

SUPPORTING STATEMENT
United States Patent and Trademark Office
Matters Related to First Inventor to File
OMB CONTROL NUMBER 0651-0071
September 2015

A. JUSTIFICATION

1. Necessity of Information Collection

The Leahy-Smith America Invents Act (AIA) was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 283 (2011). Section 3 of the AIA, *inter alia*, amended 35 U.S.C. 102 and 103 consistent with the objectives of the AIA, including the conversion of the United States patent system from a “first to invent” system to a “first inventor to file” system. The changes in section 3 of the AIA went into effect on March 16, 2013, but apply only to certain applications filed on or after March 16, 2013.

37 CFR 1.55(k), 1.78(a)(6) and 1.78(d)(6) require information needed to assist the USPTO in determining whether an application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2013. 37 CFR 1.110 requires information needed to identify the inventorship and ownership, or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, in an application or patent naming one or more joint inventors, when necessary for purposes of a USPTO proceeding. 37 CFR 1.130, 1.131, and 1.132 provide for the submission of affidavits or declarations needed (i) 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 (1.130), (ii) to show 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 (1.130), (iii) to establish prior invention or to disqualify a commonly owned patent or published application as prior art (1.131), or (iv) to submit evidence to traverse a rejection or objection on a basis not otherwise provided for (1.132).

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(k)	35 U.S.C. §§ 2(b)(2) and 119	37 CFR 1.55(k)

Requirement	Statute	Rule
Submissions Under 37 CFR 1.78(a)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(a)(6)
Submissions Under 37 CFR 1.78(d)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(d)(6)
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

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 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(k)	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, other than a nonprovisional international design application, claims priority to 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 as defined in § 1.109 that is on or after March 16, 2013. 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 AIA.
Submissions Under 37 CFR 1.78(a)(6)	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 as defined in § 1.109 that is on or after March 16, 2013. 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 AIA.
Submissions Under 37 CFR 1.78(d)(6)	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, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States 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 as defined in § 1.109 that is on or after 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 AIA.

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 inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, when necessary for purposes of a USPTO proceeding. • Used by patent applicants and patent owners to identify the invention dates of the subject matter of each claim 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) or pre-AIA 35 U.S.C. § 102(e).
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 another 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 another 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 USPTO has determined that the information covered by this collection 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

Less frequent collection of submissions under 37 CFR 1.55(k), 1.78(a)(6), and 1.78(d)(6) would cause examination costs to significantly increase. Less frequent collection of identifications of inventorship and ownership or obligation to assign ownership, and less frequent collection of 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 60-Day Notice was published in the *Federal Register* on June 9, 2015 (80 Fed. Reg. 32539). The comment period ended August 10, 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

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 3 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 50,150 responses per year for this collection, of which approximately 12,538 will be filed by small entities. The USPTO estimates that approximately 48,646 of the responses for this collection will be submitted 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 the responses in this collection will take the public between 2 and 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(k), 1.78(a)(6), or 1.78(d)(6) 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 or obligation to assign 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 \$410 per hour for respondent cost burden calculations, which is the mean rate for attorneys in private firms as shown in the *2015 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 \$410 is an accurate estimate of the cost per hour to collect this information.

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

IC Number	Information Collection Instrument	Estimated time for response (hours) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total Cost/yr (\$) (c) x (d) = (e)
1		2	9,700	19,400	\$410.00	\$7,954,000.00
1	Submissions Under 37 CFR 1.55(k)	2	300	600	\$410.00	\$246,000.00
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	2	7,760	15,520	\$410.00	\$6,363,200.00
	Submissions Under 37 CFR 1.78(a)(6)	2	240	480	\$410.00	\$196,800.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	2	1,940	3,880	\$410.00	\$1,590,800.00
3	Submissions Under 37 CFR 1.78(d)(6)	2	60	120	\$410.00	\$49,200.00
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	146	292	\$410.00	\$119,720.00
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	4	8	\$410.00	\$3,280.00
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	29,100	291,000	\$410.00	\$119,310,000.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	900	9,000	\$410.00	\$3,690,000.00
Total	50,150	340,300	\$139,523,000

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 \$5.75 and that approximately 1,474 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 \$8,475.50 per year.

Table 4 shows the postage costs for this collection.

