

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Third Party Submissions and Protests**  
**OMB CONTROL NUMBER 0651-0062**  
**July 2018**

**1. 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. §§ 122©, 122©, 131, and 151, as well as 37 CFR 1.290 and 1.291, limit the ability of a third party to have information entered and considered a patent application or to protest a patent application pending before the Office.

37 CFR 1.290 provides a mechanism for third parties to submit to the USPTO, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other patent publications of potential relevance to the examination of the application.

A preissuance submission under 37 CFR 1.290 may be made in any non-provisional utility, design, and plant application, as well as in any continuing application. A preissuance submission under 37 CFR 1.290 must include a concise description of the asserted relevance of each document submitted and must be submitted within a certain statutory specific time period.

37 CFR 1.291 permits a member of the public to file a protest against a pending application. Protest pursuant to 37 CFR 1.291 are supported by a separate statutory provision from third party submissions under 37 CFR 1.290 (35 U.S.C. 122© v. 35 U.S.C. 122©). As a result, there are several differences between protests and third-party submissions.

For example, 37 CFR 1.291 permits the submission of information that is not permitted in a third-party submission under 37 CFR 1.290. Specifically, 37 CFR 1.291 provides for the submission of information other than publications, including any facts or information submitted. Unlike the concise explanation of the relevance required for a preissuance submission under 37 CFR 1.290, which is limited to a description of a document's relevance, the concise explanation for a protest under 37 CFR 1.291 allows for arguments against patentability. Additionally, the specified time period for submitted a protest differs from the time period for submitting third party submissions and is impacted by whether the protest is accompanied by the written consent of the application.

The information collected via third party submissions under 37 CFR 1.290 and via the protests under 37 CFR 1.291 is necessary so that the public may contribute to the

quality of issued patents. The USPTO will use this information, as appropriate, during the patent examination process to assist in evaluating the patent application.

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

**Table 1: Information Requirements**

IC Number	Requirement	Statute	Rule
1	Third Party Submissions in Nonissued Applications (electronic)	35 U.S.C. §§ 122©, 131, and 151	37 CFR 1.290
2	Third Part Submissions in Nonissued Applications (paper)	35 U.S.C. §§ 122©, 131, and 151	37 CFR 1.290
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291	35 U.S.C. §§ 122©, 131, and 151	37 CFR 1.291

## 2. Needs and Uses

The public uses this information collection to contribute submissions and protests to the quality of issued patents. The USPTO will use this information, as appropriate, during the patent examination process to assist in evaluating the patent application.

The information in this collection can be submitted in paper format or electronically through the EFS-Web.

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 USPTO information quality guidelines.

Table 2 outlines how this collection of information is used by the public and the USPTO:

**Table 2: Needs and Uses**

IC Number	Form and Function	Form #	Needs and Uses
1	Third Party Submissions in Nonissued Applications (electronic)	No Form Associated	<ul style="list-style-type: none"> <li>Used by third parties to submit patents, published patent applications, or other printed publications of potential relevance to the examination of an application, together with a concise description of the asserted relevance of each document submitted, in accordance with 37 CFR 1.290.</li> <li>Used by the USPTO to enter third party-submitted patents, published patent applications, or other printed publications in the application file, in accordance with 37 CFR 1.290.</li> </ul>
	Third Part Submissions in Nonissued	PTO/SB/429	<ul style="list-style-type: none"> <li>Used by third parties to submit patents,</li> </ul>

2	Applications (paper)		<p>published patent applications, or other printed publications of potential relevance to the examination of an application, together with a concise description of the asserted relevance of each document submitted, in accordance with 37 CFR 1.290.</p> <ul style="list-style-type: none"> <li>• Used by the USPTO to enter third party-submitted patents, published patent applications, or other printed publications in the application file, in accordance with 37 CFR 1.290.</li> </ul>
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291	No Form Associated	<ul style="list-style-type: none"> <li>• Used by the public to call attention to any facts or information within the protestor's knowledge that, in the protestor's opinion, would make the grant of a patent on an application pending in the USPTO improper.</li> <li>• Used by the USPTO to better avoid the issuance of an invalid patent.</li> </ul>

### 3. Use of Information Technology

The USPTO has a dedicated interface that permits third party preissuance submissions to be filed via its electronic filing system (EFS-Web). Third party preissuance submissions are not automatically entered into the electronic image file wrapper (IFW) for an application. Instead, preissuance submissions are reviewed to determine compliance with 35 U.S.C. 122© and 37 CFR 1.290 before being entered into the IFW. Third parties filing preissuance submissions electronically via EFS-Web receive immediate, electronic acknowledgement of the USPTO's receipt of the submission, instead of waiting for the USPTO to mail a return postcard.

