

SUPPORTING STATEMENT
United States Patent and Trademark Office
Post Patent Public Submissions
OMB CONTROL NUMBER 0651-0067
September 2018

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 a patent: (1) 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 (2) 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 provides the specified statutes and regulations authorizing the USPTO to collect the information discussed above:

Table 1: information Requirements

IC Number	Requirement	Statute	Rule
1	Information Disclosure Citation in a Patent	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 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 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	Information Disclosure Citation in a Patent (paper and electronic)	PTO/SB/42	<ul style="list-style-type: none">• 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.• Used by the USPTO, as appropriate, in subsequent reissue or reexamination proceedings.

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 (1) 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 (2) 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 June 18th, 2018 (83 Fed. Reg. 28205). The comment period ended on August 17th, 2018. 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 of Gifts to Respondents

This information 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 in 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 Factor**

The USPTO estimates that it will receive a total of 100 total responses per year for this collection. The USPTO estimates that 98 percent of the responses will be filed electronically.

- **Burden Hour Calculation**

The USPTO estimates that it will take the public approximately 10 hours to complete the collection of information. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO. The USPTO calculates that 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 professional rate of \$438 per hour for respondent cost burden calculations, which is the rate for intellectual property attorney 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	Time for Response (hours) (a)	Responses (b)	Annual Burden (c) (a) x (b)	Rate (d)	Hourly Cost (e) (c) x (d)
1	Electronic Information Disclosure Citation in a Patent	10	98	980	\$438.00	\$429,240.00
1	Information Disclosure Citation in a Patent	10	2	20	\$438.00	\$8,760.00
	Total		100	1,000		\$438,000.00

13. Total Annual (Non-hour) Cost Burden

This collection has non-hourly cost burdens in associated postage costs for mailing items to the USPTO.

Postage Costs

The non-electronic items in this collection have associated first-class postage costs when submitted by mail, for a total of \$11.50.

Total

The total (non-hour) respondent cost burden for this collection is estimated to be \$11.50, which comes from postage costs.

14. Annual Cost to the Federal Government

The USPTO employs a GS-7 to process submissions for this collection.

The USPTO estimates that the cost of a GS-7, step 1 employee is \$28.64 per hour (GS hourly rate of \$22.03 with 30% (\$6.61) added for benefits and overhead).

The USPTO also estimates that it takes an employee approximately 30 minutes (0.50 hours) to process the items in this collection.

Table 4 calculates the burden hours and costs to the Federal Government for processing this information collection:

Table 4: Burden Hour/Cost to the Federal Government

IC Number	Item	Time for Response (hours) (a)	Responses (b)	Annual Burden (c) (a) x (b)	Rate (d)	Total Cost (e) (c) x (d)
1	Electronic Information Disclosure Citation in a Patent	0.50 (30 minutes)	98	49	\$28.64	\$1,403.36
1	Information Disclosure Citation in a Patent	0.50 (30 minutes)	2	1	\$28.64	\$28.64
	Total		100	50		\$1,432.00

15. Reason for Change in Burden

A. Changes in Collection since previous OMB approval in 2015

OMB previously approved the renewal of this collection in October 2015. The current collection contains:

- 240 responses

- 2,400 burden hours
- \$933,600 in respondent hourly cost burden
- \$57.50 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:

- 100 responses
- 1,000 burden hours
- \$438,000 in respondent hourly cost burden
- \$11.50 in annual (non-hourly) costs

Changes in Respondent Cost Burden

The total respondent cost burden for this collection has decreased by \$495,600 (from (\$933,600 to \$438,000) from the previous renewal of this renewal in October 2015:

- Increases in estimated hourly rates. The 2015 renewal used an estimated rate of \$389 per hour for respondents to this collection, which was the rate for intellectual property attorneys in private firms. For the current renewal, the USPTO is using an updated hourly attorney rate of \$438.
- Decreases in burden hours. The total estimated burden hours have decreased from 2,400 in the 2015 renewal to 1,000 for the current renewal due to overall decreases in the estimated annual responses for this collection.

Changes in Responses and Burden Hours

For this renewal, the USPTO estimates that the annual responses will decrease by 140 (from 240 to 100) and the total burden hours will decrease by 1,400 (from 2,400 to 1,000) from the currently approved burden for this collection. These changes are due to the following administrative adjustments:

- Decrease of estimated annual responses from 2,400 to 1,000.

Changes in Annual (Non-hour) Cost

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$46 (from \$57.50 to \$11.50) due to a decrease in postage costs.

16. Project Schedule

The USPTO does not plan to publish this information for statistical use.

17. Display of Expiration Date

The form in this information collection 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.