

SUPPORTING STATEMENT
United States Patent and Trademark Office
Statutory Invention Registration
OMB CONTROL NUMBER 0651-0036
(December 2011)

A. JUSTIFICATION

1. Necessity of Information Collection

An applicant for an original patent may request, at any time during the applicant's pending complete application, that the specification and drawings be published as a statutory invention registration (SIR). A published SIR is not a patent. It has the defensive attributes of a patent, e.g., it is usable as a reference as of its filing date in the same manner as a patent, but does not have the enforceable attributes of a patent. Historically, applicants have requested that the United States Patent and Trademark Office (USPTO) publish their patent applications as SIRs in certain instances when, for any of a variety of reasons, applicants no longer wanted to go through the effort and expense of obtaining patents on the inventions claimed in the applications. However, given the fact that 37 CFR 1.211 requires the publication of most nonprovisional applications filed on or after November 29, 2000, applicants have increasingly found § 1.211 publication of an application to be a desirable alternative to requesting a SIR, particularly since § 1.211 publication of the application is achieved without any waiver of patent rights.

35 U.S.C. § 157 authorizes the USPTO to publish a SIR containing the specifications and drawings of a regularly filed application for a patent without examination if the applicant: (i) meets the requirements of 35 U.S.C. § 112; (ii) has complied with the requirements for printing; (iii) waives the right to receive a patent on the invention claimed effective upon the date of publication of the SIR; and (iv) pays all application, publication, and other processing fees.

The USPTO administers 35 U.S.C. § 157 through 37 CFR 1.293-1.297. Any request for a SIR is examined to determine whether the subject matter of the application is appropriate for publication, the requirements for publication are met, and the requirements of 35 U.S.C. § 112 and 37 CFR 1.293 are met.

The requester may petition the USPTO to review rejection decisions within one month or such other time as is set forth in the decision refusing publication. The requester may also petition the USPTO to withdraw a request to publish a SIR prior to the date of the notice of the intent to publish.

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

The public uses Form PTO/SB/94 Request for Statutory Invention Registration to request and authorize publication of a regularly filed patent application as a SIR, 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 SIR, and to state that the identified patent application complies with the requirements for printing. No forms are associated with the petition for review of the refusal to publish a SIR or the petition to withdraw the request for publication of a SIR.

The America Invents Act, P.L. 112-29, was enacted September 16, 2011. It calls for the repeal of Statutory Invention Registration 18 months after the enactment of the Act. The USPTO, therefore, will request renewal for this collection based upon the impending requirement for discontinuation in early 2013.

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
Petition to Withdraw SIR Publication Request	35 U.S.C. § 157	37 CFR 1.296

2. Needs and Uses

The public uses form PTO/SB/94, Request for Statutory Invention Registration, to request and authorize publication of a regularly filed patent application as an SIR, 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 SIR, and to state that the identified patent application complies with the requirements for printing.

No forms are associated with the petition for review of the refusal to publish a statutory invention registration or the petition 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 this information collection and its supporting statement 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	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	<ul style="list-style-type: none"> • Used by the public to obtain review of a final refusal to publish a statutory invention registration. • Used by the USPTO to review, grant, or deny a final refusal to publish a statutory invention registration.
Petition to Withdraw SIR Publication Request	No Form	<ul style="list-style-type: none"> • Used by the public to request withdrawal of a request to publish a statutory invention registration. • Used by the USPTO to review a petition 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.

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 withdraw of a petition 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 petition 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 July 19, 2011 (76 Fed. Reg. 42684). The public comment period ended on September 19, 2011. 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 sensitive.

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 8 responses per year for this collection, with approximately 25% of these responses submitted by small entities.
- Burden Hour Calculation Factors**
 The USPTO estimates that it will take the public approximately 24 minutes (0.40 hours) to 30 minutes (0.50) to submit the information in this collection, including the time to gather the necessary information, prepare the appropriate form or document, and submit the completed request to the USPTO.
- Cost Burden Calculation Factors**
 The USPTO uses a professional rate of \$340 per hour for respondent rate cost burden calculations, which is the median rate for attorneys in private firms as shown in the 2011 *Report of the Economic Survey*, published by the American Intellectual Property Law Association (AIPLA).

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	0.40	5	2	\$340.00	\$680.00
Petition to Review Final Refusal to Publish	0.50	1	1	\$340.00	\$340.00
Petition to Withdraw SIR Publication Request	0.40	2	1	\$340.00	\$340.00
Total	- - - - -	8	4	- - - - -	\$1,360.00

13. Total Annual (Non-hour) Cost Burden

The total annual (non-hour) respondent cost burden for this collection is estimated to be \$7,770 per year, which includes \$7,760 in filing fees and \$10 in postage costs.