Because third party preissuance submissions may be filed electronically, the USPTO protects applicants via established procedures that determine whether a third party preissuance submission is in compliance with the requirements of 35 U.S.C. 122© and 37 CFR 1.290 before entering the submission into the IFW of an application or making the submission available to an examiner for consideration. The USPTO always strives to complete such determinations promptly following receipt of the submissions so that compliant preissuance submissions are quickly entered into the IFW and made available to the examiner for consideration. Non-compliant third party preissuance submissions are not entered into the IFW of an applicant or considered and are discarded. Also, no refund of the required fees is provided in the event that a preissuance submission is determined to be non-compliant. If an electronic mail message address is provided with a third party preissuance submission, the USPTO strives to notify the third party submitter of such non-compliance; however, the statutory time period for making a preissuance submission is not tolled by the initial non-compliant submission.

Alternatively, third party preissuance submissions may be paper-filed using form PTO/SB/429. The safeguards noted above with respect to preissuance submissions that are filed via the dedicated EFS-Web interface are also in place for paper-filed submissions.

Protests made by the public against applications submitted under 37 CFR 1.291 must be paper-filed.

#### **4. Efforts to Identify Duplication**

The information collected is required to process (1) third party submissions in non-issued applications, and (2) protests by the public against pending applications. This information is not collected elsewhere and does not result in a duplication of effort.

#### **5. Minimizing the Burden to Small Entities**

This collection of information does not impose a significant economic impact on small entities or small businesses. The information required by this collection provides the USPTO with the necessary materials for (1) entering prior art documents obtained from a third party in the application file, and (2) bringing information to the attention of the USPTO and voiding the issuance of an invalid patent. The same information is required from every member of the public and is not available from any other source.

#### **6. Consequences of Less Frequent Collection**

The information is collected only when the public submits (1) a third-party submission and/or (2) a 37 CFR 1.291 protest. If this information were not collected, the USPTO would not be able to balance the mandate of 35 U.S.C. § 122© and © and the USPTO's authority and responsibility under 35 U.S.C. §§ 131 and 151 to issue a patent only if it appears that the applicant is entitled to a patent under the law. This information could not be collected less frequently.

#### **7. Special Circumstances in the Conduct of Information Collections**

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 April 17<sup>th</sup>, 2018 (83 CFR 16836). The comment period ended on June 18<sup>th</sup>, 2018. No comments were received.

The USPTO has long-standing relationships with groups from who patent application 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 and during the renewal of an information collection. No views have been expressed impacting 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 content. The disclosure of the invention in the application is the *quid pro quo* for the property right conferred by the patent grant and the very means by which the patent statute right conferred by the patent grant, and the very means by which the patent statute achieves its constitutional objective of “prompt[ing] the progress of science and useful arts.” The prosecution history contained in the application file is critical for determining the scope of the property right conferred by a property grant.

## 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 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 approximately 1,450 total responses per year for this collection.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public approximately 10 hours to gather the necessary information, prepare the appropriate form or document, and submit the information to the USPTO.

- **Cost Burden Calculation Factors**

The USPTO uses a professional hourly rate of \$438 per hour for respondent cost burden calculations, which is the median rate for intellectual property attorneys in private firms, as shown in the 2017 *Report of the Economic Survey* published by the American Intellectual Property Law Association (AIPLA).

**Table 3: Burden Hour/Burden Cost to Respondents**

IC Number	Item	Response Time (Hours) (a)	Responses (b)	Annual Burden (Hours) © (a) x (b)	Rate (\$) (d)	Total Cost © x (d)
1	Third-Party Submissions in Non-issued Applications (electronic)	10	1,400	14,000	\$438.00	\$6,132,000.00
2	Third-Party Submissions in Non-issued Applications (paper)	10	40	400	\$438.00	\$175,200.00

3	Protests by the Public Against Pending Applications Under 37 CFR 1.291 (paper)	10	10	100	\$438.00	\$43,800.00
	<b>Total</b>		<b>1,450</b>	<b>14,500</b>		<b>\$6,351,000.00</b>

### 13. Total Annual (Non-hour) Cost Burden

There are no capital start-up, recordkeeping, or maintenance costs associated with this information collection. This collection does have non-hourly cost burdens in both fees paid by the public and postage costs for items mailed to the USPTO.

#### Fees

37 CFR 1.290 requires payment of the fee set forth in 37 CFR 1.17(o) (\$180 for a large entity, \$90 for a small or micro entity) for every ten documents, or a fraction thereof, listed in each third-party submission. The USPTO provides an exemption from the 1.17(o) fee requirement where a third-party submission listing three or fewer total documents is the first third-party submission submitted in an application by the third party, or a party in privity with the third party. The effect of this is that the first three documents submitted by a third party are exempt from the fee requirement.

There are no fee for filing protests under 37 CFR 1.291 unless the filed protests is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(i) fee of \$130 must be included. The USPTO estimates that only 1 out of every 10 protests filed per year will require this fee.

