

SF-83 SUPPORTING STATEMENT
United States Patent and Trademark Office
Statutory Invention Registration
OMB CONTROL NUMBER 0651-0036

A. JUSTIFICATION

1. Necessity of Information Collection

A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforceable attributes of a patent. In other words, a person occasionally invents something solely for personal use, not for production or sale, and does not want to go through the effort and expense of obtaining a patent on the invention. At the same time, the inventor wants to prevent someone else from later obtaining a patent on a like invention. In that situation, the inventor can register a statutory invention and have it published. Once published, it cannot be claimed or patented by another person.

35 U.S.C. § 157 authorizes the United States Patent and Trademark Office (USPTO) to publish a statutory invention registration containing the specifications and drawings of a regularly filed application for a patent without examination, providing the applicant meets all the requirements for printing, waives the right to receive a patent on the claimed invention within a certain period of time prescribed by the USPTO, and pays all application, publication and other processing fees.

The USPTO administers 35 U.S.C. § 157 through 37 CFR 1.293-1.297. Under these rules, an applicant for an original patent may request, at any time during the pendency of the applicant's complete application, that the specifications and drawings be published as a statutory invention registration. Any request for a statutory invention registration may be examined to determine if the requirements have been met, if the subject matter of the application is appropriate for publication, and if the requirements for publication are met. Any request also must be signed by (1) the applicant and any assignee of record, or (2) an attorney or agent of record in the application. The request for publication must also include a waiver of the applicant's right to receive a patent on the invention claimed effective upon the date of publication of the statutory invention registration.

The requester may petition the USPTO to review a final refusal to publish a statutory invention registration within one month or such other time as is set forth in the decision refusing publication. The petition may include a request for refund of the petition fee.

The requester may also request the USPTO to withdraw the request to publish a statutory invention registration prior to the date of the notice of the intent to publish. The request to withdraw may also include a request for a refund.

If the request for a statutory invention registration is approved, a notice to that effect will be published in the *Official Gazette* of the USPTO. Each statutory invention registration published will include a statement relating to the attributes of a statutory invention registration.

Table 1 provides the specific statute and rules requiring the USPTO to collect the information discussed above:

Table 1: Information Requirements for Statutory Invention Registration

Requirement	Statute	Rule
Request for Statutory Invention Registration	35 U.S.C. § 157	37 CFR 1.293 - 1.294 and 1.297
Petition to Review Final Refusal to Publish	35 U.S.C. § 157	37 CFR 1.295
Request to Withdraw SIR Publication Request	35 U.S.C. § 157	37 CFR 1.296

2. Needs and Uses

The applicant uses Form PTO/SB/94, Request for Statutory Invention Registration, to request and authorize publication of a regularly filed patent application as a statutory invention registration, to waive the right to receive a United States patent on the same invention claimed in the identified patent application, to agree that the waiver will be effective upon publication of the statutory invention registration, and to state that the identified patent application complies with the requirements for printing.

No forms are associated with the petition for a review of the final refusal to publish a statutory invention registration or with the request to withdraw the request for publication of a statutory invention registration.

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 would 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 the information for the Statutory Invention Registration is used by the public and by the USPTO:

Table 2: Needs and Uses of Information Collected for the Request for Statutory Invention Registration

Form and Function	Form #	Needs and Uses
Request for Statutory Invention Registration (Ref. A)	PTO/SB/94	<ul style="list-style-type: none"> • Used by a patent applicant to request publication of a patent application as a statutory invention registration and to submit associated fees. • Used by a patent applicant to waive the right to a patent on the invention claimed in a patent application. • Used by the USPTO to review, grant or deny requests for publication of a statutory invention registration.
Petition to Review Final Refusal to Publish	No Form Associated	<ul style="list-style-type: none"> • Used by a requester to obtain review of a final refusal to publish a statutory invention registration. • Used by the USPTO to review a final refusal to publish a statutory invention registration.
Request to Withdraw SIR Publication Request	No Form Associated	<ul style="list-style-type: none"> • Used by a requester to request withdrawal of a request to publish a statutory invention registration. • Used by a requester and the USPTO to ensure that the appropriate fees are submitted. • Used by the USPTO to review a request to withdraw a request for publication of a statutory invention registration.

