

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Patent Review and Derivation Proceedings**  
**OMB CONTROL NUMBER 0651-0069**  
**November 2018**

**A. Justification**

**1. Necessity of Information Collection**

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. §§ 131 and 151 to examine applications and, when appropriate, issue applications as patents. These statutes also provide for consideration of trial reviews of patents, if requested. This collection of information covers the patent review process and related proceedings conducted by the Patent Trial and Appeal Board (“PTAB” or “Board”). The Leahy-Smith America Invents Act (“AIA”), which was enacted into law on September 16, 2011, provided for many changes to the procedures of the PTAB. See Pub. L. 112-29, 125 Stat. 284 (2011). These changes include the introduction of *inter partes* review, post-grant review, derivation proceedings, and the transitional program for covered business method patents.

*Inter partes* review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent only on a ground that could be raised under §§ 102 or 103, and only on the basis of prior art consisting of patents or printed publications. Post grant review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent on any ground that could be raised under § 282(b)(2) or (3). A derivation proceeding is a trial proceeding conducted at the board to determine whether (1) an inventor named in an earlier application derived the claimed invention from an inventor named in petitioner’s application, and (2) the earlier application claiming such invention was filed without authorization. The transitional program for covered business method patents (TPCBM) is a trial proceeding conducted at the Board for review the patentability of one or more claims in a covered business method patent.

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

**Table 1: Information Requirements**

IC Number	Requirement	Statute	Rule
1	Petitions for <i>Inter Partes</i> Review	35 U.S.C. § 312	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20-42.22, 42.24(a)(1), 42.63, 42.65, and 42.101-42.105
2	Petition for Post-Grant Review or Covered Business Method Patent Review	35 U.S.C. § 322	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20-42.22, 42.24(a)(2), 42.24(a)(3), 42.63, 42.65, 42.201-42.205, and 42.302-42.304

3	Petition for Derivation	35 U.S.C. § 135	37 CFR 42.5, 42.6, 42.8, 42.11, 42.13, 42.20-42.22, 42.24(a)(4), 42.63, 42.65, 42.402-42.406
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	35 U.S.C. § 313	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.23, 42.24(c), 42.51-42.54, 42.63 and 42.65
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	35 U.S.C. § 323	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.23, 42.24(c), 42.51-42.54, 42.63 and 42.65
6	Request for Rehearing	35 U.S.C. §§ 2(b)(2), 16(a)(13), and 326(a)(12)	37 CFR 42.71
7	Motions, Replies and Oppositions After Institution in <i>Inter Partes</i> Review	35 U.S.C. § 316	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21, 42.22, 42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51-42.54, 42.63-42.65, 42.107, 42.120, 42.121, and 42.123
8	Motions, Replies and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	35 U.S.C. § 326	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21-42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51-42.54, 42.63-42.65, 42.221, 42.207, 42.220 and 42.223
9	Motions, Replies and Oppositions in Derivation Proceeding	35 U.S.C. § 135(b)	37 CFR 42.6, 42.8, 42.11, 42.13, 42.21-42.23, 42.24(a)(5), 42.24(b), 42.24(c), 42.51-42.54, 42.63-42.65
10	Request for Oral Hearing	35 U.S.C. §§ 2(b)(2), 316(a)(10), and 326(a)(10)	37 CFR 42.70
11	Request to Treat a Settlement as Business Confidential	35 U.S.C. §§ 135(e), 317(a), and 327(a)	37 CFR 42.74(c) and 42.410
12	Settlement	35 U.S.C. §§ 2(b)(2), 135(e), 317, and 327	37 CFR 42.73(b) and 42.74(b)
13	Arbitration Agreement and Award	35 U.S.C. § 135(f)	37 CFR 42.410
14	Request to Make a Settlement Agreement Available	35 U.S.C. §§ 135(e), 317(b), and 327(b)	37 CFR 42.74(c)
15	Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. § 142)	35 U.S.C. §§ 141, 142, 145, and 146	37 CFR 90.1 through 90.3

## 2. Needs and Uses

The public will use this information collection to petition the Board to seek the institution of – and to participate in – *inter partes* reviews, post-grant reviews, covered business method patent reviews, and derivation proceedings.

The Board disseminates information that it collects (unless filed under seal) through various publications and databases. This information collection includes the filings of the parties and decisions and orders by the Board in trials and derivation proceedings.

