

SUPPORTING STATEMENT
United States Patent and Trademark Office
Post Patent Public Submissions
OMB CONTROL NUMBER 0651-00xx
(January 2012)

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. Currently, the provisions of 35 U.S.C. 301 and 37 CFR 1.501 govern the ability of a person to cite to the USPTO in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a patent.

However, the Leahy-Smith America Invents Act was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). Section 6(g) of the Leahy-Smith America Invents Act amends 35 U.S.C. 301 to expand the information that can be submitted in the file of an issued patent by including written statements made by a patent owner before a Federal court or the USPTO regarding the scope of any claim of the patent. Section 6(g) of the Leahy-Smith America Invents Act is effective on September 16, 2012.

The USPTO published a notice of proposed rulemaking titled "Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act" (RIN 0651-AC66) in the *Federal Register*. In the notice, the USPTO proposed to rewrite 37 CFR 1.501 to reflect the amendment to 35 U.S.C. 301 by section 6(g)(1) of the Leahy-Smith America Invents Act. For example, new 35 U.S.C. 301(a)(2) would permit a submission under 35 U.S.C. 301 and 37 CFR 1.501 to contain, in addition to prior art (currently provided for in § 1.501), "statements of the patent owner filed in a proceeding before a Federal court or the [USPTO] in which the patent owner took a position on the scope of any claim of a particular patent" (claim scope statements of the patent owner). Proposed § 1.501 therefore provides that a submission can include prior art and claim scope statements of the patent owner.

In light of the proposed rulemaking, the USPTO is submitting this new information collection, Post Patent Public Submissions, and requesting that the item "Information Disclosure Citation in a Patent" (PTO/SB/42) be transferred out of the 0651-0031 Patent Processing (Updating) approved inventory and into this new collection. The information in this collection can be submitted electronically through EFS-Web, the USPTO's web-based electronic filing system, as well as on paper. The USPTO is therefore accounting for both electronic and paper submissions in this collection.

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

Table 1: Information Requirements for Post Patent Public Submissions

Requirement	Statute	Rule
Information Disclosure Citation in a Patent (paper and electronic)	35 U.S.C. § 301	37 CFR 1.501

2. Needs and Uses

This information collection is necessary so that the public may file, in a patent, submissions of patents and printed publications believed to have a bearing on the patentability of the patent, and statements of the patent owner filed in a proceeding before a Federal court or the USPTO in which the patent owner took a position on the scope of any claim of the patent. The public may use this information to aid in ascertaining the patentability and/or scope of the claims of the patent. The USPTO may use the information during subsequent reissue or reexamination proceedings, except that the USPTO's use of statements of the patent owner filed in a proceeding before a Federal court or the USPTO will be limited under the proposed rulemaking to determining the meaning of a patent claim in *ex parte* reexamination proceedings that have already been ordered and in *inter partes* review and post grant review proceedings that have been instituted.

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 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: Needs and Uses for Post Patent Public Submissions

Form and Function	Form #	Needs and Uses
Information Disclosure Citation in a Patent (paper and electronic)	PTO/SB/42	<ul style="list-style-type: none"> Used by the public to file, in a patent, submissions of patents and printed publications believed to have a bearing on the patentability of the patent, and statements of the patent owner filed in a proceeding before a Federal court or the USPTO in which the patent owner took a position on the scope of any claim of the patent. Used by the USPTO, as appropriate, in subsequent reissue or reexamination proceedings.

3. Use of Information Technology

The USPTO permits information disclosure citations in a patent to be filed via its electronic filing system (EFS-Web). However, a citation will not be entered into the patent's Image File Wrapper (IFW) if it does not include either proof of service compliant with 37 CFR 1.248(b) or a sufficient explanation and proof of a *bona fide* attempt of service, and if such a citation is inadvertently entered, it will be expunged. Where a citation complies with the rule, all information included in the citation will be made of record in the IFW of the patent.

4. Efforts to Identify Duplication

This information will be collected during the enforceability of a patent. It will not duplicate information or collection of data found elsewhere.

5. Minimizing the Burden to Small Entities

This collection of information will not impose a significant economic impact on a substantial number of small entities. The burden to all entities, including small entities, imposed by the information requirements associated with the rules proposed in the notice of proposed rulemaking is a minor addition to that of the current regulations for information disclosure citations in a patent under 37 CFR 1.501. Furthermore, there are no filing fees associated with this information collection.

