

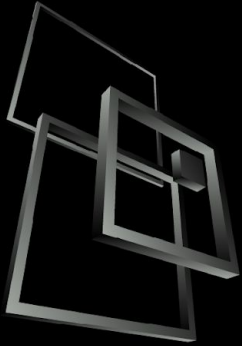


RECENT USPTO NEWS: AFCP, PTA AND FEES

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Recent USPTO News

- AFCP 2.0 program to expire on December 14, 2024
- USPTO Coding Error in Patent Term Adjustment
- Proposed USPTO Fee Increase for 2025



AFCP 2.0 TERMINATION ON DECEMBER 14, 2024

What is AFCP 2.0?

- A USPTO pilot program Designed to address these after-final issues by enhancing communication between Examiner and Applicant
 - Started May 19, 2013
- Applicant fills AFCP 2.0 form with After Final response including amendment to independent claim that is not broadening, and remarks

How Does AFCP 2.0 Work?

- Examiner is given extra time and credit to perform limited search and discuss results with Applicant in after-final interview
- If successful, application may be allowed without advisory action and RCE
- If not successful, applicant will receive advisory action and explanation, and will need to file RCE to enter amendment

Impact of AFCP 2.0

- Program has been very popular
 - successful to obtain further information from examiners
 - avoid RCE in some cases
 - streamline prosecution by keeping good relations between USPTO and applicants
 - No USPTO fee

Statistics on Success

- More than 60,000 requests filed
- Acceptance
 - 50% of AFCP requests were accepted, leading to AFCP search and interview
- Allowance
 - 30% of AFCP cases were allowed that would otherwise have received Advisory Action and required RCE or Appeal
 - 70% of AFCP cases required RCE or Appeal, but due to AFCP interview, the applicant could better understand the remaining issues

Why Is AFCP 2.0 Program Being Canceled?

- In 2024, USPTO proposed to charge \$500 per AFCP 2.0 request to cover administrative costs
 - However, the public comments opposed the proposal
- In response to the opposition, USPTO determined the pilot program will expire due to cost
- Last date for AFCP 2.0 Submission: December 14, 2024

Practice Tips - Before program expires

- Manage docket to file AFCP 2.0 by December for pending Final Office Actions
 - Expedite internal review of final office actions
 - Ask outside counsel to assist with final office action review
 - Prioritize final office action review ahead of nonfinal action review
 - Identify strong cases for AFCP 2.0 based on type of rejection (or ask outside counsel to assist)

Practice Tips - Once program expires

- Reduce Final Office Actions
 - Interview more aggressively at the non-final stage to negotiate on rejections, and do not wait until after-final to do an interview
 - Include a variety of dependent claims at an early stage to obtain search results on more features before the Final Office Action
 - Give the Examiner earlier chance to provide input or more

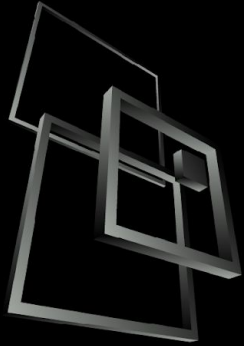
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Practice Tips - Once program expires

- Update After-Final Strategy
 - Examiners might still accept interviews in their discretion, but it is completely optional and will likely become more rare
 - File response early (e.g., 2 months) to reduce extension of time fees
 - For extensive amendments likely to cause Advisory Action, file RCE directly in response to Final OA instead of response to Office Action

Practice Tips - Once program expires

- Update After-Final Strategy
 - Pre-Appeal Brief Conference option is still available (no amendments can be made, and arguments should be focused on technical issues rather than legal arguments)
 - Proceed with full appeal
 - USPTO has a Fast-Track Appeals Pilot Program
 - Average time to decide petition: 2 days!
 - Average time to decide appeal: 2.6 months!



