

Chapter 2500 Maintenance Fees

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2501 Introduction [R-3]

35 U.S.C. 41. *Patent fees; patent and trademark search systems.*

(b) The Commissioner shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

- (1) 3 years and 6 months after grant, \$650 [\$*>1,020<].
- (2) 7 years and 6 months after grant, \$1,310 [\$*>2,050<].
- (3) 11 years and 6 months after grant, \$1,980 [\$*>3,080<].

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period. The Commissioner may require the payment of a surcharge as a condition of accepting within such six-month grace period the late payment of the applicable maintenance fee. No fee will be established for maintaining a design or plant patent in force.

Note: Under 35 U. S. C. 41 (f), the amounts of the fees have been increased by rule effective October 1, *>1996< to the bracketed amounts; see 37 CFR 1.20 (e) - (g) for current fee amounts.

(c)(1) The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable. The Commissioner may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Commissioner accepts payment of a maintenance fee after

the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

(2) A patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall not abridge or affect the right of any person or that person's successors in business who made, purchased, offered to sell, or used anything protected by the patent within the United States, or imported anything protected by the patent into the United States after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection, to continue the use of, to offer for sale, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, or used within the United States, or imported into the United States, as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

Public Law 96-517, enacted December 12, 1980, established the requirement to pay maintenance fees for applications filed on or after that date. The statutory provisions regarding maintenance fees have been subsequently modified by Public Law 97-247, enacted August 27, 1982; Public Law 98-622, enacted November 8, 1984; Public Law 102-204, enacted December 10, 1991; and Public Law 102-444, enacted October 23, 1992.

Patent Maintenance Division

The Patent Maintenance Division provides specialized advice and guidance to the public on maintenance fee matters, sets policy and provides guidelines to the Entity and Status Branch.

The Entity and Status Branch determines the proper status of issued patents which are subject to payment of maintenance fees; receives and processes fee transmittals; determines small entity status; responds to public inquiries on post-issuance status and maintenance fees; determines if patents have expired and/or can be revived; and determines if maintenance fees are timely and properly computed. This Branch also produces *Official Gazette* notices of maintenance fees due and of expiration of patents due to failure to pay maintenance fee addresses in a patent post-issuance automated file.

*Office of Public Records Dissemination Support Division
Records Maintenance Branch*

The Records Maintenance Branch updates patent post issuance automated files using the following information:

- (1) Change of Address
- (2) Powers of Attorney and Revocations Thereof
- (3) Withdrawals of Attorneys and Agents
- (4) Small Entity Status

The official mailing address for submitting requests to update all post—issuance patent information is:

> Box 9<

Commissioner of Patents and Trademarks

ATTN: ** Dissemination Support Division

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Washington, D.C. 20231

2504 Patents Subject to Maintenance Fees

37 CFR 1.362. Time for payment of maintenance fees.

(a) Maintenance fees as set forth in § 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8, and 12 years after the date of grant.

(b) Maintenance fees are not required for any plant patents or any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, the United States filing date of the original non—reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11 (1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

(1) 3 years through 3 years and 6— months after grant for the first maintenance fee,

(2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and

(3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee,

(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and

(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e), or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

Maintenance fees are required to be paid on all patents based on applications filed on or after December 12, 1980, except for plant patents and design patents. Furthermore, maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

Application filing dates for purposes of determining whether or not a patent is subject to payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the actual United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original nonreissue application on which the patent reissued is based.

(5) For an international application that has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

2506 Times for Submitting Maintenance Fee Payments

37 CFR 1.362(d) sets forth the time periods when the maintenance fees for a utility patent can be paid without surcharge. Those periods, referred to generally as the "window period," are the 6-month periods preceding each due date. The "due dates" are defined in 35 U.S.C. 41(b). The window periods are (1) 3 years to 3 1/2 years after the date of issue for the first maintenance fee payment, (2) 7 years to 7 1/2 years after the date of issue for the second maintenance fee payment, and (3) 11 years to 11 1/2 years after the date of issue for the third and final maintenance fee payment. A maintenance fee paid on the last day of a window period can be paid without surcharge. The last day of a window period is the same day of the month the patent was granted 3 years and 6 months, 7 years and 6 months, or 11 years and 6 months after grant of the patent.

37 CFR 1.362(e) sets forth the time periods when the maintenance fees for a utility patent can be paid with surcharge. Those periods, referred to generally as the "grace period," are the 6-month periods immediately following each due date. The grace periods are (1) 3 1/2 years and through the day of the 4th anniversary of the grant of the patent, (2) 7 1/2 years and through the day of the 8th anniversary of the grant of the patent and, (3) 11 1/2 years and through the day of the 12th anniversary of the grant of the patent. A maintenance fee may be paid with the surcharge on the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant to prevent the patent from expiring.

