

SUPPLEMENTAL APPENDIX B

For reference, the statutory and regulatory provisions that authorize the USPTO to collect the information associated with fees in pending information collections that are impacted by this proposed rulemaking but have not received final approval from OMB are outlined in this supplemental document Appendix B. The information requirements themselves will remain in their existing information collection requests pending their approval by OMB.

PATENTS 0651-0031
Patent Processing (Updating)

Filing a Submission After Final Rejection (see 37 CFR 1.129(a)) is a pending item that is being added into the current renewal of this collection (expires 7/31/12). 60-Day FRN published 3/22/12; public comment period ended 5/21/12. Supporting Statement in Progress.

0031 – Pending Requirement	Statute	Rule
Filing a Submission After Final Rejection (see 37 CFR 1.129(a)) (paper and electronic)	35 U.S.C. §§ 120, 121, and 365(c)	37 CFR 1.116 and 1.129(a)

0031 Pending - Form and Function	Form #	Needs and Uses
Filing a Submission After Final Rejection (see 37 CFR 1.129(a))	No Form	<ul style="list-style-type: none"> • Used by the applicant to have a first submission entered and considered on the merits after final rejection under the conditions set forth at 37 CFR 1.129(a). • Used by the applicant to have a second submission entered and considered on the merits after a subsequent final rejection under the conditions set forth at 37 CFR 1.129(a). • Used by the USPTO to automatically withdraw the finality of the final rejection when the conditions of 37 CFR 1.129(a) have been met. • Used by the USPTO to automatically withdraw the finality of the subsequent final rejection when the conditions of 37 CFR 1.129(a) have been met.
Electronic Filing a Submission After Final Rejection (see 37 CFR 1.129(a))	No Form	<ul style="list-style-type: none"> • Used by the applicant to electronically submit a first submission to be entered and considered on the merits after final rejection under the conditions set forth at 37 CFR 1.129(a). • Used by the applicant to electronically submit a second submission to be entered and considered on the merits after a subsequent final rejection under the conditions set forth at 37 CFR 1.129(a). • Used by the USPTO to automatically withdraw the finality of the final rejection when the conditions of 37 CFR 1.129(a) have been met. • Used by the USPTO to automatically withdraw the finality of the subsequent final rejection when the conditions of 37 CFR 1.129(a) have been met.

PATENTS 0651-0064

Patent Reexaminations and Supplemental Examination

**AIA NPRM RIN 0651-AC69 Supporting Statement submitted to OMB for Review 1/25/12;
OMB Comment Filed 3/13/12**

0064 - Requirement	Statute	Rule
Request for Supplemental Examination	35 U.S.C. § 257	37 CFR 1.20(k), 1.26(c)(3), 1.601-1.625
Request for <i>Ex Parte</i> Reexamination	35 U.S.C. § 302	37 CFR 1.20(c)(1) and (7), 1.26(c)(1), 1.510-1.570
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	35 U.S.C. §§ 2, 303, and 312	37 CFR 1.20(c)(6), 1.181, 1.182, 1.183, 1.515(c), and 1.927
Patent Owner's 37 CFR 1.530 Statement	35 U.S.C. § 304	37 CFR 1.530
Third Party Requester's 37 CFR 1.535 Reply	35 U.S.C. § 304	37 CFR 1.535
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	35 U.S.C. §§ 132, 305, and 314	37 CFR 1.111, 1.530, 1.941, and 1.943
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	35 U.S.C. § 314	37 CFR 1.947
Response to Final Rejection in <i>Ex Parte</i> Reexamination	35 U.S.C. §§ 132 and 305	37 CFR 1.116 and 1.530
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	35 U.S.C. §§ 132 and 314	37 CFR 1.116 and 1.951
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	35 U.S.C. § 314	37 CFR 1.951
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	35 U.S.C. §§ 304-305 and 314	37 CFR 1.17(g), 1.550(c) and 1.956

