

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Post Patent Public Submissions**  
**OMB CONTROL NUMBER 0651-0067**  
**July 2015**

**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. The provisions of 35 U.S.C. 301 and 37 CFR 1.501 govern the ability of a person to submit into the file of an issued patent (i) prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the patent, and (ii) statements of the patent owner 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 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**

IC Number	Requirement	Statute	Rule
1	Information Disclosure Citation in a Patent (electronic and paper)	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 consisting of patents or printed publications which the 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 in which the patent owner took a position on the scope of any claim of the patent 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 collected, maintained and used in this collection is based on OMB and USPTO guidelines. This includes the basic information quality standards established in the Paperwork Reduction Act (44 U.S.C. Chapter 35), in OMB Circular A-130, and in the OMB information quality guidelines.

**Table 2: Needs and Uses for Post Patent Public Submissions**

IC Number	Form and Function	Form #	Needs and Uses
1	Information Disclosure Citation in a Patent (paper and electronic)	PTO/SB/42	<ul style="list-style-type: none"> <li>• Used by the public to submit, in a patent file, prior art consisting of patents and printed publications which the 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.</li> <li>• Used by the USPTO, as appropriate, in subsequent reissue or reexamination proceedings.</li> </ul>

### **3. Use of Information Technology**

The USPTO permits 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 information disclosure citations in a patent under 37 CFR 1.501 is minor. 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 consisting of patents or printed publications which the

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 60-Day Notice was published in the Federal Register on March 20, 2015 (80 Fed. Reg. 14910). The comment period ended on May 19, 2015. No public comments were received.

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 and during the renewal of an information collection. No views have been expressed regarding the present renewal.

## **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 consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability, 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 240 responses to this information collection annually, of which 60 will be filed by small entities. The USPTO estimates that 230 of the 240 responses will be filed electronically.

- **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.

- **Cost Burden Calculation Factors**

The USPTO estimates a rate of \$389 per hour. The USPTO uses a professional rate of \$389 per hour for respondent cost burden calculations, which is the median rate for attorneys in private firms as shown in the *2013 Report of the Economic Survey*, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA).

**Table 3: Burden Hour/Burden Cost to Respondents for Post Patent Public Submissions**

IC Number	Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
1	Information Disclosure Citation in a Patent; electronic	10.0	230	2,300	\$389.00	\$894,700.00
1	Information Disclosure Citation in a Patent; paper	10.0	10	100	\$389.00	\$38,900.00
	<b>Total</b>	- - - - -	<b>240</b>	<b>2,400</b>	- - - - -	<b>\$933,600.00</b>

## 13. Total Annualized (Non-Hour) 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 \$5.75 and approximately 10 submissions will be submitted to the USPTO requiring postage. The estimated postage cost for this collection will be \$57.50.

Therefore, the USPTO estimates that that the total annualized (non-hour) cost burden for this collection, in the form of postage costs, will amount to \$57.50 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 \$20.63 according to the U.S. Office of Personnel Management's (OPM's) 2015 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 \$26.75 (\$20.63 + \$6.19).

Table 6 calculates the processing hours and costs of this information collection to the Federal Government:

**Table 6: Burden Hour/Burden Cost to the Federal Government for Post Patent Public Submissions**

IC Number	Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (a) x (b) (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
1	Electronic Information Disclosure Citation in a Patent	0.50	230	115	\$26.75	\$3,076.25
1	Information Disclosure Citation in a Patent	0.50	10	5	\$26.75	\$133.75
	<b>Total</b>	- - - - -	<b>240</b>	<b>120</b>	- - - - -	<b>\$3,210.00</b>

#### 15. Reason for Change in Burden

##### Summary of Changes in Annual Burden

For this renewal, the USPTO estimates that the total annual responses will be 240 and that the total annual burden hours will be 2,400. These numbers correspond to a decrease of 760 responses and 7,600 burden hours from the previously approved burden.

The currently approved (non-hour) cost burden for this collection is \$347. This renewal estimates that the non-hour cost burden will decrease by \$289.50, dropping the burden to \$57.50.

The cost to the Federal Government for this renewal is estimated to decline to \$3,210, a \$9,935 decrease from the previously-approved government burden of \$13,145. This decline will occur despite the increase in GS rates for 2015.

##### Changes in Responses and Respondent Burden Hours

With this renewal, a total of 7,600 burden hours have been removed from this collection. This decreases the total number of burden hours associated with this collection from 10,000 to 2,400. This decrease is the result of an administrative adjustment, as follows:

- **Decrease of 760 responses.** The USPTO estimates that the total number of responses received for the items in this information collection will decrease by 760, from 1,000 to 240. This decrease in responses led to the corresponding decrease in burden hours described above.

#### Changes in Respondent Cost Burden

For this renewal, the USPTO estimates that the total respondent cost burden will decrease by \$2,776,400, from \$3,710,000 to \$933,600. This overall decrease is due to the following:

- **Decrease of 760 Responses:** The decrease of 760 responses to this collection—which in turn led to a decrease in the number of respondent burden hours from which respondent cost burden is derived—contributed to the decrease in the respondent cost burden.
- **Increase in Professional Salaries:** For this renewal, the USPTO is using the recently-updated professional hourly salary for attorneys of \$389, rather than the \$371 used in the previous submission.

#### Changes in Annual (non-hour) Cost Burden

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$289.50, from \$347 to \$57.50. This overall decrease is due to the following:

- **Decrease of 60 Responses Requiring Postage:** The currently-approved version of this collection lists 70 responses as requiring postage. For this proposed renewal, the number of responses requiring postage is estimated to decrease by 60, from 70 to 10.
- **Increase in Postage Costs:** For this collection, the USPTO is using the more recent postage rate of \$5.75 for a one-pound mailed submission, in place of the \$4.95 rate that was used for comparable mailed submissions in the previous authorization of this collection.

#### Changes in Federal Government Cost Burden

For this renewal, the USPTO estimates that the annual burden to the Federal Government will decrease by \$9,935, from \$13,145 to \$3,210. This overall decrease is due to the following:

- **Decrease of 760 Responses:** As with the respondent cost burden, the decrease of 760 responses to this collection—responses that would have been handled and processed by members of the Federal Government—contributed to the decrease in the Federal Government cost burden.
- **Increase in GS Rates:** For this collection, the USPTO is using the 2015 GS Rate table (with locality pay for the Washington, D.C. area) to calculate the work done by Federal employees. The 2012 submission valued an hour of work from a GS-7, step 1, at \$26.29 (\$20.22 base hourly with an additional 30 percent added for benefits/overtime compensation). This submission, however, values that same time at \$26.75 (\$20.63 base hourly with the additional 30 percent benefits/overtime compensation). Despite this increase, however, the total federal cost burden declined, primarily due to the decrease in the number of responses described above.

#### **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.