Maintenance fees for a reissue patent are due based upon the schedule established for the original utility patent.

If the day for paying a maintenance fee falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee may be paid on the next succeeding day that is not a Saturday, Sunday, or Federal holiday. For example, if the window period for paying a maintenance fee without a surcharge ended on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee can be paid without surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. Likewise, if the grace period for paying a maintenance fee with a surcharge ended on a Saturday, Sunday, or a Federal holiday within the

District of Columbia, the maintenance fee can be paid with surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. In the latter situation, the failure to pay the maintenance fee and surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia will result in the patent expiring on a date (4, 8, or 12 years after the date of grant) earlier than the last date on which the maintenance fee and surcharge could be paid. This situation results from the provisions of 35 U.S.C. 21, but those provisions do not extend the expiration date of the patent if the maintenance fee and any required surcharge are not paid when required. For example, if the grace period for paying a maintenance fee with a surcharge ended on a Saturday, the maintenance fee and surcharge could be paid on the next succeeding business day; e.g., Monday, but the patent will have expired at midnight on Saturday if the maintenance fee and surcharge were not paid on the following Monday. Therefore, if the maintenance fee and any applicable surcharge are not paid, the patent will expire as of the end of the grace period as listed above. A patent that expires for failure of payment will expire on the anniversary date the patent was granted in the 4th, 8th, or 12th year after the grant.

2510 Mailing Address for Maintenance Fee Documents

The mailing address for all communications concerning maintenance fee payments is:

Commissioner of Patents and Trademarks
Box M Fee
Washington, D.C. 20231

37 CFR 1.366(b) provides that the certificate of mailing procedures of 37 CFR 1.8 or the mailing by "Express Mail" provisions of 37 CFR 1.10 may be utilized in paying maintenance fees. The specific requirements of either 37 CFR 1.8 or 1.10 must be fully complied with if the benefits of either are desired. See MPEP § 512 and § 513.

2511 Submission of Maintenance Fee Documents by Facsimile

Payment of a maintenance fee is accepted via facsimile, when charged to a deposit account. In addition,

requests pertaining to post-issuance documents, such as change of correspondence address, assignment of fee address, etc., may be submitted by facsimile.

37 CFR 1.366(b) provides that the certificate of transmission procedure of 37 CFR 1.8 may be utilized in paying maintenance fees. The specific requirements of 37 CFR 1.8 must be fully complied with if the benefits thereof are desired.

2515 Information Required for Submission of Maintenance Fee Payment [R-3]

37 CFR 1.366. *Submission of maintenance fees.*

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee need not be filed in the Patent and Trademark Office to pay maintenance fees and any necessary surcharges on behalf of the patentee.

(b) A maintenance fee and any necessary surcharge submitted for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid and may be paid in the manner set forth in § 1.23 or by an authorization to charge a deposit account established pursuant to § 1.25. Payment of a maintenance fee and any necessary surcharge or the authorization to charge a deposit account must be submitted within the periods set forth in § 1.362(d), (e), or (f). Any payment or authorization of maintenance fees and surcharges filed at any other time will not be accepted and will not serve as a payment of the maintenance fee except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner in an expired patent pursuant to a petition filed under § 1.378. Any authorization to charge a deposit account must authorize the immediate charging of the maintenance fee and any necessary surcharge to the deposit account. Payment of less than the required amount, payment in a manner other than that set forth in § 1.23, or the filing of an authorization to charge a deposit account having insufficient funds will not constitute payment of a maintenance fee or surcharge on a patent. The certificate procedures of either § 1.8 or § 1.10 may be utilized in paying maintenance fees and any necessary surcharges.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the following:

- (1) The patent number, and
- (2) The serial number of the United States application for the patent on which the maintenance fee is being paid.

(d) Payments of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3 1/2, 7 1/2, or 11 1/2 year fee, whether small entity status is being changed or claimed, the amount of the maintenance fee and any surcharge being paid, any assigned payor number, the patent issue date, and the United States application filing date. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application serial number as required by paragraph (c) of this section and should also include the original patent number, the original patent issue date and the original United States application filing date.

(e) Maintenance fee payments and surcharge payments relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in § 1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See § 1.28(b).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§ 1.26 and 1.28(a).