0064- Form and Function	Form #	Needs and Uses
Request for Supplemental Examination Transmittal Form	PTO/SB/59	<ul style="list-style-type: none"> Used by the requester (patent owner) of a supplemental examination as a checklist to ensure compliance with the requirements of the statutes and rules for supplemental examinations. Used by the USPTO to ensure compliance by the requester (patent owner) with the requirements of the statutes and rules for supplemental examinations.
Request for Supplemental Examination	No Form	<ul style="list-style-type: none"> Used by the requester (patent owner) to provide: an identification of each aspect of the patent to be examined; an identification of each issue raised by each item of information listed in the request; a separate, detailed explanation for each identified issue; and an explanation of how each item of information is relevant to each aspect of the patent to be examined and of how each item of information raises each identified issue. Used by the USPTO to determine whether a substantial new question of patentability affecting any claim of the patent is raised by the items of information presented and identified in the request, and whether <i>ex parte</i> reexamination of the patent should be ordered under 35 U.S.C. § 257.

0064- Form and Function	Form #	Needs and Uses
Request for <i>Ex Parte</i> Reexamination Transmittal Form	PTO/SB/57	<ul style="list-style-type: none"> • Used by the requester (patent owner or third-party) of an <i>ex parte</i> reexamination as a checklist to ensure compliance with the requirements of the statutes and rules for <i>ex parte</i> reexaminations. • Used by the USPTO to ensure compliance by the requester (patent owner or third-party) with the requirements of the statutes and rules for <i>ex parte</i> reexaminations.
Request for <i>Ex Parte</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the requester (patent owner or third-party) to provide a statement identifying each substantial new question of patentability. • Used by the requester (patent owner or third-party) to provide an identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. • Used by the USPTO to evaluate whether a substantial new question of patentability has been raised by the requester (patent owner or third-party). • Used by the USPTO to determine how and whether the patent claims are to be confirmed, amended, or canceled.
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	No Form	<ul style="list-style-type: none"> • Used by the requester (patent owner or third-party) to request review by the Director of a decision refusing <i>ex parte</i> or <i>inter partes</i> reexamination. • Used by the requester to raise a question not specifically provided for in the rules or to request the suspension of the rules. • Used by the USPTO to determine whether the decision to refuse <i>ex parte</i> or <i>inter partes</i> reexamination should be upheld. • Used by the USPTO to consider other questions and suspend or waive the rule requirements if appropriate.
Patent Owner's 37 CFR 1.530 Statement	No Form	<ul style="list-style-type: none"> • Used by the patent owner in response to an order granting <i>ex parte</i> reexamination to point out why the patent claims are believed to be patentable. • Used by the patent owner in response to an order granting <i>ex parte</i> reexamination to propose that specified changes be made to the patent specification, including the claims, or to the drawings. • Used by the USPTO to determine whether the patent claims are patentable. • Used by the USPTO to enter, if in compliance with the rules, the specified changes for purposes of examination.
Third Party Requester's 37 CFR 1.535 Reply	No Form	<ul style="list-style-type: none"> • Used by the third-party requester to comment on Patent Owner's 37 CFR 1.530 Statement. • Used by the third-party requester to raise any issue appropriate for reexamination. • Used by the third-party requester to identify additional prior art patents and printed publications. • Used by the USPTO to determine whether the patent claims are patentable.
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the patent owner in response to an Office action to point out why the patent claims are believed to be patentable. • Used by the patent owner in response to an Office action to propose that specified changes be made to the patent specification, including the claims, or to the drawings. • Used by the USPTO to determine whether the patent claims are patentable. • Used by the USPTO to enter, if in compliance with the rules, the specified changes for purposes of examination.
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the third-party requester to comment on issues raised by an Office action or by patent owner's response to the Office action. • Used by the USPTO to determine whether the patent claims are patentable.

