

USPTO Introduces Program that Allows Deferral of Patent Application Filing Fees

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Recently, the *U.S. Patent and Trademark Office* (“USPTO”) introduced a pilot program that allows applicants the ability to defer some of the fees associated with having a nonprovisional patent application that claims the benefit of an earlier provisional patent application examined at the USPTO. As stated by the USPTO, this program is intended to benefit applicants by providing additional time to determine if patent protection should be sought and to permit applicants to focus efforts on commercializing the invention. The program is intended to benefit the USPTO by removing from the USPTO’s workload applications that applicants later decide to abandon.

The pilot program, titled, *Pilot Program for Extended Time Period to Reply to a Notice to File Missing Parts of Nonprovisional Application*, gives an applicant up to 12 months from filing an application to decide whether to pay the search fee, the examination fee, any excess claim fees, and the surcharge for the late submission of these fees. Therefore, an applicant could use the 12 month time period to decide whether to pay the search and examination fees (\$760 total) plus any excess claim fees and the \$130 surcharge for late submission of these fees and to further assess the value of patent protection.^[1] The applicant would still need to submit the basic filing fee (\$330) on filing the application, along with an executed oath or declaration from the inventors. If an executed oath or declaration is not available at filing, the applicant will receive another missing parts notice and have two months (extendable) to reply with an executed oath or declaration.

In order to participate in the pilot program the applicant must satisfy the following requirements:

1. the applicant must submit a request to participate in this program using USPTO Form PTO/SB/421;
2. the application must be an original nonprovisional utility or plant application;
3. the nonprovisional application must directly claim the benefit of a prior provisional application filed within the previous twelve months; and
4. the applicant must not have filed a nonpublication request.

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Therefore, an applicant must use the delay provided by a provisional application before using the additional delay provided by this pilot program. Also, this program is only available for original applications and not continuation or divisional applications. Applicants should also keep in mind that this pilot program does not extend the 12 month period for filing a nonprovisional application claiming priority to a provisional application. Rather, an applicant's disclosure and claims should be complete upon filing the nonprovisional application. However, should the applicant decide to abandon the application during the 12 month period provided by the pilot program, the applicant does not need to pay the search fee, examination fee, and missing parts surcharge (\$870 total), plus any excess claim fees.

The USPTO states that if an applicant chooses to pay the required fees within the 12 month period provided by this program, the application will then go into the examination queue based on the actual filing date of the application. Alternatively stated, the application will not be examined until the fees are paid, but the application will be chosen for examination based on its actual filing date. However, the delay in paying the required fees past three months will reduce the amount of patent term adjustment the application may receive based on USPTO delays.

[1] All fee amounts are the regular or large entity fee amounts. Fee amounts for a small entity would be reduced by one-half.

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