

SUPPORTING STATEMENT
United States Patent and Trademark Office
Matters Related to First Inventor to File
OMB CONTROL NUMBER 0651-00xx
June 28, 2012

A. JUSTIFICATION

1. Necessity of Information Collection

The Leahy-Smith America Invents Act was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 283 (2011). Section 3 of the Leahy-Smith America Invents Act, *inter alia*, amends the patent laws to: (1) convert the United States patent system from a “first to invent” system to a “first inventor to file” system; (2) treat U.S. patents and U.S. patent application publications as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the U.S. or in another country; (3) eliminate the requirement that a prior public use or sale be “in this country” to be a prior art activity; and (4) treat commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of 35 U.S.C. § 102, as well as 35 U.S.C. § 103. These changes in section 3 of the Leahy-Smith America Invents Act are effective on March 16, 2013, but apply only to certain applications filed on or after March 16, 2013.

The USPTO published a notice of proposed rulemaking titled “Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act” (RIN 0651-AC77) in the *Federal Register*. In the notice, the USPTO proposed changes to the rules of practice in title 37, CFR, for consistency with, and to address the examination issues raised by, the changes in section 3 of the Leahy-Smith America Invents Act.

In support of the proposed rulemaking, the USPTO is submitting this new information collection, Matters Related to First Inventor to File. 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 provides the statutes and regulations authorizing the USPTO to collect the information:

Table 1: Information Requirements for Matters Related to First Inventor to File

Requirement	Statute	Rule
Submissions Under 37 CFR 1.55(a)(4)	35 U.S.C. § 2(b)(2)	37 CFR 1.55(a)(4)
Submissions Under 37 CFR 1.78(a)(3)	35 U.S.C. § 2(b)(2)	37 CFR 1.78(a)(3)

Requirement	Statute	Rule
Submissions Under 37 CFR 1.78(c)(2)	35 U.S.C. § 2(b)(2)	37 CFR 1.78(c)(2)
Identification of Inventorship and Ownership of the Subject Matter of Individual Claims Under 37 CFR 1.110	35 U.S.C. §§ 2(b)(2), 102, and 103	37 CFR 1.110
Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	35 U.S.C. §§ 2(b)(2), 102, and 103	37 CFR 1.130, 1.131, and 1.132

2. Needs and Uses

This information collection is necessary so that patent applicants and/or patentees may: (1) provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013: (2) provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application: (3) identify the inventor, and ownership on the effective filing date, of each claimed invention in an application or patent with more than one named inventor, when necessary for purposes of a USPTO proceeding; and (4) show that a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor, or that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor.

The USPTO will use the statement that a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, or that such application does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application (or lack of such a statement) to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. §§ 102 and 103 in the AIA. The USPTO will use the identification of the inventor, and ownership on the effective filing date, when it is necessary to determine whether a U.S. patent or U.S. patent application publication resulting from another nonprovisional application qualifies as prior art under 35 U.S.C. § 102(a)(2). The USPTO will use information concerning whether a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor, or that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor, to determine whether the disclosure qualifies as prior art under 35 U.S.C. § 102(a)(1) or (a)(2).

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.

Table 2 outlines how this collection of information is used by the public and the USPTO:

Table 2: Needs and Uses for Matters Related to First Inventor to File

Form and Function	Form #	Needs and Uses
Submissions Under 37 CFR 1.55(a)(4)	No Form	<ul style="list-style-type: none"> • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that as an effective filing date on or after March 16, 2013. • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application. • Used by the USPTO to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. §§ 102 and 103 in the Leahy-Smith America Invents Act.
Submissions Under 37 CFR 1.78(a)(3)	No Form	<ul style="list-style-type: none"> • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the provisional application. <p>Used by the USPTO to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. §§ 102 and 103 in the Leahy-Smith America Invents Act.</p>
Submissions Under 37 CFR 1.78(c)(2)	No Form	<ul style="list-style-type: none"> • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. • Used by patent applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the nonprovisional application filed prior to March 16, 2013. • Used by the USPTO to readily determine whether the nonprovisional application filed on or after March 16, 2013, is subject to the changes to 35 U.S.C. §§ 102 and 103 in the Leahy-Smith America Invents Act.

