claim to S will not be considered to be presented for purposes of the CAF when it is included in the ADS upon filing of WA. Accordingly, in this example, no fee would be due under § 1.17(w).

Example 20: Non-continuing reissue application adding benefit claim under 35 U.S.C. 120.

In reissue application WA from Example 19, two months after WA's filing and after the effective date of this final rule, the applicant files a second ADS containing a benefit claim under 35 U.S.C. 120 to nonprovisional application O filed on February 2, 2021. While the newly added benefit claim does not change WA's EBD, its presentation in an application having an EBD more than nine years earlier than its actual filing date prompts the fee in § 1.17(w)(2). The waiver discussed in Question 8 in this guide does not apply here, because the benefit claim to O was not properly presented and entered in original patent W. Accordingly, the § 1.17(w)(2) fee of \$4,000 is due upon filing of the second ADS. In addition, because this benefit claim is delayed (not submitted within the required time period in § 1.78(d)), a petition for acceptance of an unintentionally delayed benefit claim under § 1.78(e) and the petition fee under § 1.17(m) are also required.

Example 21: Continuing reissue application adding benefit claim under 35 U.S.C. 120.

On May 5, 2028, patentee files application WB as a continuation reissue of reissue application WA from Example 19. In other words, WB is a continuation of reissue application WA and an application for reissue of original patent W. The ADS present upon WB's filing contains a benefit claim under 35 U.S.C. 120 to nonprovisional application S filed on February 5, 2018, and a benefit claim under 35 U.S.C. 120 to reissue application WA filed on February 1, 2028. These benefit claims are presented in an application having an EBD more than nine years earlier than its actual filing date, which prompts the fee in § 1.17(w)(2). The waiver discussed in Question 8 in this guide does not apply here, because WB is a continuing reissue application. Accordingly, the § 1.17(w)(2) fee of \$4,000 is due upon WB's filing.