

SUPPORTING STATEMENT
United States Patent and Trademark Office
Patent Reexamination and Supplemental Examinations
OMB CONTROL NUMBER 0651-0064
September 2018

A. Justification

1. Necessity of Information Collection

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. §§ 131 and 151 to examine applications and, when appropriate, allow applications and issue them as patents. Chapter 30 of Title 35 U.S.C. provides that any person at any time may file a request for reexamination by the USPTO of any claim of a patent on the basis of prior art patents or printed publications. Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from third parties. The rules outlining *ex parte* reexaminations are found at 37 CFR 1.510-1.570.

35 U.S.C. 257 permits a patent owner to request supplemental examination of a patent by the USPTO to consider, reconsider, or correct information believed to be relevant to the patent. The rules outlining supplemental examination are found at 37 CFR 1.601-1.625.

The Leahy-Smith America Invents Act terminated *inter partes* reexamination effective September 16, 2012. However, *inter partes* reexamination proceedings based on *inter partes* reexamination requests filed before September 16, 2012, continue to be prosecuted. Therefore, this collection continues to include items related to the prosecution of *inter partes* reexamination proceedings. The rules outlining *inter partes* reexaminations are found at 37 CFR 1.903-1.931.

Thus, the items included in this collection cover (1) requests for *ex parte* reexamination, (2) requests for supplemental examination, and (3) information that may be submitted by patent owners and third-party requesters in relation to the prosecution of an *ex parte* or *inter partes* reexamination proceeding. It should be noted that the Requests for Ex Parte Reexamination and Supplemental Examination are distinct collections from the Request for Ex Parte Reexamination and Supplemental Examination Transmittal Forms, respectively. Whereas the transmittal forms are used by a requester (patent owner or third party) as a checklist to ensure compliance with the requirements of the statutes and rules for *ex parte* reexaminations and supplemental examinations, the requests themselves represent the substantive analysis undertaken by requesters of *ex parte* reexamination and supplemental examination.

The public uses this information collection to request *ex parte* reexamination and supplemental examination, to prosecute reexamination proceedings, and to ensure that the associated documentation is submitted to the USPTO.

Table 1 provides the specific statutes and regulations authorizing the USPTO to collect the information discussed above:

Table 1: Information Requirements

IC Number	Requirement	Statute	Rule
1	Request for Supplemental Examination Transmittal Form	35 U.S.C. 257	37 CFR 1.601-1.625
2	Request for Supplemental Examination	35 U.S.C. 257	37 CFR 1.601-1.625
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form	35 U.S.C. 302	37 CFR 1.510-1.570
4	Request for <i>Ex Parte</i> Reexamination	35 U.S.C. 302	37 CFR 1.510-1.570
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	35 U.S.C. 303, 312	37 CFR 1.181, 1.515(c), and 1.927
6	Patent Owner's 37 CFR 1.530 Statement	35 U.S.C. 304	37 CFR 1.530
7	Third Party Requester's 37 CFR 1.535 Reply	35 U.S.C. 304	37 CFR 1.535
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	35 U.S.C. 132, 305, and 314	37 CFR 1.111, 1.530, 1.941, and 1.943
9	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	35 U.S.C. 314	37 CFR 1.947
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	35 U.S.C. 132 and 305	37 CFR 1.116 and 1.530
11	Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	35 U.S.C. 132 and 314	37 CFR 1.116 and 1.951
12	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	35 U.S.C. 314	37 CFR 1.951
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	35 U.S.C. 304-305 and 314	37 CFR 1.550(c) and 1.956

2. Needs and Uses

The public uses this information collection to request supplemental examination and reexamination proceedings and to ensure that the associated documentation is submitted to the USPTO.

This information in this collection can be submitted electronically in paper format or electronically through the EFS-Web.

The information collected, maintained, and used in this collection is based on OMB and USPTO guidelines. This includes the basic information quality standards established in

the Paperwork Reduction Act (44 U.S.C. Chapter 35), in OMB Circular A-130, and in the USPTO information quality guidelines.

