

108TH CONGRESS  
1ST SESSION

# S. 1760

To amend title 35, United States Code, with respect to patent fees, and for other purposes.

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IN THE SENATE OF THE UNITED STATES

OCTOBER 20, 2003

Mr. COLEMAN introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, with respect to patent fees, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “United States Patent  
5 and Trademark Fee Modernization Act of 2003”.

6 **SEC. 2. FEES FOR PATENT SERVICES.**

7 (a) GENERAL PATENT FEES.—Section 41(a) of title  
8 35, United States Code, is amended to read as follows:

9 “(a) GENERAL FEES.—The Director shall charge the  
10 following fees:

1 “(1) FILING AND BASIC NATIONAL FEES.—

2 “(A) On filing each application for an  
3 original patent, except for design, plant, or pro-  
4 visional applications, \$300.

5 “(B) On filing each application for an  
6 original design patent, \$200.

7 “(C) On filing each application for an  
8 original plant patent, \$200.

9 “(D) On filing each provisional application  
10 for an original patent, \$200.

11 “(E) On filing each application for the re-  
12 issue of a patent, \$300.

13 “(F) The basic national fee for each inter-  
14 national application filed under the treaty de-  
15 fined in section 351(a) of this title entering the  
16 national stage under section 371 of this title,  
17 \$300.

18 “(G) In addition, excluding any sequence  
19 listing or computer program listing filed in an  
20 electronic medium as prescribed by the Direc-  
21 tor, for any application the specification and  
22 drawings of which exceed 100 sheets of paper  
23 (or equivalent as prescribed by the Director if  
24 filed in an electronic medium), \$250 for each  
25 additional 50 sheets of paper (or equivalent as

1           prescribed by the Director if filed in an elec-  
2           tronic medium) or fraction thereof.

3           “(2) EXCESS CLAIMS FEES.—In addition to the  
4           fee specified in paragraph (1)—

5                   “(A) on filing or on presentation at any  
6                   other time, \$200 for each claim in independent  
7                   form in excess of 3;

8                   “(B) on filing or on presentation at any  
9                   other time, \$50 for each claim (whether de-  
10                  pendent or independent) in excess of 20; and

11                  “(C) for each application containing a mul-  
12                  tiple dependent claim, \$360.

13           For the purpose of computing fees under this para-  
14           graph, a multiple dependent claim referred to in sec-  
15           tion 112 of this title or any claim depending there-  
16           from shall be considered as separate dependent  
17           claims in accordance with the number of claims to  
18           which reference is made. The Director may by regu-  
19           lation provide for a refund of any part of the fee  
20           specified in this paragraph for any claim that is can-  
21           celed before an examination on the merits, as pre-  
22           scribed by the Director, has been made of the appli-  
23           cation under section 131 of this title. Errors in pay-  
24           ment of the additional fees under this paragraph

1 may be rectified in accordance with regulations pre-  
2 scribed by the Director.

3 “(3) EXAMINATION FEES.—

4 “(A) For examination of each application  
5 for an original patent, except for design, plant,  
6 provisional, or international applications, \$200.

7 “(B) For examination of each application  
8 for an original design patent, \$130.

9 “(C) For examination of each application  
10 for an original plant patent, \$160.

11 “(D) For examination of the national stage  
12 of each international application, \$200.

13 “(E) For examination of each application  
14 for the reissue of a patent, \$600.

15 The provisions of section 111(a)(3) of this title re-  
16 lating to the payment of the fee for filing the appli-  
17 cation shall apply to the payment of the fee specified  
18 in this paragraph with respect to an application filed  
19 under section 111(a) of this title. The provisions of  
20 section 371(d) of this title relating to the payment  
21 of the national fee shall apply to the payment of the  
22 fee specified in this paragraph with respect to an  
23 international application. The Director may by regu-  
24 lation provide for a refund of any part of the fee  
25 specified in this paragraph for any applicant who

1 files a written declaration of express abandonment  
2 as prescribed by the Director before an examination  
3 has been made of the application under section 131  
4 of this title, and for any applicant who provides a  
5 search report that meets the conditions prescribed  
6 by the Director.

