

SUPPORTING STATEMENT
United States Patent and Trademark Office
Matters Related to First Inventor to File
OMB CONTROL NUMBER 0651-0071
2022

A. JUSTIFICATION

- 1. Explain the circumstances that make the collection of information necessary. Identify any legal or administrative requirements that necessitate the collection. Attach a copy of the appropriate section of each statute and regulation mandating or authorizing the collection of information.**

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.

This information collection covers information required by 37 CFR 1.55(k), 1.78(a)(6), and 1.78(d)(6) to assist the USPTO in determining whether an application is subject to 35 U.S.C. 102 and 103 as amended by Section 3 of the Leahy-Smith America Invents Act (AIA), or 35 U.S.C. 102 and 103, in effect on March 15, 2013.

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

Item No.	Requirement	Statute	Regulation
1	Submissions Under 37 CFR 1.55(k)	35 U.S.C. §§ 2(b)(2) and 119	37 CFR 1.55(k)
2	Submissions Under 37 CFR 1.78(a)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(a)(6)

Item No.	Requirement	Statute	Regulation
3	Submissions Under 37 CFR 1.78(d)(6)	35 U.S.C. §§ 2(b)(2) and 120	37 CFR 1.78(d)(6)

2. Indicate how, by whom, and for what purpose the information is to be used. Except for a new collection, indicate the actual use the agency has made of the information received from the current collection.

The items in this information collection are used by the USPTO to determine whether a patent application is subject to 35 U.S.C. 102 and 103 as amended by Section 3 of the Leahy-Smith America Invents Act (AIA), or 35 U.S.C. 102 and 103, in effect on March 15, 2013.

The information collected, maintained, and used in this information collection is based on Office of Management and Budget (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

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

- 3. Describe whether, and to what extent, the collection of information involves the use of automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses, and the basis for the decision for adopting this means of collection. Also describe any consideration of using information technology to reduce burden.**

The items in this information collection may be submitted online using the Patent Electronic System (EFS-Web and Patent Center), the USPTO's Web-based filing system. The items in this information collection can be created based on the guidelines set forth in MPEP 210(III). Applicants may then submit these items to the USPTO through the Patent Electronic System.

The Patent Electronic System 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 electronic documents and then upload them to the USPTO servers using the secure Patent Electronic System interface. The Patent Electronic System 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.

To protect the confidentiality, authenticity, and integrity of electronic submissions, the USPTO employs Public Key Infrastructure (PKI) technology for secure electronic communications with its customers. All electronic submissions are automatically encrypted prior to transmission to ensure confidentiality of the submission contents. After the electronic package has been received by the USPTO, the Patent Electronic System server uses digital signature technology to verify that the package contents have not been altered and generates an electronic acknowledgement receipt that is immediately returned to the customer.

- 4. Describe efforts to identify duplication. Show specifically why any similar information already available cannot be used or modified for use for the purposes described in Item 2 above.**

The USPTO has determined that the information covered by this information collection is not collected elsewhere and does not result in a duplication of effort.

- 5. If the collection of information impacts small businesses or other small entities, describe any methods used to minimize burden.**

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. Describe the consequence to Federal program or policy activities if the collection is not conducted or is conducted less frequently, as well as any technical or legal obstacles to reducing burden.

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 increase, and could result in confusion as to the applicable version of 35 U.S.C. 102 and/or 103 (i.e., AIA versus pre-AIA) to be used in determining patentability.

7. Explain any special circumstances that would cause an information collection to be conducted in a manner:

- **requiring respondents to report information to the agency more often than quarterly;**
- **requiring respondents to prepare a written response to a collection of information in fewer than 30 days after receipt of it;**
- **requiring respondents to submit more than an original and two copies of any document;**
- **requiring respondents to retain records, other than health, medical, government contract, grant-in-aid, or tax records, for more than three years;**
- **in connection with a statistical survey, that is not designed to produce valid and reliable results that can be generalized to the universe of study;**
- **requiring the use of a statistical data classification that has not been reviewed and approved by OMB;**
- **that includes a pledge of confidentiality that is not supported by authority established in statute or regulation, that is not supported by disclosure and data security policies that are consistent with the pledge, or which unnecessarily impedes sharing of data with other agencies for compatible confidential use; or**
- **requiring respondents to submit proprietary trade secrets, or other confidential information unless the agency can demonstrate that it has instituted procedures to protect the information's confidentiality to the extent permitted by law.**

There are no special circumstances associated with this collection of information.