Form and Function	Form #	Needs and Uses
Identification of Inventorship and Ownership of the Subject Matter of Individual Claims Under 37 CFR 1.110	No Form	<ul style="list-style-type: none"> • Used by patent applicants and patent owners to identify the inventor, and ownership on the effective filing date, of each claimed invention in an application or patent with more than one named inventor, when necessary for purposes of a USPTO proceeding. • Used by the USPTO when it is necessary to determine whether a U.S. patent or U.S. patent application publication resulting from another nonprovisional application qualifies as prior art under 35 U.S.C. § 102(a)(2)
Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	No Form	<ul style="list-style-type: none"> • Used by patent applicants and patent owners to show that a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor, or that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor. • Used by patent applicants and patent owners to submit evidence by way of an oath or declaration to traverse a rejection or objection on a basis not otherwise provided for, when any claim of an application or a patent under reexamination is rejected or objected to. • Used by the USPTO to determine whether the disclosure qualifies as prior art under 35 U.S.C. § 102(a)(1) or (a)(2). • Used by the USPTO to determine whether to maintain a rejection or objection of a claim of an application or a patent under reexamination.

3. Use of Information Technology

The items in this collection may be submitted online using EFS-Web, the USPTO's Web-based electronic filing system.

EFS-Web allows customers to file patent applications and associated documents electronically through their standard Web browser without downloading special software, changing their document preparation tools, or altering their workflow processes. Typically, the customer will prepare the documents as standard PDF files and then upload them to the USPTO servers using the secure EFS-Web interface. EFS-Web offers many benefits to filers, including immediate notification that a submission has been received by the USPTO, automated processing of requests, and avoidance of postage or other paper delivery costs.

4. Efforts to Identify Duplication

The information collected is required in order to readily determine whether: nonprovisional applications are subject to the changes to 35 U.S.C. §§ 102 and 103 in the AIA; a U.S. patent or U.S. patent application publication resulting from another nonprovisional application qualifies as prior art under 35 U.S.C. § 102(a)(2); a disclosure qualifies as prior art under 35 U.S.C. § 102(a)(1) or (a)(2); and a rejection or objection of a claim of an application or a patent under reexamination should be maintained. 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 will not impose a significant economic impact on a substantial number of small entities. The same information will be required from every member of the public in the applicable situation and will not be available from any other source. In addition, there are no filing fees associated with this information collection.

6. Consequences of Less Frequent Collection

The information in this collection is collected only when: certain nonprovisional applications filed on or after March 16, 2013, claim the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013 (submissions under 37 CFR 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2)); necessary for purposes of a USPTO proceeding (identification of inventorship and ownership of the subject matter of individual claims under 37 CFR 1.110); needed to determine whether the disclosure qualifies as prior art under 35 U.S.C. § 102(a)(1) or (a)(2) (1.130, 1.131, and 1.132 affidavits or declarations); and needed to submit evidence by way of an oath or declaration to traverse a rejection or objection on a basis not otherwise provided for, when any claim of an application or a patent under reexamination is rejected or objected to (1.130, 1.131, and 1.132 affidavits or declarations). Less frequent collection of submissions under 37 CFR 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2) would cause examination costs to significantly increase. Less frequent collection of identifications of inventorship and ownership of the subject matter of individual claims under 37 CFR 1.110 and 37 CFR 1.130, 1.131, and 1.132 affidavits or declarations would impact the USPTO's duty under 35 U.S.C. §§ 131 and 151 to issue a patent where "it appears that the applicant is entitled to a patent under the law." Thus, the information in this collection 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 USPTO published a notice of proposed rulemaking titled "Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act" (RIN 0651-AC77) in the *Federal Register* and is seeking comments from the public on the notice of proposed rulemaking and will consider any comments received in development of the final rule.