USPTO PATENT TERM ADJUSTMENT: EXPLANATION, ERROR AND RECOMMENDATIONS

Types of PTA

- PTA defines 3 categories of delay
 - Type A delay: USPTO delay in certain actions (e.g., OA or Allowance > 14 months, patent grant > 4 months after Issue Fee payment, and others)
 - Type B delay: patent is pending > 3 years, excluding certain delays (e.g., secrecy order, applicant-requested delays, etc.)
 - Type C delay: interference/ derivation proceeding, secrecy order, or appellate review by PTO or federal court that reversed an adverse determination of patentability

PTA Calculation

- Sum of (A delay + B delay + delay)
- Minus the following
 - Overlap between A, B and C delays
 - Terminally disclaimed patent term
 - Applicant-caused delays (e.g., extension of time, converting provisional to nonprovisional, defective reply, etc.).
- USPTO calculates PTA and provides on patent grant

How to Challenge PTA Error by USPTO

- Request for Consideration
 - Must be done during 2 months prior to issuance (5 extensions of time are possible)
- Civil action within 180 days of issuance
 - 180 days may be tolled while awaiting Request for Reconsideration

Some Best Practices to Maximize PTA

- Independently perform PTA calculation
 - File a petition with the PTO to challenge the PTA calculation, if an error is believed to have occurred
- Ensure responses to an office action are proper and timely
- Avoid filing IDS after filing a reply
 - Review patent office communications from counterpart applications as soon as they are received, and instruct international associates to report such communications as quickly as possible.
- Use oral election of species instead of written election practice
- Consider challenging obviousness type double patenting instead of filing terminal disclaimer.
- Avoiding filing RCE and post-allowance amendments

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USPTO Coding Error: What Happened

- September 25, 2024: USPTO warning of a coding error in its PTA software that may affect U.S. patents with grant dates between March 19 - July 30, 2024 as follows:
 - 35 USC 154(b)(1)(A) (statutory guarantee for prompt USPTO office responses)
 - 35 USC 154(b)(2)(A) (calculations of overlap with various statutory guarantees that do not extend total delay)
 - 35 USC 154(b)(1)(B) was not affected by this error.

USPTO Coding Error: What Happened

- USPTO states that it has identified the source of the error and corrected the software, and has advised patentees seeking revised PTA determination based on this error to submit a timely reconsideration petition
- USPTO waives all fees, including extension-of-time fees

USPTO Coding Error: What Happened

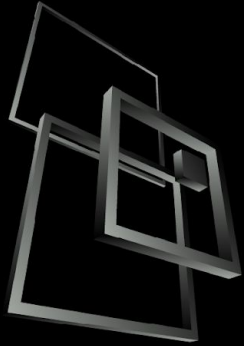
- Deadline under 37 CFR 1.705(b) requires request for reconsideration of the patent term adjustment indicated on the patent must be filed within two months from the date the patent was granted but may be extended an additional five months.
 - This means that requests for correction of the earliest potentially affected patents must be filed by Oct. 19, 2024.
 - Burden of proof is still on patentee

USPTO Coding Error: What Happened

- Informal USPTO comments
 - Less than 1 percent of granted patents during the time period were affected.
 - Patents with zero days of “A” delay or zero days of overlap are not been affected by the error
 - Patents in which the aggregate amount of “A” delay in the summary box is correctly calculated are likewise not affected.

USPTO Coding Error: What To Do

- Check for granted patents between March 19 and July 30, 2024 and docket appropriate due date
- Manually check patent term by contacting US attorney or using independent calculation service
- Consider USPTO comments on potentially unaffected patents
 - 0 days of “A” delay or zero days of overlap
 - Aggregate amount of “A” delay in summary box is correctly calculated
- File petition by the due date, including the basis for the request (e.g., identification of USPTO error)



PROPOSED USPTO FEE INCREASE FOR FISCAL YEAR 2025

UTILITY APPLICATION FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1011	Filing	\$320	\$350	\$30	9%
1111	Search	\$700	\$770	\$70	10%
1311	Examination	\$800	\$880	\$80	10%
1501	Issue	\$1,200	\$1,290	\$90	8%
1551	1st stage maintenance	\$2,000	\$2,150	\$150	8%
1552	2nd stage maintenance	\$3,760	\$4,040	\$280	7%
1553	3rd stage maintenance	\$7,700	\$8,280	\$580	8%

CONTINUING APPLICATION FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
New fee code	Filing an application or presentation of benefit claim more than six years after earliest benefit date	n/a		\$2,700	n/a
New fee code	Filing an application or presentation of benefit claim more than nine years after earliest benefit date	n/a		\$4,000	n/a

