

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Patent Prosecution Highway (PPH) Program
OMB CONTROL NUMBER 0651-0058
(December 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 PCT-PPH pilot program: PCT-PPH Australia, PCT-PPH Canada, and PCT-PPH Finland. The USPTO plans to launch the PCT-PPH pilot programs with Australia and Finland on January 24, 2011, and with Canada in early 2011.

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
- Danish Patent and Trademark Office (DKPTO), Form PTO/SB/20DK

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- 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
- Hungarian Patent Office (HPO), Form PTO/SB/20HU
- Spanish Patent and Trademark Office (SPTO), Form PTO/SB/20ES
- Austrian Patent Office (APO), Form PTO/SB/20AT

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
- Korean Intellectual Property Office (KIPO), Form PTO/SB/20PCT-KR
- Austrian Patent Office (APO), Form PTO/SB/20PCT-AT
- Russian Patent Office (ROSPATENT), Form PTO/SB/20PCT-RU
- Spanish Patent and Trademark Office (SPTO), Form PTO/SB/20PCT-ES
- U.S. Applications Where the USPTO was the ISA or IPEA, Form PTO/SB/20PCT-US

Summary of Changes

The USPTO is proposing to add three forms to this collection for new participants in the PCT-PPH pilot program:

- Request for Participation in the PCT-PPH Pilot Program Between the Intellectual Property Office of Australia (IPAU) and the USPTO, Form PTO/SB/20PCT-AU
- Request for Participation in the PCT-PPH Pilot Program Between the Canadian Intellectual Property Office (CIPO) and the USPTO, Form PTO/SB/20PCT-CA
- Request for Participation in the PCT-PPH Pilot Program Between the National Board of Patents and Registration of Finland (NBPR) and the USPTO, Form PTO/SB/20PCT-FI

Changes in Burden

The addition of the PCT-PPH Australia, PCT-PPH Canada, and PCT-PPH Finland pilot forms will result in the following burden changes for this information collection:

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| Burden Type | Currently approved | Proposed change | New estimates |
|-------------------------|---------------------------|------------------------|----------------------|
| Responses | 2,600 | 300 | 2,900 |
| Hours | 5,200 | 600 | 5,800 |
| Annual (non-hour) costs | \$7,800 | -\$7,800 | \$0 |

The USPTO estimates that it will receive 100 responses per year for each of the pilot programs for PCT-PPH Australia, PCT-PPH Canada, and PCT-PPH Finland, 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. **Therefore, this collection takes an increase of 300 responses and 600 burden hours as a program change.**

This collection was previously approved with a total of \$7,800 in annual (non-hour) costs for recordkeeping associated with printing and retaining a copy of the acknowledgment receipt for electronic submissions. The USPTO is removing these recordkeeping costs from this collection because keeping a copy of the acknowledgment receipt is a suggestion for customers and not a requirement. **Therefore, this collection takes a decrease of \$7,800 in annual (non-hour) costs as a program change.**

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

- Increase of 300 responses as a program change
- Increase of 600 burden hours as a program change
- Decrease of \$7,800 in annual (non-hour) costs as a program change

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

- 2,900 responses
- 5,800 hours
- \$0 in annual (non-hour) costs