37 CFR 1.366 establishes the guidelines and procedures for submission of maintenance fees, including any necessary surcharges. The patentee may pay maintenance fees and any necessary surcharges or any person or organization may pay maintenance fees and any necessary surcharges on behalf of the patentee without filing in the Office evidence of authorization by the patentee to pay maintenance fees. This will enable patentees to pay the maintenance fees and any necessary surcharges themselves or authorize some person or organization to pay maintenance fees and any necessary surcharges on their behalf. No verification of the authority to pay maintenance fees and any necessary surcharges in a particular patent will be made by the Office. While anyone may pay the maintenance fees and any necessary surcharges on a patent, any Office notices relating to maintenance fees will be mailed to the "fee address" set forth in 37 CFR 1.363.

A maintenance fee and any necessary surcharge for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid, and at the proper time; i.e., within the periods set forth in 37 CFR 1.362. If the amount of the maintenance fee is correct on the date it is paid and credited to the patent, a later change in the maintenance fees to reflect a new fee amount will not require a modification in the amount paid. However, in order for the maintenance fee to be considered paid, it must be submitted in accordance with 37 CFR 1.366.

Maintenance fee payments and any necessary surcharges must include the Patent Number and the Application/Serial Number as required by 37 CFR 1.366(c). The >application< serial number required to be submitted is not that of a prior parent application, but rather

the actual application that matured into the patent for which maintenance fees are to be paid. If the maintenance fee is being paid on a reissue patent, the >application< serial number required is that of the reissue application. Since this required information will be used as a cross-check to ensure that the maintenance fee is properly credited, the application serial number must correspond to the patent that issued therefrom. If less than the required information is submitted, the Office will not credit the payment. Additionally, if notice is required that the proper identifying data has not been submitted, it would result in requiring the payment of a surcharge if the necessary data is submitted after the window period closes. If the required information is not submitted until after the end of the grace period, the patent would have expired because of the failure to properly identify the patent to which the maintenance fee payment is to be credited prior to the expiration of the grace period. The patentee in such circumstance could proceed under 37 CFR 1.378 (see MPEP § 2590), if appropriate, or could file a petition under 37 CFR 1.377 (see MPEP § 2580) within the period set therein seeking to have the maintenance fee accepted as timely even though all of the required identifying data was not present prior to expiration of the grace period.

Under 37 CFR 1.366(d), the following information should also be submitted for each patent on which a maintenance fee or surcharge is paid (37 CFR 1.366(d)): (1) the United States Application Filing Date, (2) the Issue Date, (3) the Fee Year (e.g., 3½, 7½, or 11½ year fee), (4) the amount of the maintenance fee and any surcharge being submitted, (5) any assigned payor >(now customer)< number, and (6) whether small entity status is being changed or claimed with the payment. Where the payment is a maintenance fee and any necessary surcharge on a reissue patent, in addition to the information requested for all payments, it is requested that the original patent number, original issue date, and the original U.S. application filing date be furnished. The reason for requesting this additional information is that the original issue date and the original U.S. application filing date are the dates that control if and when maintenance fees must be paid to prevent the reissue patent from expiring. Although the submission of the information requested under 37 CFR 1.366(d) is not mandatory, it would expedite the processing of maintenance fee payments. In addition, the indication of the fee code used by the Office would assist in proper financial crediting of

the maintenance fee within the Office. It is also suggested that the telephone number of the person submitting the maintenance fee be supplied.

The required information is considered to be the least that can be required to make a cross-check and thus ensure that the maintenance fee is being credited to the proper patent. An error in either the patent issue date or the application filing date, or both, by the person paying the maintenance fee would not result in a refusal to accept the maintenance fee and to credit the payment thereof to the patent, if the patent number and the U.S. application serial number were correct; i.e., in agreement. However, if any error included either the patent number or the U.S. application serial number such that they were not in agreement, the payment would not be accepted and credited until correction was made. The date of the correction would be the date the maintenance fee payment is credited as being made.

The Maintenance Fee Transmittal Form, PTO/SB/45, is suggested when submitting maintenance fees. This form is available, upon request, from the Patent Maintenance Division.

The Office processes fees in the order in which they are presented. If payment submitted is insufficient to cover the maintenance fees and surcharges for all patents listed, and there is no authorization to charge a deposit account, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

2520 Maintenance Fee Amounts

37 CFR 1.20(e)–(h) sets the fee amounts for the maintenance fees and the grace period surcharge. The maintenance fee amounts are subject to adjustment to reflect fluctuations occurring in the Consumer Price Index pursuant to 35 U.S.C. 41(f). The maintenance fee amounts (37 CFR 1.20(e)–(h)) are subject to a 50% reduction for small entities pursuant to 35 U.S.C. 41(h). The Patent Maintenance Division may be contacted for the current maintenance fee amounts.

