August 1, 2025

Patently Enabled August 2025 – Avoid New USPTO Fees: File Your Continuations Before the 6-Year Deadline

Key takeaway: Review pending U.S. patent applications for possible subject matter for continuing applications as the six-year anniversary from the earliest priority date approaches.

The U.S. Patent and Trademark Office (USPTO) has instituted new fees for continuation applications filed six or nine years from the earliest priority date. A continuation application is a new patent application that claims the benefit of an earlier utility patent application.

The Fees

For large entities, the six-year fee is $2,700 and the nine-year fee is $4,000. For small and micro entities, the six-year fees are $1,080 and $540, respectively; the nine-year fees are $1,600 and $800, respectively. These fees are significant enough that practitioners and applicants should docket in advance of the six- and nine-year deadlines to assess how best to proceed and, ideally, avoid paying these fees.

Example

It can take years for the claims of a patent application to be allowed, particularly where computer, pharmaceutical and/or life sciences inventions are claimed. Therefore, continuation applications filed only upon achieving allowance of claims in the parent application are very likely to carry priority claims dating back more than six or even nine years.

For example, consider a patent application filed in the United States from a pending PCT application at the national stage deadline, which is defined as 30 months from the earliest priority application filing date. After performing such a filing, it may take an additional two or more years to receive a first office action. Prosecution will then routinely proceed over the course of another one to two years. As a result, an applicant will often be past six years from the earliest priority date claimed by the time claims are allowed in an initial U.S. patent application, and the six-year priority claim fee would therefore apply to any continuation application filed upon allowance.

Factors to Consider at Years Six and Nine

Is the product a huge success? Such products may warrant maximum protection and therefore the filing of a continuing application(s) before the six-year deadline, to maintain one or more pending U.S. patent applications in a cost-effective manner.

Are there potential infringers? Continuations can provide great flexibility in litigious scenarios by allowing an applicant to pursue claims of commercially relevant scope that is broader than and/or different from that covered in a parent patent application, even while the patent issuing from such parent application is asserted and/or challenged.

Does the application include important features not yet protected? Complex products often have many features that can be patented. By presenting them all in an initial application, some patent prosecution costs can be deferred. However, as the respective six- and nine-year fees loom, it will likely be practical to avoid these additional fees by performing parallel continuing application filings in advance of these deadlines (particularly immediately before the six-year deadline) to protect any unclaimed features of commercial relevance without incurring these significant additional fees.

Was a restriction imposed? If so, the USPTO identified at least one more distinct invention in the initial patent application. To protect this additional invention without incurring the hefty six-year priority claim fee, a divisional application (a subtype of continuing application) should be filed claiming such invention.

In summary, filing continuing applications before the newly established six- and nine-year deadlines should be prioritized.

The purpose of this monthly series, *Patently Enabled*, is to share simplified patent-related information to assist non-patent practitioners in making the best decisions when considering their intellectual property rights.

For any patent-related comments, questions or other inquiries, please contact patent attorneys Emily Ferriter Russo or George Chaclas.

Authors

George Chaclas
Partner

Providence, RI | (401) 283-1226

gchaclas@daypitney.com

Christopher R. Cowles, Ph.D.
Partner

Boston, MA | (617) 345-4719

ccowles@daypitney.com