Opinions authored by the Board have varying degrees of authority attached to them. There are precedential opinions, which when published, are binding and provide the criteria and authority that the Board will use to decide all other factually similar cases (until the opinion is overruled or changed by statute). There are informative opinions, which are non-precedential and illustrate the norms of Board decision-making for the public. There are representative opinions, which are non-precedential and are publicly

available opinions that provide a representative sample of outcomes on a matter. The final type of Board opinion is the routine opinion. Routine opinions are also non-precedential and are publicly available opinions. Since public policy favors a widespread publication of opinions, the Board publishes all publicly available opinions, even if the opinions are not binding precedent upon the Board.

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	Petition for <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties who are not the owners of a patent to file a petition to institute an <i>inter partes</i> review of a patent.</li> <li>• Used by parties to request to cancel as unpatentable one or more claims of a patent only on a ground that could be raised under 35 U.S.C. § 102 or 103 and only on the basis of prior art consisting of patents or printed publications.</li> <li>• Used by parties to demonstrate that they have standing to file the petition (i.e., the patent is available for <i>inter partes</i> review and the petitioner is not barred from requesting such review).</li> <li>• Used by the Board to determine whether to institute an <i>inter partes</i> review including whether the petition identifies all real parties in interest, identifies each claim challenged (including the grounds on which the challenge to each claim is based, and the evidence that supports the grounds), provides copies of the necessary documents, and that the necessary fee is included.</li> </ul>

2	Petition for Post-Grant Review or Covered Business Method Patent Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties who are not owners of a patent and who, along with any real party-in-interest, has not filed a civil action challenging the validity of a claim of the patent to file a petition to institute a post-grant review of a patent.</li> <li>• Used by parties to request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under 35 U.S.C. § 282(b)(2) or (3) (relating to invalidity of the patent or any claim) as part of a post-grant review.</li> <li>• Used by parties to file a petition for a transitional proceeding with respect to a covered business method patent when the petitioner, the petitioner's real party-in-interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent and where the petitioner, the petitioner's real party-in-interest has not filed a civil action challenging the validity of a claim of the patent.</li> <li>• Used by the Board to determine whether to institute a post-grant review including whether the petition identifies all real parties in interest, identifies each claim challenged (including the grounds on which the challenge to each claim is based and the evidence that supports the grounds), provides copies of the necessary documents, and that the necessary fee is included.</li> <li>• Used by the Board to determine whether to institute a transitional proceeding for covered business method patents including whether a claim is a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service and not a technological invention.</li> </ul>
3	Petition for Derivation	No Form Associated	<ul style="list-style-type: none"> <li>• Used by an applicant for patent to petition the Board to institute a derivation proceeding.</li> <li>• Used by the applicant to demonstrate that they have standing to file the petition for derivation (i.e., timely filing a petition that demonstrates that the earlier filed application derived the claimed invention and was filed by another inventor without authorization and that the applicant has taken steps to obtain patent protection for the invention).</li> <li>• Used by the Board to determine whether to institute a derivation proceeding as long as the necessary requirements are met (i.e., the petition identifies the precise relief requested, the petition is filed within one year after the first publication of a claim to an invention, the fee is submitted with the petition).</li> </ul>
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by patent owner to set forth reasons why no <i>inter partes</i> review should be instituted.</li> <li>• Used by the Board together with the petition for <i>inter partes</i> review to determine whether to institute an <i>inter partes</i> review.</li> </ul>

5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by patent owner to set forth reasons why no post-grant review or covered business method review should be instituted.</li> <li>• Used by the Board together with the petition for post-grant review or covered business method review to determine whether to institute a post-grant review or covered business method review.</li> </ul>
6	Request for Rehearing	No Form Associated	<ul style="list-style-type: none"> <li>• Used by the parties to request the Board to reconsider the decision not to institute a trial or another decision.</li> <li>• Used by the Board to review the original decision to not institute a trial or another decision.</li> </ul>
7	Motions, Replies, Surreplies, and Oppositions After Institution in <i>Inter Partes</i> Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for <i>inter partes</i> review.</li> <li>• Used by the opposing parties, such as by a patent owner in response to a petition, to set forth the reasons why the Board should not grant the relief sought in a motion.</li> <li>• Used by the Board in issuing a final written decision with respect to patentability of a challenged patent claim.</li> </ul>
8	Motions, Replies, Surreplies, and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for post-grant review or covered business method patent review.</li> <li>• Used by the opposing parties, such as by a patent owner in response to a petition, to set forth the reasons why the Board should not grant the relief sought in a motion.</li> <li>• Used by the Board in issuing a final written decision with respect to patentability of a challenged patent claim.</li> </ul>
9	Motions, Replies, Surreplies, and Oppositions in Derivation Proceeding	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to seek relief in a proceeding including motions to amend, motions to exclude evidence, motions to seal, motions for joinder, motions to file supplemental information, motions for judgment based on supplemental information, motions for observations on cross-examination, and motions to correct clerical or typographical mistakes in a petition for a derivation proceeding.</li> <li>• Used by the opposing parties, such as by a patent owner in response to a petition, to set forth the reasons why the Board should not grant the relief sought in a motion.</li> <li>• Used by the Board in issuing a final written decision with respect to the alleged derivation.</li> </ul>