37 CFR 1.366(g) provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 1.28(a). A patentee cannot obtain a refund of a maintenance fee which was due and payable on the patent. Any duplicate payment will be refunded to the fee address.

2522 Methods of Payment

The maintenance fee and any necessary surcharge may be paid in the manner set forth in 37 CFR 1.23; i.e., it should be in United States specie (e.g., cash), Treasury notes, national bank notes, post office money orders, or by certified check. As indicated in 37 CFR 1.23, if the maintenance fee and any necessary surcharge is sent in any other form, the Office may delay or cancel the credit until collection is made. For example, a personal or other uncertified check drawn on a U.S. bank that is not immediately negotiable; e.g., because of a lack of a signature or insufficient funds, will not constitute payment of a maintenance fee and/or surcharge. Any remittance from a foreign country must be payable and immediately negotiable in the United States for the full amount of the maintenance fee and/or surcharge required.

37 CFR 1.366(b) provides that maintenance fees and any necessary surcharge may be paid by authorization to charge a deposit account established pursuant to 37 CFR 1.25. The authorization to charge the deposit account must be submitted within an appropriate window or grace period and must be limited to maintenance fees and surcharges payable on the date of submission. The authorization to charge the deposit account cannot be submitted prior to the third, seventh, or eleventh year after grant of the patent. If an authorization to charge a deposit account were submitted to pay the maintenance due at 3 years and 6 months after grant, a new authorization to charge a deposit account or other form of payment will have to be submitted at the appropriate time for each of the maintenance fees due at 7 years and 6 months and 11 years and 6 months. Any payment or authorization filed at any time other than that set forth in 37 CFR 1.362(d), (e), or (f) will not serve as a payment of the maintenance fee, except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner pursuant to 37 CFR 1.378. See MPEP § 2590. A payment of less than the required amount, a payment in a manner other than that set forth in 37 CFR 1.23, or the filing of an authorization to charge a deposit account having insufficient funds, will not constitute payment of a maintenance fee on a patent. The authorization is required to authorize the immediate charging of the maintenance fee to the deposit account. An authorization would be improper if it only authorized the maintenance fee to be charged at a later date; e.g., on the last possible day of payment without surcharge. Such an authoriza-

tion would not serve as payment of the maintenance fee. Any payment which fails to result in the entire proper amount of the maintenance fee being present on the due date will not constitute payment of the maintenance fee.

Maintenance fee payments and any surcharges relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in 37 CFR 1.23 or by authorization to charge a deposit account, 37 CFR 1.366(e). Maintenance fee payments and surcharge payments relating thereto that are comingled with payments for other fees or charges; e.g., application filing fees, issue fees, document supply fees, etc., will not be accepted. Maintenance fees require processing by a separate area of the Office and are not processed in the same manner as other fees and charges. Maintenance fees for a number of patents can be submitted together in one submission and one payment. 37 CFR 1.366(e) specifies that if maintenance fee payments for more than one patent are submitted together, they should be submitted on as few sheets as possible, listing the patent numbers in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and any surcharges for all the listed patents, the payment will be applied in the order the patents are listed. In such a circumstance where the fees are insufficient, the maintenance fee and any surcharge for one or more of the last listed patents will not be paid.

Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount required.

It is not suggested that cash be sent by mail. However, if cash is sent it will be at the risk of the sender and should be sent via registered mail.

2530 Informalities

Informalities in the payment of maintenance fees occur when:

- (1) Payment was received without the patent and application serial number,
- (2) Payment was received with an incorrect patent or application serial number,
- (3) Payment for a reissue patent was received and the reissue patent number and/or the reissue application serial number was not provided,
- (4) Payment was received; however, additional funds are required due to surcharge or fee increase,
- (5) Payment was received in an amount

for small entity; however, records do not indicate a statement claiming small entity was received, or (6) Payment was received after the patent expired.

If an informality occurs, notice will be sent to the party submitting the maintenance fee provided the grace period provided by 37 CFR 1.362(e) has not expired. Response to the informality is required prior to expiration of the grace period in order to avoid the expiration of the patent. If a response is not received prior to expiration of the patent, then an appropriate petition under 37 CFR 1.377 or 1.378 is required. See MPEP § 2580 and § 2590.