7 “(4) ISSUE FEES.—

8 “(A) For issuing each original patent, ex-  
9 cept for design or plant patents, \$1,400.

10 “(B) For issuing each original design pat-  
11 ent, \$800.

12 “(C) For issuing each original plant pat-  
13 ent, \$1,100.

14 “(D) For issuing each reissue patent,  
15 \$1,400.

16 “(5) DISCLAIMER FEE.—On filing each dis-  
17 claimer, \$130.

18 “(6) APPEAL FEES.—

19 “(A) On filing an appeal from the exam-  
20 iner to the Board of Patent Appeals and Inter-  
21 ferences, \$500.

22 “(B) In addition, on filing a brief in sup-  
23 port of the appeal, \$500, and on requesting an  
24 oral hearing in the appeal before the Board of  
25 Patent Appeals and Interferences, \$1,000.

1           “(7) REVIVAL FEES.—On filing each petition  
2 for the revival of an unintentionally abandoned ap-  
3 plication for a patent, for the unintentionally delayed  
4 payment of the fee for issuing each patent, or for an  
5 unintentionally delayed response by the patent owner  
6 in any reexamination proceeding, \$1,500, unless the  
7 petition is filed under section 133 or 151 of this  
8 title, in which case the fee shall be \$500.

9           “(8) EXTENSION FEES.—For petitions for 1-  
10 month extensions of time to take actions required by  
11 the Director in an application—

12                   “(A) on filing a first petition, \$120;

13                   “(B) on filing a second petition, \$330; and

14                   “(C) on filing a third or subsequent peti-  
15 tion, \$570.”.

16           (b) PATENT MAINTENANCE FEES.—Section 41(b) of  
17 title 35, United States Code, is amended to read as fol-  
18 lows:

19           “(b) MAINTENANCE FEES.—The Director shall  
20 charge the following fees for maintaining in force all pat-  
21 ents based on applications filed on or after December 12,  
22 1980:

23                   “(1) 3 years and 6 months after grant, \$900.

24                   “(2) 7 years and 6 months after grant, \$2,300.

1           “(3) 11 years and 6 months after grant,  
2       \$3,800.

3 Unless payment of the applicable maintenance fee is re-  
4 ceived in the United States Patent and Trademark Office  
5 on or before the date the fee is due or within a grace pe-  
6 riod of 6 months thereafter, the patent will expire as of  
7 the end of such grace period. The Director may require  
8 the payment of a surcharge as a condition of accepting  
9 within such 6-month grace period the payment of an appli-  
10 cable maintenance fee. No fee may be established for  
11 maintaining a design or plant patent in force.”.

12       (c) PATENT SEARCH FEES.—Section 41(d) of title  
13 35, United States Code, is amended to read as follows:

14       “(d) PATENT SEARCH AND OTHER FEES.—

15           “(1) PATENT SEARCH FEES.—(A) The Director  
16 shall charge a fee for the search of each application  
17 for a patent, except for provisional applications. The  
18 Director shall establish the fees charged under this  
19 paragraph to recover an amount not to exceed the  
20 estimated average cost to the Office of searching ap-  
21 plications for patent either by acquiring a search re-  
22 port from a qualified search authority, or by causing  
23 a search by Office personnel to be made, of each ap-  
24 plication for patent.

1           “(B) For purposes of determining the fees to be  
2           established under this paragraph, the cost to the Of-  
3           fice of causing a search of an application to be made  
4           by Office personnel shall be deemed to be—

5                   “(i) \$500 for each application for an origi-  
6                   nal patent, except for design, plant, provisional,  
7                   or international applications;

8                   “(ii) \$100 for each application for an origi-  
9                   nal design patent;

10                  “(iii) \$300 for each application for an  
11                  original plant patent;

12                  “(iv) \$500 for the national stage of each  
13                  international application; and

14                  “(v) \$500 for each application for the re-  
15                  issue of a patent.

16           “(C) The provisions of section 111(a)(3) of this  
17           title relating to the payment of the fee for filing the  
18           application shall apply to the payment of the fee  
19           specified in this paragraph with respect to an appli-  
20           cation filed under section 111(a) of this title. The  
21           provisions of section 371(d) of this title relating to  
22           the payment of the national fee shall apply to the  
23           payment of the fee specified in this paragraph with  
24           respect to an international application.

