

SUPPORTING STATEMENT
United States Patent and Trademark Office
Patent Reexaminations and Supplemental Examinations
(formerly Patent Reexaminations)
OMB CONTROL NUMBER 0651-0064
(July 13, 2012)

A. Justification

1. Necessity of Information Collection

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. §§ 131 and 151 to examine applications and, when appropriate, allow applications and issue them as patents. Chapter 30 of Title 35 U.S.C. provides that any person at any time may file a request for reexamination by the USPTO of any claim of a patent on the basis of prior art patents or printed publications. Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from third parties. Chapter 31 of Title 35 U.S.C. provides for *inter partes* reexamination allowing third parties to participate throughout the reexamination proceeding. If a request for *ex parte* or *inter partes* reexamination is denied, the requester may petition the Director to review the examiner's refusal of reexamination. The rules outlining *ex parte* and *inter partes* reexaminations are found at 37 CFR 1.510-1.570 and 1.902-1.997.

The Requests for *Ex Parte* and *Inter Partes* Reexamination are distinct collections from the Request for *Ex Parte* Reexamination Transmittal Form and the Request for *Inter Partes* Reexamination Transmittal Form, respectively. Whereas the Transmittal Forms are used by a requester (patent owner or third party) as a checklist to ensure compliance with the requirements of the statutes and rules for *ex parte* and *inter partes* reexaminations, the Requests themselves represent the substantive analysis undertaken by a requester of reexamination. Other items included in this collection cover additional information that may be submitted by patent owners and third-party requesters in relation to a reexamination proceeding.

The Patent Owner's 37 CFR 1.530 Statement allows patent owners to respond to an order for *ex parte* reexamination with a statement pointing out why the patent claims are believed to be patentable, considering the cited prior art patents or printed publications alone or in any reasonable combination. The Statement also allows patent owners to propose narrowing amendments to the patent claims in response to an order for *ex parte* reexamination. The Third Party Requester's 37 CFR 1.535 Reply allows third-party requesters to respond to the Patent Owner's 37 CFR 1.530 Statement. The Reply may include additional prior art patents and printed publications and may raise any issue appropriate for *ex parte* reexamination.

Amendments in *Ex Parte* or *Inter Partes* Reexaminations allow patent owners to respond to Office actions by pointing out why the patent claims are believed to be patentable. Amendments also allow patent owners to propose narrowing amendments to the patent claims. The Third Party Requester's 37 CFR 1.947 Comments in *Inter Partes* Reexamination allow third-party requesters during the examination stage of an *inter partes* reexamination to file written comments on any patent owner response to an Office action. The Comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

Responses to Final Rejections in *Ex Parte* Reexaminations allow patent owners to respond to final rejections in *ex parte* reexaminations by pointing out why the patent claims are believed to be patentable. Responses also allow patent owners to propose narrowing amendments to the patent claims.

The Patent Owner's 37 CFR 1.951 Response in *Inter Partes* Reexaminations allows patent owners to respond to Actions Closing Prosecution in *inter partes* reexaminations by pointing out why the patent claims are believed to be patentable. Responses also allow patent owners to propose narrowing amendments to the patent claims. The Third Party Requester's 37 CFR 1.951 Comments in *Inter Partes* Reexamination allow third-party requesters in an *inter partes* reexaminations to file written comments on any patent owner response to an Action Closing Prosecution. The Comments must be directed to the patent owner's response to an Action Closing Prosecution and/or the issues raised in the Action Closing Prosecution.

The USPTO published a final rule titled "Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees" (RIN 0651-AC69) in the *Federal Register*. In the final rule, the USPTO is revising the rules of practice in title 37 of the Code of Federal Regulations (CFR) to implement the supplemental examination provisions of section 12 of the Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). The supplemental examination provisions permit a patent owner to request supplemental examination of a patent by the USPTO to consider, reconsider, or correct information believed to be relevant to the patent. These provisions could assist the patent owner in addressing certain challenges to the enforceability of the patent during litigation. The USPTO is also setting certain fees to implement supplemental examination, adjusting the fee for filing a Request for *Ex Parte* Reexamination, and setting a fee for petitions filed in reexamination proceedings to more accurately reflect the estimated average cost to the Office for these processes.