8. If applicable, provide a copy and identify the date and page number of publication in the Federal Register of the agency's notice, required by 5 CFR 1320.8(d), soliciting comments on the information collection prior to submission to OMB. Summarize public comments received in response to that notice and describe actions taken by the agency in response to these

comments. Specifically address comments received on cost and hour burden.

Describe efforts to consult with persons outside the agency to obtain their views on the availability of data, frequency of collection, the clarity of instructions and recordkeeping, disclosure, or reporting format (if any), and on the data elements to be recorded, disclosed, or reported.

Consultation with representatives of those from whom information is to be obtained or those who must compile records should occur at least once every 3 years - even if the collection of information activity is the same as in prior periods. There may be circumstances that may preclude consultation in a specific situation. These circumstances should be explained.

The 60-Day Notice was published in the *Federal Register* on October 5, 2021 (86 FR 54946). The comment period ended December 6, 2021. 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 its public facilities. Views expressed by these groups are considered in developing information collection requirements and during the renewal of an information collection. No views have been expressed regarding the present renewal.

9. Explain any decision to provide any payment or gift to respondents, other than remuneration of contractors or grantees.

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

10. Describe any assurance of confidentiality provided to respondents and the basis for the assurance in statute, regulation, or agency policy. If the collection requires a systems of records notice (SORN) or privacy impact assessment (PIA), those should be cited and described here.

Confidentiality of patent applications is governed by statute (35 U.S.C. § 122) and regulation (37 CFR 1.11 and 1.14). The USPTO has a legal obligation to maintain the confidentiality of the contents of unpublished patent applications and related documents. For secure electronic access to PAIR, the USPTO employs digital certificates and PKI technology to permit only authorized individuals to access private patent application information and to maintain the confidentiality and integrity of the information as it is transmitted over the Internet. Upon publication of an application or issuance of a patent, the patent application file is made available to the public, subject to the provisions for

providing only a redacted copy of the file contents. The entire file of a reexamination proceeding is available to the public.

USPTO is required by 35 U.S.C. § 131, to maintain the patenting process. Information is collected on petitions and applications for patent products including information regarding representation. These information collection activities are covered under the Statement of Records Notice (SORN COMMERCE/PAT-TM-7 Patent Application Files, available at Federal Register /Vol. 78, No. 61 / Friday, March 29, 2013 /Notices 19243. <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>).

This SORN covers the following categories of individuals: applicants for patent, including inventors, legal representatives for inventors, and other persons authorized by law to make applications for patent.

The information is protected from disclosure to third parties in accordance with the Privacy Act. However, routine uses of this information may include disclosure to the following: to law enforcement and investigation in the event that the system of records indicates a violation or potential violation of law; to a Federal, state, local, or international agency, in response to its request; to an agency, organization, or individual for the purpose of performing audit or oversight operations as authorized by law; to non-federal personnel under contract to the agency; to a court for adjudication and litigation; to the Department of Justice for Freedom of Information Act assistance; to members of congress working on behalf of an individual; to the Office of Personnel Management for personnel research purposes; to National Archives and Records Administration for records activities, and to OMB for legislative coordination and clearance.

- 11. Provide additional justification for any questions of a sensitive nature, such as sexual behavior and attitudes, religious beliefs, and other matters that are commonly considered private. This justification should include the reasons why the agency considers the questions necessary, the specific uses to be made of the information, the explanation to be given to persons from whom the information is requested, and any steps to be taken to obtain their consent.**

None of the required information is considered to be sensitive.

- 12. Provide estimates of the hour burden of the collection of information. The statement should:**
 - Indicate the number of respondents, frequency of response, annual hour burden, and an explanation of how the burden was estimated. Unless directed to do so, agencies should not conduct special surveys to obtain information on which to base hour burden estimates. Consultation with a sample (fewer than 10) of potential respondents is desirable. If the hour burden on respondents is expected to vary widely because of differences in**

activity, size, or complexity, show the range of estimated hour burden, and explain the reasons for the variance. Generally, estimates should not include burden hours for customary and usual business practices.

