



UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents  
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**MEMORANDUM**

DATE: January 17, 2025

TO: Patent Examining Corps

FROM: Charles Kim  
Deputy Commissioner for Patents

SUBJECT: **Revised and New Form Paragraphs in View of Setting and Adjusting Patent Fees During Fiscal Year 2025 (Final Rule)**

The USPTO published on November 20, 2024, a final rule entitled [“Setting and Adjusting Patent Fees During Fiscal Year 2025”](#) establishing the fee adjustments needed to generate sufficient revenue to recover the aggregate estimated costs of patent operations in future years. The final rule is effective on January 19, 2025. New and revised form paragraphs will be released on January 21, 2025, in Patents End-to-End Official Correspondence (PE2E-OC) to reflect the patent fee rule changes in the final rule. Tables listing the new and revised form paragraphs are attached.

Patent fee rule changes include the following:

- A continuing application fee (CAF) for presenting benefit claims in applications or patents meeting certain timing thresholds (37 CFR 1.17(w))
- The information disclosure statement (IDS) size fee (37 CFR 1.17(v)) and size fee assertion (37 CFR 1.98(a)(4))
- A tiered petition fee for suspension of action under 37 CFR 1.103(a) (37 CFR 1.17(g)(2)) creating a higher fee for second and subsequent requests for suspension
- Creating separate extension of time fees pursuant to 37 CFR 1.136(a) for provisional applications (37 CFR 1.17(u))
- The tiered petition fee for an unintentional delay (37 CFR 1.17(m)(1)-(3)) creating a higher fee for petitions filed more than two years after the date when the required action was due

Examiners should continue to use the most updated form paragraph available to provide correct information to applicants. For example, when indicating whether an IDS is compliant under amended 37 CFR 1.97(a) and 1.98(a), examiners should use new form paragraph 6.49.11 or 6.49.12 when the IDS lacks the required size assertion and/or appropriate size fee set forth in new rule 37 CFR 1.17(v). New form paragraph 2.14 should be used to indicate when a benefit claim presented in an application was not entered because an appropriate CAF under 37 CFR

1.17(w) was required by 37 CFR 1.78(d)(3) but not paid. In addition, examiners should use the latest versions of form paragraphs 7.39 and 7.40, which appear in many final Office actions. An updated listing of [consolidated rules](#) that includes the patent fee rule changes will be posted after January 19, 2025, the effective date of the rule changes.

These revisions to the form paragraphs supersede the content in the Ninth Edition, Revision 01.2024, of the Manual of Patent Examining Procedure (MPEP). The MPEP will be updated in due course to include the new and revised form paragraphs.

<b>Table of New Form Paragraphs</b>	
Form Paragraph No.	Form Paragraph Title
2.14	Continuing Application Fee, 35 U.S.C. 120, 121, 365(c), or 386(c) Benefit Claim
6.49.11	Information Disclosure Statement Not Considered, No Size Fee Assertion
6.49.12	Information Disclosure Statement Not Considered, No Size Fee

<b>Table of Revised Form Paragraphs</b>		
Form Paragraph No.	Form Paragraph Title	Summary of Changes
2.01	Possible Status as Divisional	Added CAF warning language
2.05	Possible Status as Continuation	Added CAF warning language
2.06	Possible Status as Continuation-in-Part	Added CAF warning language
2.09	Heading for Conditions for Benefit Claims Under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c)	Added a reference to new CAF form paragraph in examiner note
2.11.01	Application Must Be Filed Within 12 Months From the Provisional Application Unless Petition Granted	<ol style="list-style-type: none"> <li>1. Changed citation of 1.17(m)</li> <li>2. Added CAF warning language</li> </ol>
2.15	Reference to Prior Application, 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) Benefit	<ol style="list-style-type: none"> <li>1. Changed citation of 1.17(m)</li> <li>2. Added CAF warning language</li> </ol>
2.21.01	35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) Foreign Priority Claim is Untimely	Changed citation of 1.17(m)

<b>Table of Revised Form Paragraphs</b>		
Form Paragraph No.	Form Paragraph Title	Summary of Changes
2.22	Certified Copy Filed, But Proper Claim Not Made	Added citation to 1.17(m)
2.23	Foreign Filing More Than 12 Months Earlier, No Petition to Restore Priority Granted	Changed citation of 1.17(m)
2.39	35 U.S.C. 119(e), 120, 121, or 365(c), or 386(c) Benefit Claim is Untimely	1. Changed citation of 1.17(m) 2. Added CAF warning language
6.49.01	Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Timing Statement	Added a specified “Timing” statement
6.49.02	Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Timing Fee	Added a specified “Timing” fee
6.49.03	Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Timing Statement	Added a specified “Timing” statement
6.49.05	Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Timing Fee	Added a specified “Timing” fee
6.55	References Not Considered in 35 U.S.C. 371 Application Based Upon Search Report	Modified language related to IDS practice
7.39	Action Is Final	Added a specified nonprovisional EOT
7.40	Action Is Final, Necessitated by Amendment	Added a specified nonprovisional EOT

