

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Proposed Addition to**  
**Patent Prosecution Highway (PPH) Pilot Program**  
**OMB CONTROL NUMBER 0651-0058**

**A. JUSTIFICATION**

**1. Necessity of Information Collection**

A work-sharing pilot program is being established between the United States Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO). This work-sharing program is called the "New Route." Under the New Route, a filing in one member office of this arrangement would be deemed a filing in all member offices. The first office and applicant would be given a 30-month processing time frame in which to make available a first office action and any necessary translations to the second office(s), and the second office(s) would exploit the search and examination results in conducting their own examination. The New Route proposal permits the search and examination results of the first office to be transmitted to the second office(s) according to an internationally coordinated time frame. By allowing the second office to exploit the search and examination results of the first office, the primary benefits of the New Route program would be to reduce overall office workload, minimize duplication of search efforts, and increase examination quality.

Because the New Route, as envisioned, would require changes in law in both the USPTO and JPO, the USPTO and JPO agreed to commence a pilot program to test the New Route concept based on the two filing scenarios currently available under existing law in both offices. The two filing scenarios eligible to participate in the New Route pilot program are: (1) a priority application is filed in the first office and a Patent Cooperation Treaty (PCT) application claiming priority to that application is filed with the same office as the PCT receiving Office; if the search and examination results of the priority application are available within about 26 months from its filing date and the corresponding PCT application enters the national stage in the second office, that national stage application would be eligible to participate in the New Route pilot program based on the priority application; and (2) a PCT application is filed with the PCT receiving Office of the first office (no priority application), then the PCT application enters the national stage early in the first office; if the search and examination results on the national stage application are available by about the 26th month from the international filing date, and the PCT application enters national stage in the second office at the 30th month, that national stage application in the second office would be eligible to participate in the New Route pilot program based on the national stage application in the first office.

In order to participate in the New Route pilot program, applicants must separately submit the following at the time of entry into the national stage of the PCT application in the USPTO: (a) a copy of the first office action by the JPO and English translation thereof; (b)

a copy of the claims searched and examined by the JPO and English translation thereof; (c) a statement that the translations are accurate; and (d) a request to participate in the New Route pilot program along with a petition to make special and the required petition fee under 37 CFR 1.17(h).

The pilot program began on January 28, 2008, and will end when the number of requests reaches 50 or the expiration of one year, whichever occurs first. The information collection includes one proposed form, Request for Participation in the New Route Pilot Program Between the JPO and the USPTO (PTO/SB/10), which may be used by applicants to request participation in the pilot program and to ensure that they meet the program requirements. This form will be added to this collection.

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

**Table 1: Information Requirements for the New Route Pilot Program**

Requirement	Statute	Rule
Request for Participation in the New Route 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 New Route 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 New Route Pilot Program Between the JPO and the USPTO (PTO/SB/10). 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.

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 New Route Pilot Program**

Form and Function	Form #	Needs and Uses
Request for Participation in the New Route Pilot Program Between the JPO and the USPTO (Attachment C)	PTO/SB/10	<ul style="list-style-type: none"><li>Used by the public to request participation in the pilot program, submit the required materials, and pay the appropriate fee.</li><li>Used by the USPTO to determine whether the applicant is eligible for the pilot program and to advance the examination of eligible applications.</li></ul>

### **3. Use of Information Technology**

Requests to participate in the New Route 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 pilot period has concluded.

