

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE

United States Patent and Trademark Office Patent Prosecution Highway (PPH) Program OMB CONTROL NUMBER 0651-0058

January 2010 PCT-PPH Pilot Program and Russian Update

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 revising one existing form in this collection to modify the requirements to permit the submission of machine translation into the English language for certain documents. The USPTO is also proposing to update this collection to include new forms for Russian participants and 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.

The PPH pilot program was originally established between the USPTO and the Japan Patent Office (JPO) on July 3, 2006. The USPTO and the JPO agreed at the November 2007 Trilateral Conference to fully implement the PPH program on a permanent basis starting on January 4, 2008.

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 PPH forms collect similar data; however, there is a unique form for each participant. In addition to the Japan Patent Office program (Form PTO/SB/20JP), PPH programs have since been established with the following:

United Kingdom Intellectual Property Office (UKIPO), Form PTO/SB/20UK
Canadian Intellectual Property Office (CIPO), Form PTO/SB/20CA
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

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Summary of Changes

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

- The USPTO is revising Form PTO/SB/20JP to indicate that an accuracy statement is not required for English translations of JPO office actions if the translation is provided by the JPO.
- The USPTO is proposing to add a new form for a new participant in the PPH program: Russian Patent Office (ROSPATENT), Form PTO/SB/20RU.
- The USPTO is proposing to add two new forms for a new category of participants in the PPH program based on the framework provided by the PCT: Request for Participation in the PCT-PPH Pilot Program Between the EPO and the USPTO (PTO/SB/20PCT-EP) and Request for Participation in the PCT-PPH Pilot Program Between the JPO and the USPTO (PTO/SB/20PCT-JP).

At the November 2009 Trilateral Conference, the Trilateral Offices (USPTO, EPO and JPO) agreed to expand the PPH program based on positive PCT work products. PPH agreements streamline the patent system by allowing patent examiners to avail themselves of the work product from other participating patent offices. Previously, the PPH program has been limited to the utilization of search and examination results of national applications between cross filings under the Paris Convention. The new PCT-PPH agreements will greatly expand the potential of the PPH program by permitting a Trilateral Office to draw upon the positive results of the PCT work product from another Trilateral Office. The PCT-PPH pilot program will use 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 new forms will allow participants to file a request in a corresponding U.S. application and petition to make the U.S. application special under the PCT-PPH pilot program.

The PCT-PPH pilot program will commence on January 29, 2010, for a period of two years ending on January 28, 2012. The trial period may be extended if necessary until the participating Offices receive a sufficient number of PPH requests to adequately assess the feasibility of the program.

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Changes in Burden

There are no burden changes associated with the revision of Form PTO/SB/20JP. The addition of the PPH Russia pilot form and the PCT-PPH EPO and JPO pilot forms will result in the following burden changes for this information collection:

Burden Type	Currently approved	Proposed addition	New estimates
Responses	1,650	300	1,950
Hours	3,225	600	3,825
Fees	\$214,500	\$39,000	\$253,500
Recordkeeping costs	\$130	\$30	\$160
Annual (non-hour) costs	\$214,630	\$39,030	\$253,660

The USPTO estimates that it will receive 100 responses per year for each of the pilot programs for PPH Russia, PCT-PPH EPO, and PCT-PPH JPO, and that it will take the public approximately 2 hours to prepare and submit the information for each request. Therefore, this collection would take an increase of 300 responses and 600 hours as a program change.

There are annual (non-hour) costs in the form of petition fees and recordkeeping costs associated with the items being added to this collection. The petition fee for requests to participate in the PPH programs is \$130 under 37 CFR 1.17(h). Based on the estimated 300 total annual responses for the proposed additions, a total of \$39,000 in petition fees will be added to this collection as a program change.

There are also recordkeeping costs associated with submitting the PPH forms in this collection online using the USPTO's web-based electronic filing system, EFS-Web. The USPTO recommends that customers print and retain a copy of the acknowledgment receipt as evidence of the successful submission. The 300 responses for the proposed additions will be filed online, and the USPTO estimates that it will take 5 seconds (0.001 hours) to print a copy of the acknowledgment receipt, for a total of approximately 0.3 hours per year. The USPTO expects that these receipts will be printed by paraprofessionals at an estimated rate of \$100 per hour, for a total increase in recordkeeping costs of \$30 per year as a program change.

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

- 300 responses
- 600 hours
- \$39,030 in annual (non-hour) costs as a program change

Therefore, this collection would have a revised total burden of:

- 1,950 responses
- 3,825 hours
- \$253,660 in annual (non-hour) costs