- If this request for approval covers more than one form, provide separate hour burden estimates for each form and aggregate the hour burdens.
- Provide estimates of annualized cost to respondents for the hour burdens for collections of information, identifying and using appropriate wage rate categories. The cost of contracting out or paying outside parties for information collection activities should not be included here. Instead, this cost should be included under 'Annual Cost to Federal Government'.

Tables 3 and 4 calculate 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 144 responses per year from 99 respondents for this information collection, with approximately 25% of these responses submitted by small entities.

- **Burden Hour Calculation Factors**

The USPTO estimates that the responses in this information collection will take the public 2 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO.

These estimates are based on the Agency's longstanding 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. Using these burden factors, USPTO estimates that the total respondent hourly burden for this information collection is 288 hours per year.

- **Cost Burden Calculation Factors**

The USPTO uses a professional rate of \$435 per hour for respondent cost burden calculations, which is the mean rate of intellectual property attorneys in private firms as shown in the 2021 Report of the Economic Survey published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA). Using these hourly rates, the USPTO estimates that the total respondent cost burden for this information collection is \$125,280 per year.

Table 3: Total Burden Hours and Hourly Cost to Private Sector Respondents

Item No.	Item	Estimated Annual Respondents (a)	Estimated Responses per Respondent (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time For Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ¹ (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Submissions Under CFR 1.55(k)	47	1.5	71	2	142	\$435	\$61,770
2	Submissions Under 37 CFR 1.78(a)(6)	37	1.5	56	2	112	\$435	\$48,720
3	Submissions Under 37 CFR 1.78(d)(6)	9	1.5	14	2	28	\$435	\$12,180
	Total	93		141		282		\$122,670

Table 4: Total Burden Hours and Hourly Cost to Individuals or Households Respondents

Item No.	Item	Estimated Annual Respondents (a)	Estimated Responses per Respondent (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time For Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ² (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Submissions Under CFR 1.55(k)	1	1	1	2	2	\$435	\$870
2	Submissions Under 37 CFR 1.78(a)(6)	1	1	1	2	2	\$435	\$870
3	Submissions Under 37 CFR 1.78(d)(6)	1	1	1	2	2	\$435	\$870
	Total	3		3		6		\$2,610

- 13. Provide an estimate for the total annual cost burden to respondents or record keepers resulting from the collection of information. (Do not include the cost of any hour burden already reflected on the burden worksheet).**
- The cost estimate should be split into two components: (a) a total capital and start-up cost component (annualized over its expected useful life) and (b) a total operation and maintenance and purchase of services component. The estimates should take into account costs associated with generating, maintaining, and disclosing or providing the information. Include descriptions of methods used to estimate major cost factors including system and technology acquisition, expected useful life of capital equipment, the discount rate(s), and the time period over which costs will be incurred. Capital and start-up costs include, among other items, preparations for collecting information such as purchasing computers and**

¹ 2021 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2021-report-of-the-economic-survey>, pg. F–27. The USPTO uses the average billing rate for intellectual property attorneys in private firms which is \$435 per hour.

² 2021 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2021-report-of-the-economic-survey>, pg. F–27. The USPTO uses the average billing rate for intellectual property attorneys in private firms which is \$435 per hour..

software; monitoring, sampling, drilling and testing equipment; and record storage facilities.

- **If cost estimates are expected to vary widely, agencies should present ranges of cost burdens and explain the reasons for the variance. The cost of purchasing or contracting out information collections services should be a part of this cost burden estimate. In developing cost burden estimates, agencies may consult with a sample of respondents (fewer than 10), utilize the 60-day pre-OMB submission public comment process and use existing economic or regulatory impact analysis associated with the rulemaking containing the information collection, as appropriate.**
- **Generally, estimates should not include purchases of equipment or services, or portions thereof, made: (1) prior to October 1, 1995, (2) to achieve regulatory compliance with requirements not associated with the information collection, (3) for reasons other than to provide information or keep records for the government, or (4) as part of customary and usual business or private practices.**

There are no capital start-up, maintenance, recordkeeping costs, or fees associated with this information collection. However, there may be postage costs associated with submitting these items. The USPTO estimated that the total non-hour cost burden for this information collection is \$8.