In support of the final rule, the USPTO is submitting this information collection to add new information requirements and update existing information requirements that would be impacted by the rulemaking. The modifications to this information collection include the following:

- Addition of Requests for Supplemental Examination and associated fees.
- Revision of estimated annual responses for existing items related to *ex parte* reexaminations that would be impacted by the addition of supplemental examinations.
- Revision of fees for reexamination items as outlined in the final rule notice, including refunds for refused reexamination requests and updated fees for certain petitions in reexamination proceedings.
- Adjustment of time estimates for Requests for *Ex Parte* and *Inter Partes* Reexamination based on recent data.
- Minor revision to Form PTO/SB/57 to support the final rule, allowing the respondent to certify that the statutory estoppel provisions of 35 U.S.C. § 315 (e)(1) or 35 U.S.C. § 325 (e)(1) do not prohibit the respondent from filing the request for *ex parte* reexamination. (See 37 CFR 1.510 (b)(6).)

Table 1 provides the specific statutes and regulations authorizing the USPTO to collect the information discussed above:

Table 1: Information Requirements

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
Request for <i>Inter Partes</i> Reexamination	35 U.S.C. § 311	37 CFR 1.26(c)(2), 1.902-1.997
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

2. Needs and Uses

The public will use this information collection to request supplemental examination and reexamination proceedings and to ensure that the associated fees and documentation are submitted to the USPTO.

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 will be used by the public and the USPTO:

Table 2: Needs and Uses

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.
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.

Form and Function	Form #	Needs and Uses
Request for <i>Inter Partes</i> Reexamination Transmittal Form	PTO/SB/58	<ul style="list-style-type: none"> Used by a third-party requester of an <i>inter partes</i> reexamination as a checklist to ensure compliance with the requirements of the statutes and rules for <i>inter partes</i> reexamination. Used by the USPTO to ensure compliance by the third-party requester with the requirements of the statutes and rules for <i>inter partes</i> reexamination.
Request for <i>Inter Partes</i> Reexamination	No Form	<ul style="list-style-type: none"> Used by the third-party requester to provide a statement identifying each substantial new question of patentability. Used by the third-party requester 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 third-party requester. 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.

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.

3. Use of Information Technology

The forms associated with this collection may be downloaded from the USPTO Web site in Portable Document Format (PDF) and filled out electronically. Requests for Supplemental Examination and the other 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 forms or 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

This information is collected only when a respondent files a request related to patent reexamination or supplemental examination. This information is not collected elsewhere and does not result in a duplication of effort.

5. Minimizing Burden to Small Entities

The information in this collection is necessary in order to process requests related to patent reexaminations and supplemental examinations. The same information is required from every requester and is not available from any other source.

6. Consequences of Less Frequent Collection

This information is collected only when the public submits an item related to a request for reexamination or supplemental examination and is not found elsewhere. If the information were not collected, the USPTO would not be able to comply with the statutes and regulations governing reexaminations and supplemental examinations. This information 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. Consultations Outside the Agency

The USPTO published a notice of proposed rulemaking titled “Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees” (RIN 0651-AC69) in the *Federal Register* on January 25, 2012 (77 Fed. Reg. 3666). The USPTO received comments from the public in response to the proposed rulemaking and has 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 reexamination 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

The confidentiality of patent applications is governed by statute (35 U.S.C. § 122) and 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. Upon publication of an application or issuance of a patent, the patent

application file is made available to the public, subject to the provisions for providing only a redacted copy of the file contents. The entire file of an *ex parte* or *inter partes* reexamination proceeding is available to the public. Likewise, the entire file of a supplemental examination proceeding will be made available to the public.

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 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 approximately 9,560 responses per year for this collection. For this final rule, the USPTO considered approximately 36% of all supplemental examination responses and 100% of all responses for requests for *ex parte* reexamination and petitions in a reexamination proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d)) to be submitted by small entities. Approximately 85% 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 it will take the public from 18 minutes (0.30 hours) to 135 hours to gather the necessary information, prepare the appropriate form or other documents, and submit the information to the USPTO.