1           “(D) The Director may by regulation provide  
2           for a refund of any part of the fee specified in this  
3           paragraph for any applicant who files a written dec-  
4           laration of express abandonment as prescribed by  
5           the Director before an examination has been made  
6           of the application under section 131 of this title, and  
7           for any applicant who provides a search report that  
8           meets the conditions prescribed by the Director.

9           “(E) For purposes of subparagraph (A), a  
10          ‘qualified search authority’ may not include a com-  
11          mercial entity unless—

12                 “(i) the Director conducts a pilot program  
13                 of limited scope, conducted over a period of not  
14                 more than 18 months, which demonstrates that  
15                 searches by commercial entities of the available  
16                 prior art relating to the subject matter of inven-  
17                 tions claimed in patent applications—

18                         “(I) are accurate; and

19                         “(II) meet or exceed the standards of  
20                         searches conducted by and used by the  
21                         Patent and Trademark Office during the  
22                         patent examination process;

23                 “(ii) the Director submits a report on the  
24                 results of the pilot program to the Congress

1 and the Patent Public Advisory Committee that  
2 includes—

3 “(I) a description of the scope and du-  
4 ration of the pilot program;

5 “(II) the identity of each commercial  
6 entity participating in the pilot program;

7 “(III) an explanation of the method-  
8 ology used to evaluate the accuracy and  
9 quality of the search reports; and

10 “(IV) an assessment of the effects  
11 that the pilot program, as compared to  
12 searches conducted by the Patent and  
13 Trademark Office, had and will have on—

14 “(aa) patentability determina-  
15 tions;

16 “(bb) productivity of the Patent  
17 and Trademark Office;

18 “(cc) costs to the Patent and  
19 Trademark Office;

20 “(dd) costs to patent applicants;  
21 and

22 “(ee) other relevant factors;

23 “(iii) the Patent Public Advisory Com-  
24 mittee reviews and analyzes the Director’s re-  
25 port under clause (ii) and the results of the

1 pilot program and submits a separate report on  
2 its analysis to the Director and the Congress  
3 that includes—

4 “(I) an independent evaluation of the  
5 effects that the pilot program, as compared  
6 to searches conducted by the Patent and  
7 Trademark Office, had and will have on  
8 the factors set forth in clause (ii)(IV); and

9 “(II) an analysis of the reasonable-  
10 ness, appropriateness, and effectiveness of  
11 the methods used in the pilot program to  
12 make the evaluations required under clause  
13 (ii)(IV); and

14 “(iv) the Congress does not, during the 1-  
15 year period beginning on the date on which the  
16 Patent Public Advisory Committee submits its  
17 report to the Congress under clause (iii), enact  
18 a law prohibiting searches by commercial enti-  
19 ties of the available prior art relating to the  
20 subject matter of inventions claimed in patent  
21 applications.

22 “(2) OTHER FEES.—The Director shall estab-  
23 lish fees for all other processing, services, or mate-  
24 rials relating to patents not specified in this section  
25 to recover the estimated average cost to the Office

1 of such processing, services, or materials, except that  
2 the Director shall charge the following fees for the  
3 following services:

4 “(A) For recording a document affecting  
5 title, \$40 per property.

6 “(B) For each photocopy, \$.25 per page.

7 “(C) For each black and white copy of a  
8 patent, \$3.

9 The yearly fee for providing a library specified in  
10 section 12 of this title with uncertified printed copies  
11 of the specifications and drawings for all patents in  
12 that year shall be \$50.”.

13 (d) ADJUSTMENTS.—Section 41(f) of title 35, United  
14 States Code, shall apply to the fees established under the  
15 amendments made by this section, beginning in fiscal year  
16 2005.