10	Request for Oral Hearing	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to request an oral hearing.</li> <li>• Used by the Board to schedule an oral hearing, if appropriate.</li> </ul>
11	Request to Treat a Settlement as Business Confidential	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to request that the settlement agreement be kept confidential and be filed separately from the patent or application file.</li> <li>• Used by the Board to provide that the settlement agreement be designated as business confidential and kept separately from the publicly available patent or application files.</li> </ul>
12	Settlement	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to concede the contest.</li> <li>• Used by the Board to render judgment against the party conceding the contest.</li> </ul>
13	Arbitration Agreement and Award	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to give notice to the Office of the result of an arbitration between parties.</li> <li>• Used by the Board to update the records of an instituted derivation proceeding.</li> </ul>
14	Request to Make a Settlement Agreement Available	No Form Associated	<ul style="list-style-type: none"> <li>• Used by a requester to gain access to a settlement agreement.</li> <li>• Used by the Board to determine whether the requester may be granted access to the settlement agreement.</li> </ul>
15	Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. § 142)	No Form Associated	<ul style="list-style-type: none"> <li>• Used by parties to notify the USPTO that a party has filed a notice of appeal or election</li> <li>• Used by the Board to recognize that the final decision of the Board has been appealed.</li> </ul>

### 3. Use of Information Technology

All of the patent review and derivation papers will be filed electronically, unless otherwise authorized by the Board. The USPTO currently utilizes the Patent Trial and Appeal Board End-to-End System (PTAB E2E), which allows parties to file proceedings electronically.

The PTAB disseminates opinions and decisions to the public through the USPTO's website and in the individual case locations in PTAB E2E, which has a public portal. The PTAB also posts final decisions in patent review and derivation proceedings on the USPTO's electronic Freedom of Information Act (e-FOIA) website.

### 4. Efforts to Identify Duplication

This information is collected only when parties file petitions and other associated papers for *inter partes* reviews, post-grant reviews, covered business method patent reviews, and derivations. This collection does, in part, solicit data already available at the USPTO, in that certain copies of evidence may have been submitted earlier as part of the patent examination process of the application that resulted in the patent under

review. The duplication of effort is limited, however, and the agency considers it necessary as such duplication is required pursuant to 35 U.S.C. § 312. Although the copies of evidence relied upon in petitions may be duplicates of evidence already in the file of the application that resulted in the patent under review, the necessity of absolute clarity as to the evidence relied on in the proceeding to have a complete record, coupled with the requirement to collect this information under the AIA, outweighs the burden on the public.

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

This collection of information does not impose a significant economic impact on small entities or small businesses.

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

This information is collected only when a member of the public files petitions for *inter partes* review, post-grant review, covered business method patent review, or an applicant files a petition seeking a derivation proceeding or files any of the responses, replies, requests, motions, oppositions, or other papers associated with these proceedings. This information is not collected elsewhere. Therefore, this collection of information could not be conducted less frequently. If this information was not collected, the Board could not ensure that the petitioner has submitted all of the information (and applicable fees) necessary to initiate these new proceedings, nor could the Board determine whether the proceeding should be instituted. If this information was not collected, the Office could not comply with the requirements of 35 U.S.C. §§ 135, 141, 142, 145, 146, 312, 313, 316, 317, 322, 323, 326, and 327, and adopted 37 CFR Parts 42 and 90.

## **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<sup>th</sup>, 2018 (37 FR 45104). The comment period ended on November 4<sup>th</sup>, 2018. No comments were received.

The USPTO has long-standing relationships with groups from whom patent application information 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 search facilities. Their views are expressed in regularly scheduled meetings and considered in developing proposals for information collection requirements. There have been no comments or concerns expressed by these or similar organizations concerning the time to provide the information required under this program.

## 9. Payment or Gifts to Respondents

This information collection does not include a payment or gift to any respondent.