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 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

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b)	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
Request for Supplemental Examination Transmittal Form (PTO/SB/59)	0.30	1,430	429	\$371.00	\$159,159.00
Request for Supplemental Examination	25.00	1,430	35,750	\$371.00	\$13,263,250.00
Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57)	0.30	690	207	\$371.00	\$76,797.00
Request for <i>Ex Parte</i> Reexamination	55.00	690	37,950	\$371.00	\$14,079,450.00
Request for <i>Inter Partes</i> Reexamination Transmittal Form (PTO/SB/58)	0.30	380	114	\$371.00	\$42,294.00
Request for <i>Inter Partes</i> Reexamination	135.00	380	51,300	\$371.00	\$19,032,300.00
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	23.00	850	19,550	\$371.00	\$7,253,050.00
Patent Owner's 37 CFR 1.530 Statement	8.00	105	840	\$371.00	\$311,640.00
Third Party Requester's 37 CFR 1.535 Reply	8.00	60	480	\$371.00	\$178,080.00
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	33.00	1,750	57,750	\$371.00	\$21,425,250.00
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	41.00	300	12,300	\$371.00	\$4,563,300.00
Response to Final Rejection in <i>Ex Parte</i> Reexamination	17.00	560	9,520	\$371.00	\$3,531,920.00
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	41.00	120	4,920	\$371.00	\$1,825,320.00
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	41.00	95	3,895	\$371.00	\$1,445,045.00
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.50	720	360	\$371.00	\$133,560.00
Totals	-----	9,560	235,365	-----	\$87,320,415.00

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	Total Change	New Proposed Burden Estimate
Responses	5,124	Increase of 3,620	Increase of 816	Increase of 4,436	9,560
Burden Hours	161,128	Increase of 52,819	Increase of 21,418	Increase of 74,237	235,365
Respondent Cost Burden	\$52,366,600	Increase of \$18,830,409	Increase of \$16,123,406	Increase of \$34,953,815	\$87,320,415

13. Total Annual (Non-hour) Cost Burden

The total annual (non-hour) respondent cost burden for this collection is estimated to be approximately \$35,592,825 per year, which includes \$35,587,868 in fees and \$4,957 in postage.

Fees

The USPTO estimates that the total fees associated with this collection will be approximately \$35,587,868 per year, including \$35,136,560 in filing fees (calculated in Table 4a below) and \$451,308 in surcharges for oversized documents.

(Note: In the final rule, the basic fee of \$5,140 for filing a request for supplemental examination has been reduced from the original fee of \$5,180 set forth in the proposed rulemaking.)

Table 4a: Filing Fees for Respondents

Item	Estimated annual responses	Fee Amount	Estimated annual filing costs
Request for Supplemental Examination Transmittal Form (PTO/SB/59) – Granted (total fee of \$5,140 for the request plus \$16,120 for the ensuing reexamination)	715	\$21,260.00	\$15,200,900.00
Request for Supplemental Examination Transmittal Form (PTO/SB/59) – Denied (net fee for a refused request, after refund)	715	\$5,140.00	\$3,675,100.00
Request for Supplemental Examination	1,430	\$0.00	\$0.00
Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57) – Granted	620	\$17,750.00	\$11,005,000.00
Request for <i>Ex Parte</i> Reexamination – Denied (net fee for a refused request, after refund)	70	\$4,320.00	\$302,400.00
Request for <i>Ex Parte</i> Reexamination	690	\$0.00	\$0.00
Request for <i>Inter Partes</i> Reexamination Transmittal Form (PTO/SB/58) – Granted	358	\$8,800.00	\$3,150,400.00
Request for <i>Inter Partes</i> Reexamination – Denied (net fee for a refused request, after refund)	22	\$830.00	\$18,260.00