Although the USPTO prefers that the items in this information collection be submitted electronically, responses may be submitted by mail through the United States Postal Service (USPS). The USPTO estimates that 1% of the 144 items will be submitted in the mail resulting in 1 mailed item. The USPTO estimates that the average postage cost for a mailed submission, using a Priority Mail 2-day flat rate legal envelope, will be \$8.25. Therefore, the USPTO estimates \$8 in postage costs associated with this information collection.

- 14. Provide estimates of annualized costs to the Federal government. Also, provide a description of the method used to estimate cost, which should include quantification of hours, operational expenses (such as equipment, overhead, printing, and support staff), and any other expense that would not have been incurred without this collection of information. Agencies may also aggregate cost estimates from Items 12, 13, and 14 in a single table.**

The USPTO estimates the annualized cost to the Federal Government to process and administer the items in this information collection to be \$1,102. 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).

The hourly rate for a GS-7, step 1, employee is currently \$23.55 according to 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 \$30.62 (\$23.55 + \$7.07).

Estimates are based upon Agency longstanding institutional knowledge of and experience with processing this type of information.

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

Table 5: Burden Hour/Burden Cost to the Federal Government for Post Patent Public Submissions

Item No.	Item	Estimated Annual Responses (a)	Estimated Time For Response (hours) (b)	Estimated Burden (hour/year) (a) x (b) = (c)	Rate (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
1	Submissions Under CFR 1.55(k)	72	.25	18	\$30.62	\$551
2	Submissions Under 37 CFR 1.78(a)(6)	57	.25	14	\$30.62	\$429
3	Submissions Under 37 CFR 1.78(d)(6)	15	.25	4	\$30.62	\$122
	Totals	144		36		\$1,102

15. Explain the reasons for any program changes or adjustments reported on the burden worksheet.

ICR Summary of Burden:

	Requested	Program Change Due to New Statute	Program Change Due to Agency Discretion	Change Due to Adjustment in Agency Estimate	Change Due to Potential Violation of the PRA	Previously Approved
Annual Number of Responses	144	0	-20,179	-3,358	0	23,681
Annual Time Burden (Hr)	288	0	-200,358	-6,716	0	207,362
Annual Cost Burden (\$)	8	0	-61	-13	0	82

Changes in Annual Responses, Time Burden, and Cost Burdens due to Agency Discretion

USPTO removed two items from this information collection due to Paperwork Reduction Act exemptions. This removal results in a decrease of 20,179 responses, 200,358 burden hours, and \$61 annual cost burden.

The USPTO finds that the 'Identification of Inventorship under 37 CFR 1.110', previously reported as item 4, is not reportable information per 5 CFR 1320.3(h)(6) and 5 CFR 1320.3(h)(9). Relevant information collected for establishment and correction of inventorship is reported to OMB within other items in information collections 0651-0031 and 0651-0032.

The USPTO also finds that the Rule 1.130, 1.131, and 1.132 Affidavits or Declarations, as they relate to AIA inventorship matters and as previously reported as item 5, are not reportable information per 5 CFR 1320.3(h)(1), (6), and (9).

Accordingly, items previously listed as 4 and 5 have been removed from the information collection.

Estimated Annual Responses and Hourly Burdens due to Adjustment in Agency Estimate

Decreases in the number of responses (-3,358) and burden hours (-6,716) are due to the estimated normal fluctuation in the number of responses for the items remaining in this information collection.

Change in Annual (Non-hour) Costs due to Adjustment in Agency Estimate

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$13 from the previous approval. This decrease is due to the respondents filing more electronic submissions and fewer mailed submissions.

- 16. For collections of information whose results will be published, outline plans for tabulation and publication. Address any complex analytical techniques that will be used. Provide the time schedule for the entire project, including beginning and ending dates of the collection of information, completion of report, publication dates, and other actions.**

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. If seeking approval to not display the expiration date for OMB approval of the information collection, explain the reasons that display would be inappropriate.**

There are no forms in this information collection. Therefore, the display of the OMB Control Number and the expiration date is not applicable.

- 18. Explain each exception to the topics of the certification statement identified in "Certification for Paperwork Reduction Act Submissions."**

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.