

Will Applicants and Patentees Face Major New Fees/Increases in FY2025? A Blog Post by Doreen Trujillo

On April 3, 2024, the United States Patent and Trademark Office (“USPTO”) issued a Notice of Proposed Rulemaking entitled “Setting and Adjusting Patent Fees During Fiscal Year 2025.” *Federal Register*, Vol. 85, No. 69, 23226-91, April 3, 2024 (“NPRM”). The NPRM can be found [here](#).

The NPRM proposed increases in current official fees as well as the imposition of **entirely new fees**. The NPRM stated that these fee adjustments were necessary “...to provide the USPTO with sufficient aggregate revenue to recover the aggregate costs of patent operations in future years (based on assumptions and estimates found in the agency’s Fiscal Year 2025 Congressional Justification (FY 2025 Budget))...” The NPRM further stated the following.

The proposed fee adjustments will enable the USPTO to accomplish its mission to drive U.S. innovation, inclusive capitalism, and global competitiveness. The USPTO’s goal is to drive innovation, entrepreneurship, and creativity for the benefit of all Americans and people around the world.

NPRM, at 23226. The NPRM solicited written comments from the public, setting a deadline of June 3, 2024.

Twenty-eight comments were submitted to the USPTO by the deadline and are available for review. The comments are linked [here](#). Commenters include individuals as well as legal and trade organizations; e.g., Ericsson, Biocom California, PhRMA, AIPLA (American Intellectual Property Lawyers Association), IPO (Intellectual Property Owners Association), Professor Dennis Crouch (Patently-O Blog), PTAB Bar Association, US Chamber of Commerce (Global Innovation Policy Center), and the Council For Innovation Promotion. Most commenters were opposed to several of the proposed fees and increases. Several, including Google, LLC, were supportive of the proposed fees and increases.

Kurt Mulville, David Thibodeau, and I submitted one of the 28 comments. A copy of our comment letter can be found [here](#). As we state in the comment letter, several of the new fees and fee increases proposed could have an effect that is the complete opposite of the USPTO’s intended missions and goals enumerated above, especially the missions to drive inclusive capitalism and global competitiveness. Indeed, the impact of these new fees and fee increases could drive smaller companies and start-ups out of the U.S. patent process altogether.

In the comment letter, we focused upon those fees and fee increases we believe would impact our clients the most. Specifically, we addressed the new Continuing Application Fees (starting at \$2200 for large entity for application filed five years after the earliest benefit date claimed); the doubling of the

Total Excess Claim Fees (from \$100 to \$200 for large entity); the new Information Disclosure Size Fees for submitting over 50, over 100, and over 200 references (from \$200 to \$800, no discount); the quadrupling of the Patent Term Extension Fees (from \$1180 to \$6700, no discount); the increasing of the fee for filing third and subsequent Requests for Continued Examination (\$3600 for large entity); and the new tiering of Terminal Disclaimer fees depending upon time of filing (from \$200 to a maximum of \$1400, almost 10 times the current fee of \$170, no discount). We also noted that implementation of several of the proposed new fees and fee increases would exceed the USPTO's authority under 35 U.S.C. § 41. Several of the comments submitted by others focused on the same fees, and raised the USPTO exceeding its authority under 35 U.S.C. § 41.

FY2025 begins October 1, 2024. We are hopeful that the USPTO will not implement any of the new fees, nor implement some of the increases proposed that are excessive, before that time. The USPTO must consider all the comments submitted in response to the NPRM and must publish any final rule at least 30 days before the effective date of the rule. This means that the USPTO must publish a final rule based upon this NPRM by September 1, 2024.