Item	Estimated annual responses	Fee Amount	Estimated annual filing costs
Request for <i>Inter Partes</i> Reexamination	380	\$0.00	\$0.00
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	850	\$1,930.00	\$1,640,500.00
Patent Owner's 37 CFR 1.530 Statement	105	\$0.00	\$0.00
Third Party Requester's 37 CFR 1.535 Reply	60	\$0.00	\$0.00
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	1,750	\$0.00	\$0.00
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	300	\$0.00	\$0.00
Response to Final Rejection in <i>Ex Parte</i> Reexamination	560	\$0.00	\$0.00
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	120	\$0.00	\$0.00
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	95	\$0.00	\$0.00
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	720	\$200.00	\$144,000.00
Totals	9,560	\$35,136,560.00

There are additional surcharges for oversized documents submitted with a Request for Supplemental Examination as specified in 37 CFR 1.20(k)(3). Each of the 1,430 responses may have up to 10 associated documents, and the USPTO estimates that approximately 12% (1,716) of these 14,300 documents may be oversized. The USPTO also estimates that, on average, approximately 2/3 of the oversized documents will incur the \$170 surcharge for being 21 to 50 pages in length and 1/3 will incur a \$450 surcharge for being 51 to 100 pages in length, for an average surcharge of \$263 per oversized document. Therefore, the total estimated surcharges for oversized documents in Requests for Supplemental Examination will be \$451,308 (1,716 oversized documents at \$263 each).

Postage

The USPTO expects that approximately 85 percent of the responses in this collection will be submitted electronically and 15 percent will be submitted by mail. The USPTO estimates that the average postage cost for a mailed submission will be 45 cents for Petitions to Request Extension of Time and \$5.15 for all other mailed submissions. (The documentation for requests for supplemental examination and requests for *ex parte* or *inter partes* reexamination will typically be mailed to the USPTO with the appropriate transmittal form.) The USPTO estimates that the total postage cost associated with this collection will be approximately \$4,957 per year, as calculated in Table 4b below.

Table 4b: Postage Costs for Respondents

Item	Estimated annual mailed responses	Estimated postage amount	Estimated annual postage costs
Request for Supplemental Examination Transmittal Form (PTO/SB/59)	215	\$5.15	\$1,107.00
Request for Supplemental Examination (submitted with transmittal form above)	215	\$0.00	\$0.00
Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57)	104	\$5.15	\$536.00
Request for <i>Ex Parte</i> Reexamination (submitted with transmittal form above)	104	\$0.00	\$0.00
Request for <i>Inter Partes</i> Reexamination Transmittal Form (PTO/SB/58)	57	\$5.15	\$294.00
Request for <i>Inter Partes</i> Reexamination (submitted with transmittal form above)	57	\$0.00	\$0.00
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	128	\$5.15	\$659.00
Patent Owner's 37 CFR 1.530 Statement	16	\$5.15	\$82.00
Third Party Requester's 37 CFR 1.535 Reply	9	\$5.15	\$46.00
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	263	\$5.15	\$1,354.00
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	45	\$5.15	\$232.00
Response to Final Rejection in <i>Ex Parte</i> Reexamination	84	\$5.15	\$433.00
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	18	\$5.15	\$93.00
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	14	\$5.15	\$72.00
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	108	\$0.45	\$49.00
Totals	1,437	\$4,957.00

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

Table 4c: Annual (Non-hour) Cost Burden Changes – Rulemaking/Non-Rulemaking Impact

	Current Inventory	Rulemaking Impact	Non-rule Impact	Total Change	New Proposed Burden Estimate
Fees	\$5,568,400	Increase of \$29,810,308	Increase of \$209,160	Increase of \$30,019,468	\$35,587,868
Postage	\$8,565	Increase of \$1,645	Decrease of \$5,253	Decrease of \$3,608	\$4,957
Recordkeeping	\$300	None	Decrease of \$300	Decrease of \$300	\$0
Total Annual (Non-hour) Cost Burden	\$5,577,265	Increase of \$29,811,953	Increase of \$203,607	Increase of \$30,015,560	\$35,592,825

14. Annual Cost to Federal Government

The USPTO estimates that it takes USPTO staff (GS-7, step 1 and GS-11, step 1 employees) approximately 15 minutes (0.25 hours) to 4 hours and 48 minutes (4.80 hours) to process the information in this collection, depending on the type and amount of information submitted. The USPTO estimates that the cost of a GS-7, step 1 employee is \$26.29 per hour (GS hourly rate of \$20.22 with 30% (\$6.07) added for benefits and overhead) and the cost of a GS-11, step 1 employee is \$38.91 per hour (GS hourly rate of \$29.93 with 30% (\$8.98) added for benefits and overhead).