Table 2 outlines how this collection of information is used by the public and the USPTO:

Table 2: Needs and Uses

IC Number	Form and Function	Form #	Needs and Uses
1	Request for Supplemental Examination Transmittal Form	PTO/SB/59	<ul style="list-style-type: none"> Used by the requester (patent owner) of a supplemental examination as a checklist to ensure compliance with the requirements of the statutes and rules for supplemental examinations. Used by the USPTO to ensure compliance by the requester (patent owner) with the requirements of the statutes and rules for supplemental examinations.
2	Request for Supplemental Examination	No Form	<ul style="list-style-type: none"> Used by the requester (patent owner) to provide: an identification of each aspect of the patent to be examined; an identification of each issue raised by each item of information listed in the request; a separate, detailed explanation for each identified issue; and an explanation of how each item of information is relevant to each aspect of the patent to be examined and of how each item of information raises each identified issue. Used by the USPTO to determine whether a substantial new question of patentability affecting any claim of the patent is raised by the items of information presented and identified in the request, and whether <i>ex parte</i> reexamination of the patent should be ordered under 35 U.S.C. § 257.
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form	PTO/SB/57	<ul style="list-style-type: none"> Used by the requester (patent owner or third-party) of an <i>ex parte</i> reexamination as a checklist to ensure compliance with the requirements of the statutes and rules for <i>ex parte</i> reexaminations. Used by the USPTO to ensure compliance by the requester (patent owner or third-party) with the requirements of the statutes and rules for <i>ex parte</i> reexaminations.
4	Request for <i>Ex Parte</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the requester (patent owner or third-party) to provide a statement identifying each substantial new question of patentability. Used by the requester (patent owner or third-party) to provide an identification of every claim for which reexamination is requested, and a detailed explanation of pertinency and manner of applying the cited art to every claim for which reexamination is requested. Used by the USPTO to evaluate whether a substantial new question of patentability has been raised by the requester (patent owner or third-party). Used by the USPTO to determine how and whether the patent claims are to be confirmed, amended, or canceled.
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	No Form	<ul style="list-style-type: none"> Used by the requester (patent owner or third-party) to request review by the Director of a decision refusing <i>ex parte</i> reexamination. Used by the requester to raise a question not specifically provided for in the rules or to request the suspension of the rules. Used by the USPTO to determine whether the decision to refuse <i>ex parte</i> reexamination should be upheld. Used by the USPTO to consider other questions and suspend or waive the rule requirements if appropriate.
6	Patent Owner's 37 CFR 1.530 Statement	No Form	<ul style="list-style-type: none"> Used by the patent owner in response to an order granting <i>ex parte</i> reexamination to point out why the patent claims are believed to be patentable. Used by the patent owner in response to an order granting <i>ex parte</i> reexamination to propose that specified changes be made to the patent specification, including the claims, or to the drawings. Used by the USPTO to determine whether the patent claims are patentable. Used by the USPTO to enter, if in compliance with the rules, the specified changes for purposes of examination.