0064- Form and Function	Form #	Needs and Uses
Response to Final Rejection in <i>Ex Parte</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the patent owner in response to a final Office action to point out why the patent claims are believed to be patentable. • Used by the patent owner in response to a final Office action to propose that specified changes be made to the patent specification, including the claims, or to the drawings. • Used by the USPTO to determine whether the patent claims are patentable. • Used by the USPTO to determine whether the specified changes will be entered for purposes of examination.
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the patent owner in response to an Action Closing Prosecution to point out why the patent claims are believed to be patentable. • Used by the patent owner in response to an Action Closing Prosecution to propose that specified changes be made to the patent specification, including the claims, or to the drawings. • Used by the USPTO to determine whether the patent claims are patentable. • Used by the USPTO to determine whether the specified changes will be entered for purposes of examination.
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the third-party requester to comment on issues raised by an Action Closing Prosecution or by patent owner's response to the Action Closing Prosecution. • Used by the USPTO to determine whether the patent claims are patentable.
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> • Used by the public to request additional time to take action in a reexamination proceeding. • Used by the USPTO to determine whether the cause is sufficient to grant additional time to act in a reexamination proceeding.

PATENTS 0651-0069**Patent Review and Derivation Proceedings****AIA NPRM RINs 0651-AC70, AC71, AC72, AC73, AC74, and AC75 Supporting Statement submitted to OMB for Review 2/9/12; OMB Comment Filed 3/27/12**

0069 - Requirement	Statute	Rule
Petition for <i>Inter Partes</i> Review	35 U.S.C. § 312	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20, 42.21, 42.22, 42.24(a)(1), 42.63, 42.65, and 42.101 through 42.105
Petition for Post-Grant Review or Covered Business Method Patent Review	35 U.S.C. § 322	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20, 42.21, 42.22, 42.24(a)(2), 42.24(a)(3), 42.63, 42.65, 42.201 through 42.205, and 42.302 through 42.304
Petition for Derivation	35 U.S.C. § 135	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20, 42.21, 42.22, 42.24(a)(4), 42.63, 42.65, 42.402 through 42.406
Reply to Petition for <i>Inter Partes</i> Review	35 U.S.C. § 313	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.23, 42.24(c), 42.51, 42.52, 42.53, 42.54, 42.63 and 42.65
Reply to Petition for Post-Grant Review or Covered Business Method Patent Review	35 U.S.C. § 323	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.23, 42.24(c), 42.51, 42.52, 42.53, 42.54, 42.63 and 42.65
Request for Reconsideration	35 U.S.C. §§ 2(b)(2), 316(a)(13), and 326(a)(12)	37 CFR 42.71
Motions, Replies and Oppositions After Institution in <i>Inter Partes</i> Review	35 U.S.C. § 316	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.22, 42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51, 42.52, 42.53, 42.54, 42.63, 42.64, 42.65, 42.107, 42.120, 42.121, and 42.123
Motions, Replies and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	35 U.S.C. § 326	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.22, 42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51, 42.52, 42.53, 42.54, 42.63, 42.64, 42.65, 42.221, 42.207, 42.220 and 42.223
Motions, Replies and Oppositions in Derivation Proceeding	35 U.S.C. § 135(b)	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.22, 42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51, 42.52, 42.53, 42.54, 42.63, 42.64, 42.65
Request for Oral Hearing	35 U.S.C. §§ 2(b)(2), 316(a)(10), and 326(a)(10)	37 CFR 42.70
Request to Treat a Settlement as Business Confidential	35 U.S.C. §§ 135(e), 317(a), and 327(a)	37 CFR 42.74(c) and 42.410
Request for Adverse Judgment, Default Adverse Judgment or Settlement	35 U.S.C. §§ 2(b)(2), 135(e), 317, and 327	37 CFR 42.73(b) and 42.74(b)
Arbitration Agreement and Award	35 U.S.C. § 135(f)	37 CFR 42.410