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 this information collection:

Table 5: Burden Hour/Burden Cost to the Federal Government

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b)	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
Request for Supplemental Examination Transmittal Form (PTO/SB/59)	1.20	1,430	1,716	\$26.29	\$45,114.00
Request for Supplemental Examination	4.80	1,430	6,864	\$38.91	\$267,078.00
Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57)	1.00	690	690	\$26.29	\$18,140.00
Request for <i>Ex Parte</i> Reexamination	4.00	690	2,760	\$38.91	\$107,392.00
Request for <i>Inter Partes</i> Reexamination Transmittal Form (PTO/SB/58)	1.00	380	380	\$26.29	\$9,990.00

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b)	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
Request for <i>Inter Partes</i> Reexamination	4.00	380	1,520	\$38.91	\$59,143.00
Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	0.50	850	425	\$26.29	\$11,173.00
Patent Owner's 37 CFR 1.530 Statement	0.25	105	26	\$38.91	\$1,012.00
Third Party Requester's 37 CFR 1.535 Reply	0.25	60	15	\$38.91	\$584.00
Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.33	1,750	578	\$38.91	\$22,490.00
Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	0.33	300	99	\$38.91	\$3,852.00
Response to Final Rejection in <i>Ex Parte</i> Reexamination	0.33	560	185	\$38.91	\$7,198.00
Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	0.33	120	40	\$38.91	\$1,556.00
Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	0.33	95	31	\$38.91	\$1,206.00
Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	0.25	720	180	\$26.29	\$4,732.00
Totals	-----	9,560	15,509	-----	\$560,660.00

15. Summary of Changes in Burden

OMB previously approved this information collection in February 2010 with a total of 5,124 responses, 161,128 burden hours, and \$5,577,265 in annual (non-hour) costs. There have been no interim approvals.

For this final rule submission, the USPTO estimates that the total annual responses will be 9,560 and the total annual burden hours will be 235,365, which is an increase of 4,436 responses and 74,237 burden hours from the currently approved burden for this collection. This increase in responses and burden hours is due to program changes and administrative adjustments.

The total annual (non-hour) cost burden for this submission of \$35,592,825 is an increase of \$30,015,560 from the currently approved total of \$5,577,265. This increase is due to program changes and administrative adjustments.

Change in Respondent Cost Burden

The total respondent cost burden has increased by \$34,953,815, from \$52,366,600 to \$87,320,415, from the submission of this collection that was approved in February 2010, due to:

- **Increases in estimated hourly rates.** The submission approved in February 2010 used an estimated median rate of \$325 per hour for attorneys to prepare the items in this collection. For the current submission, the USPTO is using an updated mean rate of \$371 per hour for attorneys.
- **Increases in estimated burden hours.** The total estimated burden hours have increased from 161,128 in the February 2010 submission to 235,365 for the current submission due to increases in the estimated total annual responses for this collection and changes in the estimated time per response for some information requirements.

Changes in Responses and Burden Hours

For this submission, the USPTO estimates that the total annual responses will increase by 4,436 (from 5,124 to 9,560) and the total burden hours will increase by 74,237 (from 161,128 to 235,365) from the currently approved burden for this collection due to program changes and administrative adjustments, as follows:

Program Changes (net increase of 71,587 hours):

- **Increase of 1,430 estimated annual responses** for adding the Request for Supplemental Examination Transmittal Form (PTO/SB/59) due to the final rule; a **burden increase of 429 hours.**
- **Increase of 1,430 estimated annual responses** for adding Requests for Supplemental Examination due to the final rule; a **burden increase of 35,750 hours.**
- **Decrease of 155 estimated annual responses** for the Request for *Ex Parte* Reexamination Transmittal Form (PTO/SB/57) due to the final rule; a **burden decrease of 47 hours.**
- **Decrease of 155 estimated annual responses** for Requests for *Ex Parte* Reexamination due to the final rule; a **burden decrease of 6,820 hours.** (This item also has administrative adjustments below.)