2540 Fee Address for Maintenance Fee Purposes [R-3]

37 CFR 1.363. *Fee address for maintenance fee purposes.*

(a) All notices, receipts, refunds, and other communications relating to payment or refund of maintenance fees will be directed to the correspondence address used during prosecution of the application as indicated in § 1.33(a) unless:

(1) A "fee address" for purposes of payment of maintenance fees is set forth when submitting the issue fee, or

(2) A change in the correspondence address for all purposes is filed after payment of the issue fee, or

(3) A "fee address" or a change in the "fee address" is filed for purposes of receiving notices, receipts and other correspondence relating to the payment of maintenance fees after the payment of the issue fee, in which instance, the latest such address will be used.

(b) An assignment of a patent application or patent does not result in a change of the "correspondence address" or "fee address" for maintenance fee purposes.

All notices, receipts, refunds and other communications relating to the payment or refund of a maintenance fee will be directed to the correspondence address used during the prosecution of the application, unless a "fee address" for the purpose of payment of the maintenance fee has been designated or a change in the correspondence address has been made (see MPEP § 2542). 37 CFR 1.33(d) allows a correspondence address or change thereto to be filed during the enforceable life of the patent. Due to the possible expiration of a patent for failure to timely pay a required maintenance fee, patentees should ensure that the Office is properly notified of the proper "fee address" to which all maintenance fee communications are to be directed.

Under the statutes and regulations, the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent

expiration of the patent. The failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b); see *In re Patent No. 4,409,763*, 7 USPQ2d 1798 (Comm'r Pat. 1988), *aff'd Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd* **, 937 F.2d 623 (Fed. Cir. 1991) >(table)<, *cert. denied* **, 502 U.S. 1075 < (** 1992). Maintenance fee correspondence will not be directed to more than one address.

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The "Fee Address" Indication Form, PTO/SB/47, and the Request for *>Customer< Number Form, PTO/SB/*>125<, are suggested when requesting establishment of a "Fee Address" or the assignment of a ">Customer< Number." **>The "Fee Address" Indication Form, PTO/SB/47 is < available, upon request, from the Patent Maintenance Division. Requests for the establishment of a "Fee Address" ** should be submitted to the Patent Maintenance Division prior to or at the time of payment of maintenance fees in order to ensure that receipt of payment is directed to the fee address. >See MPEP § 403 concerning requests for a Customer Number.<

Additional patent numbers may be assigned to a ">Customer< Number" at any time, with a written request.

The ">Customer< Number" of the Fee Address should be referred to on all future maintenance fee payments in order to expedite the payment.

2542 Change of Correspondence Address

Unless a fee address has been designated, all notices, receipts, refunds, and other communications relating to the patent will be directed to the correspondence address used during the prosecution of the application. Practitioners of record when the patent issues who do not wish to receive correspondence relating to maintenance fees must change the correspondence address in the patented file or provide a fee address to which such correspondence should be sent. It is not required that a

practitioner file a request for permission to withdraw pursuant to 37 CFR 1.36 solely for the purpose of changing the correspondence address in a patented file, even though a withdrawal of a practitioner would change the correspondence address.

The correspondence address should be updated or changed as necessary to ensure that all communications are received in a timely manner. A change of correspondence address may be made by the inventors named in the patent, an attorney or agent of record, or by the assignee complying with 37 CFR 3.73(b).

Requests for a change of the correspondence address may be sent to the Office of Public Records, Dissemination Support Division, Records Maintenance Branch during the enforceable life of the patent. To ensure accuracy and to expedite requests for change to the correspondence address, it is suggested that the request include both the patent number and the application serial number.

2550 Small Entity Status

In order to claim small entity status for the purpose of paying a maintenance fee, a verified statement must be filed prior to or with the maintenance fee paid as a small entity. A verified statement is only required to be filed once and will remain effective until changed.

37 CFR 1.366(f) serves as a reminder to patentees of the necessity to check for the loss of small entity status prior to paying each maintenance fee on a patent. This is also a requirement of 37 CFR 1.28(b). The notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. If status as a small entity has been previously established by filing a statement and such status is checked and found to be proper, no notification is required. It is not necessary to file new verified statements claiming small entity status at this point if the status as a small entity has been established and is still proper even if rights have been transferred to a small entity who has not previously filed a verified statement. The requirement is to notify the Office of the loss of entitlement and to pay the maintenance fee in the proper amount for other than a small entity where appropriate. The refund provisions of 37 CFR 1.28(a) for later sub-

mitted small entity statements does apply to maintenance fees.

2560 Revocation of Power of Attorney and Withdrawal of Attorney

The revocation or withdrawal of an attorney may be submitted at any time; however, it is recommended that it be done well prior to the date a maintenance fee is due.

When processing a revocation of a power of attorney, the Office of Public Records, Dissemination Support Division, Records Maintenance Branch forwards copies of the completed action to the requester and the attorney being removed. Also, a copy is placed in the patent file wrapper.