3. Use of Information Technology

The USPTO currently accepts the electronic filing of some patent applications and certain related documents through the Electronic Filing System (EFS-Web). While there is not a specific EFS-Web form for statutory invention registrations, form PTO/SB/94 (and all of the other SIR-related submissions) may be submitted over EFS-Web. New features and capabilities are being added to EFS as it undergoes further development, and customers will eventually be able to file all applications and related documents electronically through EFS-Web. As the USPTO expands the use of electronic filing, the USPTO will reevaluate whether it is feasible for the request for statutory invention registration to be filed electronically as well. If the security issues are resolved and the electronic collection of this item does become feasible, the USPTO will submit the associated electronic form to the Office of Management and Budget (OMB) for review, as necessary.

4. Efforts to Identify Duplication

This information is collected only when the applicant submits a request for a statutory invention registration, petitions the USPTO to review a final refusal to publish, or requests withdrawal of a request to publish a statutory invention registration.

5. Minimizing the Burden to Small Entities

This collection of information does not impose a significant economic impact on small entities or small businesses. The same information is required of every applicant and is not available from any other source.

6. Consequences of Less Frequent Collection

This information is collected only when the respondent submits a request for a statutory invention registration, petitions the USPTO to review a final refusal to publish, or requests withdrawal of a request to publish a statutory invention registration. Therefore, this collection of information could not be conducted less frequently. If the information were not collected, the USPTO could not publish statutory invention registrations as provided for in 35 U.S.C. § 157 and 37 CFR 1.293-1.297.

7. Special Circumstances in the Conduct of Information Collection

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

8. Consultation Outside the Agency

The 60-Day Notice was published in the *Federal Register* on October 7, 2008 [73 Fed. Reg. 58572]. 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 by regulation (37 CFR 1.11 and 1.14). The USPTO has a legal obligation to maintain the confidentiality of the contents of unpublished patent applications and related documents.

11. Justification for 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 anticipated 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 5 requests to publish a patent application as a statutory invention registration, 1 petition to review a final refusal, and 2 requests to withdraw publication requests annually.
- Burden Hour Calculation Factors**
 The USPTO estimates that it will take the public approximately 24 minutes (0.4 hours), depending on the complexity of the situation, to gather the necessary information, prepare, and submit a request for a statutory invention registration, a petition to review final refusal to publish, and a request to withdraw a publication request.
- Cost Burden Calculation Factors**
 In 2007, the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA) published a report that summarized the results of a survey with data on hourly billing rates. The professional rate of \$310 per hour used in this submission to calculate the respondent cost burden is the median rate for associate attorneys in private forms as published in that report. The USPTO expects that the information in this collection will be prepared by associate attorneys. This is a fully-loaded hourly rate.

Table 3: Burden Hour/Burden Cost to Respondents for the Request for Statutory Invention Registration

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
Request for Statutory Invention Registration	0.4	5	2	\$310.00	\$620.00
Petition to Review Final Refusal to Publish	0.4	1	1	\$310.00	\$310.00
Request to Withdraw SIR Publication Request	0.4	2	1	\$310.00	\$310.00
Total	- - - -	8	4	- - - -	\$1,240.00

13. Total Annualized (Non-hour) Cost Burden

There are no capital start-up, maintenance, or record keeping costs associated with this information collection. There is, however, non-hour burden due to filing fees and postage costs.

There is annual (non-hour cost) burden in the way of filing fees for the items in this collection. The total annual filing fee/non-hour cost burden to respondents is outlined in Table 4 below:

Table 4: Filing Fees/Non-hour Cost Burden to Respondents for the Request for Statutory Invention Registration

Item	Responses (a)	Filing fee (\$) (b)	Total Non-Hour Cost Burden (a) x (b) (c)
Statutory Invention Registration (requested prior to mailing of first office action (37 CFR 1.17(n)))	2	\$920.00	\$1,840.00
Statutory Invention Registration (requested after mailing of first office action (37 CFR 1.17(o)))	3	\$1,840.00	\$5,520.00
Petition to Review Final Refusal to Publish (37 CFR 1.295)	1	\$200.00	\$200.00
Request to Withdraw SIR Publication Request (37 CFR 1.296)	1	\$200.00	\$200.00
Petition to Withdraw Publication Request on or after date of Notice of Intent to Publish (37 CFR 1.296)	1	\$400.00	\$400.00
Total	8	- - - - -	\$8,160.00

Customers may incur postage costs when submitting the information in this collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that the average first class postage cost for a mailed submission will be 75 cents and approximately 8 submissions will be submitted to the USPTO by mail. Therefore, the estimated postage cost for this collection of \$6.

