

**SF-83 SUPPORTING STATEMENT
PAPERWORK REDUCTION ACT - OMB CONTROL NUMBER 0651-00XX
PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM**

A. JUSTIFICATION

1. Necessity of Information Collection

The Patent Prosecution Highway (PPH) pilot program is being established between the United States Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO). This program will allow applicants whose claims are determined to be patentable in the office of first filing to have the corresponding application that is filed in the office of second filing be advanced out of turn for examination. At the same time, this program will allow the office of second filing to exploit the search and examination results of the office of first filing, which will increase examination efficiency and improve patent quality. The USPTO published a notice in the *Official Gazette* outlining the details of the program on June 13, 2006 (Attachment A). The one-year pilot program began on July 3, 2006.

In order to participate in this program, applicants must meet certain requirements. Some of the requirements are: (1) the U.S. application must validly claim foreign priority to the JPO application; (2) the JPO application must have at least one claim that was determined to be patentable; (3) all the claims in the U.S. application must be amended to sufficiently correspond to the patentable claims in the JPO application; (4) examination of the U.S. application has not begun; (5) applicant must submit copies of the JPO office actions and English translations thereof; and (6) applicant must file a petition to make special along with the required petition fee under 37 CFR 1.17(h).

This information collection includes one proposed form, Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO (PTO/SB/20), which may be used by applicants to request participation in the pilot program and to ensure that they meet the program requirements.

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

Table 1: Information Requirements for the PPH Pilot Program

Requirement	Statute	Rule
Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO	35 U.S.C. ' 119	37 CFR 1.55, 1.102(d) and 1.17(h)

2. Needs and Uses

This information collection is necessary so that patent applicants may participate in the PPH pilot program between the JPO and the USPTO and receive the benefits of more efficient examination. The USPTO will provide one form to assist the public with submitting the required information for the program, Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO (PTO/SB/20). The public uses this form to request participation in the program, submit the required materials, and pay the appropriate petition fee.

The Information Quality Guidelines from Section 515 of Public Law 106-554, Treasury and General Government Appropriations Act for Fiscal Year 2001, apply to this information collection and comply with all applicable information quality guidelines, i.e. OMB and specific operating unit guidelines.

This proposed collection of information will result in information that will be collected, maintained, and used in a way consistent with all applicable OMB and USPTO Information Quality Guidelines. (See Attachment B, 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 of Information Collected for the PPH Pilot Program

Form and Function	Form #	Needs and Uses
Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO (Attachment C)	PTO/SB/20	<ul style="list-style-type: none">□ Used by the public to request participation in the pilot program, submit the required materials, and pay the appropriate fee.□ Used by the USPTO to determine whether the applicant is eligible for the pilot program and to advance the examination of eligible applications.

3. Use of Information Technology

Requests to participate in the PPH pilot program must be submitted by fax to the Office of the Commissioner for Patents to ensure that the request is processed in a timely manner. The form associated with this collection may be downloaded from the USPTO web site in PDF format, printed, and then filled out for faxing to the USPTO. The USPTO will consider alternative methods of submission under this program, including electronic submission, after the one-year pilot period has concluded.

4. Efforts to Identify Duplication

The information collected is required to process requests to participate in the PPH pilot program and enable fast-track examination. This information is not collected elsewhere and does not result in a duplication of effort. If any of the documents required for participation in the PPH pilot program have already been filed in the U.S. application,

the applicant will not need to resubmit those documents and may simply indicate in the request for participation when the documents were previously filed.

5. Minimizing the Burden to Small Entities

This collection does not impose a significant economic burden on small entities or small businesses. The information required by this collection provides the USPTO with the necessary materials for expediting the examination of applications that are eligible for the pilot program. The same information is required from every applicant and is not available from any other source.

6. Consequences of Less Frequent Collection

This information is collected only when the public submits a request to participate in the PPH pilot program. If this information were not collected, the USPTO would not be able to fulfill its obligations under this joint program with the JPO and provide the ensuing fast-track examination benefits to eligible applicants. 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 May 22, 2006 (71 Fed. Reg. 29318) (Attachment D). The comment period ended on July 21, 2006. No public comments were received.