Request to Make a Settlement Agreement Available	35 U.S.C. §§ 135(e), 317(b), and 327(b)	37 CFR 42.74(c)
Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. § 142)	35 U.S.C. §§ 141, 142, 145, and 146	37 CFR 90.1 through 90.3

0069 - Form and Function	Form #	Needs and Uses
Petition for <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> Used by parties who are not the owners of a patent to file a petition to institute an <i>inter partes</i> review of a patent. Used by parties to request to cancel as unpatentable one or more claims of a patent only on a ground that could be raised under 35 U.S.C. § 102 or 103 and only on the basis of prior art consisting of patents or printed publications. Used by parties to demonstrate that they have standing to file the petition (i.e., the patent is available for <i>inter partes</i> review and the petitioner is not barred from requesting such review). Used by the Board to determine whether to institute an <i>inter partes</i> review including whether the petition identifies all real parties in interest, identifies each claim challenged (including the grounds on which the challenge to each claim is based, and the evidence that supports the grounds), provides copies of the necessary documents, and that the necessary fee is included.
Petition for Post-Grant Review or Covered Business Method Patent Review	No Form Associated	<ul style="list-style-type: none"> Used by parties who are not owners of a patent to file a petition to institute a post-grant review of a patent. Used by parties to request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under 35 U.S.C. § 282(b)(2) or (3) (relating to invalidity of the patent or any claim) as part of a post-grant review. Used by parties to file a petition for a transitional proceeding with respect to a covered business method patent when the person or person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent. Used by the Board to determine whether to institute a post-grant review including whether the petition identifies all real parties in interest, identifies each claim challenged (including the grounds on which the challenge to each claim is based and the evidence that supports the grounds), provides copies of the necessary documents, and that the necessary fee is included. Used by the Board to determine whether to institute a transitional proceeding for covered business method patents including whether a claim is a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service and not a technological invention.
Petition for Derivation	No Form Associated	<ul style="list-style-type: none"> Used by an applicant for patent to petition the Board to institute a derivation proceeding. Used by the applicant to demonstrate that they have standing to file the petition for derivation (i.e., timely filing a petition that demonstrates that the earlier filed application derived the claimed invention and was filed by another inventor without authorization and that the applicant has taken steps to obtain patent protection for the invention). Used by the Board to determine whether to institute a derivation proceeding as long as the necessary requirements are met (i.e., the petition identifies the precise relief requested, the petition is filed within one year after the first publication of a claim to an invention, the fee is submitted with the petition).

0069 - Form and Function	Form #	Needs and Uses
Reply to Petition for <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> • Used by patent owner to set forth reasons why no <i>inter partes</i> review should be instituted. • Used by the Board together with the petition for <i>inter partes</i> review to determine whether to institute an <i>inter partes</i> review.
Reply to Petition for Post-Grant Review or Covered Business Method Patent Review	No Form Associated	<ul style="list-style-type: none"> • Used by patent owner to set forth reasons why no post-grant review or covered business method review should be instituted. • Used by the Board together with the petition for post-grant review or covered business method review to determine whether to institute a post-grant review or covered business method review.
Request for Reconsideration	No Form Associated	<ul style="list-style-type: none"> • Used by parties to request the Board to reconsider the decision not to institute a trial or another decision. • Used by the Board to review the original decision to not institute a trial or another decision.
Motions, Replies and Oppositions After Institution in <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> • Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for <i>inter partes</i> review. • Used by the opposing parties to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the Board in issuing a final written decision with respect to patentability of a challenged patent claim.
Motions, Replies and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	No Form Associated	<ul style="list-style-type: none"> • Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for post-grant review or covered business method patent review. • Used by the opposing parties to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the Board in issuing a final written decision with respect to patentability of a challenged patent claim.
Motions, Replies and Oppositions in Derivation Proceeding	No Form Associated	<ul style="list-style-type: none"> • Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for a derivation proceeding. • Used by the opposing parties to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the Board in issuing a final written decision with respect to the alleged derivation.
Request for Oral Hearing	No Form Associated	<ul style="list-style-type: none"> • Used by parties to request an oral hearing. • Used by the Board to schedule an oral hearing if appropriate.
Request to Treat a Settlement as Business Confidential	No Form Associated	<ul style="list-style-type: none"> • Used by parties to request that the settlement agreement be kept confidential and be filed separately from the patent or application file. • Used by the Board to provide that the settlement agreement be designated as business confidential and kept separately from the publicly available patent or application files.
Request for Adverse Judgment, Default Adverse Judgment or Settlement	No Form Associated	<ul style="list-style-type: none"> • Used by a party to concede the contest. • Used by the Board to render judgment against the party conceding the contest.

