

SUPPORTING STATEMENT
United States Patent and Trademark Office
Third-Party Submissions and Protests
OMB CONTROL NUMBER 0651-0062
2021

A. JUSTIFICATION STATEMENT

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

The United States Patent and Trademark Office (USPTO) is authorized by the Leahy-Smith America Invents Act P.L. 112-29 and 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. §§ 122(c), 122(e), 131, and 151, as well as 37 CFR 1.290 and 1.291, limit the ability of a third-party to have information entered and considered in a patent application or to protest a patent application pending before the Office.

37 CFR 1.290 provides a mechanism for third-parties to submit to the USPTO, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other patent publications of potential relevance to the examination of the application.

A preissuance submission under 37 CFR 1.290 may be made in any nonprovisional utility, design, and plant application, as well as in any continuing application. A preissuance submission under 37 CFR 1.290 must include a concise description of the asserted relevance of each document submitted and must be submitted within a certain statutory specific time period.

37 CFR 1.291 permits a member of the public to file a protest against a pending application. Protests pursuant to 37 CFR 1.291 are supported by a separate statutory provision from third-party submissions under 37 CFR 1.290 (35 U.S.C. 122(c) v. 35 U.S.C. 122(e)). As a result, there are several differences between protests and third-party submissions.

For example, 37 CFR 1.291 permits the submission of information that is not permitted in a third-party submission under 37 CFR 1.290. Specifically, 37 CFR 1.291 provides for the submission of information other than publications, including any facts or information submitted. Unlike the concise explanation of the relevance required for a preissuance submission under 37 CFR 1.290, which is limited to a description of a document's relevance, the concise explanation for a protest under 37 CFR 1.291 allows for arguments against patentability. Additionally, the specified time period for submitting a protest differs from the time period for submitting third-party submissions and is impacted by whether the protest is accompanied by the written consent of the applicant.

The information collected via third-party submissions under 37 CFR 1.290 and via protests under 37 CFR 1.291 is necessary so that the public may contribute to the quality of issued patents. The USPTO will use this information, as appropriate, during the patent examination process to assist in evaluating the patent application.

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

Table 1: Information Requirements

Item No.	Requirement	Statute	Regulation
1	Third-Party Submissions in Nonissued Applications	35 U.S.C. §§ 122(e), 131, and 151	37 CFR 1.290
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	35 U.S.C. §§ 122(c), 131, and 151	37 CFR 1.291

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

The public uses this information collection to contribute submissions and protests to pending patent applications. The USPTO will use this information, as appropriate, during the patent examination process to assist in evaluating patent applications.

The information in this information collection can be submitted in paper format or electronically through the EFS-Web.

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 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

Item No.	Form and Function	Form No.	Needs and Uses
	Third-Party Submissions in	PTO/SB/429	• Used by third-parties to submit

1	Nonissued Applications		<p>patents, published patent applications, or other printed publications of potential relevance to the examination of an application, together with a concise description of the asserted relevance of each document submitted, in accordance with 37 CFR 1.290.</p> <ul style="list-style-type: none"> • Used by the USPTO to enter third-party submitted patents, published patent applications, or other printed publications in the application file, in accordance with 37 CFR 1.290.
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	No Form Associated	<ul style="list-style-type: none"> • Used by the public to call attention to any facts or information within the protestor's knowledge that, in the protestor's opinion, would make the grant of a patent on an application pending in the USPTO improper. • Used by the USPTO to better avoid the issuance of an invalid patent.

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 information collection. Also describe any consideration of using information technology to reduce burden

The USPTO has a dedicated interface that permits third-party preissuance submissions to be filed via the Patent Electronic Systems (EFS-Web and Patent Center). Third-party preissuance submissions are not automatically entered into the electronic image file wrapper (IFW) for an application. Instead, preissuance submissions are reviewed to determine compliance with 35 U.S.C. 122(e) and 37 CFR 1.290 before being entered into the IFW. Third-parties filing preissuance submissions electronically via EFS-Web receive immediate, electronic acknowledgement of the USPTO's receipt of the submission, instead of waiting for the USPTO to mail a return postcard.

Because third-party preissuance submissions may be filed electronically, the USPTO protects applicants via established procedures that determine whether a third-party preissuance submission is in compliance with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290 before entering the submission into the IFW of an application or making the submission available to an examiner for consideration. The USPTO always strives to complete such determinations promptly following receipt of the submissions so that

compliant preissuance submissions are quickly entered into the IFW and made available to the examiner for consideration. Non-compliant third-party preissuance submissions are not entered into the IFW of an application, nor are they considered; they are discarded. In addition, no refund of the required fees is provided in the event that a preissuance submission is determined to be non-compliant. If an electronic mail message address is provided with a third-party preissuance submission, the USPTO strives to notify the third-party submitter of such non-compliance; however, the statutory time period for making a preissuance submission is not tolled by the initial non-compliant submission.