The USPTO has consulted with the public about the AIA in general through the agency microsite at http://www.uspto.gov/aia_implementation/index.jsp.

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. Views expressed by these groups are 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

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). Therefore, the information collected by this collection will necessarily be available to the public when it is filed in a published application or issued patent, or, if it is filed in an application that has yet to publish or issue as a patent, when the application publishes or issues as a patent.

11. Justification for Sensitive Questions

None of the required information is considered to be sensitive.

12. Estimate of Hour and Cost Burden to Respondents

Table 3a calculates the 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 approximately 189,150 responses per year for this collection, of which approximately 47,000 will be filed by small entities. The USPTO estimates that approximately 175,910 of the responses for this collection will be submitted electronically via EFS-Web.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected by these items.

- **Burden Hour Calculation Factors**

The USPTO estimates that the responses in this collection will take the public from 2 to 10 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO. Specifically, the USPTO estimates that: (1) preparing an affidavit or declaration under 37 CFR 1.130, 1.131, or 1.132 will require, on average, 10 hours; (2) identifying under 37 CFR 1.55(a)(4), 1.78(a)(3), or 1.78(c)(2) whether there is any claim or subject matter not disclosed in the prior foreign, provisional, or nonprovisional application will require, on average, 2 hours; and (3) identifying under 37 CFR 1.110 inventorship and ownership of the subject matter of claims will require, on average, 2 hours. 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.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected and the length of time necessary to complete responses containing similar or like information.

- **Cost Burden Calculation Factors**

The USPTO uses a professional rate of \$371 per hour for respondent cost burden calculations, which is the mean 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). Based on the Agency's long-standing institutional knowledge of and experience with the type of information collected, the Agency believes \$371 is an accurate estimate of the cost per hour to collect this information.

Table 3a: Burden Hour/Burden Cost to Respondents for Matters Related to First Inventor to File

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
Electronic Submissions Under 37 CFR 1.55(a)(4)	2.0	65,100	130,200	\$371.00	\$48,304,200.00
Submissions Under 37 CFR 1.55(a)(4)	2.0	4,900	9,800	\$371.00	\$3,635,800.00
Electronic Submissions Under 37 CFR 1.78(a)(3)	2.0	53,010	106,020	\$371.00	\$39,333,420.00
Submissions Under 37 CFR 1.78(a)(3)	2.0	3,990	7,980	\$371.00	\$2,960,580.00
Electronic Submissions Under 37 CFR 1.78(c)(2)	2.0	11,160	22,320	\$371.00	\$8,280,720.00
Submissions Under 37 CFR 1.78(c)(2)	2.0	840	1,680	\$371.00	\$623,280.00
Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2.0	140	280	\$371.00	\$103,880.00
Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2.0	10	20	\$371.00	\$7,420.00
Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10.0	46,500	465,000	\$371.00	\$172,515,000.00
Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10.0	3,500	35,000	\$371.00	\$12,985,000.00
Total	- - - -	189,150	778,300	- - - -	\$288,749,300.00

Table 3b shows the impact of the rulemaking and non-rulemaking changes to the burden estimates for this information collection:

Table 3b: Burden Changes – Rulemaking/Non-Rulemaking Impact

	Current Inventory	Rulemaking Impact	Non-rule Impact	New Proposed Burden Estimate
Responses	0	Increase of 189,150	0	189,150

Burden Hours	0	Increase of 778,300	0	778,300
Respondent Cost Burden	0	Increase of \$288,749,300	0	\$288,749,300

13. Total Annualized Cost Burden

There are postage costs associated with the items in this collection. Specifically, 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 these submissions will be sent by priority mail and that they will weigh no more than one pound. The USPTO estimates that the average priority postage cost for a one-pound submission will be \$4.95 and that approximately 13,240 will be mailed to the USPTO.

The USPTO estimates that the total annualized (non-hour) cost burden for this collection is due to postage costs of \$65,539 per year.

Table 4a shows the postage costs for this collection.