When processing a withdrawal of an attorney, the Office of Public Records, Dissemination Support Division, Records Maintenance Branch forwards copies of the completed action to the attorney and the patent owner. Also, a copy is placed in the patent file wrapper.

It should be noted that an assignment does not act as a revocation of power of attorney for authorization previously given. However, the assignee of the entire interest may revoke a previous power of attorney. See 37 CFR 3.71 and 3.73.

2570 Status Requests

The Patent Maintenance Division will respond to requests for the status of patents. Status can be requested in person, by telephone, or by facsimile. Telephone status requests are limited to five patent numbers per telephone call. In-person and facsimile requests are limited to 30 patent numbers.

When requesting status of a patent, the patent and application serial number must be provided to the Patent Maintenance Division.

The Patent Maintenance Division has a form available, for the user's convenience, when submitting requests in person or via facsimile.

2575 Notices

Under the statutes and the regulations, the Office has no duty to notify patentees when their maintenance fees are due. It is the responsibility of the patentee to ensure that the maintenance fees are paid to prevent expiration of the patent. The Office will, however, provide some notices as reminders that maintenance fees are due, but the notices, errors in the notices, or the lack of

notices will in no way relieve a patentee from the responsibility to make timely payment of each maintenance fee to prevent the patent from expiring by operation of law. The notices provided by the Office will be merely courtesy in nature and intended to aid patentees. These notices, errors in these notices, or the lack of notices will in no way shift the burden of monitoring the time for paying maintenance fees on patents from the patentee to the Office.

Preprinted Standard Notices

The patent grant currently includes a reminder notice that maintenance fees may be due. The Notice of Allowance currently includes a reminder notice that maintenance fees may be due.

Official Gazette Notice

A notice will appear in each issue of the *Official Gazette* which will indicate which patents have been granted 3, 7, and 11 years earlier, that the window period has opened, and that maintenance fee payments will now be accepted for those patents.

Another *Official Gazette* notice published after expiration of the grace period will indicate any patent which has expired due to nonpayment of maintenance fees and any patents which have been reinstated. An annual compilation of such expirations and reinstatements will also be published.

Maintenance Fee Reminders

Since patentees are expected to maintain their own record and docketing systems and since most patentees are expected to pay their maintenance fees during the window period to prevent payment of a surcharge, the Office will not send any reminder notices to the patentee until after the grace period has begun. This will reduce and simplify the mailing of notices but still give patentees an opportunity to pay their maintenance fee with surcharge during the grace period before expiration of their patents. The Office will mail any Maintenance Fee Reminder to the fee address as set forth in 37 CFR 1.363. See MPEP § 2540.

Receipt Notices

The Office will issue a receipt for payment of maintenance fees after entry of the maintenance fee payment. Such a receipt will provide an opportunity for the patentee

to check if the Office has properly credited the payment. The original document submitted by the patentee when paying the maintenance fee will also be appropriately marked and returned to the fee address.

Expiration Notices

The Office will mail a Notice of Patent Expiration to the fee address when Office records indicate that a patent has expired for failure to pay a required maintenance fee.

2580 Review of Decision Refusing to Accept and Record Payment of a Maintenance Fee Filed Prior to Expiration of Patent [R-3]

37 CFR 1.377. Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Commissioner to accept and record the maintenance fee.

(b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(h). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of paragraph (b) of § 1.181 and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

37 CFR 1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 CFR 1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Commissioner to accept and record the maintenance fee. This petition may be used, for example, in situations where an error is present in the identifying data required by 37 CFR 1.366(c) with the maintenance fee payment; i.e., either the patent number or the application serial number are incorrect. See MPEP § 2515. A petition under 37 CFR 1.377 would not be appropriate where there is a complete failure to include at least one correct mandatory identifier as required by 37 CFR 1.366(c) for the patent since no evidence would be present as to the patent on which the

maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would not credit the fee to a patent. A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application serial number. Likewise, a petition under 37 CFR 1.377 would not be appropriate where the entire maintenance fee payment, including any necessary surcharge, was not filed prior to expiration of the patent.

Any petition filed under 37 CFR 1.377 must be filed within 2— months of the action complained of, or within such other time as may be set in the action complained of. The petition must be accompanied by the proper petition fee. The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to have resulted from an error by the Office.

Any petition filed under 37 CFR 1.377 must comply with the requirements of 37 CFR 1.181(b) and must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes 37 CFR 1.377. The petition must be in the form of verified statement if made by a person not registered to practice before the Office. If the petition is signed by a person not registered to practice before the Office, the petition must indicate whether the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324.

