

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
Patent Reexaminations and Supplemental Examinations
OMB Control Number 0651-0064
(October 2013)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update the current inventory estimates for information collection 0651-0064 Patent Reexaminations and Supplemental Examinations. The USPTO proposes the following updates:

1. Remove two items and their associated costs from 0651-0064 because the information is no longer being collected. These are items related to initial requests for *inter partes* reexamination. Pursuant to section 6(c)(3) of the Leahy-Smith America Invents Act, the authority to file *inter partes* reexamination requests terminated on September 16, 2012.
2. Remove the remaining fee cost burden from 0651-0064 to avoid double-counting the costs in the annual (non-hour) cost burden. The fee cost burden associated with items in 0651-0064 was moved into collection 0651-0072 effective January 2013.

Table 1 below details the two items in 0651-0064 related to initial requests for *inter partes* reexamination that are being removed because the information is no longer being collected:

Table 1: Items No Longer Being Collected (To Be Removed from 0651-0064)

Item	Estimated annual responses	Estimated burden hours	Estimated annual fee costs	Estimated annual postage costs	Estimated total annual (non-hour) costs
Request for <i>Inter Partes</i> Reexamination Transmittal Form (PTO/SB/58)	380	114	\$3,168,660.00	\$294.00	\$3,168,954.00
Request for <i>Inter Partes</i> Reexamination	380	51,300	\$0.00	\$0.00	\$0.00
Totals	760	51,414	\$3,168,660.00	\$294.00	\$3,168,954.00

Table 2 below details the fees that have been moved to 0651-0072 and therefore are to be removed from 0651-0064:

Table 2: Fees for Respondents (Moved to 0651-0072)

Fee code	Item	Estimated annual responses	Fee amount	Estimated annual filing costs
1827 2827 3827	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
1826 2826 3826	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
N/A	Request for Supplemental Examination	1,430	\$0.00	\$0.00
1812 2812 3812	Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57) – Granted	620	\$17,750.00	\$11,005,000.00
N/A	Request for <i>Ex Parte</i> Reexamination – Denied (net fee for a refused request, after refund)	70	\$4,320.00	\$302,400.00
N/A	Request for <i>Ex Parte</i> Reexamination	690	\$0.00	\$0.00
1824 2824 3824	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
N/A	Patent Owner's 37 CFR 1.530 Statement	105	\$0.00	\$0.00
N/A	Third Party Requester's 37 CFR 1.535 Reply	60	\$0.00	\$0.00
N/A	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	1,750	\$0.00	\$0.00
N/A	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	300	\$0.00	\$0.00
N/A	Response to Final Rejection in <i>Ex Parte</i> Reexamination	560	\$0.00	\$0.00
N/A	Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	120	\$0.00	\$0.00
N/A	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	95	\$0.00	\$0.00
1463 2463 3463	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	720	\$200.00	\$144,000.00
1828 2828 3828 1829 2829 3829	Surcharges for oversized documents submitted with a Request for Supplemental Examination that are 21-50 pages in length (with extra charges for each additional 50 pages)	1,716	\$263 (average)	\$451,308.00
	Total fees	\$32,419,208.00

Summary of Changes in Burden

- Removal of two items related to *inter partes* reexamination requests, resulting in the following changes:
 - Decrease of 760 annual responses
 - Decrease of 51,414 burden hours
 - Decrease of \$3,168,954 in annual (non-hour) costs
- Removal of \$32,419,208 in fees from 0651-0064 that are currently accounted for in 0651-0072, resulting in a decrease of \$32,419,208 in annual (non-hour) costs.

Burden Type	Currently Approved	Proposed Change	New Estimates
Responses	9,560	(760)	8,800
Hours	235,365	(51,414)	183,951
Postage	\$4,957	(\$294)	\$4,663
Fees	\$35,587,868	(\$35,587,868)	\$0
Total Annual (Non-hour) Costs	\$35,592,825	(\$35,588,162)	\$4,663

Consequently, this collection takes a burden reduction of 760 responses, 51,414 hours, and \$35,588,162 in annual (non-hour) costs as a program change.

The 0651-0064 revised total burden is as follows:

- 8,800 responses
- 183,951 burden hours
- \$4,663 in annual (non-hour) costs