

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Patent Prosecution Highway (PPH) Program
OMB CONTROL NUMBER 0651-0058
(July 2010)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0058 Patent Prosecution Highway (PPH) Program. The USPTO is adding three forms to this collection for new participants in the existing/upcoming PPH and PCT-PPH programs. The USPTO is also proposing to update this collection to delete two items that are no longer being collected, remove fees that have recently been eliminated, and revise the time estimates related to recordkeeping costs.

The PPH program allows 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, the PPH program allows the office of second filing to exploit the search and examination results of the office of first filing, which increases examination efficiency and improves patent quality. The PCT-PPH pilot program is an expansion to the PPH program based on the framework of the Patent Cooperation Treaty (PCT). Information collected for the PCT is approved under OMB control number 0651-0021.

PPH agreements streamline the patent system by allowing patent examiners to avail themselves of the work product from other participating patent offices. Originally, the PPH program was limited to the utilization of search and examination results of national applications between cross filings under the Paris Convention. The newer PCT-PPH agreements have greatly expanded the potential of the PPH program by permitting participating patent offices to draw upon the positive results of the PCT work product from another participating office. The PCT-PPH pilot program uses international search reports, written opinions, and international preliminary examination reports developed within the framework of the PCT, thereby making the PPH program available to a larger number of applicants.

The forms in this collection allow participants to file a request in a corresponding U.S. application and petition to make the U.S. application special under the PPH or PCT-PPH program. The PPH forms collect similar data; however, there is a unique form for each participant. This collection currently includes forms for the following PPH programs:

- Japan Patent Office (JPO), Form PTO/SB/20JP
- United Kingdom Intellectual Property Office (UKIPO), Form PTO/SB/20UK
- Canadian Intellectual Property Office (CIPO), Form PTO/SB/20CA

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- Danish Patent and Trademark Office (DKPTO), Form PTO/SB/20DK
- European Patent Office (EPO), Form PTO/SB/20EP
- Korean Intellectual Property Office (KIPO), Form PTO/SB/20KR
- Intellectual Property Office of Australia (IPAU), Form PTO/SB/20AU
- Intellectual Property Office of Singapore (IPOS), Form PTO/SB/20SG
- German Patent and Trade Mark Office (DPMA), Form PTO/SB/20DE
- National Board of Patents and Registration of Finland (NBPR), Form PTO/SB/20FI
- Russian Patent Office (ROSPATENT), Form PTO/SB/20RU (program will start on Sept. 1, 2010)

This collection also includes forms for the following PCT-PPH pilot programs:

- European Patent Office (EPO), Form PTO/SB/20PCT-EP
- Japan Patent Office (JPO), Form PTO/SB/20PCT-JP

Summary of Changes

The USPTO is proposing to make the following changes to this collection:

- The USPTO is adding three forms to this collection for new participants in the existing/upcoming PPH and PCT-PPH programs: Request for Participation in the PPH Pilot Program Between the Hungarian Patent Office (HPO) and the USPTO (PTO/SB/20HU), Request for Participation in the PPH Pilot Program Between the Spanish Patent and Trademark Office (SPTO) and the USPTO (PTO/SB/20ES) (program will start on Sept. 1, 2010), and Request for Participation in the PCT-PPH Pilot Program Between the KIPO and the USPTO (PTO/SB/20PCT-KR).
- The USPTO is deleting two forms from this collection because the information is no longer being collected: Request for Participation in the New Route Pilot Program Between the JPO and the USPTO (PTO/SB/10) and Request for Participation in the Triway Pilot Program Among the USPTO, the EPO and the JPO (PTO/SB/12).
- The USPTO is removing the petition fees from this collection because they have been eliminated as of May 25, 2010 (75 Fed. Reg. 29312).
- The USPTO is revising the estimated recordkeeping costs associated with submitting the information in this collection online.

Changes in Burden

The addition of the PPH HPO, PPH SPTO, and the PCT-PPH KIPO pilot forms; the deletion of the New Route and Triway pilot forms; the removal of the petition fees; and the revision of the estimated recordkeeping costs will result in the following burden changes for this information collection:

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| Burden Type | Currently approved | Proposed change | New estimates |
|-------------------------|---------------------------|------------------------|----------------------|
| Responses | 1,950 | 150 | 2,100 |
| Hours | 3,825 | 375 | 4,200 |
| Fees | \$253,500 | -\$253,500 | \$0 |
| Recordkeeping costs | \$160 | \$6,140 | \$6,300 |
| Annual (non-hour) costs | \$253,660 | -\$247,360 | \$6,300 |

The USPTO estimates that it will receive 100 responses per year for each of the pilot programs for PPH HPO, PPH SPTO, and PCT-PPH KIPO, and that it will take the public approximately 2 hours to prepare and submit the information for each request, for a total of 300 responses and 600 burden hours per year. The removal of the New Route and Triway programs results in a decrease of 150 responses and 225 burden hours per year. **Therefore, this collection takes a net increase of 150 responses and 375 burden hours as a program change.**

The USPTO has eliminated the \$130 petition fee under 37 CFR 1.17(h) that was previously associated with the items in this collection. **Therefore, this collection takes a decrease of \$253,500 in annual (non-hour) costs as a program change.**

The USPTO has revised the estimated time for recordkeeping from 5 seconds (0.001 hours) to 2 minutes (0.03 hours) per response for printing and retaining a copy of the acknowledgment receipt as evidence of the successful electronic submission. This collection was previously approved with a total of \$160 in recordkeeping costs. The proposed changes in this collection result in a total of 2,100 responses, all submitted electronically, for a revised total of 63 hours of recordkeeping per year. The USPTO expects that the receipts will be printed by paraprofessionals at an estimated rate of \$100 per hour, for a total revised recordkeeping cost of \$6,300 per year. The three new forms being added into this collection account for \$900 of these costs. **Therefore, this collection takes an increase of \$6,140 in annual (non-hour) costs, with \$900 as a program change and \$5,240 as an administrative adjustment.**

The USPTO estimates that the proposed changes for this collection will result in the following total burden changes:

- Net increase of 150 responses as a program change
- Net increase of 375 burden hours as a program change
- Net decrease of \$247,360 in annual (non-hour) costs, with a net decrease of \$252,600 as a program change partially offset by an increase of \$5,240 as an administrative adjustment

Therefore, this collection would have the following revised total burden:

- 2,100 responses
- 4,200 hours
- \$6,300 in annual (non-hour) costs