Any petition under 37 CFR 1.377 should be marked on the front page of the communication to the attention of the Office of Petitions and addressed as follows:

By mail: >Assistant< Commissioner *>for<
Patents **
Box DAC
Washington, D.C. 20231

2590 Acceptance of Delayed Payment of Maintenance Fee in Expired Patent to Reinstate Patent [R-3]

37 CFR 1.378. Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) the required maintenance fee set forth in § 1.20 (c)–(g);
- (2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty—four months after the six—month grace period provided in § 1.362(e) and must include:

- (1) the required maintenance fee set forth in § 1.20 (c)–(g);
- (2) the surcharge set forth in § 1.20(i)(2); and
- (3) a statement that the delay in payment of the maintenance fee was unintentional.

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two— months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

37 CFR 1.378(a) provides that the Commissioner may accept the payment of any maintenance fee due on a

patent based on an expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable or unintentional. The appropriate surcharge set forth in §1.20(i) must be paid as a condition of accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

Any petition under 37 CFR 1.378(b) or (c) should be marked on the front page of the communication to the attention of the Office of Petitions and addressed as follows:

By mail: >Assistant< Commissioner *>for<
Patents **
Box DAC
Washington, D.C. 20231

Any petition under 37 CFR 1.378 must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes of 37 CFR 1.378. The petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office. If the petition is signed by a person not registered to practice before the Office, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324.

37 CFR 1.378(e) provides a mechanism for obtaining reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a). This mechanism is a petition for reconsideration which may be filed within 2 months of, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee. In contrast to petitions filed under paragraph (a), the petition for reconsideration requires the petition fee set forth in 37 CFR 1.17(h). After a decision on the petition for reconsideration,

no further reconsideration or review of the matter will be undertaken by the Commissioner. The maintenance fee and the surcharge submitted will be refunded if the delayed payment of the maintenance fee is not accepted. The refund will be made following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. The petition fee for filing the petition for reconsideration will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Office.

Unavoidable Delay

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include (1) the required maintenance fee set forth in § 1.20 (e)-(g), (2) the surcharge set forth in § 1.20(i) (1), and (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Such a statement must be verified if made by a person not registered to practice before the Patent and Trademark Office. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

**>As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd*, *Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). Decisions on reviving

abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514–15 (1912) (quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32–33 (Comm'r Pat. 1887)); see also *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable (or expiration of the patent as it applies to 35 U.S.C. 41(c)(1)), but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive (or a petition under 37 CFR 1.378(b) to reinstate the patent under 35 U.S.C. 41(c)(1)). See *In re Application of Takao*, 17 USPQ2d 1155 (Comm'r Pat. 1990). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316–17, 5 USPQ2d 1130, 1131–32 (N.D. Ind. 1987).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance

fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, *supra*. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the *Federal Register* at 49 Fed. Reg. 34716, 34722–23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable. For example, an error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and if it were shown that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.<

Unintentional Delay

Public Law 102–444 amended 35 U.S.C. 41(c)(1) to permit the Commissioner to accept late payment of any

maintenance fee filed within 24 months after the 6-month grace period, if the delay in payment is shown to the satisfaction of the Commissioner to have been unintentional.

In addition to the timeliness deadline set forth in the preceding paragraph, a petition filed under the unintentional standard of 37 CFR 1.378(c) must include (1) the required maintenance fee set forth in 37 CFR 1.20 (e) through (g), (2) the surcharge for an unintentionally expired patent as set forth in 37 CFR 1.20(i)(2), and (3) a statement that the delay in payment of the maintenance fee was unintentional. Such statement must be verified if made by a person not registered to practice before the Patent and Trademark Office.

A person seeking reinstatement of an expired patent should not make a statement that the delay in payment of the maintenance fee was unintentional unless the entire delay was unintentional, including the period from discovery that the maintenance fee was not timely paid until payment of the maintenance fee. For example, a statement that the delay in payment of the maintenance fee was unintentional would not be proper when the patentee becomes aware of an unintentional failure to timely pay the maintenance fee and then intentionally delays filing a petition for reinstatement of the patent under 37 CFR 1.378.

Public Law 102-444 and 37 CFR 1.378(c) are effective as to any patent that would be covered by the literal language of the sections. Public Law 102-444 and interim rule 37 CFR 1.378(c) were effective October 23, 1992. Since Public Law 102-444 provides up to a 24-month period after the 6-month grace period provided in 35 U.S.C. 41(c) to seek reinstatement of an expired patent where the delay was unintentional, any patent that expired on or after October 23, 1990, for failure to timely pay a maintenance fee is eligible for relief under 37 CFR 1.378(c). However, it should be noted that a petition to reinstate an unintentionally expired patent, the required maintenance fee, and the surcharge required under the

unintentional standard (37 CFR 1.20 (i) (2)) must be filed within 24 months after the 6-month grace period to be eligible for relief under the unintentional standard.

