

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Matters Related to First Inventor to File**  
**OMB CONTROL NUMBER 0651-0071**  
**November 2018**

**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**

IC #	Requirement	Statute	Rule
1	Submissions Under 37 CFR 1.55(k)	35 U.S.C. §§ 2(b)(2) and 119	37 CFR 1.55(k)

IC #	Requirement	Statute	Rule
2	Submissions Under 37 CFR 1.78(a)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(a)(6)
3	Submissions Under 37 CFR 1.78(d)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(d)(6)
4	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
5	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**

IC #	Form and Function	Form #	Needs and Uses
1	Submissions Under 37 CFR 1.55(k)	No Form	<ul style="list-style-type: none"> <li>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.</li> <li>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.</li> </ul>
2	Submissions Under 37 CFR 1.78(a)(6)	No Form	<ul style="list-style-type: none"> <li>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.</li> <li>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.</li> </ul>
3	Submissions Under 37 CFR 1.78(d)(6)	No Form	<ul style="list-style-type: none"> <li>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.</li> <li>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.</li> </ul>

IC #	Form and Function	Form #	Needs and Uses
4	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"> <li>• 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.</li> <li>• 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.</li> <li>• 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).</li> </ul>
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	No Form	<ul style="list-style-type: none"> <li>• 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.</li> <li>• 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.</li> <li>• Used by the USPTO to determine whether the disclosure qualifies as prior art under 35 U.S.C. § 102(a)(1) or (a)(2).</li> <li>• Used by the USPTO to determine whether to maintain a rejection or objection of a claim of an application or a patent under reexamination.</li> </ul>

### 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 September 5, 2018 (83 Fed. Reg. 45106). The comment period ended November 5, 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 23,681 responses per year for this collection. The USPTO estimates that approximately 23,162 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 \$438 per hour for respondent cost burden calculations, which is the mean rate for attorneys in private firms as shown in the *2017 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 \$438 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	1,700	3,400	\$438.00	\$1,489,200.00
1	Submissions Under 37 CFR 1.55(k)	2	50	100	\$438.00	\$43,800.00
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	2	1,375	2,750	\$438.00	\$1,204,500.00
	Submissions Under 37 CFR 1.78(a)(6)	2	25	50	\$438.00	\$21,900.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	2	340	680	\$438.00	\$297,840.00
3	Submissions Under 37 CFR 1.78(d)(6)	2	10	20	\$438.00	\$8,760.00
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	147	294	\$438.00	\$128,772.00
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	2	34	68	\$438.00	\$29,784.00
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	19,600	196,000	\$438.00	\$85,848,000.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	10	400	4,000	\$438.00	\$1,752,000.00
<b>Total</b>	---	---	<b>23,681</b>	<b>207,362</b>	---	<b>\$90,824,556.00</b>

### 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 \$6.70 and that approximately 12 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 \$80.40 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 CFR 1.55 (k)	1	\$6.70	\$6.70
2	Submissions Under 37 CFR 1.78(a)(6)	1	\$6.70	\$6.70
3	Submissions Under 37 CFR 1.78(d)(6)	1	\$6.70	\$6.70
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	1	\$6.70	\$6.70
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	8	\$6.70	\$53.60
	<b>Totals</b>	<b>0</b>	<b>---</b>	<b>0</b>

#### 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 \$28.64 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 \$28.64 (\$22.03 + \$6.59).

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)
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1	CFR 1.55(k)	0.25	1,700	425.00	\$28.64	\$12,172.00
1	Submissions Under 37 CFR 1.55(k)	0.25	50	12.50	\$28.64	\$358.00
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	0.25	1,375	343.75	\$28.64	\$9,845.00
2	Submissions Under 37 CFR 1.78(a)(6)	0.25	25	6.25	\$28.64	\$179.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	0.25	340	85.00	\$28.64	\$2,434.00
3	Submissions Under 37 CFR 1.78(d)(6)	0.25	10	2.50	\$28.64	\$71.60
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	147	36.75	\$28.64	\$1,052.52
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	0.25	34	8.50	\$28.64	\$234.44
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	0.50	19,600	9,800.00	\$28.64	\$280,672.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	0.50	400	200.00	\$28.64	\$5,728.00
	<b>Total</b>	- - -	<b>23,681</b>	<b>10,902.25</b>	- - -	<b>\$312,755.96</b>

## 15. Reason for Change in Burden

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

OMB previously approved a change worksheet for this information collection in November 2015. The current collection contains:

- 50,150 responses
- 340,300 burden hours
- \$139,523,000.00 in respondent hourly cost burden
- \$8,478.00 in annual (non-hour) costs

### Changes since the 60-Day Notice publication

The 60-day notice for this renewal published on September 5, 2018. That notice listed IC line 4 (Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110) as having 3 respondents. This has been corrected to show 34 responses. The burden hours remain unchanged.

### 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:

- 23,681 responses



- 207,362 burden hours
- \$90,824,556.00 in respondent hourly cost burden
- \$80.40 in annual (non-hour) costs

#### Change in Respondent Cost Burden

The total respondent cost burden for this collection has decreased by \$48,698,444.00 (from \$139,523,000.00 to \$90,824,556.00) from the 2015 renewal, due to:

- **Decrease in burden hours (decrease of 132,938).** The previous approval estimated that 340,300 hours would be spent annually by respondents completing the forms in this collection. This renewal has revised that number to reflect that approximately 207,362 hours will be spent completing the forms in this collection. This decrease occurs in spite of the increased wage rate since the previous approval. More respondents have shifted to electronic fee payments that are less time-consuming to complete.

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

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$8,397.60 (from \$8,478.00 to \$80.40) from the previous approval due to the decrease in responses and increased electronic submissions.

#### **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.