The total annualized (non-hour) respondent cost burden for this collection in the form of filing fees (\$8,160) and postage costs (\$6) is estimated to be \$8,166 per year.

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-5, step 1, 6 minutes (0.1 hours) to process a statutory invention registration or a petition under 37 CFR 1.295 or 1.296. The hourly rate for a GS-5, step 1, is currently \$14.18 according to the U.S. Office of Personnel Management's (OPM's) wage chart, including locality pay for the Washington, DC area. When 30% is added to account for a fully loaded hourly rate (benefits plus overhead), the rate per hour for a GS-5, step 1, is \$18.43 (\$14.18+ \$4.25).

Table 5 calculates the processing hours and costs for a disclosure document deposit request to the Federal Government:

Table 5: Burden Hour/Burden Cost to the Federal Government for the Request for Statutory Invention Registration

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
Request for Statutory Invention Registration	0.1	5	1	\$18.43	\$18.00
Petition to Review Final Refusal to Publish	0.1	1	1	\$18.43	\$18.00

Request to Withdraw SIR Publication Request	0.1	2	1	\$18.43	\$18.00
Total	- - - - -	8	3	- - - - -	\$54.00

15. Reason for Change in Burden

Summary of Changes Since the Previous Renewal

OMB previously approved the renewal of this collection in April of 2006 with a total of 8 responses and 4 burden hours. For this renewal, the USPTO estimates that the responses and burden hours will remain the same

The total annual (non-hour) cost burden for this renewal of \$8,166 is an increase of \$1 over the currently approved total of \$8,165. The increase is due to an administrative adjustment for postage costs.

Change in Burden Estimates Since the 60-Day Notice

There has been no change to the estimated responses and burden hours since the publication of the 60-Day Notice.

The 60-Day Notice reported total (non-hour) cost burden in the amount of \$7,760. (Non-hour) cost burden is being increased in this submission to \$8,166 due to a petition fee being added back into the collection.

Change in Respondent Cost Burden

When this collection was previously approved in April 2006, the estimated hourly rate for respondents was \$286 for the reported 4 burden hours, yielding a respondent cost burden of \$1,144.

For this renewal, the USPTO is using the current professional hourly rate of \$310. At this rate, the 4 burden hours yield a respondent cost burden of \$1,240, which is an increase of \$96 over the currently approved burden at the previous hourly rate. This increase in respondent cost burden is due to the increase in the estimated hourly rate.

Changes in Annualized (Non-hour) Costs

For this renewal, the USPTO estimates that the total annual (non-hour) costs will increase by \$1, from \$8,165 currently reported on the OMB inventory to the present \$8,166 per year. **Therefore, this collection has an increase in annual non-hour cost burden of \$1 due to an administrative adjustment.**

[Note: The previously approved estimate of \$8,165 in annual (non-hour) costs for this collection is listed as \$8,000 in the current inventory system. The \$165 difference is due to rounding the estimate to the nearest thousand dollars in order to accommodate the

legacy inventory system. This rounded figure was carried over when the legacy data was migrated to the current inventory system. Consequently, the annual cost burden increase of \$1 for this collection that is due to an administrative adjustment is displayed as an increase of \$166 in the current inventory system in order to compensate for the previously rounded figure and to result in the new annual cost burden of \$8,166 for this collection as described above.]

16. Project Schedule

There is no plan to publish this information for statistical use.

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. Exception to the Certificate Statement

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

B. COLLECTIONS OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.

Reference

- A. Information Quality Guidelines
- B. Form PTO/SB/94, Request for Statutory Invention Registration