- **Increase of 816 estimated annual responses** for Petitions in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d)), which includes the previously approved Petitions to Review Refusal to Grant *Ex Parte* or *Inter Partes* Reexamination but also includes Petitions Under 37 CFR 1.182 and 1.183 that are being added to this collection; a **burden increase of 18,768 hours**.
- **Increase of 585 estimated annual responses** for Amendments in *Ex Parte* or *Inter Partes* Reexaminations due to the final rule; a **burden increase of 19,305 hours**.
- **Increase of 240 estimated annual responses** for Responses to Final Rejection in *Ex Parte* Reexaminations due to the final rule; a **burden increase of 4,080 hours**.
- **Increase of 245 estimated annual responses** for Petitions to Request Extension of Time in *Ex Parte* or *Inter Partes* Reexaminations due to the final rule; a **burden increase of 122 hours**.

Administrative Adjustments (net increase of 2,650 hours):

- Revised the time estimate per response from 44 hours to 55 hours for Requests for *Ex Parte* Reexamination; a **burden increase of 7,590 hours**. (This item also has program changes above.)
- Revised the time estimate per response from 148 hours to 135 hours for Requests for *Inter Partes* Reexamination; a **burden decrease of 4,940 hours**.

Changes in Annual (Non-hour) Costs

For this submission, the USPTO estimates that the total annual (non-hour) costs will increase by \$30,015,560 (from \$5,577,265 to \$35,592,825) due to program changes and administrative adjustments, as follows:

Program Changes (net increase of \$30,021,446):

- **Increase of \$30,019,468**. This collection is currently approved with a total of \$5,568,400 in fees associated with submitting requests for reexamination and petitions. For this submission, the USPTO estimates that total fees will increase to \$35,587,868 due to several factors: addition of fees for Requests for Supplemental Examination, increases in the fee amounts for Requests for *Ex Parte* Reexamination and Petitions in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d)), and increases in responses and the associated total fees for Petitions to Request Extension of Time in *Ex Parte* or *Inter Partes* Reexaminations.

- **Increase of \$2,278.** This collection is currently approved with a total of \$8,565 in postage costs associated with mailing responses to the USPTO. For this submission, the USPTO estimates that the postage costs for mailed items will include a net increase of \$2,278 attributed to submitting items related to supplemental examinations and *ex parte* reexaminations as well as the addition of Petitions Under 37 CFR 1.182 and 1.183 (included in Petitions in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))).
- **Decrease of \$300.** This collection was previously approved with a total of \$300 in recordkeeping costs associated with printing and retaining a copy of the acknowledgment receipt after submitting information electronically. The USPTO is removing these recordkeeping costs from this collection because keeping a copy of the acknowledgment receipt is a suggestion and not a requirement.

Administrative Adjustments (net decrease of \$5,886):

- **Decrease of \$5,886.** This collection is currently approved with a total of \$8,565 in postage costs associated with mailing responses to the USPTO. For this submission, the USPTO estimates that the postage costs for mailed items will include a net decrease of \$5,886 attributed to an overall decrease in the expected number of mailed submissions from 2,558 to 1,437 per year. This decrease is partially offset by a small increase in first-class and priority mail postage rates since the previous submission in 2010.

16. Published Collections of Information

No special publication of the items in this collection is planned. However, information regarding requests for reexamination filed is published weekly in the *Official Gazette of the United States Patent and Trademark Office*. The *Official Gazette* is published in electronic format on the USPTO Web site.

17. Display of Expiration Date of OMB Approval

The forms in this information collection will display the OMB Control Number and the expiration date of OMB approval.

18. Exceptions to the Certificate Statement

This collection of information does not include any exceptions to the certificate statement.

B. COLLECTION OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.