0069 - Form and Function	Form #	Needs and Uses
Arbitration Agreement Award	No Form Associated	<ul style="list-style-type: none"> • Used by parties to give notice to the Office of the result of an arbitration between parties. • Used by the Board to update the records of an instituted derivation proceeding.
Request to Make a Settlement Agreement Available	No Form Associated	<ul style="list-style-type: none"> • Used by a requester to gain access to a settlement agreement. • Used by the Board to determine whether the requester may be granted access to the settlement agreement.
Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. § 142)	No Form Associated	<ul style="list-style-type: none"> • Used by parties to notify the USPTO that a party has filed a notice of appeal or election. • Used by the Board to recognize that the final decision of the Board has been appealed.

PATENTS 0651-00xx
Matters Related to Patent Appeals

60-Day FRN published 1/4/12; public comment period ended 3/5/12. Supporting Statement in Progress (Items are currently covered under 0651-0031 and will be transferred into this collection once it is established).

Matters Related to Patent Appeals - Requirement	Statute	Rule
Notice of Appeal (paper and electronic)	35 U.S.C. §134	37 CFR 1.191
Request for Oral Hearing Before the Board of Patent Appeals and Interferences (paper and electronic)	35 U.S.C. §134	37 CFR 1.194(b)
Pre-Appeal Brief Request for Review (paper and electronic)	35 U.S.C. §§2(b)(2) and 134	37 CFR 41.32

Matters Related to Patent Appeals - Form and Function	Form #	Needs and Uses
Notice of Appeal	PTO/SB/31	<ul style="list-style-type: none"> Used by the applicant to file a Notice of Appeal. Used by the USPTO to ensure that applicants comply with regulations when filing a Notice of Appeal.
Electronic Notice of Appeal	PTO/SB/31	<ul style="list-style-type: none"> Used by the applicant to file a Notice of Appeal electronically. Used by the USPTO to ensure that applicants comply with regulations when filing a Notice of Appeal.
Request for Oral Hearing Before the Board of Patent Appeals and Interferences	PTO/SB/32	<ul style="list-style-type: none"> Used by the applicant to file a written request in a separate paper for an oral hearing before the Board. Used by the USPTO to process and consider the request for an oral appeal hearing.
Electronic Request for Oral Hearing Before the Board of Patent Appeals and Interferences	PTO/SB/32	<ul style="list-style-type: none"> Used by the applicant to electronically file a written request in a separate paper for an oral hearing before the Board. Used by the USPTO to process and consider the request for an oral appeal hearing.
Pre-Appeal Brief Request for Review	PTO/SB/33	<ul style="list-style-type: none"> Used by the applicant to request that a panel of examiners formally review the basis of the rejections in their application prior to filing an appeal brief. Used by the USPTO to determine whether an appeal should be maintained.
Electronic Pre-Appeal Brief Request for Review	PTO/SB/33	<ul style="list-style-type: none"> Used by the applicant to electronically request that a panel of examiners formally review the basis of the rejections in their application prior to filing an appeal brief. Used by the USPTO to determine whether an appeal should be maintained.