Table 4a: Postage Costs for Respondents for Matters Related to First Inventor to File

Item	Estimated Annual Mailed Responses	Estimated Postage Amount	Estimated Annual Postage Costs
Submissions Under 37 CFR 1.55(a)(4)	4,900	\$4.95	\$24,255.00
Submissions Under 37 CFR 1.78(a)(3)	3,990	\$4.95	\$19,751.00
Submissions Under 37 CFR 1.78(c)(2)	840	\$4.95	\$4,158.00
Identification of Inventorship and Ownership of the Subject Matter of Individual Claims Under 37 CFR 1.110	10	\$4.95	\$50.00
Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	3,500	\$4.95	\$17,325.00
Totals	13,240	-----	\$65,539.00

Table 4b shows the impact of the rulemaking and non-rulemaking changes to the annual (non-hour) cost burden estimates for this information collection:

Table 4b: Annual (Non-Hour) Cost Burden Changes – Rulemaking/Non-Rulemaking Impact

	Current Inventory	Rulemaking Impact	Non-rule Impact	New Proposed Burden Estimate
Fees	0	Increase of \$0	0	\$0
Postage	0	Increase of \$65,539	0	\$65,539
Total Annual (Non-hour) Cost Burden	0	Increase of \$65,539	0	\$65,539

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-7, step 1 employee approximately 15 minutes (0.25 hours) on average to process the submissions under 37 CFR 1.55(a)(4),

1.78(a)(3), and 1.78(c)(2), and the identification of inventorship and ownership of the subject matter of individual claims under 37 CFR 1.110. The USPTO estimates that it will take approximately 30 minutes (.50 hours) on average to process the rule 1.130, 1.131, and 1.132 affidavits or declarations.

The hourly rate for a GS-7, step 1, employee 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).

Estimates are based upon agency long-standing institutional knowledge of and experience with processing the type of information collected and the length of time necessary to process similar or like information.

Table 5 calculates the burden hours and costs to the Federal Government for processing the items in this information collection:

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 Submissions Under 37 CFR 1.55(a)(4)	0.25	65,100	16,275	\$26.29	\$427,870.00
Submissions Under 37 CFR 1.55(a)(4)	0.25	4,900	1,225	\$26.29	\$32,205.00
Electronic Submissions Under 37 CFR 1.78(a)(3)	0.25	53,010	13,253	\$26.29	\$348,421.00
Submissions Under 37 CFR 1.78(a)(3)	0.25	3,990	998	\$26.29	\$26,237.00
Electronic Submissions Under 37 CFR 1.78(c)(2)	0.25	11,160	2,790	\$26.29	\$73,349.00
Submissions Under 37 CFR 1.78(c)(2)	0.25	840	210	\$26.29	\$5,521.00
Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	140	35	\$26.29	\$920.00
Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	10	3	\$26.29	\$79.00
Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	0.50	46,500	23,250	\$26.29	\$611,243.00
Rule 1.130, Rule 1.131, and 1.132 Affidavits or Declarations	0.50	3,500	1,750	\$26.29	\$46,008.00
Total	- - - -	189,150	59,789	- - - -	\$1,571,853.00

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 the First Inventor to File Provisions of the Leahy-Smith America Invents Act” (RIN 0651-AC77). In the notice, the USPTO proposed changes to the rules of practice in title 37, CFR, for consistency with, and to address the examination issues raised by, the changes in section 3 of the Leahy-Smith America Invents Act.

The USPTO estimates that it will receive 189,150 responses for this collection annually, with an associated burden of 778,300 hours per year and estimated respondent costs of \$288,749,300. **Therefore, the USPTO estimates that 778,300 burden hours per year will be added to the USPTO’s current information collection inventory as a program change.**

There is annual (non-hour) cost burden in the form of postage costs associated with this information collection, which amounts to \$65,539 per year. **Therefore, the USPTO estimates that \$65,539 in non-hour costs per year 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

There are no forms in this information collection. Therefore, the display of the OMB Control Number and the expiration date is not applicable.

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.