



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2018-0031]

RIN 0651-AD31

Setting and Adjusting Patent Fees During Fiscal Year 2020

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule; delay of effective date and final rule.

SUMMARY: The United States Patent and Trademark Office (USPTO) published a final rule in the Federal Register on August 3, 2020, that includes a fee for patent applications that are not filed in the DOCX format, except for design, plant, or provisional applications. The effective date of this new fee was most recently delayed in a final rule published in the Federal Register on March 27, 2023, and was scheduled to become effective on June 30, 2023. Through this final rule, the USPTO is delaying the effective date of this fee until January 17, 2024.

DATES: This final rule is effective on January 17, 2024. As of [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER], the effective date of amendatory instruction 2.i. (affecting 37 CFR 1.16(u)), published at 85 FR 46932 on August 3, 2020; and delayed at 86 FR 66192 on November 22, 2021, and at 87 FR 80073 on December 29, 2022; and as further amended at 88 FR 17147 on March 22, 2023; and thereafter delayed at 88 FR 18052 on March 27, 2023, is further delayed until January 17, 2024. The change to 37 CFR 1.16(u) in amendatory instruction 2.i., published at 85 FR 46932 on August 3, 2020, is applicable only to nonprovisional utility applications filed under 35 U.S.C. 111 for an original patent on or after January 17, 2024.

FOR FURTHER INFORMATION CONTACT: Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7709; or Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727. You can also send inquiries to patentpractice@uspto.gov.

SUPPLEMENTARY INFORMATION: On August 3, 2020, the USPTO published a final rule in the Federal Register that included a new fee set forth in § 1.16(u) with an effective date of January 1, 2022. See Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932. As specified in § 1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent—except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format. Therefore, the fee is due for nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are not filed in the DOCX format.

Currently, applicants may file patent applications in the DOCX format through EFS-Web and Patent Center. The USPTO plans to retire EFS-Web and therefore encourages stakeholders and applicants to review the information about Patent Center available at www.uspto.gov/PatentCenter. The USPTO continues to hold many discussions and training sessions with stakeholders to ensure a fair and reasonable transition to the DOCX format.

The USPTO is delaying the effective date of the fee set forth in § 1.16(u) until January 17, 2024. This further delay will give the USPTO an opportunity, through a separate Federal Register Notice, to invite and consider public comments on a proposed information collection pertaining to the impact of the § 1.16(u) fee on the filing of nonprovisional utility applications under 35 U.S.C. 111, including continuing applications. As required by the Paperwork Reduction Act of 1995 (PRA), the USPTO will submit the proposed information collection together with a summary of any received

comments to the Office of Management and Budget for review under the PRA. Federal Register Notices published by the USPTO pertaining to the PRA are available at www.uspto.gov/learning-and-resources/federal-register-notices/federal-register-notices-2023. The USPTO expects that this delay will afford sufficient time to complete the PRA clearance process.

This delay will also provide applicants more time to adjust to filing patent applications in the DOCX format. Applicants are encouraged to begin filing patent applications in the DOCX format before the new effective date of the fee. The USPTO also reminds applicants that they can file test submissions through the Patent Center training mode to practice filing in DOCX. Applicants who have not yet taken advantage of the DOCX training sessions the USPTO hosts are encouraged to do so. Information on filing application documents in DOCX and a link to the DOCX training sessions are available at www.uspto.gov/patents/docx.

Rulemaking Requirements

A. Administrative Procedure Act: This final rule revises the effective date of a final rule published on August 3, 2020, implementing a non-DOCX filing surcharge fee, and is a rule of agency practice and procedure pursuant to 5 U.S.C. 553(b)(A). See *JEM Broad. Co. v. F.C.C.*, 22 F.3d 32 (D.C. Cir. 1994) (“[T]he ‘critical feature’ of the procedural exception [in 5 U.S.C. 553(b)(A)] ‘is that it covers agency actions that do not themselves alter the rights or interests of parties, although [they] may alter the manner in which the parties present themselves or their viewpoints to the agency.’” (quoting *Batterton v. Marshall*, 648 F.2d 694, 707 (D.C. Cir. 1980))); see also *Bachow Commc’ns Inc. v. F.C.C.*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims). Prior notice and an

opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice-and-comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))).

Moreover, the Director of the USPTO, pursuant to the authority at 5 U.S.C. 553(b)(B), finds good cause to adopt the change to the effective date of § 1.16(u) in this final rule without prior notice and an opportunity for public comment, as such procedures would be impracticable and contrary to the public interest. The change to the effective date will provide the public an opportunity to more fully comprehend the nature of, and prepare to comply with, the DOCX format before the new fee is effective, as well as provide the USPTO sufficient time to complete the PRA clearance process for the new fee. Delay of this provision to provide prior notice-and-comment procedures is also impracticable because it would allow § 1.16(u) to go into effect before the public is ready for the DOCX format. The Director finds good cause under 5 U.S.C. 553(d)(3) to waive the 30-day delay in effectiveness of this rule. Immediate implementation of the delay in the effective date of the fee is in the public interest because it will provide the public an opportunity to more fully comprehend the nature of, and prepare to comply with, the DOCX format before the new fee in § 1.16(u) is effective, as well as provide the USPTO sufficient time to complete the PRA clearance process for the new fee.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Paperwork Reduction Act: The PRA (44 U.S.C. 3507(d)) requires that the USPTO consider the impact of paperwork and other information collection burdens imposed on the public. The USPTO has determined that there are no new requirements for information collection associated with this final rule.

List of Subjects for 37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons stated in the preamble, the USPTO amends 37 CFR part 1 as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

§ 1.16 [Amended]

2. In § 1.16, amend paragraph (u) introductory text by removing “June 30, 2023” and adding “January 17, 2024” in its place.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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