DESIGN APPLICATION FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1012	Basic filing fee – Design	\$220	\$300	\$80	36%
1017	Basic filing fee – Design CPA	\$220	\$300	\$80	36%
1112	Design search fee or Design CPA search fee	\$160	\$300	\$140	88%
1312	Design examination fee or Design CPA examination fee	\$640	\$700	\$60	9%
1502	Design issue fee	\$740	\$1,300	\$560	76%
1791	International design application first part U.S. designation fee	\$1,020	\$1,300	\$280	27%
1792	(Part II Designation Fee) Issue fee paid through the International Bureau in an international design application	\$740	\$1,300	\$560	76%

EXCESS CLAIM FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1202	Each claim in excess of 20	\$100	\$200	\$100	100%
1201	Each independent claim in excess of three	\$480	\$600	\$120	25%

PROVISIONAL APPLICATION EOT FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
New fee code	Extension for response within first month, provisional application	\$220	\$50	(\$170)	-77%
New fee code	Extension for response within second month, provisional application	\$640	\$100	(\$540)	-84%
New fee code	Extension for response within third month, provisional application	\$1,480	\$200	(\$1,280)	-86%
New fee code	Extension for response within fourth month, provisional application	\$2,320	\$400	(\$1,920)	-83%
New fee code	Extension for response within fifth month, provisional application	\$3,160	\$800	(\$2,360)	-75%

IDS FEES					
Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
New fee code	Filing an information disclosure statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 50 but not exceed 100	n/a	\$200	n/a	n/a
New fee code	Filing an information disclosure statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 100 but not exceed 200	n/a	\$500, less any amount previously paid	n/a	n/a
New fee code	Filing an information disclosure statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 200	n/a	\$800, less any amounts previously paid	n/a	n/a
TERMINAL DISCLAIMER FEES					
Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1814	Terminal disclaimers	\$170		\$183 ^{\$13}	8%
RCE FEES					
Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1801	Request for continued examination (RCE) – first request	\$1,360	\$1,500	\$140	10%
1820	Request for continued examination (RCE) – second request and subsequent request	\$2,000	\$2,860	\$860	43%
SUSPENSION OF ACTION FEES					
Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
New fee code	First request for suspension of action	\$220	\$300	\$80	36%
New fee code	Subsequent request for suspension of action	\$220	\$450	\$230	105%

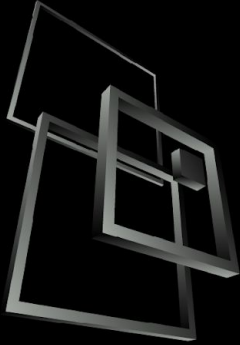
PTAB FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1406	Inter partes review request fee – up to 20 claims	\$19,000	\$23,750	\$4,750	25%
1414	Inter partes review post-institution fee – up to 20 claims	\$22,500	\$28,125	\$5,625	25%
1407	Inter partes review request of each claim in excess of 20	\$375	\$470	\$95	25%
1415	Inter partes post-institution request of each claim in excess of 20	\$750	\$940	\$190	25%
1408	Post-grant or covered business method review request fee – up to 20 claims	\$20,000	\$25,000	\$5,000	25%
1416	Post-grant or covered business method review post-institution fee – up to 20 claims	\$27,500	\$34,375	\$6,875	25%
1409	Post-grant or covered business method review request of each claim in excess of 20	\$475	\$595	\$120	25%
1417	Post-grant or covered business method review post-institution request of each claim in excess of 20	\$1,050	\$1,315	\$265	25%
New fee code	Request for review of a PTAB decision by the Director	n/a	\$452	n/a	n/a

PETITION FEES

Fee code	Description	Current fee*	Final rule fee*	Dollar change	Percent change
1455	Filing an application for patent term adjustment	\$210	\$226	\$16	8%
1454/1558/1784	Unintentional delay less than or equal to two years	\$2,100	\$2,260	\$160	8%
New fee code	Unintentional delay greater than two years	\$2,100	\$3,000	\$900	43%
1457	Application for extension of term of patent	\$1,180	\$2,500	\$1,320	112%
1458	Initial application for interim extension	\$440	\$1,320	\$880	200%
1459	Subsequent application for interim extension	\$230	\$680	\$450	196%
New fee code	Supplemental redetermination after notice of final determination	n/a	\$1,440	\$1,440	n/a

THANK YOU!!



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