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

IC Number	Item	Estimated Annual Mailed Responses	Estimated Postage Amount	Estimated Annual Postage Costs
1	Submissions Under 37 CFR1.55 (k)	294	\$5.75	\$1,690.50
2	Submissions Under 37 CFR 1.78(a)(6)	235	\$5.75	\$1,351.25
3	Submissions Under 37 CFR 1.78(d)(6)	59	\$5.75	\$339.25
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	4	\$5.75	\$23.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	882	\$5.75	\$5,071.50
	Totals	0	-----	0

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(k), 1.78(a)(6), and 1.78(d)(6), and the identification of inventorship and ownership or obligation to assign 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 \$20.63 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 \$26.82 (\$20.63 + \$6.19).

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

IC Number	Item	Estimated time for response (hours) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total Cost/yr (\$) (c) x (d) = (e)
1	CFR 1.55(k)	0.25	9,700	2,425	\$26.82	\$65,038.50
1	Submissions Under 37 CFR 1.55(k)	0.25	300	75	\$26.82	\$2,011.50
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	0.25	7,760	1,930	\$26.82	\$51,762.60
2	Submissions Under 37 CFR 1.78(a)(6)	0.25	240	60	\$26.82	\$26,766.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	0.25	1,940	485	\$26.82	\$1,609.20
3	Submissions Under 37 CFR 1.78(d)(6)	0.25	60	36.5	\$26.82	\$978.93
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	146	36.5	\$26.82	\$939.00
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	4	1	\$26.82	\$26.82
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	0.50	29,100	14,550	\$26.82	\$390,231.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	0.50	900	450	\$26.82	\$12,069.00
	Total	- - - - -	50,150	0	- - - - -	\$537,419.16

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 50,150 and that the total annual burden hours will be 340,300. These numbers represent a decrease of 139,000 responses and 438,000 burden hours from the previously approved burden.

The currently-approved annual (non-hour) cost burden for this collection is \$65,539. This renewal estimates that burden will decrease by \$57,063.50, dropping the non-hour cost burden to \$8,475.50.

The cost to the Federal Government for this renewal is estimated to decline to \$537,419.16 due to the decrease in the number of responses, despite the increased GS rates used for 2015.

Changes since the 60-Day Notice Publication

When the 60-day notice for this renewal published on June 19, 2015, it used the 2013 AIPLA Report of the Economic Survey to arrive at the hourly rates for the agents and

practitioners who would be completing items in this information collection. Since that time, AIPLA released the 2015 Report of the Economic Survey, which increased the hourly rates for both of those two groups. As such, the new hourly rates have been integrated into this document where applicable and the hourly cost burden has been adjusted accordingly.

Changes in Responses and Respondent Burden Hours

With this renewal, a total of 438,000 burden hours have been removed from this collection. This decreases the total number of burden hours associated with this collection from 778,300 to 340,300. This decrease is the result of an administrative adjustment, as follows:

- **Decrease of 139,000 Responses.** The USPTO estimates that the total number of responses received for the items in this information collection will decrease by 139,000, from 189,150 to 50,150. This decrease in responses also 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 \$149,226,300.00, from \$288,749,300.00 to \$139,523,000.00, despite an increase in the hourly rate for respondents. This overall decrease is due to the following:

- **Decrease of 139,000 Responses:** The decrease of 139,000 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.

Changes in Annual (non-hour) Cost Burden

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$57,063.50, from \$65,539 to \$8,475.50. This overall decrease is due to the following:

- **Decrease of 11,766 Responses Requiring Postage:** The currently approved version of this collection lists 13,240 responses as requiring postage. For this proposed renewal, the number of responses requiring postage is estimated to decrease by 11,766, from 13,240 to 1,474.
- **Increase in Postage Costs:** For this collection, the USPTO is using the more recent postage rate of \$5.75 for mailed submissions, in place of the rate- \$5.25—that were used in the previous authorization for the comparable mailed submissions.

Changes in Federal Government Burden

For this renewal, the USPTO estimate that the annual burden to the Federal Government will decrease to \$537,419.16, a drop of \$1,034,433.84. This will occur despite an increase in GS Rates. This overall decrease is due to the following:

- **Decrease of 139,000 Responses:** As with the respondent cost burden, the decrease of 139,000 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 position at \$26.82 (\$20.63 base hourly with the 30 percent benefits/overtime compensation). Despite this increase, the total federal cost burden declined to \$537,419.16, primarily due to a 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

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.