

SUPPORTING STATEMENT
United States Patent and Trademark Office
Post Patent Public Submissions
OMB CONTROL NUMBER 0651-0067
(June 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.

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 may be submitted in the file of an issued patent to include written statements of a 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. Section 6(g) of the Leahy-Smith America Invents Act is effective on September 16, 2012.

The USPTO published a final rule 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 rewrites 37 CFR 1.501 to implement 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) provides for any person to submit in the patent file written "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." Section 1.501, implementing 35 U.S.C. 301(a)(2), provides that a submission may include prior art and written patent owner claim scope statements.

In light of the final rule, the USPTO is submitting this new information collection, Post Patent Public Submissions. The item associated with this collection, "Information Disclosure Citation in a Patent" (PTO/SB/42), is currently in the 0651-0031 Patent Processing (Updating) approved inventory and will be deleted from that collection when this one is approved. 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 submit, in a patent file, prior art patents and printed publications that a person making the submission believes to have a bearing on the patentability of any claim of the patent, and statements of the patent owner that were filed by the patent owner 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 that were filed by the patent owner in a proceeding before a Federal court or the USPTO will be limited 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 already 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.

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 submit, in a patent file, prior art patents and printed publications that a person making the submission believes to have a bearing on the patentability of any claim of the patent, and statements of the patent owner that were filed by the patent owner 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 will permit information disclosure citations in a patent to be submitted via its electronic filing system (EFS-Web). However, a submission made by a party other

than the patent owner will not be entered into the patent's Image File Wrapper (IFW) if it does not include proof of service compliant with 37 CFR 1.248(b). 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 final rule 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 patents or printed publications that a person making the submission believes to have a bearing on the patentability of any claim of a particular patent, or (b) statements of the patent owner that were filed by the patent owner 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-AC66) in the *Federal Register* and sought comments from the public on the notice of proposed rulemaking and considered those comments 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, 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

The information will be collected from any person who elects to cite, in an issued patent, prior art patents or printed publications, or statements of the patent owner that were filed by the patent owner 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. 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, 37 CFR 1.501(d) states that “[i]f the person making the submission wishes his or her identity to be excluded from the patent file and kept confidential, the submission papers must be submitted anonymously without any identification of the person making the submission.”

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.

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 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.

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

- **Cost Burden Calculation Factors**

The USPTO estimates a rate of \$371 per hour. 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 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	\$371.00	\$3,450,300.00
Information Disclosure Citation in a Patent	10.0	70	700	\$371.00	\$259,700.00
Total	- - - - -	1,000	10,000	- - - - -	\$3,710,000.00

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).

Estimates are based on the Agency’s 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 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 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 final rule titled “Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act” (RIN 0651-AC66). In the final rule, the USPTO rewrites 37 CFR 1.501 to implement 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 final rule 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.

Changes in Responses, Burden Hours, and Respondent Cost Burden

The Information Disclosure Citation in a Patent (PTO/SB/42) is currently in the 0651-0031 Patent Processing (Updating) approved inventory and is being moved into this collection. This item is currently approved with 1,830 estimated responses and 3,660 burden hours, with an estimated time per response of 2 hours and a total respondent cost burden of \$1,112,640 based on a previous estimated attorney rate of \$304 per hour.

Based on the most recent available data, the USPTO estimates that it receives approximately 600 Information Disclosure Citations per year with a revised estimated time per response of 10 hours, for a total of 6,000 burden hours. These adjustments are due to non-rule factors. As noted in Section 12 above, the USPTO estimates the current hourly rate for respondents to be \$371. This is the mean attorney rate published in the American Intellectual Property Law Association (AIPLA) Report of the Economic Survey, which is published every two years. Based on the USPTO’s institutional

knowledge of and experience with the type of information in this collection, the USPTO estimates \$371 to be an accurate benchmark. Using the updated estimated attorney rate of \$371 per hour, the total respondent cost burden for the adjusted estimate of 6,000 burden hours is \$2,226,000.

For this final rule submission, the USPTO estimates that it will receive 1,000 responses per year, which is an increase of 400 responses and 4,000 burden hours per year due to the rule impact. Using the updated estimated attorney rate of \$371 per hour, this increase of 4,000 burden hours results in a corresponding increase of \$1,484,000 in respondent cost burden due to the rule impact, for a revised total estimate of 10,000 burden hours and \$3,710,000 in respondent cost burden for this collection. These changes are summarized in Table 5 below.

Changes in Annual (Non-hour) Cost Burden

The Information Disclosure Citation in a Patent (PTO/SB/42) is currently in the 0651-0031 Patent Processing (Updating) approved inventory with associated annual (non-hour) cost burden of \$1,061 from postage costs. Based on the adjusted estimate of 600 responses per year and a revised estimated postage cost of \$4.95 per submission, the total postage cost would be \$2,970, an increase of \$1,909 due to non-rule factors.

For this final rule submission, the USPTO estimates that the total postage cost for this collection will be \$347. Although the estimated responses are increasing from the rule impact, the USPTO expects a large decrease in the number of submissions by mail due to increased electronic filing (non-rule impact), resulting in a net decrease of \$2,623 in total postage costs for this collection. These changes are summarized in Table 5 below.

Rulemaking/Non-Rulemaking Impact

Table 5: Changes – Rulemaking/Non-Rulemaking Impact

	Current Inventory Moved from 0651-0031 (Non-rule Impact)	Administrative Adjustments to Burden Estimates (Non-rule Impact)	Net Estimated Burden Before Rule	Rulemaking Impact	Additional Non-rule Impact	New Proposed Burden Estimates
Responses	1,830	Decrease of 1,230	600	Increase of 400	0	1,000
Hours	3,660	Increase of 2,340	6,000	Increase of 4,000	0	10,000
Respondent Cost Burden	\$1,112,640	Increase of \$1,113,360	\$2,226,000	Increase of \$1,484,000	0	\$3,710,000
(Non-Hour) Cost Burden (Postage)	\$1,061	Increase of \$1,909	\$2,970	\$0	Decrease of \$2,623	\$347

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.