## 10. Assurance of Confidentiality

Generally, the file of any *inter partes* review, post-grant review, covered business method patent review, and derivation proceeding would be available to the public. See 35 U.S.C. §§ 122, 316(a)(1), and 326(a)(1). In 37 CFR 42.55, petitioners filing confidential information can file, concurrently with the filing of the petition, a motion for a protective order as to the confidential information. Under those rules, the petitioner must file with the petition, but not serve the patent owner with the confidential information, and can do so under seal. The patent owner may then access the confidential information prior to the institution of a trial by agreeing to the terms of the motion for protective order.

## 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 11,994 total responses per year for this collection.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public between approximately 6 minutes (0.10 hours) and 165.30 hours to complete an individual form in this collection.

- **Cost Burden Calculation Factors**

The USPTO uses a professional 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	Estimated Response Time (Hours) (a)	Estimated Responses (b)	Estimated Burden Hours (c) (a) x (b)	Rate (d)	Estimated Cost Burden (e) (c) x (d)
1	Petition for <i>Inter Partes</i> Review	124	1,553	192,572.00	\$438.00	\$84,346,536.00



2	Petition for Post-Grant Review or Covered Business Method Patent Review	165.30	91	15,042.30	\$438.00	\$6,588,527.40
3	Petition for Derivation	165.30	11	1,818.30	\$438.00	\$796,415.40
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	91.60	1,333	122,102.80	\$438.00	\$53,481,026.40
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	91.60	68	6,228.80	\$438.00	\$2,728,214.40
6	Request for Rehearing	80	322	25,760.00	\$438.00	\$11,282,880.00
7	Motions, Replies, Surreplies, and Oppositions After Institution in <i>Inter Partes</i> Review	158	6,482	1,024,156.00	\$438.00	\$448,580,328.00
8	Motions, Replies, Surreplies, and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	148	245	36,260.00	\$438.00	\$15,881,880.00
9	Motions, Replies, Surreplies, and Oppositions After Institution in Derivation Proceedings	120	7	840.00	\$438.00	\$367,920.00
10	Request for Oral Hearing	18.30	727	13,304.10	\$438.00	\$5,827,195.80
11	Request to Treat a Settlement as Business Confidential	2	356	712.00	\$438.00	\$311,856.00
12	Settlement	100	356	35,600.00	\$438.00	\$15,592,800.00
13	Arbitration Agreement and Award	4	2	8.00	\$438.00	\$3,504.00
14	Request to Make a Settlement Agreement Available	1	1	1.00	\$438.00	\$438.00
15	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	0.10	440	44.00	\$438.00	\$19,272.00
	<b>Total</b>		<b>11,994</b>	<b>1,474,449.30</b>		<b>\$645,808,793.40</b>

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

This collection has non-hourly costs in the form of fees paid to the USPTO. There are no capital start-up, maintenance, or postage costs associated with this collection.

#### Fees

The filing fees associated with this information collection are listed in Table 4 below:

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

IC Number	Item	Responses (a)	Filing Fee (b)	Total Cost (c) (a) x (b)
1	<i>Inter Partes</i> Review Request Fee – Up to 20 Claims	1,560	\$15,500.00	\$24,180,000.00

1	<i>Inter Partes</i> Post-Institution Fee – Up to 15 Claims	1,569	\$15,000.00	\$23,535,000.00
1	<i>Inter Partes</i> Review Request of Each Claim in Excess of 20	3,390	\$300.00	\$1,017,000.00
1	<i>Inter Partes</i> Post-Institution Request of Each Claim in Excess of 15	1,768	\$600.00	\$1,071,600.00
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	92	\$16,000.00	\$1,472,000.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	92	\$22,000.00	\$2,024,000.00
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	638	\$375.00	\$239,250.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	925	\$825.00	\$763,125.00
3	Petition for Derivation	12	\$400.00	\$4,800.00
14	Request to Make a Settlement Agreement Available	1	\$400.00	\$400.00
	<b>Total</b>	<b>10,047</b>		<b>\$54,307,175.00</b>

Total

The total (non-hour) respondent cost burden for this collection is estimated to be \$54,307,175 per year, which covers the filing fees associated with this collection.

**14. Annual Cost to Federal Government**

With the exception of the notices of judicial review of a Board decision (e.g., notice of appeal under 35 U.S.C. §142), all of the items in this collection are processed by administrative patent judges. The notices of judicial review of a Board decision are processed by USPTO staff at a GS-15, step 5 level. The USPTO estimates that it will take GS-15, step 5 staff 6 minutes (0.10 hours) to process the notices of judicial review of a Board decision and that it will take the administrative patent judges between 15 minutes (0.25 hours) and 53 hours to process the remaining items. The USPTO estimates that the hourly rate (with benefits and overhead) for an administrative patent judge is \$258.32, based upon the Department of Commerce’s 2018 Pay Scale. The USPTO estimates that the cost of a GS-15, step 5 employee is \$95.16 per hour (GS hourly rate of \$73.20 with 30% (\$21.96) added for benefits and overhead).