2591 Intervening Rights in Reinstated Patents

Intervening rights in reinstated patents are provided by 35 U.S.C. 41(c) (2) which is reproduced in MPEP § 2501. No patent, the term of which has been maintained as a result of the acceptance of a late payment of a maintenance fee, shall abridge or affect the right of any person or his successors in business who made, purchased, or used after the 6-month grace period but prior to the acceptance of the late maintenance fee anything protected by the patent, to continue the use of, or to sell to others to be used or sold, the specific thing made, purchased, or used. A court before which such matter is in question may provide for the continued manufacture, use, or sale of the thing made, purchased, or used as specified, or for the manufacture, use, or sale of which substantial preparation was made after the 6-month grace period but before the acceptance of the late maintenance fee, and it may also provide for the continued practice of any process, practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but prior to the acceptance of the late maintenance fee, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of the late maintenance fee.

>2595 Forms [R-3]

The following forms which are suggested when submitting a maintenance fee or establishing a fee address for maintenance fee purposes are reproduced on the following pages. "Maintenance Fee Transmittal Form," Form PTO/SB 45; and "Fee Address Indication Form," Form PTO/SB/47.<

> PTO/SB/ 45 (10-92)

MAINTENANCE FEE TRANSMITTAL FORM									
Address to: Commissioner of Patents and Trademarks Box M Fee Washington, D.C. 20231				I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope address to "Commissioner of Patents and Trademarks, Box M Fee, Washington, D.C. 20231" on _____. Signature _____ Typed or printed name _____					
Enclosed herewith is the payment of the maintenance fee(s) for the listed patent(s).									
1. ☐ A check for the amount of \$ _____ for the full payment of the maintenance fee(s) and any necessary surcharge on the following patents is enclosed.									
2. ☐ The Commissioner is hereby authorized to charge \$ _____ to cover the payment of the fee(s) indicated below to Deposit Account No. _____.									
3. ☐ The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. _____.									
<i>* Information required by 37 CFR 1.366(c)(columns 1 & 5). Information requested under 37 CFR 1.366(d) (columns 2-4 & 6-9)</i>									
Item	Patent Number ^a	Fee Code (see below)	Maintenance Fee Amount (37 CFR 1.20)	Surcharge Amount	U.S. Application Number ^a [00/555,555]	Patent Date mm/dd/yy	Application Filing Date mm/dd/yy	Payment Year	Small Entity?
1									
2									
3									
4									
5									
6									
7									
8									
Sub-totals ___ Columns 3 & 4					Use additional sheets for listing additional patents.				
Total Payment									
Maintenance Fee Codes: 183 (283 for small entity).....Due at 3.5 years 184 (284 for small entity).....Due at 7.5 years 185 (285 for small entity).....Due at 11.5 years 186 (286 for small entity).....Surcharge - Late payment within 6 months 187.....Surcharge after expiration									
<i>[For Office Accounting Use Only]</i>									
Respectfully submitted**:					PAYOR'S NUMBER (if assigned) _____				
(Payor's name):					FEE ADDRESS _____				
(Payor's Signature):					_____				
<i>Note: All correspondence will be forwarded to the "Fee Address" or to the "Correspondence Address" if no "Fee Address" has been provided. 37 CFR 1.363.</i>									
**WHERE MAINTENANCE FEE PAYMENTS ARE TO BE MADE BY AUTHORIZATION TO CHARGE A DEPOSIT ACCOUNT, PAYOR'S NAME AND SIGNATURE SHOULD BOTH APPEAR IN THE BOTTOM LEFT CORNER OF THIS FORM.									

PTO/SB/ 45 (10-92)

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE <

Approved for use through 7/31/99. OMB 0651-0016

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Address to:
Assistant Commissioner for Patents
Box M. Fee
Washington, D.C. 20231

Please recognize as the "Fee Address" under the provisions of 37 CFR 1.363 the following address:

☐ Customer Number →

OR

☐ Request for Customer Number (PTO/SB/125) attached hereto

Place Customer Number Bar Code Label here

PATENT NUMBER (if known)	APPLICATION NUMBER

Burden Hour Statement: This form is estimated to take 0.08 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231. <**

MANUAL OF PATENT EXAMINING PROCEDURE