IC Number	Form and Function	Form #	Needs and Uses
7	Third Party Requester's 37 CFR 1.535 Reply	No Form	<ul style="list-style-type: none"> Used by the third-party requester to comment on Patent Owner's 37 CFR 1.530 Statement. Used by the third-party requester to raise any issue appropriate for reexamination. Used by the third-party requester to identify additional prior art patents and printed publications. Used by the USPTO to determine whether the patent claims are patentable.
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the patent owner in response to an Office action to point out why the patent claims are believed to be patentable. Used by the patent owner in response to an Office action to propose that specified changes be made to the patent specification, including the claims, or to the drawings. Used by the USPTO to determine whether the patent claims are patentable. Used by the USPTO to enter, if in compliance with the rules, the specified changes for purposes of examination.
9	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the third-party requester to comment on issues raised by an Office action or by patent owner's response to the Office action. Used by the USPTO to determine whether the patent claims are patentable.
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the patent owner in response to a final Office action to point out why the patent claims are believed to be patentable. Used by the patent owner in response to a final Office action to propose that specified changes be made to the patent specification, including the claims, or to the drawings. Used by the USPTO to determine whether the patent claims are patentable. Used by the USPTO to determine whether the specified changes will be entered for purposes of examination.
11	Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the patent owner in response to an Action Closing Prosecution to point out why the patent claims are believed to be patentable. Used by the patent owner in response to an Action Closing Prosecution to propose that specified changes be made to the patent specification, including the claims, or to the drawings. Used by the USPTO to determine whether the patent claims are patentable. Used by the USPTO to determine whether the specified changes will be entered for purposes of examination.
12	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the third-party requester to comment on issues raised by an Action Closing Prosecution or by patent owner's response to the Action Closing Prosecution. Used by the USPTO to determine whether the patent claims are patentable.
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the public to request additional time to take action in a reexamination proceeding. Used by the USPTO to determine whether the cause is sufficient to grant additional time to act in a reexamination proceeding.

3. Use of Information Technology

The forms associated with this collection may be downloaded from the USPTO website in Portable Document Format (PDF) and filled out electronically. The items in this collection may be submitted online using EFS-Web, the USPTO's Web-based electronic filing system.

EFS-Web allows customers to file patent applications and associated documents electronically through their standard Web browser without downloading special software, changing their document preparation tools, or altering their workflow processes. Typically, the customer will prepare the forms or documents as standard

PDF files and then upload them to the USPTO servers using the secure EFS-Web interface. EFS-Web offers many benefits to filers, including immediate notification that a submission has been received by the USPTO, automated processing of requests, and avoidance of postage or other paper delivery costs.

4. Efforts to Identify Duplication

This information is collected only when a respondent files a request related to patent reexamination or supplemental examination. This information is not collected elsewhere and does not result in a duplication of effort.

5. Minimizing Burden to Small Entities

The information in this collection is necessary in order to process requests related to patent reexaminations and supplemental examinations. The same information is required from every requester and is not available from any other source.

6. Consequences of Less Frequent Collection

This information is collected only when the public submits an item related to a request for reexamination or supplemental examination and is not found elsewhere. If the information were not collected, the USPTO would not be able to comply with the statutes and regulations governing reexaminations and supplemental examinations. This information could not be collected less frequently.

7. Special Circumstances in the Conduct of Information Collection

There are no special circumstances associated with this collection of information.

8. Consultations Outside the Agency

The 60-Day Notice was published in the *Federal Register* on July 5, 2018 (83 FR 31379). The comment period ended on September 4, 2018. No public comments were received.

The USPTO has long-standing relationships with groups from whom reexamination data is collected, such as the American Intellectual Property Law Association, as well as patent bar associations, independent inventor groups, and users of our public search facilities. Views expressed by these groups are considered in developing proposals for information collection requirements and during the renewal of an information collection. No comments or concerns have been expressed impacting the present renewal.

9. Payment or Gifts to Respondents

This information collection does not involve a payment or gift to any respondent.

10. Assurance of Confidentiality

The confidentiality of patent applications is governed by statute (35 U.S.C. 122) and regulation (37 CFR 1.11 and 1.1or 4). The USPTO has a legal obligation to maintain the confidentiality of the contents of unpublished patent applications and related documents. Upon publication of an application or issuance of a patent, the patent application file is made available to the public, subject to the provisions for providing only a redacted copy of the file contents. The entire file of an *ex parte* reexamination proceeding is available to the public.

11. Justification for Sensitive Questions

None of the required information in this collection is considered to be sensitive.

12. Estimate of Hour and Cost Burden to Respondents

Table 3 calculates the burden hours and costs of this information collection to the public, based on the following factors:

- **Respondent Cost Burden**

The USPTO estimates that it will receive approximately 1,540 total responses per year for this collection.

The USPTO estimates that approximately 98% of the annual responses for this collection will be submitted electronically via EFS-Web, which customers may access through the USPTO Web site.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public approximately between 18 minutes (0.30 hours) to 55 hours to gather the necessary information, prepare the appropriate form or other document, and submit the information to the USPTO.

