

**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), 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 the patent and trademark processes. 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.

This request is to update the fees attached to collection 0651-0069 (Patent Review and Derivation Proceedings) that are affected by the rulemaking NPRM **RIN 0651-AD31 (84 FRN 37398)**. There are ten fees being adjusted as a result of the 2019 Patent Biennial Fee Review.

**Table 1: Proposed Fee**

IC #	Item	Current Fees	Proposed Fees	Changes in Fees
1	Inter Partes Review Request Fee - Up to 20 Claims	\$15,500	\$19,500	\$4,000
1	Inter Partes Post-Institution Fee - Up to 20 Claims	\$15,000	\$18,750	\$3,750
1	Inter Partes Review Request of Each Claim in Excess of 20	\$300	\$375	\$75
1	Inter Partes Post-Institution Request of Each Claim in Excess of 20	\$600	\$750	\$150
2	Post-Grant of Covered Business Method Review Request Fee - Up to 20 Claims	\$16,000	\$20,000	\$4,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee - Up to 15 Claims	\$22,000	\$27,500	\$5,500
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	\$375	\$475	\$100
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	\$825	\$1,050	\$225
3	Petition for Derivation	\$400	\$420	\$20
14	Request to Make a Settlement Agreement Available	\$400	\$420	\$20

**Table 2: Proposed Burden**

IC #	Item	Responses	Proposed Fees	Proposed Cost
1	Inter Partes Review Request Fee - Up to 20	1,560	\$19,500.00	\$30,420,000.00

	Claims			
1	Inter Partes Post-Institution Fee - Up to 20 Claims	1,569	\$18,750.00	\$29,418,750.00
1	Inter Partes Review Request of Each Claim in Excess of 20	3,390	\$375.00	\$1,271,250.00
1	Inter Partes Post-Institution Request of Each Claim in Excess of 20	1,768	\$750.00	\$1,326,000.00
2	Post-Grant of Covered Business Method Review Request Fee - Up to 20 Claims	92	\$20,000.00	\$1,840,000.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee - Up to 15 Claims	92	\$27,500.00	\$2,530,000.00
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	635	\$475.00	\$301,625.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	925	\$1,050.00	\$971,250.00
3	Petition for Derivation	12	\$420.00	\$5,040.00
14	Request to Make a Settlement Agreement Available	1	\$420.00	\$420.00
	<b>Totals</b>	<b>10,044</b>		<b>\$68,084,335.00</b>

**Table 3: Change in Cost**

IC #	Item	Current Cost	Proposed Cost	Change in Cost
1	Inter Partes Review Request Fee - Up to 20 Claims	\$24,180,000.00	\$30,420,000.00	\$6,240,000.00
1	Inter Partes Post-Institution Fee - Up to 20 Claims	\$23,535,000.00	\$29,418,750.00	\$5,883,750.00
1	Inter Partes Review Request of Each Claim in Excess of 20	\$1,017,000.00	\$1,271,250.00	\$254,250.00
1	Inter Partes Post-Institution Request of Each Claim in Excess of 20	\$1,060,800.00	\$1,326,000.00	\$265,200.00
2	Post-Grant of Covered Business Method Review Request Fee - Up to 20 Claims	\$1,472,000.00	\$1,840,000.00	\$368,000.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee - Up to 15 Claims	\$2,024,000.00	\$2,530,000.00	\$506,000.00
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	\$238,125.00	\$301,625.00	\$63,500.00
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	\$763,125.00	\$971,250.00	\$208,125.00
3	Petition for Derivation	\$4,800.00	\$5,040.00	\$240.00

14	Request to Make a Settlement Agreement Available	\$400.00	\$420.00	\$20.00
	<b>Totals</b>	<b>\$54,295,250.00</b>	<b>\$68,084,335.00</b>	<b>\$13,789,085.00</b>

Summary of Changes

The Patent Review resulted in a revision of ten forms and an increase of \$13,789,073 in annual (non-hourly) costs.

Changes in Burden

<b>Burden Type</b>	<b>Currently Approved</b>	<b>Proposed Change</b>	<b>New Estimate</b>
Non-hourly Costs	<b>\$54,306,775</b>	\$13,789,073	<b>\$68,095,848</b>

0651-0069's revised burden is as follows:

- \$68,095,848 in annual (non-hourly) costs