6. Consequences of Less Frequent Collection

This information will be collected only when a member of the public submits an information disclosure citation in a patent. If this information were not collected, the public would not be able to exercise its statutory right under 35 U.S.C. 301 to cite to the USPTO in writing (a) prior art consisting of patents or printed publications believed to have a bearing on the patentability of any claim of a particular patent, or (b) statements of the patent owner filed in a proceeding before a Federal court or the USPTO in which the patent owner took a position on the scope of any claim of a particular patent. Therefore, this collection of information could not be conducted 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 USPTO published a notice of proposed rulemaking titled "Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act" (RIN 0651-0066) in the *Federal Register*.

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, 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.

9. Payment or Gifts to Respondents

This information collection does not involve a payment or gift to any respondent.

10. Assurance of Confidentiality

The information will be collected from any person who elects to cite, in an issued patent, prior art consisting of patents or printed publications, or statements of the patent owner filed in a proceeding before a Federal court or the USPTO. Confidentiality of patent applications is governed by 35 U.S.C. § 122 and 37 CFR 1.14, and upon issuance of an application as a patent, the entire file contents of the application are available to the public (subject to the provisions for providing only a redacted copy of the filed contents). Therefore, information disclosure citations in a patent are necessarily available to the public as well.

However, proposed 37 CFR 1.501(d) states that “[i]f the person making the [citation] wishes his or her identity to be excluded from the patent file and kept confidential, the [citation] papers must be submitted without any identification of the person making the [citation].”

11. Justification for Sensitive Questions

None of the required information 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 a total of 1,000 responses to this information collection annually, of which 250 will be filed by small entities. The USPTO estimates that 930 of the 1,000 responses will be filed electronically.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public 10 hours to complete the collection of information. This includes time to gather the necessary information, create the document, and submit the completed request to the USPTO. The USPTO calculates that, on balance, it takes the same amount of time to gather the necessary information, create the document, and submit it to the USPTO, whether the applicant submits the information in paper form or electronically.

- **Cost Burden Calculation Factors**

The USPTO estimates a rate of \$340 per hour. The USPTO uses a professional rate of \$340 per hour for respondent 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 Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA).

Table 3: Burden Hour/Burden Cost to Respondents for Post Patent Public Submissions

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
Electronic Information Disclosure Citation in a Patent	10.0	930	9,300	\$340.00	\$3,162,000.00
Information Disclosure Citation in a Patent	10.0	70	700	\$340.00	\$238,000.00
Total	- - - - -	1,000	10,000	- - - - -	\$3,400,000.00

13. Total Annualized Cost Burden

There are postage costs associated with information disclosure citations in a patent.

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 \$4.95 and approximately 70 submissions will be submitted to the USPTO requiring postage. Therefore, the estimated postage cost for this collection will be \$347.

Therefore, the USPTO estimates that that the total annualized (non-hour) cost burden for this collection due to the postage costs is \$347 per year.

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-7, step 1 approximately 30 minutes (0.50 hours) to process the items in this collection. The hourly rate for a GS-7, step 1, is currently \$20.22 according to the U.S. Office of Personnel Management's (OPM's) wage chart, including locality pay for the Washington, DC area. 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, is \$26.29 (\$20.22 + \$6.07).

Table 6 calculates the processing hours and costs of this information collection to the Federal Government:

Table 6: Burden Hour/Burden Cost to the Federal Government for Post Patent Public Submissions

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
Electronic Information Disclosure Citation in a Patent	0.50	930	465	\$26.29	\$12,225.00
Information Disclosure Citation in a Patent	0.50	70	35	\$26.29	\$920.00
Total	- - - - -	1,000	500	- - - - -	\$13,145.00

15. Reason for Change in Burden

The USPTO is submitting this new information collection request in support of a notice of proposed rulemaking titled “Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act” (RIN 0651-0066). In the notice, the USPTO proposed to rewrite 37 CFR 1.501 to reflect the amendment to 35 U.S.C. 301 by section 6(g)(1) of the Leahy-Smith America Invents Act. The new requirement proposed in the notice of proposed rulemaking is a requirement of statute (i.e., the submission of patent owner statements) and thus the sole means of accomplishing the purpose of the statute.

The USPTO estimates that it will receive 1,000 responses for this collection annually and that the associated burden will be 10,000 hours per year. **Therefore, an additional 10,000 burden hours per year will be added to the USPTO’s current information collection inventory as a program change.**

There is non-hour cost burden in the form of postage costs associated with this information collection, which amounts to \$347 per year. **Therefore, an additional \$347 per year in the way of non-hour cost burden will be added to the USPTO’s current information collection inventory as a program change.**

16. Project Schedule

There is no plan to publish this information for statistical use. No special publication of the items discussed in this justification statement is planned.

17. Display of Expiration Date of OMB Approval

The form in this information collection (PTO/SB/42) will display the OMB Control Number and 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.