- **Cost Burden Calculation Factors**

The USPTO uses a professional rate of \$438 per hour for the respondent cost burden calculations, which is the hourly rate for intellectual property attorneys in private firms as shown in the 2017 *Report of the Economic Survey* published by the American Intellectual Property Law Association (AIPLA).

Table 3: Burden Hour/Burden Cost to Respondents

IC Number	Item	Estimated Time for Response (a)	Estimated Respondents (b)	Estimated Burden Hours (c) (a) x (b)	Rate (d)	Total Cost (e) (c) x (d)
1	Request for Supplemental Examination Transmittal Form	0.30 (18 minutes)	75	22.50	\$438.00	\$9,855.00

2	Request for Supplemental Examination	25	75	1,875.00	\$438.00	\$821,250.00
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form	0.30 (18 minutes)	200	60.00	\$438.00	\$26,280.00
4	Request for <i>Ex Parte</i> Reexamination	55	200	11,000.00	\$438.00	\$4,818,000.00
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	23	200	4,600.00	\$438.00	\$2,014,800.00
6	Patent Owner's 37 CFR 1.530 Statement	8	85	680.00	\$438.00	\$297,840.00
7	Third Party Requester's 37 CFR 1.535 Reply	8	25	200.00	\$438.00	\$84,600.00
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	33	310	10,230.00	\$438.00	\$4,480,740.00
9	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	41	5	205.00	\$438.00	\$89,790.00
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	17	200	3,400.00	\$438.00	\$1,489,200.00
11	Patent Owner's 37 CFR 1.951 Resposne in <i>Inter Partes</i> Reexamination	41	10	410.00	\$438.00	\$179,580.00
12	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	41	5	205.00	\$438.00	\$89,790.00
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.50 (30 minutes)	150	75.00	\$438.00	\$32,520.00
	Total		1,540	32,962.50		\$14,437,575.00

13. Total Annualized (Non-hour) Cost Burden

This collection has non-hourly cost burden in both fees paid by the public and associated postage costs for mailing items to the USPTO.

Fees

There are fees associated with this collection. These fees were previously contained in USPTO information collection 0651-0072, America Invents Act Section 10 Patent Fee Adjustment. 0651-0072 was discontinued in 2016 and the fees were returned to this collection.

Table 4: Filing Fees

IC Number	Item	Estimated Annual Responses (a)	Filing Fee (b)	Total Cost (c) (a) x (b)
2	Supplemental Examination Request (large entity)	55	\$4,400.00	\$242,000.00

2	Supplemental Examination Request (small entity)	15	\$2,200.00	\$33,000.00
2	Supplemental Examination Request (micro entity)	5	\$1,100.00	\$5,500.00
2	Supplemental Examination Reexamination (large entity)	35	\$12,100.00	\$423,500.00
2	Supplemental Examination Reexamination (small entity)	10	\$6,050.00	\$60,500.00
2	Supplemental Examination Reexamination (micro entity)	1	\$3,025.00	\$3,025.00
2	Supplemental Examination document size fees, 21-50 documents (large entity)	10	\$180.00	\$1,800.00
2	Supplemental Examination document size fees, 21-50 documents (small entity)	5	\$90.00	\$450.00
2	Supplemental Examination document size fees, 21-50 documents (micro entity)	1	\$45.00	\$45.00
2	Supplemental examination document size fees, each additional 50 documents (large entity)	10	\$280.00	\$2,800.00
2	Supplemental examination document size fees, each additional 50 documents (small entity)	1	\$140.00	\$140.00
2	Supplemental examination document size fees, each additional 50 documents (micro entity)	1	\$70.00	\$70.00
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (large entity)	35	\$460.00	\$16,100.00
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity)	10	\$230.00	\$2,300.00
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity)	5	\$115.00	\$575.00
2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (large entity)	55	\$100.00	\$5,500.00
2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity)	20	\$50.00	\$1,000.00
2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity)	5	\$25.00	\$125.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (large entity)	42	\$6,000.00	\$252,000.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (small entity)	27	\$3,000.00	\$81,000.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (micro entity)	1	\$1,500.00	\$1,500.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (large entity)	78	\$12,000.00	\$936.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (small entity)	51	\$6,000.00	\$306,000.00
4	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (micro entity)	1	\$3,000.00	\$3,000.00