When electronically submitting the information in this collection to the USPTO, the applicant is encouraged to retain a copy of the file submitted to the USPTO as evidence of the application. Inclusion of an USPS acknowledgement receipt with mailed items provides evidence of the date the file was received by the USPTO. The USPTO does not, however, require this recordkeeping, and thus does not consider this action to be a recordkeeping cost imposed on the applicant.

The fees associated with this information collection total \$73,930 per year, as outlined in Table 4 below:

**Table 4: Filing Fee/Non-hour Cost Burden to the Respondents**

IC Number	Item	Estimated Annual Responses (a)	Filing Fees (\$) (b)	Total Filing Fee Costs © (a) x (b)
1-2	Third-Party Submissions in Non-Issued Applications	410	\$180.00	\$73,800.00
1-2	Third-Party Submissions in Non-Issued Applications (small and micro entities)	170	\$90.00	\$15,300.00

3	Protests by the Public Against Pending Applications Under 37 CFR 1.291	1	\$130.00	\$130.00
	<b>Total</b>	<b>581</b>		<b>\$89,230.00</b>

Postage Cost

The non-electronic items in this collection have associated first-class postage costs when submitted by mail. Customers may incur postage costs when submitting the instruments contained within 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 one-pound submission mailed in a flat-rate envelope to be \$6.70. The USPTO estimates that the vast majority of all paper submissions will be delivered by mail, with the remainder being delivered by hand. The USPTO estimates that approximately 40 submissions will require postage. Therefore, the estimated postage cost for this collection will be \$268.

Total

The total (non-hour) respondent cost burden for this collection is estimated to be \$89,498, which includes \$89,230 in fees and \$268 in postage costs.

**14. Annual Cost to the Federal Government**

The USPTO employs a GS-7 to process the submissions for this collection. The USPTO estimates that the cost of a GS-7, step 1 is \$28.64 per hour (GS hourly rate of \$22.03 with 30% (\$6.61) added for benefits and overhead). The USPTO estimates that it takes an employee 30 minutes (0.50 hours) to process the protests under 37 CFR 1.291 and the third-party submissions.

Table 5 calculates the processing hours and costs of this information collection to the Federal Government:

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

IC Number	Item	Hours (a)	Responses (b)	Burden (c) (a) x (b)	Rate (\$) (d)	Total Cost (e) (c) x (d)
1	Third-Party Submissions in Non-issued Applications (electronic)	0.50 (30 minutes)	1,400	700	\$28.64	\$20,048.00
2	Third-Party Submissions in Non-issued Applications (paper)	0.50 (30 minutes)	40	20	\$28.64	\$572.80
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291	0.50 (30 minutes)	10	5	\$28.64	\$143.20
	<b>Total</b>		<b>1,450</b>	<b>725</b>		<b>\$20,764.00</b>

## 15. Reason for Change in Burden

### A. Changes in Collection since previous OMB approval in 2015

OMB previously approved the renewal of this information collection in July 2018. The current collection contains:

- 1,560 responses
- 15,600 burden hours
- \$6,068,400 in respondent hourly costs
- \$237,619.25 in annual (non-hour) costs

### B. Changes proposed in this request to OMB

The proposed collection, as outlined in the tables above, seeks to modify the existing collection. The proposed collection contains an estimated:

- 1,450 responses
- 14,500 burden hours
- \$6,351,000 in respondent hourly costs
- \$89,498 in annual (non-hour) costs

### Changes in Respondent Cost Burden

The total respondent cost burden has increased by \$282,600 (from \$6,068,400 to \$6,351,000) from the previous renewal of this collection in July 2015:

- Decreases in estimated burden hours. The total estimated burden hours have decreased from 15,600 in the 2015 renewal to 14,500 for the current renewal due to overall decreases in the estimated annual responses for this collection.
- Increases in estimated hourly rate. The 2015 renewal used an estimated rate of \$389 per hour for respondents to this collection, which was the estimated rate for intellectual property attorneys in private firms. For the current renewal, the USPTO is using an updated hourly rate of \$438.

### Changes in Responses and Burden Hours

For this renewal, the USPTO estimates that the annual responses will decrease by 110 (from 15,600 to 14,500) and the total burden hours will decrease by 1,100 (from 15,600 to 14,500) from the currently approved burden for this collection. These changes are due to the following adjustments:



- Decrease of responses due to updated agency estimates based on information gathered in the last three years. The decreases in the response estimate results in the burden hour estimates to be decreased as well.

#### Changes in Annual (Non-hour) Cost

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$141,121.25 (from \$237,619.25 to \$89,498). Below is the list of changes to the annual (non-hour) cost:

- Decrease of \$141,050 in filing fee estimates, due to a decrease in the estimated number of respondents providing the fees.
- Decrease of \$71.25 in postage costs.

#### **16. Project Schedule**

The USPTO does not plan to publish this information for statistical use. However, patent and trademark assignment records are available to the public at the USPTO Public Search Facilities and 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. 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.