

HR 1561

United States Patent and Trademark Fee Modernization Act of 2004

Congress: 108 (2003–2005, Ended)

Chamber: House

Policy Area: Commerce

Introduced: Apr 2, 2003

Current Status: Placed on Senate Legislative Calendar under General Orders. Calendar No. 487.

Latest Action: Placed on Senate Legislative Calendar under General Orders. Calendar No. 487. (Apr 29, 2004)

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Sponsor

Name: Rep. Smith, Lamar [R-TX-21]

Party: Republican • State: TX • Chamber: House

Cosponsors (1 total)

Cosponsor	Party / State	Role	Date Joined
Rep. Berman, Howard L. [D-CA-28]	D · CA		Apr 2, 2003

Committee Activity

Committee	Chamber	Activity	Date
Judiciary Committee	House	Reported by	May 22, 2003
Judiciary Committee	Senate	Reported By	Apr 29, 2004

Subjects & Policy Tags

Policy Area:

Commerce

Related Bills

Bill	Relationship	Last Action
108 HRES 547	Procedurally related	Mar 3, 2004: Motion to reconsider laid on the table Agreed to without objection.

(This measure has not been amended since it was passed by the House on March 3, 2004. The summary of that version is repeated here.)

United States Patent and Trademark Fee Modernization Act of 2004 - (Sec. 2) Amends Federal patent law to reduce the filing fee for an application for: (1) an original patent from \$690 to \$300; (2) an original design patent from \$310 to \$200; (3) a plant patent from \$480 to \$200; and (4) reissue of a patent from \$690 to \$300. Changes from \$670, \$690, \$970, and \$96 (in different specified circumstances) to \$300 the basic national fee for each international application filed under the Patent Cooperation Treaty done at Washington, on June 19, 1970, entering the national stage.

Increases from \$150 to \$200 the patent filing fee for a provisional application for an original patent.

Sets additional fees for any application whose specification and drawings exceed 100 sheets of paper (or equivalent, if filed in an electronic medium), excluding any sequence listing or computer program listing filed in an electronic medium, at \$250 for each additional 50 sheets of paper (or equivalent, if filed in an electronic medium) or fraction thereof.

Increases excess claims fees for: (1) each claim in independent form in excess of three from \$78 to \$200; and (2) each claim (whether dependent or independent) in excess of 20 from \$18 to \$50. Repeals the \$260 excess claim fee for each national stage of an international application containing a multiple dependent claim. Sets a new \$360 excess claim fee for each application containing a multiple dependent claim (regardless of whether it is a national or international application).

Prescribes examination application fees for: (1) an original patent at \$200; (2) an original design patent at \$130; (3) an original plant patent at \$160; (4) the national stage of each international application at \$200; and (5) reissue of a patent at \$600.

Increases fees: (1) for issuing each original patent from \$1,210 to \$1,400, original design patent from \$430 to \$800, original plant patent from \$580 to \$1,100, and each reissue patent from \$1,210 to \$1,400; (2) for filing each disclaimer from \$110 to \$130, for filing an appeal from the examiner to the Board of Patent Appeals and Interferences from \$300 to \$500, for filing a brief in support of the appeal from \$300 to \$500, and for requesting an oral hearing in the appeal before the Board from \$260 to \$1,000; (4) for filing a certain revival petition of patent application from \$1,210 to \$1,500, or, in specified circumstances, from \$110 to \$500; (5) for filing petitions for one-month extensions for the first petition from \$110 to \$120, for the second petition from \$270 to \$330, and for the third or subsequent petition from \$490 to \$570; and (6) for maintaining in force certain patents three years and six months after grant from \$830 to \$900, seven years and six months after grant from \$1,900 to \$2,300, and for eleven years and six months after grant from \$2,910 to \$3,800.

Requires the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office (Director) to: (1) charge a fee for the search of each patent application, except for provisional applications; and (2) establish the fees charged to recover an amount not to exceed the estimated average cost to the Patent and Trademark Office (PTO) of searching patent applications either by acquiring a search report from a qualified search authority or by causing a search by PTO personnel to be made for each patent. Provides patent search fee limits for the three-year period beginning on October 1, 2004. Prohibits the Director from: (1) increasing any such fee by more than 20 percent in each of the next three one-year periods; or (2) increasing any such fee thereafter.

Deems PTO's cost of causing such application search to be: (1) \$500 for each original patent; (2) \$100 for each original design patent; (3) \$300 for each original plant patent; (4) \$500 for the national stage of each international application; and (5) \$500 for each reissue of a patent.

Disqualifies commercial entities from being qualified search authorities unless: (1) the Director conducts a pilot program of limited scope within a 18-month period, which demonstrates that searches by commercial entities of the available prior art relating to the subject matter of inventions claimed in patent applications are accurate and meet or exceed the PTO standards used during the patent examination process; (2) the Director reports to Congress and the Patent Public Advisory Committee on the results of the pilot program; (3) the Committee reviews and analyzes the Director's report and the results of the pilot program and submits a separate report on its analysis to the Director and Congress; and (4) Congress does not, during the one-year period beginning on the submittal of such report, enact a law prohibiting searches by such commercial entities. Requires any search by a qualified search entity that is a commercial entity to be conducted in the United States by persons that: (1) if individuals, are U.S. citizens; and (2) if businesses, are organized under the laws of the United States or any State and employ U.S. citizens to perform the search. Requires searches of applications that are the subject of a secrecy order or otherwise involves classified information to be conducted only by PTO personnel. Prohibits a qualified commercial search authority from conducting a search if the entity has any financial interest in any patent or patent application filed or to be filed with the PTO.