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

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

IC	Item	Hours (a)	Responses (b)	Burden (c)	Rate (d)	Total Cost (e)
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Number				(a) x (b)		(c) x (d)
1	Petition for <i>Inter Partes</i> Review	40	1,553	62,120.00	\$258.32	\$16,046,838.40
2	Petition for Post-Grant Review or Covered Business Method Patent Review	53	91	4,823.00	\$258.32	\$1,245,877.36
3	Petition for Derivation	53	11	583.00	\$258.32	\$150,600.56
4	Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review	12	1,333	15,996.00	\$258.32	\$4,132,086.72
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	14	68	952.00	\$258.32	\$245,920.64
6	Request for Rehearing	16	322	5,152.00	\$258.32	\$1,330,984.64
7	Motions, Replies, Surreplies, and Oppositions After Institution in <i>Inter Partes</i> Review	13	6,482	84,266.00	\$258.32	\$21,767,593.12
8	Motions, Replies, Surreplies, and Oppositions After Institution in Post-Grant Review or Covered Business Method Review	14	245	3,430.00	\$258.32	\$886,037.60
9	Motions, Replies, Surreplies, and Oppositions After Institution in Derivation Proceedings	14	7	98.00	\$258.32	\$25,315.36
10	Request for Oral Hearing	3.75 (225 minutes)	727	2,726.25	\$258.32	\$704,244.90
11	Request to Treat a Settlement as Business Confidential	1	356	356.00	\$258.32	\$91,961.92
12	Settlement	0.25 (15 minutes)	356	89.00	\$258.32	\$22,990.48
13	Arbitration Agreement and Award	0.50 (30 minutes)	2	1.00	\$258.32	\$258.32
14	Request to Make a Settlement Agreement Available	1	1	1.00	\$258.32	\$258.32
15	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	0.10 (6 minutes)	440	44.00	\$95.16	\$4,187.04
	<b>Total</b>		<b>11,994</b>	<b>180,637.25</b>		<b>\$46,655,035.38</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 November 2015. The current collection contains:

- 11,349 responses
- 1,459,184 burden hours

- \$598,265,440 in respondent hourly cost burden
- \$60,404,425.50 in annual (non-hour) costs

#### Changes due to rulemaking activity

In March 2016, information collection 0651-0072 (America Invents Act Section 10 Patent Fee Adjustments) was discontinued. During this process, fees associated with 0651-0069 were returned to this collection. As a result of this transition, six fees were moved into this collection.

In December 2017, the fees in this collection were updated as part the Biennial Fee Review process. During this process, the annual (non-hourly) cost amount increased by \$46,338,275.

#### 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:

- 11,994 responses
- 1,474,449.30 burden hours
- \$645,808,793.40 in respondent hourly cost burden
- \$504,307,175 in annual (non-hour) costs

#### Change in Respondent Cost Burden

The total respondent cost burden for this collection has increased by \$47,543,353.40 (from \$598,265,440 to \$645,808,793.40) from the previous renewal of this collection in November 2015:

- Increases in estimated hourly rates. The 2015 renewal used an estimated rate of \$410 per hour for respondents to this collection, which was the estimated professional rate for intellectual property attorneys in private firms. For the current renewal, the USPTO is using an updated hourly rate of \$438 for attorneys.
- Increase in estimated burden hours. The total estimated burden hours have increased from 1,459,184 in the 2015 renewal to 1,474,449.30 in the current renewal due to overall increases in the estimated annual responses for this collection.

#### Changes in Responses and Burden Hours

For this renewal, the USPTO estimates that the annual response will increase by 645 (from 11,349 to 11,994) and the total burden hours will increase by 15,265.30 (from 1,459,184 to 1,474,449.30) from the currently approved burden for the collection.

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

For this renewal, the USPTO estimates that the total annual (non-hour) costs will increase by \$43,902,749.50 (from \$60,404,425.50 to \$504,307,175). Below is a list of the changes to this collection:

- Return of filing fees due to the discontinuation of collection 0651-0072 (America Invents Act Section 10 Patent Fee Adjustment).
- Adjustment of the fees as part of the Patent Biennial Fee Review. As a part of this process, the annual (non-hourly) costs increased by \$46,338,275.

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

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

#### **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.