### **4. Efforts to Identify Duplication**

The information collected is required to process requests to participate in the New Route 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 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 New Route 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 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 November 19, 2007 (72 Fed. Reg. 65015). The comment period ended on January 18, 2008. 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 800 total responses per year for this collection, including 50 responses per year for the Request to Participate in the New Route Pilot Program.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public approximately 1.5 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 New Route 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 New Route Pilot Program Between the JPO and the USPTO	1.5	50	75	\$304.00	\$22,800.00
<b>Totals</b>	-----	<b>50</b>	<b>75</b>	-----	<b>\$22,800.00</b>

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

The proposed addition to this information collection, plus the approved burden in the current inventory, will result in the total burden estimates shown below:

Current inventory responses = 750  
 Current inventory burden hours = 1,500  
 Current inventory burden hour costs = \$456,000

Impact on responses due to the proposed addition = increase of 50  
 Impact on burden hours due to the proposed addition = increase of 75  
 Impact on burden hour costs due to the proposed addition = increase of \$22,800

Total estimated responses after the proposed addition = 800  
 Total estimated burden hours after the proposed addition = 1,575  
 Total estimated burden hour costs after the proposed addition = \$478,800

### 13. Total Annualized Cost Burden

There are no capital start-up, maintenance, postage, or recordkeeping costs associated with this collection. However, there are additional filing fees associated with the proposed Requests for Participation in the New Route Pilot Program. The filing fee for a Request for Participation in the New Route Pilot Program is \$130 under 37 CFR 1.17(h), and up to 50

filings are expected per year, for a total of \$6,500 in filing fees due to these requests. The fees are calculated in Table 4 below:

**Table 4: Petition Fees to Respondents for the New Route Pilot Program**

Item	Responses (a)	Fee (\$) (b)	Total Non-hour Cost Burden (c) (a) x (b)
Request for Participation in the New Route Pilot Program Between the JPO and the USPTO	50	\$130.00	\$6,500.00
<b>TOTAL</b>	50	.....	<b>\$6,500.00</b>

Currently approved annual (non-hour) costs = \$97,500  
 Impact due to the proposed addition = increase of \$6,500  
 Total estimated annual (non-hour) costs after the proposed addition = \$104,000

#### 14. Annual Cost to the Federal Government

The USPTO estimates that it will take a Senior Level employee approximately one hour on average to process a request for participation in the New Route pilot program. The hourly rate for a Senior Level employee is approximately \$74.33. When 30% is added to account for a fully-loaded hourly rate (benefits and overhead), the hourly rate for processing these items is \$96.63 (\$74.33 + \$22.30).

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 New Route 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 New Route Pilot Program Between the JPO and the USPTO	1.0	50	50	\$96.63	\$4,832.00
<b>Totals</b>	-----	50	50	-----	<b>\$4,832.00</b>

Current government cost burden = \$50,235  
 Impact due to the proposed addition = increase of \$4,832  
 Total estimated government cost burden after the proposed addition = \$55,067

#### 15. Reason for Changes in Annual Burden

This information collection is currently approved by OMB with a total of 750 responses and 1,500 burden hours per year. Due to the proposed addition of the Request for Participation in the New Route Pilot Program (PTO/SB/10), the USPTO estimates that the annual

responses will be 800 and the annual burden hours will be 1,575, which is an increase of 50 responses and 75 burden hours from the currently approved burden for this collection. This burden increase is due to a program change resulting from the addition of this new form in support of the New Route program. There is no change for the remaining items in this collection. **Therefore, this information collection would have a total burden increase of 75 hours due to a program change.**

This collection is currently approved with an estimated 1,500 burden hours, which results in a respondent cost burden of \$456,000 when calculated at the hourly rate for attorneys of \$304. The proposed additions to this collection would increase the respondent cost burden by \$22,800, up to \$478,800, due to the increase of 75 burden hours from the New Route pilot program.

For this proposed addition, the USPTO estimates that the total annual (non-hour) costs will increase by \$6,500, from \$97,500 to \$104,000 per year. This increase is due to the addition of filing fees for Requests to Participate in the New Route Pilot Program. **Therefore, this collection has an increase in annual (non-hour) cost burden of \$6,500 as 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.

## REFERENCES

- A. The USPTO Information Quality Guidelines
- B. Request for Participation in the New Route Pilot Program Between the JPO and the USPTO (PTO/SB/10)
- C. 60-Day Notice published in the *Federal Register* on November 19, 2007 (72 Fed. Reg. 65015)