

SUPPORTING STATEMENT
United States Patent and Trademark Office
Third-Party Submissions and Protests
(formerly Green Technology Pilot Program)
OMB CONTROL NUMBER 0651-0062
(January 2011)

A. JUSTIFICATION

1. Necessity of Information Collection

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. § 131 *et seq.* to examine an application for patent and, when appropriate, issue a patent. The provisions of 35 U.S.C. § 122(c) and 37 CFR 1.99 and 1.291 limit the ability of a third party to have information entered and considered in, or to protest, a patent application pending before the Office.

With respect to third-party submissions, 37 CFR 1.99 permits a third party to submit patents and publications (i.e., documents that are public information and that the Office would discover on its own with an ideal prior art search) during a limited (two-month) period after publication of an application. 37 CFR 1.99 prohibits a third party from submitting any explanation of the patents or publications, or submitting any other information.

In addition to third-party submissions under 37 CFR 1.99, the USPTO accepts third-party submissions via its pilot program for public submission of peer reviewed prior art. Under the peer review pilot program, a limited number of volunteer applicants with unexamined applications classified in specific areas have the opportunity to consent to the placement of their published application(s) onto the Peer-To-Patent Website for the purposes of collaborative review. Peer-to-Patent is a non-USPTO Web-site developed by the New York Law School for the pilot program. Participating applications are analyzed by members of the public who, in an organized manner using Internet Peer Review techniques, determine the (up to) six (6) most pertinent prior art documents, which are then submitted to the USPTO as a third-party submission under a waiver of certain sections of both 37 CFR 1.99 and 1.291. The peer review pilot program does not violate 35 U.S.C. § 122, given that applicants must provide a certification and request to participate in the program that includes an express written consent to the inclusion of the explanations submitted by Peer-to-Patent coordinators regarding how the prior art documents relate to the disclosed invention as defined by the claims. The Office of Management and Budget (OMB) has determined that, under 5 CFR 1320.3(h), the certification and request to participate in the Peer Review Pilot Program does not collect "information" within the meaning of the Paperwork Reduction Act of 1995 (44 U.S.C. § 3501 *et seq.*).

With respect to protests, 37 CFR 1.291 permits a party obtaining knowledge of an application pending in the Office to file a protest against the application and to therein call attention to any facts within the protestor's knowledge which, in the protestor's opinion, would make the grant of a patent on the application improper. However, 35 U.S.C. § 122(c) provides that the Office "shall establish appropriate procedures to ensure that no protest . . . to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant." Therefore, with the exception of a protest accompanied by a written consent of the applicant, all protests must be submitted prior to the publication of the application or the mailing of a notice allowance, whichever occurs first.

The USPTO is now requesting the renewal of:

- Third-Party Submissions in Published Applications (previously titled Third-party Submissions in Published Applications Under 37 CFR 1.99), and
- Protests by the Public Against Pending Applications Under 37 CFR 1.291

The USPTO is revising the title of the third-party submissions itemization in this collection to clarify that both third-party submissions under 37 CFR 1.99 and third-party submissions under the agency pilot program associated with peer reviews are included.

This collection previously contained a third item: Request for Green Technology Pilot Program (PTO/SB/420). OMB has determined that, under 5 CFR 1320.3(h), the Requests for Green Technology Pilot Program do not collect "information" within the meaning of the Paperwork Reduction Act of 1995 (44 U.S.C. § 3501 *et seq.*). The USPTO is therefore requesting the removal of the Request for Green Technology Pilot Program from this collection. The USPTO is also requesting an adjustment of the title of this collection to reflect the removal.

Table 1 identifies the proposed statutory and regulatory provisions that require the USPTO to collect this information:

Table 1: Information Requirements for Third-Party Submissions and Protests

Requirement	Statute	Rule
Third-Party Submissions in Published Applications	35 U.S.C. §§ 122(c), 131 and 151	37 CFR 1.99
Protests by the Public Against Pending Applications Under 37 CFR 1.291	35 U.S.C. §§ 122(c), 131 and 151	37 CFR 1.291

2. Needs and Uses

This information collection is necessary so that the public may (i) make a submission in a published application, and (ii) protest a pending application.