Requires fees charged to small businesses to be reduced by 75 percent if the application is filed by electronic means as prescribed by the Director. Requires the Director to study the effect of patent fees on the ability of small business inventors to file patent applications.

(Sec. 3) Amends the Trademark Act of 1946 to prescribe a fee of \$325 for filing an electronic application for the registration of a trademark. Increases the fee to \$375 for a paper application. Authorizes the Director to reduce the fee to \$275 for any applicant who prosecutes the application through electronic means under such conditions as the Director prescribes. Authorizes the Director, beginning in FY 2005 and under certain conditions, to adjust such fees annually.

(Sec. 4) Amends the Intellectual Property and High Technology Technical Amendments Act of 2002 as enacted by the 21st Century Department of Justice Appropriations Authorization Act to replace the name of the "Deputy Commissioner" with the "Deputy Director" with respect to the officers on the Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board.

(Sec. 5) Establishes in the Treasury a Patent and Trademark Fee Reserve Fund for the deposit of excess PTO fees (fees collected in excess of the appropriated amount). Requires the Director, after determining the amount of such excess, to make repayments to persons who paid patent or trademark fees during that fiscal year.

(Sec. 6) Applies the fees set by this Act, with specified exceptions, to all patents, whenever granted, and to all patent applications pending on or filed after the effective date of this Act.

Terminates any existing PTO appropriations in effect on October 1, 2004, or the enactment of this Act, whichever is later.

Actions Timeline

- **Apr 29, 2004:** Committee on the Judiciary. Ordered to be reported without amendment favorably.
- **Apr 29, 2004:** Committee on the Judiciary. Reported by Senator Hatch without amendment. Without written report.
- **Apr 29, 2004:** Committee on the Judiciary. Reported by Senator Hatch without amendment. Without written report.
- **Apr 29, 2004:** Placed on Senate Legislative Calendar under General Orders. Calendar No. 487.
- **Mar 4, 2004:** Received in the Senate and Read twice and referred to the Committee on the Judiciary.
- **Mar 3, 2004:** Rule H. Res. 547 passed House.
- **Mar 3, 2004:** Considered under the provisions of rule H. Res. 547. (consideration: CR H790, H793-804; text of measure as reported in House: CR H799-801)
- **Mar 3, 2004:** Rule provides for consideration of H.R. 1561 with 1 hour of general debate. Previous question shall be considered as ordered without intervening motions except motion to recommit with or without instructions. It shall be in order to consider as an original bill for the purpose of amendment under the five-minute rule the amendment in the nature of a substitute recommended by the Committee on the Judiciary now printed in the bill. Measure will be considered read. Specified amendments are in order.
- **Mar 3, 2004:** House resolved itself into the Committee of the Whole House on the state of the Union pursuant to H. Res. 547 and Rule XVIII.
- **Mar 3, 2004:** The Speaker designated the Honorable Ray LaHood to act as Chairman of the Committee.
- **Mar 3, 2004:** GENERAL DEBATE - The Committee of the Whole proceeded with one hour of general debate on H.R. 1561.
- **Mar 3, 2004:** DEBATE - Pursuant to H. Res. 547 the Committee of the Whole proceeded with twenty minutes of debate on the Sensenbrenner amendment.
- **Mar 3, 2004:** The House rose from the Committee of the Whole House on the state of the Union to report H.R. 1561.
- **Mar 3, 2004:** The previous question was ordered pursuant to the rule.
- **Mar 3, 2004:** Passed/agreed to in House: On passage Passed by the Yeas and Nays: 379 - 28 (Roll no. 38).
- **Mar 3, 2004:** On passage Passed by the Yeas and Nays: 379 - 28 (Roll no. 38).
- **Mar 3, 2004:** Motion to reconsider laid on the table Agreed to without objection.
- **Mar 2, 2004:** Rules Committee Resolution H. Res. 547 Reported to House. Rule provides for consideration of H.R. 1561 with 1 hour of general debate. Previous question shall be considered as ordered without intervening motions except motion to recommit with or without instructions. It shall be in order to consider as an original bill for the purpose of amendment under the five-minute rule the amendment in the nature of a substitute recommended by the Committee on the Judiciary now printed in the bill. Measure will be considered read. Specified amendments are in order.
- **Jul 25, 2003:** Reported (Amended) by the Committee on Judiciary. H. Rept. 108-241.
- **Jul 25, 2003:** Reported (Amended) by the Committee on Judiciary. H. Rept. 108-241.
- **Jul 25, 2003:** Placed on the Union Calendar, Calendar No. 132.
- **Jul 9, 2003:** Committee Consideration and Mark-up Session Held.
- **Jul 9, 2003:** Ordered to be Reported (Amended) by Voice Vote.
- **May 22, 2003:** Subcommittee Consideration and Mark-up Session Held.
- **May 22, 2003:** Forwarded by Subcommittee to Full Committee (Amended) by Voice Vote.
- **Apr 3, 2003:** Subcommittee Hearings Held.
- **Apr 2, 2003:** Introduced in House
- **Apr 2, 2003:** Introduced in House
- **Apr 2, 2003:** Referred to the House Committee on the Judiciary.
- **Apr 2, 2003:** Referred to the Subcommittee on Courts, the Internet, and Intellectual Property.