17 (e) CONFORMING AMENDMENTS.—

18 (1) Section 41 of title 35, United States Code,  
19 is amended—

20 (A) in subsection (c), by striking “(c)(1)”  
21 and inserting “(c) LATE PAYMENT OF FEES.—  
22 (1)”;

23 (B) in subsection (e), by striking “(e)” and  
24 inserting “(e) WAIVERS OF CERTAIN FEES.—”;

1 (C) in subsection (f), by striking “(f)” and  
2 inserting “(f) ADJUSTMENTS IN FEES.—”;

3 (D) in subsection (g), by striking “(g)”  
4 and inserting “(g) EFFECTIVE DATES OF  
5 FEES.—”;

6 (E) in subsection (h), by striking “(h)(1)”  
7 and inserting “(h) REDUCTIONS IN FEES FOR  
8 CERTAIN ENTITIES.—(1)”; and

9 (F) in subsection (i), by striking “(i)(1)”  
10 and inserting “(i) SEARCH SYSTEMS.—(1)”.

11 (2) Section 119(e)(2) of title 35, United States  
12 Code, is amended by striking “subparagraph (A) or  
13 (C) of”.

14 **SEC. 3. ADJUSTMENT OF TRADEMARK FEES.**

15 (a) **FEE FOR FILING APPLICATION.**—The fee under  
16 section 31(a) of the Trademark Act of 1946 (15 U.S.C.  
17 1113(a)) for filing an electronic application for the reg-  
18 istration of a trademark shall be \$325. If the trademark  
19 application is filed on paper, the fee shall be \$375. The  
20 Director may reduce the fee for filing an electronic appli-  
21 cation for the registration of a trademark to \$275 for any  
22 applicant who prosecutes the application through elec-  
23 tronic means under such conditions as may be prescribed  
24 by the Director. Beginning in fiscal year 2005, the provi-  
25 sions of the second and third sentences of section 31(a)

1 of the Trademark Act of 1946 shall apply to the fees es-  
2 tablished under this section.

3 (b) REFERENCE TO TRADEMARK ACT OF 1946.—For  
4 purposes of this section, the “Trademark Act of 1946”  
5 refers to the Act entitled “An Act to provide for the reg-  
6 istration and protection of trademarks used in commerce,  
7 to carry out the provisions of certain international conven-  
8 tions, and for other purposes.”, approved July 5, 1946 (15  
9 U.S.C. 1051 et seq.).

10 **SEC. 4. CORRECTION OF ERRONEOUS NAMING OF OFFICER.**

11 (a) CORRECTION.—Section 13203(a) of the 21st Cen-  
12 tury Department of Justice Appropriations Authorization  
13 Act (Public Law 107–273; 116 Stat. 1902) is amended—

14 (1) in the subsection heading, by striking  
15 “COMMISSIONER” and inserting “DIRECTOR”; and

16 (2) in paragraphs (1) and (2), by striking  
17 “Commissioner” each place it appears and inserting  
18 “Director”.

19 (b) EFFECTIVE DATE.—The amendments made by  
20 subsection (a) shall be effective as of the date of the enact-  
21 ment of Public Law 107–273.

22 **SEC. 5. PATENT AND TRADEMARK OFFICE FUNDING.**

23 Section 42 of title 35, United States Code, is amend-  
24 ed—

1 (1) in subsection (b), by striking “Appropriation”; and  
2

3 (2) in subsection (c), in the first sentence—

4 (A) by striking “To the extent” and all  
5 that follows through “fees” and inserting  
6 “Fees”; and

7 (B) by striking “shall be collected by and  
8 shall be available to the Director” and inserting  
9 “shall be collected by the Director and shall be  
10 available until expended”.

11 **SEC. 6. EFFECTIVE DATE, APPLICABILITY, AND TRANSI-**  
12 **TIONAL PROVISION.**

13 (a) **EFFECTIVE DATE.**—Except as provided in sec-  
14 tion 4 and this section, this Act and the amendments  
15 made by this Act shall take effect on October 1, 2003,  
16 or the date of the enactment of this Act, whichever is later.

17 (b) **APPLICABILITY.**—

18 (1)(A) Except as provided in subparagraphs  
19 (B) and (C), the amendments made by section 2  
20 shall apply to all patents, whenever granted, and to  
21 all patent applications pending on or filed after the  
22 effective date set forth in subsection (a) of this sec-  
23 tion.