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 this information collection and its supporting statement

comply with all applicable information quality guidelines, i.e., the 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 information is used by the public and by the USPTO:

Table 2: Needs and Uses for Third-Party Submissions and Protests

Form and Function	Form #	Needs and Uses
Third-Party Submissions in Published Applications	No Form Associated	<ul style="list-style-type: none"> • Used by the public to submit, without further comment or explanation, patents or publications as prior art documents relevant to a pending published application in accordance with 37 CFR 1.99. • Used by the public to submit prior art documents in accordance with the peer review pilot program. • Used by the USPTO to enter patents or publications as prior art documents in the application file, in accordance with 37 CFR 1.99. • Used by the USPTO to enter prior art documents in the application file, in accordance with the peer review pilot program.
Protests by the Public Against Pending Applications Under 37 CFR 1.291	No Form Associated	<ul style="list-style-type: none"> • Used by the public to call attention to any facts within the protestor's knowledge that, in the protestor's opinion, would make the grant of a patent on an application pending in the USPTO improper. • Used by the USPTO to bring information to the attention of the USPTO and to avoid the issuance of an invalid patent.

3. Use of Information Technology

Both third-party submissions under 37 CFR 1.99 and protests are prohibited from being filed via EFS-Web by the EFS-Web Legal Framework. Third-party submissions under the peer review pilot program will also not be received via EFS-Web. The agency continues to work towards electronic filing options, and will inform the public and the OMB if changes to the EFS-Web Legal Framework allow for such submissions in the future.

4. Efforts to Identify Duplication

The information collected is required to process (i) third-party submissions in published applications, and (ii) protests by the public against pending applications. This information is not collected elsewhere and does not result in a duplication of effort.

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 information required by this collection provides the USPTO with the necessary materials for (i) entering prior art documents obtained from a third party in the application file, and (ii) bringing information to the attention of the

USPTO and avoiding the issuance of an invalid patent. The same information is required from every member of the public and is not available from any other source.

6. Consequences of Less Frequent Collection

This information is collected only when the public submits (i) a third-party submission, and (ii) a 37 CFR 1.291 protest. If this information were not collected, the USPTO would not be able to balance the mandate of 35 U.S.C. § 122(c) and the USPTO's authority and responsibility under 35 U.S.C. §§ 131 and 151 to issue a patent only if "it appears that the applicant is entitled to a patent under the law." 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. Consultation Outside the Agency

The 60-Day Notice was published in the *Federal Register* on October 20, 2010 (75 Fed. Reg. 64692). The public comment period ended on December 20, 2010. No public comments were received.

The USPTO has long-standing relationships with groups from who 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 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 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 1,225 responses per year for this collection.
- Burden Hour Calculation Factors**
 The USPTO estimates that it will take the public between 7.5 hours and 10 hours to gather the necessary information, prepare the appropriate form or documents, and submit the information to the USPTO.
- Cost Burden Calculation Factors**
 In 2009 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 \$325 per hour used in this submission is the median rate for attorneys in private firms as published in that report. The USPTO expects that the information in this collection will be prepared by attorneys. These are fully-loaded hourly rates.

Table 3: Burden Hour/Burden Cost to Respondents for Third-Party Submissions and Protests

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
Third-Party Submissions in Published Applications	7.5	1,160	8,700	\$325.00	\$2,827,500.00
Protests by the Public Against Pending Applications Under 37 CFR 1.291	10 0	65	650	\$325.00	\$211,250.00
TOTAL	- - - -	1,225	9,350	- - - -	\$3,038,750.00

13. Total Annualized (Non-hour) Cost Burden

There are no capital start-up, maintenance or record keeping costs associated with this information collection. However, this collection does have filing fees and postage costs.

Although the applicant is strongly urged to retain a copy of the file submitted to the USPTO as evidence of authenticity in addition to keeping the acknowledgement receipt

as clear evidence of the date the file was received by the USPTO, this is not required and, as such, the USPTO is not considering this to be a record keeping cost imposed upon the applicant (5 CFR 1320.3(m)).

There is no fee for filing a third-party submission under the peer review pilot program. In addition, the peer review pilot program is currently scheduled to accept requests for participation from October 25, 2010 until September 30, 2011, or until one thousand (1,000) participating applications have been accepted into the pilot, whichever occurs first. Therefore, the USPTO estimates that 1,000 of the 1,160 third-party submissions will fall under the no-fee category. The remaining 160 third-party submissions are subject to the 37 CFR 1.17(p) fee of \$180 for a cost of \$28,800. There is no fee for filing protests under 37 CFR 1.291 unless the filed protest is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(l) fee of \$130 must be included. The USPTO estimates 7 of the 65 protests filed per year will trigger this fee for a cost of \$910. Therefore, the USPTO estimates that the total filing fees associated with this collection will be approximately \$29,710 per year.

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 one-pound submission will be \$4.80 and approximately 1,225 submissions will be submitted to the USPTO. Therefore, the estimated postage cost for this collection is \$5,880.