5	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (large entity)	180	\$1,940.00	\$349,200.00
5	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity)	20	\$970.00	\$19,400.00
5	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity)	1	\$485.00	\$485.00
	Total	680		\$2,747,015.00

Postage Costs

The USPTO expects that 98% of the responses in this collection will be submitted electronically. Of the remaining 2%, the vast majority will be submitted by mail for a total of 25 mailed submissions. The USPTO estimates that the average postage cost for a mailed submission will be \$0.50 for Petitions to Request Extension of Time and \$5.75 for all other mailed submissions. Therefore, the USPTO estimates that the total postage costs is approximately \$163 per year.

Table 5: Postage Costs

IC #	Item	Estimated Annual Response (a)	Postage Cost (b)	Total Postage Cost (c) (a) x (b)
1	Request for Supplemental Examination Transmittal Form	2	\$5.75	\$11.50
2	Request for Supplemental Examination	2	\$5.75	\$11.50
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form	4	\$5.75	\$23.00
4	Request for <i>Ex Parte</i> Reexamination	4	\$5.75	\$23.00
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	4	\$0.50	\$2.00
6	Patent Owner's 37 CFR 1.530 Statement	2	\$5.75	\$11.50
7	Third Party Requester's 37 CFR 1.535 Reply	1	\$5.75	\$5.75
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	6	\$5.75	\$34.50
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	4	\$5.75	\$23.00
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	3	\$5.75	\$17.25
	Total	25		\$163.00

Total

The total (non-hour) cost burden for this collection is estimated to be \$2,747,178 per year, which includes \$2,747,015 in fees and \$163 in postage.

14. Annual Cost to Federal Government

The USPTO employs a GS-7 employee and a GS-11 employee to process submissions for this collection.

The USPTO estimates that the cost of a GS-7, step 1 employee is \$28.64 per hour (GS hourly rate of \$22.03 with 30% (\$6.61) added for benefits and overhead). The USPTO estimates that the cost of a GS-11, step 1 employee is \$42.38 per hour (GS hourly rate of \$32.60 with 30% (\$9.78) added for benefits and overhead).

The USPTO estimates that it takes an employee approximately between 15 minutes (0.25 hours) and 4 hours to process the information in this collection, depending on the type and amount of information being submitted.

Table 5 calculates the burden hours and costs to the Federal Government to processing this information collection:

Table 6: Burden Hour/Cost to the Federal Government

IC Number	Item	Hours (a)	Responses (b)	Burden (c) (a) x (b)	Rate (d)	Total Cost (e) (c) x (d)
1	Request for Supplemental Examination Transmittal Form	1.20	75	90	\$28.64	\$2,577.60
2	Request for Supplemental Examination	4	75	300	\$42.38	\$12,714.00
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form	1	200	200	\$28.64	\$5,728.00
4	Request for <i>Ex Parte</i> Reexamination	4	200	800	\$42.38	\$33,904.00
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	0.50 (30 minutes)	200	100	\$28.64	\$2,864.00
6	Patent Owner's 37 CFR 1.530 Statement	0.25 (15 minutes)	85	21.12	\$42.38	\$900.58
7	Third Party Requester's 37 CFR 1.535 Reply	0.25 (15 minutes)	25	6.25	\$42.38	\$264.88
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.33 (20 minutes)	310	102.33	\$42.38	\$4,335.47
9	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	0.33 (20 minutes)	5	1.65	\$42.38	\$69.93
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	0.33 (20 minutes)	200	66	\$42.38	\$2,797.08

