

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

This notice addresses the new practice of requiring separate maintenance fees in each reissued patent based on a single original utility patent, and in original utility patents for which a reissue application is pending and at least one reissue patent has already issued. The new practice for multiple reissued patents and certain original patents that are the basis for reissue applications is set forth in the recent final rule to adjust patent fees. See *Setting and Adjusting Patent Fees During Fiscal Year 2017*, 82 FR 52780, 52791 (November 14, 2017).

Effective January 16, 2018, each utility reissued patent requires its own maintenance fee payment during the unexpired part of the term of the original patent (unless the original patent was filed before December 12, 1980). The new practice requires a maintenance fee to be paid in each reissued patent in force on (i.e., issued before) the maintenance fee due date. This includes all reissued patents that replace the same original patent and have maintenance fees due on or after January 16, 2018. The new practice also includes a requirement for maintenance fee payments in original patents that are not surrendered because one or more reissue applications of the same original patent are still pending on the maintenance fee due date. In summary, for maintenance fees due on or after January 16, 2018, the new practice requires a separate payment of the maintenance fee for each reissued patent based on a single original patent, and for the original patent if there is a pending reissue application based on the same original patent, to maintain each reissued patent(s) and the original patent in force beyond the 4th, 8th, or 12th anniversary of the grant date of the original patent. The due date for a maintenance fee is the last day the maintenance fee may be paid without a surcharge under 37 CFR 1.362(d). Sections 1415.01 and 2504 of the Manual of Patent Examining Procedure (MPEP) will be revised to reflect policies and procedures consistent with this notice.

The former practice of requiring only one maintenance fee in the latest issued reissue patent for all reissued patents based on the same original patent and for the original patent will be discontinued effective January 16, 2018. Accordingly, maintenance fee payments due on January 15, 2018, will be the last maintenance fees payable under the former practice. However, to ensure that all patentees have a six-month period to pay maintenance fees without a surcharge, the Office is establishing procedures for patentees to request a refund of the surcharge under 37 CFR 1.20(h) for payments made from January 17, 2018, to July 16, 2018. The surcharge cannot be waived during the transition due to limitations in the automated processing system. The request for refund is limited to the surcharge accompanying the maintenance fee payments that are newly required by this change in practice (e.g., for patents in reissue patent families except for the latest reissued patent). 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. A request for refund must be made by January 16, 2019.

FOR FURTHER INFORMATION: Contact James Engel, Senior Legal Advisor, at (571) 272-7725.