The total annualized (non-hour) respondent cost burden for this collection in the form of filing fees (\$29,710) and postage costs (\$5,880) is estimated to be \$35,590 per year.

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-7, step 1 employee 30 minutes (0.5 hours) to process the protests under 37 CFR 1.291 and the third-party submissions. The hourly rate for a GS-7, step 1, is currently \$20.22. When 30% is added to account for a fully-loaded hourly rate (benefits and overhead), the rate per hour for a GS-7, step 1 employee, is \$26.29 (\$20.22 + \$6.07).

Table 4 calculates the processing hours and costs of this information collection to the Federal Government:

Table 4: Burden Hour/Burden Cost to the Federal Government for Third-Party Submissions and Protests

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
Third-Party Submissions in Published Applications	0.5	1,160	580	\$26.29	\$15,248.00
Protests by the Public Against Pending Applications Under 37 CFR 1.291	0.5	65	33	\$26.29	\$868.00
TOTAL	- - - -	1,225	613	- - - -	\$16,116.00

15. Reason for Change in Burden

Summary of Changes Since the Previous Renewal

This information collection was previously approved in June of 2010 with a total of 5,225 responses and 6,850 burden hours per year.

For this renewal, the USPTO estimates that the total annual responses will be 1,225 and the total annual burden hours will be 9,350, which is a decrease of 4,000 responses and an increase of 2,500 burden hours from the currently approved burden for this collection. This decrease in responses and increase in burden hours is due to program changes and an administrative adjustment.

The total annual (non-hour) cost burden for this renewal of \$35,590 is a decrease of \$9,820 from the currently approved total of \$45,410. The decrease is due to a program change for the removal from this collection of the Request for Green Technology Pilot Program and the record keeping costs, offset by the addition of postage costs as an administrative adjustment.

Change in Burden Estimates Since the 60-Day Federal Register Notice

The 60-Day *Federal Register* Notice published in October 2010 reported that the USPTO estimated it would receive 2,225 responses resulting in 3,850 burden hours per year. Since that publication there have been adjustments in the number of responses due to the elimination from this collection of the Green Technology Pilot Program as well as an increase in estimated responses for the third-party submissions. These changes decreased the responses by 1,000 and increased the burden hours by 5,500, resulting in the present 1,225 responses and 9,350 burden hours being reported for this submission.

The 60-Day *Federal Register Notice* reported total (non-hour) cost burden in the amount of \$36,410. This (non-hour) cost burden is being decreased in this submission to \$35,590 due to the elimination of the record keeping costs but is partially offset by the addition of postage costs.

Change in Respondent Cost Burden

The 9,350 burden hours for this renewal yield a respondent cost burden of \$3,038,750, which is an increase of \$812,500 over the currently approved respondent cost burden of \$2,226,250. This increase in respondent cost burden is due to an increase in burden for one of the requirements but is partially offset by the elimination from this collection of the Green Technology Pilot Program.

Changes in Responses and Burden Hours

With this renewal, a total of 2,500 burden hours have been added to this collection. This increases the total number of burden hours from 6,850 to 9,350 per year as a result of both a program change and an administrative adjustment, as follows:

- The USPTO is eliminating the requirement Request for Green Technology Pilot Program from the collection. The USPTO estimates that this will remove 5,000 responses per year. **Therefore, this submission takes a total burden decrease of 5,000 hours as a program change.**
- The USPTO expects that the number of Third-Party Submissions in Published Applications submitted per year will increase by 1,000, from 160 to 1,160 responses per year. The name of the requirement has been changed to eliminate the words "Under 37 CFR 1.99." **Therefore, this submission takes a total burden increase of 7,500 hours as an administrative adjustment.**

A net total of 4,000 responses have been removed from this collection as a result of a program change and an administrative adjustment. The decrease in burden responses is due to a combination of the elimination of 5,000 responses as the result of the elimination from this collection of one requirement and an increase in responses of 1,000 for one requirement. This results in a total net burden hour decrease of 5,000 hours as a program change offset by an increase of 7,500 hours as an administrative adjustment.

Changes in Annualized (Non-hour) Cost Burden

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$9,820, from \$45,410 currently on the OMB inventory to the present \$35,590. Even though this collection has a decrease in costs due to the elimination of the record keeping requirement in the amount of \$15,700, postage costs in the amount of \$5,880 are being added to the collection. **Therefore, the cost burden decrease of \$15,700 due to a program change and an increase of \$5,880 due to an administrative adjustment yield a total decrease in annual (non-hour) cost burden of \$9,820.**

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. 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.