<b>Table of Revised Form Paragraphs</b>		
Form Paragraph No.	Form Paragraph Title	Summary of Changes
7.40.01	Action Is Final, Necessitated by IDS With Timing Fee	<ol style="list-style-type: none"> <li>1. Added a specified nonprovisional EOT</li> <li>2. Added a specified “Timing” fee</li> </ol>
7.40.02.aia	Action Is Final, Necessitated by Invoking the Joint Research Agreement Prior Art Exception Under 35 U.S.C. 102(b)(2)(C)	<ol style="list-style-type: none"> <li>1. Added a specified nonprovisional EOT</li> <li>2. Added a specified “Timing” fee in examiner note</li> </ol>
7.40.02.fti	Action Is Final, Necessitated by Invoking the Joint Research Agreement Prior Art Disqualification Under Pre-AIA 35 U.S.C. 103(c)	<ol style="list-style-type: none"> <li>1. Added a specified nonprovisional EOT</li> <li>2. Added a specified “Timing” fee in examiner note</li> </ol>
7.41	Action Is Final, First Action	Added a specified nonprovisional EOT
7.41.03	Action Is Final, First Action Following Submission Under 37 CFR 1.53(d), Continued Prosecution Application (CPA) in a Design Application	Added a specified nonprovisional EOT
7.42.03.fti	Action Is Final, First Action Following Submission Under 37 CFR 1.129(a) Filed Prior to June 8, 2005	Added a specified nonprovisional EOT
7.42.031.fti	Action Is Final, Action Following Submission Under 37 CFR 1.129(a) Filed On or After June 8, 2005	<ol style="list-style-type: none"> <li>1. Added a specified nonprovisional EOT</li> <li>2. Added a specified “Timing” fee</li> </ol>
7.42.09	Action Is Final, First Action Following Request for Continued Examination under 37 CFR 1.114	Added a specified nonprovisional EOT
7.54	Suspension of Action, Applicant’s Request	Added a specified “further” suspension in view of 17(g)(2)(ii)
7.91	Reply Is Not Fully Responsive, Extension of Time Suggested	Added a specified nonprovisional EOT

<b>Table of Revised Form Paragraphs</b>		
<b>Form Paragraph No.</b>	<b>Form Paragraph Title</b>	<b>Summary of Changes</b>
7.98.01	Reply Is Late, Extension of Time Suggested, Pro Se	Replaced attachment with website
7.98.02	Reply Is Late, Petition To Revive Suggested, Pro Se	1. Changed citation of 1.17(m) 2. Added link to current fees website
7.123	Waiver of Timing Fee and Statement Requirements for Certain Information Disclosures	Added a specified “Timing” fee
7.204	Petition Under 37 CFR 1.59(b) To Expunge Information: Decision Held in Abeyance	Changed citation of 1.17(g)
7.205	Petition Under 37 CFR 1.59(b) To Expunge Information Granted	Changed citation of 1.17(g)
7.207	Petition To Expunge, Conclusion, Lacks Fee	Changed citation of 1.17(g)
10.20	Petition or Request Dismissed, Proper Fee Not Submitted	Changed citation of 1.17(g)
13.02.02	Extension of Time and Examiner’s Amendment Authorized	Added examiner note with fees link
13.06	Extension of Time by Examiner’s Amendment	Added examiner note with fees link
13.09	Information Disclosure Statement, Issue Fee Paid	Added IDS language
15.01.01	Conditions Under 35 U.S.C. 172 Not Met	Changed citation of 1.17(m)
15.02	Claimed Foreign Priority, No Certified Copy Filed	Changed citation of 1.17(g)

**Table of Revised Form Paragraphs**

Form Paragraph No.	Form Paragraph Title	Summary of Changes
15.26	Identification of Prior Application(s) in Nonprovisional Applications - Benefit Claimed	Added CAF warning language
22.09	Ex Parte Reexamination - Action Is Final	Changed citation of 1.17(g)
22.10	Ex Parte Reexamination - Action Is Final, Necessitated by Amendment	Changed citation of 1.17(g)