

Revision of the Notice of Allowance and Fee(s) Due Form (PTOL-85) Concerning a Previously Paid Issue Fee

The United States Patent & Trademark Office (Office) is revising the Notice of Allowance and Fee(s) Due form (PTOL-85) to always reflect the full issue fee due, even when there was a previously paid issue fee in the same application. Thus, the issue fee amount shown will no longer reflect a provisional credit of any previously paid issue fee in the same application. Applicants can request reapplication of any previously paid issue fee by either submitting Part B of form PTOL-85, which contains a statement requesting the reapplication, or an equivalent paper. Such a submission will also confirm applicant's intention to have the application issue as a patent. The Office will soon revise form PTOL-85 to reflect the full issue fee amount due as well as separately indicate the amount of any previously paid issue fee, which can be reapplied upon request. Any previously paid publication fee in the same application will continue to satisfy the obligation to pay a publication fee, and this will continue to be reflected on form PTOL-85 by an indication that no publication fee is due.

Under the former practice, the amount of the issue fee specified on form PTOL-85 reflected a provisional credit for any issue fee previously paid in the application. For example, if applicant had previously paid the issue fee (and publication fee) in response to a first form PTOL-85, and applicant subsequently withdrew the application from issue and filed a Request for Continued Examination (RCE) in which the application was later allowed, the second form PTOL-85 reflected an issue fee amount equivalent to the difference between the current issue fee and the issue fee previously paid. If no fee increase was in effect at the time of the mailing of the second form PTOL-85 and if applicant had previously paid the full amount due for both the issue and publication fees, the second form PTOL-85 reflected an amount of \$0 fees due.

Some applicants, however, were confused when the form PTOL-85 specified an amount of \$0 for the fee due, and failed to return the required Part B of form PTOL-85, or its equivalent. To eliminate the point of confusion, the Notice of Allowance and Fee(s) Due form (PTOL-85) will now always reflect the full issue fee amount currently due.

After the mailing of a notice of allowance, an applicant can, as an alternative to paying the issue fee, file an additional RCE to continue prosecution of the application, or permit the application to go abandoned. Since paying the issue fee is not the only option for an applicant, the Office must receive, after the notice of allowance has been mailed, express authorization to reapply any previously paid issue fee. Without receiving applicant's express authorization, the Office cannot know applicant's intentions with respect to the application and whether or not the previously paid issue fee should be applied.

Therefore, the applicant must affirmatively authorize reapplication of the previously paid issue fee after the mailing of the notice of allowance by returning Part B of form PTOL-85, or an equivalent. This is analogous to the Office's requirement that applicant, after a notice of allowance has been mailed, provide authorization if monies in a deposit account are to be used to pay an outstanding issue fee (*see* 37 CFR § 1.311). In both instances,

the Office must have confirmation of applicant's intention to pay the issue fee before monies within the possession of the Office may be applied. Therefore, in the situation where an issue fee has been paid, and another notice of allowance is subsequently mailed, applicants are required to timely reply to the Notice by submitting a completed Part B of the form PTOL-85, or its equivalent, in order to request the reapplication of the previously paid issue fee (as of the filing date of the returned Part B), and to update assignee and attorney data.

Applicants are reminded that the amount of the issue fee owed is determined by the date of payment. Therefore, even if reapplication of a previously paid issue fee is requested, applicant must pay any fee increase in effect at the time of filing a completed Part B of form PTOL-85, or its equivalent.

As noted above, the filing of an equivalent of Part B of form PTOL-85 is permitted. If applicant does file an equivalent paper, there must be a conspicuous statement requesting reapplication of a previously paid issue fee (in the same application). Due to the inherent difficulty in recognizing a paper as an equivalent of Part B of form PTOL-85, considerable delays in processing may occur. Applicants, therefore, are strongly encouraged to utilize Part B of form PTOL-85 to ensure rapid and efficient processing of the paper by the Office.

Questions related to the receipt of issue and publication fee payments should be directed to the Customer Service Center of the Office of Publications by telephone at 888-786-0101, or at (571) 272-4200. Questions of a legal nature may be directed to Brian Hanlon (by phone (572) 272-7743 or by e-mail to brian.hanlon@uspto.gov) or to Cynthia Nessler (by phone (572) 272-7724 or by e-mail to cynthia.nessler@uspto.gov), Legal Advisors, Office of Patent Legal Administration.

Date: 6/12/06

/S/
Jay P. Lucas
Deputy Commissioner for
Patent Examination Policy