11	Patent Owner's 37 CFR 1.951 Resposne in <i>Inter Partes</i> Reexamination	0.33 (20 minutes)	10	3.30	\$42.38	\$139.85
12	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	0.33 (20 minutes)	5	1.65	\$42.38	\$69.93
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.25 (15 minutes)	150	37.50	\$28.64	\$1,074.00
	Total		1,540	1,729.90		\$67,439.31

15. Reason for Changes in the Annual Burden

A. Changes in Collection since OMB approval in 2015

OMB previously approved the renewal of this information collection in September 2015. The current collection contains:

- 4,170 responses
- 95,290 burden hours
- \$37,067,810 in respondent hourly costs
- \$929.80 in annual (non-hour) costs

Changes due to rulemaking activity

In March 2016, collection 0651-0072 (America Invents Act Section 10 Patent Fee Adjustments) was discontinued by the USPTO. Fees housed in that collection were returned to 0651-0064 as a part of that process, which resulted in a significant increase of the annual (non-hour) cost burden.

In November 2017, the USPTO issued rulemaking action NPRM 0651-AD02, which was its biennial patent fee adjustment. As a result of this activity, several fees were adjusted and the annual (non-hour) cost burden was increased by nearly \$35,000.

Changes from the 60-Day Notice

The 60-Day Notice listed the postage costs as \$3,171.50. The USPTO conducted a review of the postage estimates and determined that \$163 was a more accurate reflection of the postage costs. The USPTO initially estimated that all Requests for Supplemental Examinations and all Requests for *Ex Parte* Reexaminations would be mailed to the USPTO along with their respective Transmittal Forms, which was inaccurate. 98% of these requests, along with their Transittal Forms, would be submitted to the USPTO electronically and the remaining 2% would be mailed, which results in the significantly decreased postage cost amounts.

B Changes proposed in this request to OMB

The proposed collection, as outlined in the tables above, seeks to modify the existing collection. The proposed collection contains an estimated:

- 1,540 responses
- 32,962.50 burden hours
- \$14,437,575 in respondent hourly costs
- \$2,747,178 in annual (non-hour) costs

Changes in Respondent Cost Burden

The total respondent cost burden for this collection has decreased by \$22,630,235 (from \$37,067,810 to \$14,437,575) from the previous renewal of this collection in September 2015

- Increase in estimated hourly rates. The 2015 renewal used an estimated rate of \$389 per hour, which was the estimated attorney rate for intellectual property attorneys in private firms. For the current renewal, the USPTO is using the updated hourly rate of \$438 for attorneys.
- Decreases in estimated burden hours. The total estimated burden hours have decreased from 95,290 in the 2015 renewal to 32,962.50 for the current renewal due to overall decreases in the estimated annual responses for this collection.

Changes in Response and Burden Hours

For this renewal, the USPTO estimates that the annual responses will decrease by 2,630 (from 4,170 to 1,540) and the total burden hours will decrease by 62,327.50 (from 95,290 to 32,962.50) from the currently approved burden for this collection.

Changes in Annual (Non-hour) Cost

For this renewal, the USPTO estimates that the total annual (non-hour) cost will increase by \$2,749,256.70 (from \$929.80 to \$2,750,186.50) with this increase due to program changes. Below is the list of program changes:

Program Changes:

- Increase of \$2,747,015 in filing fees. The fees associated with this collection had previously been housed in information collection 0651-0072, America Invents Act Section 10 Patent Fee Adjustment. 0651-0072 was discontinued by the USPTO in 2016.
- Decreases in the postage fee amounts. The postage fees have decreased by \$766.80, from \$929.80 in the 2015 renewal to \$163 in the current proposed renewal. This results from an increased number of materials being submitted to the USPTO electronically.

16. Project Schedule

The USPTO does not plan to publish this information for statistical use.

17. Display of Expiration Date of OMB Approval

The forms in this information for statistical use.

18. Exception to the Certificate Statement

This collection of information does not include any exceptions to the certificate statement.

B. COLLECTION OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.