The USPTO has long-standing relationships with groups from whom patent application data is collected, such as the American Intellectual Property Law Association (AIPLA), as well as patent bar associations, independent inventor groups, and users of our public facilities. Their views are expressed in regularly scheduled meetings and considered in developing proposals for information collection requirements. There have been no comments or concerns expressed by these or similar organizations concerning the time required to provide the information required under this program.

9. Payment or Gifts to Respondents

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

10. Assurance of Confidentiality

Confidentiality of patent applications is governed by statute (35 U.S.C. § 122) and regulation (37 CFR 1.11 and 1.14). Upon publication of an application or issuance of a

patent, the entire patent application file is made available to the public, subject to provisions for providing only a redacted copy of the file contents. The disclosure of the invention in the application is the quid pro quo for the property right conferred by the patent grant and the very means by which the patent statute achieves its constitutional objective of “promot[ing] the progress of science and useful arts.” The prosecution history contained in the application file is critical for determining the scope of the property right conferred by a patent grant.

11. Justification of Sensitive Questions

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

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 Calculation Factors**

The USPTO estimates that it will receive approximately 500 total responses per year for this collection, as shown in Table 3 below.

! **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public approximately two hours (2.0 hours) to gather the necessary information, prepare the form, and submit the completed request to the USPTO.

! **Cost Burden Calculation Factors**

In 2005 the Committee on Economics of Legal Practice of the American Intellectual Property Law Association published a report that summarized the results of a survey with data on hourly billing rates. The professional rate of \$304 per hour is the median rate for associate attorneys in private firms as published in that report. The USPTO expects that the information in this collection will be prepared by attorneys. This is a fully-loaded hourly rate.

Table 3: Burden Hours/Burden Costs to Respondents for the PPH Pilot Program

Item/Form No.	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b)	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO	2.0	500	1,000	\$304.00	\$304,000.00
Totals	-----	500	1,000	-----	\$304,000.00

None of the total responses for this collection will be submitted electronically during the pilot program.

13. Total Annualized Cost Burden

There are no capital start-up, maintenance, postage, or recordkeeping costs associated with this collection. However, this collection does have annual (non-hour) costs in the form of petition fees. The petition fee for a request to participate in the PPH pilot program is \$130 and up to 500 filings are expected per year, for a total of \$65,000 in fees for this collection. The fees are calculated in Table 4 below:

Table 4: Petition Fees to Respondents for the PPH Pilot Program

Item	Responses (a)	Fee (\$) (b)	Total Non-hour Cost Burden (c) (a) x (b)
Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO	500	\$130.00	\$65,000.00
TOTAL	500	\$65,000.00

The total annual (non-hour) cost burden for this collection in the form of petition fees is estimated to be \$65,000.

14. Annual Cost to the Federal Government

The USPTO estimates that it will take a GS-15, step 1 employee approximately one hour (1.0 hours) on average to process a request for participation in the PPH Pilot Program. The hourly rate for a GS-15, step 1 is currently \$51.52. When 30% is added to account for a fully-loaded hourly rate (benefits and overhead), the hourly rate for processing these items is \$66.98 (\$51.52 + \$15.46).

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

Table 5: Burden Hours/Burden Costs to the Federal Government for the PPH Pilot Program

Item/Form No.	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b)	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO	1.0	500	500	\$66.98	\$33,490.00
Totals	-----	500	500	-----	\$33,490.00

15. Reason for Changes in Annual Burden

For this new information collection, the USPTO estimates that the total annual responses will be 500 and the total burden hours will be 1,000. **Therefore, this collection has a total burden of 1,000 hours due to a program change.**

The USPTO estimates that this new information collection will also have an annual (non-hour) cost burden of \$65,000 in the form of petition fees. **Therefore, this collection has \$65,000 in annual (non-hour) cost burden due to a program change.**

16. Project Schedule

The USPTO does not plan to publish this information for statistical use or any other purpose.

17. Display of Expiration Date of OMB Approval

The form in this information collection will display the OMB Control Number and the expiration date.

18. Exceptions 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.

List of Attachments

- A. Notice published in the *Official Gazette* on June 13, 2006
- B. The USPTO Information Quality Guidelines
- C. Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO Maintenance Fee Transmittal Form (PTO/SB/20)
- D. 60-Day Notice published in the *Federal Register* on May 22, 2006 (71 Fed. Reg. 29318)