

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
Patent Review and Derivation Proceedings
OMB Control Number 0651-0069

Background

The United States Patent and Trademark Office (USPTO) administers the Leahy-Smith America Invents Act (AIA), Section 10, which sets or adjusts patent fees established, authorized, or charged under Title 35, United States Code (U.S.C.). Section 10 prescribes that fees may be set or adjusted only to recover the aggregate estimated costs to the Office for processing, activities, services, and materials related to patent. Section 10 authorities also includes flexibility to set individual fees in a way that furthers key policies factors, while taking into account the cost of the respective services.

The request is to update the fees attached to this collection that are affected by the rulemaking NPRM 0651-AD02, and also to incorporate fees were not counted in previous approvals. Respondent numbers are also changing due to agency discretion in conjunction with the rule.

There are eight fees being adjusted as a result of the 2016 Biennial Fee Review. These had previously been housed in collection 0651-0072 (America Invents Act Section 10 Patent Fee Adjustment), which was discontinued in March 2016.

Table 1: Total Fee and Respondent Increases

IC #	Item	Proposed Responses	Proposed Fee	Proposed Non-hour Burden (\$)
1	Inter Partes Review Request Fee	1,565	\$15,500	\$24,257,500
1	Inter Partes Review Post-Institution Fee	1,565	\$15,000	\$23,475,000
1	Inter Partes Review Request of Each Claim in Excess of 20	4,476	\$300	\$1,342,800
1	Inter Partes Post-Institution Request of Each Claim in Excess of 15	7,051	\$600	\$4,230,600
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	118	\$16,000	\$1,888,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	118	\$22,000	\$2,596,000
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	937	\$375	\$351,375
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 15	1,290	\$825	\$1,064,250
Totals		17,120	---	\$59,205,525

Table 2: Increases in Fee Amounts

IC #	Item	Current Fee	Proposed Fee	Fee Increase
1	Inter Partes Review Request Fee	\$9,000	\$15,500	\$6,500
1	Inter Partes Review Post-Institution Fee	\$14,000	\$15,000	\$1,000

1	Inter Partes Review Request of Each Claim in Excess of 20	\$200	\$300	\$100
1	Inter Partes Post-Institution Request of Each Claim in Excess of 15	\$400	\$600	\$200
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	\$12,000	\$16,000	\$4,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	\$18,000	\$22,000	\$4,000
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	\$250	\$375	\$125
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 15	\$550	\$825	\$275

Table 3: Increases in Hourly Burden Respondents

IC #	Item	Current Annual Responses	Proposed Annual Responses	Increases in Responses
1	Inter Partes Review Request Fee	398	1,565	1,167
1	Inter Partes Review Post-Institution Fee	398	1,565	15,258
1	Inter Partes Review Request of Each Claim in Excess of 20	2,788	4,476	1,688
1	Inter Partes Post-Institution Request of Each Claim in Excess of 15	2,091	7,051	4,960
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	67	118	51
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	67	118	51
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	467	937	470
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 15	350	1,290	940
Totals		6,626	31,211	24,585

Table 3: Increases in Non-Hourly Costs (Fees)

IC #	Item	Current Total Amount (\$)	Proposed Total Cost (\$)	Total Cost Increase
1	Inter Partes Review Request Fee	\$3,582,000	\$24,257,500	\$20,675,500
1	Inter Partes Review Post-Institution Fee	\$5,572,000	\$23,475,000	\$17,903,000
1	Inter Partes Review Request of Each Claim in Excess of 20	\$557,600	\$1,342,800	\$785,200
1	Inter Partes Post-Institution Request of Each Claim in Excess of 15	\$836,400	\$4,230,600	\$3,394,200
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	\$804,000	\$1,888,000	\$1,084,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	\$1,206,000	\$2,596,000	\$1,390,000

2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	\$116,750	\$351,375	\$234,625
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 15	\$192,500	\$1,064,250	\$871,750
	Totals	\$12,867,250	\$59,205,525	\$46,338,275

Summary of Changes

The addition of 8 fees results in the addition of \$46,338,275 in non-hourly costs to collection 0651-0069. These additions account for the changes following the rulemaking action NPRM 0651-AD02.

Changes in Burden

Burden Type	Currently Approved	Proposed Change	New Estimate
Respondents	11,349	0	11,349
Burden Hours	1,459,184	0	1,459,184
Non-Hourly Cost Burden	\$60,404,425.50	\$46,338,275.00	\$106,742,700.50

The 0651-0069 revised total non-hourly burden is as follows:

- 11,349 respondents
- 1,459,184 burden hours
- \$106,742,700.50 in annual (non-hourly) costs