24 (B)(i) Except as provided in clause (ii), sections  
25 41(a)(1), 41(a)(3), and 41(d)(1) of title 35, United

1 States Code, as amended by this Act, shall apply  
2 only to—

3 (I) applications for patents filed under sec-  
4 tion 111(a) of title 35, United States Code, on  
5 or after the effective date set forth in sub-  
6 section (a) of this section, and

7 (II) international applications entering the  
8 national stage under section 371 of title 35,  
9 United States Code, for which the basic na-  
10 tional fee specified in section 41 of title 35,  
11 United States Code, was not paid before the ef-  
12 fective date set forth in subsection (a) of this  
13 section.

14 (ii) Section 41(a)(1)(D) of title 35, United  
15 States Code as amended by this Act, shall apply only  
16 to applications for patent filed under section 111(b)  
17 of title 35, United States Code, before, on, or after  
18 the effective date set forth in subsection (a) of this  
19 section in which the filing fee specified in section 41  
20 of title 35, United States Code, was not paid before  
21 the effective date set forth in subsection (a) of this  
22 section.

23 (C) Section 41(a)(2) of title 35, United States  
24 Code, as amended by this Act, shall apply only to  
25 the extent that the number of excess claims, after

1 giving effect to any cancellation of claims, is in ex-  
2 cess of the number of claims for which the excess  
3 claims fee specified in section 41 of title 35, United  
4 States Code, was paid before the effective date set  
5 forth in subsection (a) of this section.

6 (2) The amendments made by section 3 shall  
7 apply to all applications for the registration of a  
8 trademark filed or amended on or after the effective  
9 date set forth in subsection (a) of this section.

10 (c) TRANSITIONAL PROVISIONS.—

11 (1) SEARCH FEES.—During the period begin-  
12 ning on the effective date set forth in subsection (a)  
13 of this section and ending on the date on which the  
14 Director establishes search fees under the authority  
15 provided in section 41(d)(1) of title 35, United  
16 States Code, the Director shall charge—

17 (A) for the search of each application for  
18 an original patent, except for design, plant, pro-  
19 visional, or international application, \$500;

20 (B) for the search of each application for  
21 an original design patent, \$100;

22 (C) for the search of each application for  
23 an original plant patent, \$300;

24 (D) for the search of the national stage of  
25 each international application, \$500; and

1 (E) for the search of each application for  
2 the reissue of a patent, \$500.

3 (2) TIMING OF FEES.—The provisions of sec-  
4 tion 111(a)(3) of title 35, United States Code, relat-  
5 ing to the payment of the fee for filing the applica-  
6 tion shall apply to the payment of the fee specified  
7 in paragraph (1) with respect to an application filed  
8 under section 111(a) of title 35, United States Code.  
9 The provisions of section 371(d) of title 35, United  
10 States Code, relating to the payment of the national  
11 fee shall apply to the payment of the fee specified  
12 in paragraph (1) with respect to an international ap-  
13 plication.

14 (3) REFUNDS.—The Director may by regula-  
15 tion provide for a refund of any part of the fee spec-  
16 ified in paragraph (1) for any applicant who files a  
17 written declaration of express abandonment as pre-  
18 scribed by the Director before an examination has  
19 been made of the application under section 131 of  
20 title 35, United States Code, and for any applicant  
21 who provides a search report that meets the condi-  
22 tions prescribed by the Director.

23 (d) EXISTING APPROPRIATIONS.—The provisions of  
24 any appropriation Act that make amounts available pursu-  
25 ant to section 42(c) of title 35, United States Code, and

1 are in effect on the effective date set forth in subsection  
2 (a) shall cease to be effective on that effective date.

3 **SEC. 7. DEFINITION.**

4 In this Act, the term “Director” means the Under  
5 Secretary of Commerce for Intellectual Property and Di-  
6 rector of the United States Patent and Trademark Office.

7 **SEC. 8. CLERICAL AMENDMENT.**

8 Subsection (c) of section 311 of title 35, United  
9 States Code, is amended by aligning the text with the text  
10 of subsection (a) of such section.

○