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

Item	Responses (a)	Filing fee (\$) (b)	Total Non-Hour Cost Burden (a) x (b) (c)
Petition to Review Final Refusal to Publish (37 CFR 1.295)	1	\$200.00	\$200.00
Petition to Withdraw SIR Publication Request (37 CFR 1.296)	1	\$0.00	\$0.00
Petition to Withdraw Publication Request on or after date of Notice of Intent to Publish (37 CFR 1.296)	1	\$200.00	\$200.00
Total	8	- - - - -	\$7,760.00

Table 5: Postage Costs (Non-hour) Cost Burden to Respondents for the Request for Statutory Invention Registration

Item	Responses (a)	Postage Cost (\$) (b)	Total Non-Hour Cost Burden (a) x (b) (c)
Statutory Invention Registration (3 oz. large envelope, first class)	5	\$1.28	\$6.00
Petition to Review Final Refusal to Publish (3 oz. large envelope, first class)	1	\$1.28	\$1.00
Petition to Withdraw SIR Publication Request (3 oz. large envelope, first class)	2	\$1.28	\$3.00
Total	8	- - - - -	\$10.00

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-5, step 1 employee approximately 6 minutes (0.10 hours) to process a statutory invention registration or a petition under 37 CFR 1.295 or 1.296. The USPTO estimates that the cost of a GS-5, step 1 employee is currently \$21.23 (GS hourly rate of \$16.33 with 30% (\$4.90) added for benefits and overhead).

Table 6 calculates the processing hours and costs to the Federal Government for a SIR request:

Table 6: 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	\$21.23	\$21.00
Petition to Review Final Refusal to Publish	0.1	1	1	\$21.23	\$21.00
Petition to Withdraw SIR Publication Request	0.1	2	1	\$21.23	\$21.00
Total	- - - - -	8	3	- - - - -	\$63.00

15. Summary of Changes in Burden Since Previous Renewal

OMB previously approved the renewal of this collection in February of 2009 with a total of 8 responses, 4 burden hours, and \$8,166 in annualized (non-hour) costs. There have been no interim approvals.

With this renewal, the USPTO estimates that the total responses and burden hours will remain the same. The total annual (non-hour) cost burden for this renewal of \$7,770 is a decrease of \$396 over the currently approved total of \$8,166.

Changes Since the 60-Day *Federal Register* Notice

Adjustments in the estimated hourly rates for attorneys have been made since the July 2011 *Federal Register* Notice publication. Respondent cost burden reflects the most current estimated hourly rate for attorneys. See "Changes in Respondent Cost Burden" below for more details.

The USPTO has made an adjustment in the filing fees since the publication of the 60-Day Notice. The \$200 fee for the Petition to Withdraw SIR Publication Request (37 CFR 1.296) has been eliminated and the \$400 fee for the Petition to Withdraw SIR Publication Request on or after date of Notice of Intent to Publish (37 CFR 1.296) has been reduced to \$200, for a total fee reduction of \$400.

The America Invents Act, P.L. 112-29, was enacted September 16, 2011. It calls for the repeal of Statutory Invention Registration 18 months after the enactment of the Act. The USPTO, therefore, will request renewal for this collection based upon the impending requirement for discontinuation in early 2013.

Changes in Respondent Cost Burden

As noted in Section 12 above, the USPTO estimates the hourly rate for respondents at rates published in the American Intellectual Property Law Association (AIPLA) *Reports of the Economic Survey*, which is published every two years. In 2009 the USPTO estimated the hourly respondent cost burden based on a rate of \$310 per hour from the 2007 Report. For this renewal, the estimated rate has increased to \$340 per hour, based on the 2011 Report.

The rate updates have resulted in the following changes in annual respondent cost burden:

- **Increase of \$120 overall** from \$1,240 to \$1,360

Changes in Annual (Non-hour) Costs

For this renewal, the USPTO estimates a net decrease in total (non-hour) costs of \$396 (from \$8,166 to \$7,770), with a \$4 increase due to administrative adjustments offset by a \$400 decrease due to program changes, as follows:

Administrative Adjustments:

- **Increase of \$4.** This collection is currently approved with a total of \$6 in postage costs associated with mailing responses to the USPTO. For this renewal, the USPTO estimates that the postage costs for mailed items will increase to \$10, primarily due to expected increases in first-class postage rates since the previous renewal in 2009.

Program Changes:

- **Decrease of \$400.** This collection is currently approved with a total of \$8,160 in filing fees. For this renewal, the USPTO estimates that the filing fees will decrease to \$7,760, due to the elimination of the fee for the Petition to Withdraw SIR Publication Request (37 CFR 1.296) and a decrease of \$200 in the fee for the Petition to Withdraw Publication Request on or after date of Notice of Intent to Publish (37 CFR 1.296).

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 of OMB approval.

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.