Alternatively, third-party preissuance submissions may be paper-filed using form PTO/SB/429. The safeguards noted above with respect to preissuance submissions that are filed via the dedicated EFS-Web interface are also in place for paper-filed submissions.

Protests made by the public against applications submitted under 37 CFR 1.291 must be paper-filed.

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 information collected is required to process (1) third-party submissions in nonissued applications, and (2) protests by the public against pending applications. This information 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 does not impose a significant economic impact on small entities or small businesses. The information required by this information collection provides the USPTO with the necessary materials for (1) entering prior art documents obtained from a third-party in the application file, and (2) bringing information to the attention of the USPTO and voiding the issuance of an invalid patent. The same information is required from every member of the public and is not available from any other source.

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

The information is collected only when the public submits (1) a third-party submission and/or (2) a 37 CFR 1.291 protest. If this information were not collected, the USPTO

would not be able to balance the mandate of 35 U.S.C. § 122(c) and (e) and the USPTO's authority and responsibility under 35 U.S.C. §§ 131 and 151 to issue a patent only if it appears that the applicant is entitled to a patent under the law. This information could not be collected less frequently.

- 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 activity, 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 April 30, 2021 (86 FR 22939). The comment period ended on June 29, 2021. No comments were received.

The USPTO has long-standing relationships with groups from who patent application data is collected, such as the American Intellectual Property Law Association (AIPLA), as well as patent bar associations, independent inventor groups, and users of its 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 affecting 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 information 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). 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 content. The disclosure of the invention in the application is the *quid pro quo* for the property right conferred by the patent grant and the very means by which the patent statute right conferred by the patent grant, and the very means by which the patent statute achieves its constitutional objective to “promote the progress of science and useful arts.” The prosecution history contained in the application file is critical for determining the scope of the property right conferred by a property grant.

The Privacy Act of 1974 (P.L. 93-579) requires that individuals submitting these items to USPTO be given certain information in connection with that submission. The USPTO collects this information under authority of 37 CFR 1.290 and 1.291. The purpose of the system is to carry out the duties of the USPTO to grant and issue patents.

Categories of individuals covered by the system include applicants for patent, including inventors, legal representatives, and other persons authorized by law to make applications for patent. The information in this system of records is used to manage all applicant records including name, citizenship, residence, post office address, and other

information pertaining to the applicant's activities in connection with the invention for which a patent is sought.

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 (FOIA) assistance; to members of congress working on behalf of an individual; to the Office of Personnel Management (OPM) for personnel research purposes; to National Archives and Records Administration for inspection of records; and to OMB for legislative coordination and clearance. Failure to provide any part of the requested information may result in an inability to process submissions.

The applicable Privacy Act System of Records Notice for this information is 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>

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 in this information collection 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’.
- Provide an estimate for the total annual cost burden to respondents or record keepers resulting from the collection of information.

Table 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 880 total responses per year for this information collection. The USPTO estimates that 95% of the responses will be submitted electronically via the Patent Electronic System.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public approximately 10 hours to gather the necessary information, prepare the appropriate form or document, and submit the information to the USPTO. Using these burden factors, USPTO estimates that the total respondent hourly burden for this information collection is 8,800 hours per year.

- **Cost Burden Calculation Factors**

The USPTO uses a professional hourly rate of \$400 per hour for respondent cost burden calculations, which is the median rate for intellectual property attorneys in private firms, as shown in the 2019 *Report of the Economic Survey* published by the American Intellectual Property Law Association (AIPLA)¹. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this information collection is \$3,520,000 per year.

Table 3: Hourly Burden for Private Sector Respondents

Item No.	Item	Estimated Annual Respondents	Frequency	Estimated Annual Responses	Estimated Time For Response (Hours)	Estimated Hourly Burden (hour/year)	Rate ² (\$/hour)	Estimated Annual Respondent Hourly Cost Burden
		(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) =	(f)	(e) x (f) = (g)

1 2019 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/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms is \$400 per hour.

2 2019 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/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

						(e)		
1	Third-Party Submissions in Non-issued Applications	800	1	800	10	8,000	\$400	\$3,200,000
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	19	1	19	10	190	\$400	\$76,000
	Totals	819		819		8,190		\$3,276,000

Table 4: Hourly Burden for Individuals or Households Respondents

Item No.	Item	Estimated Annual Respondents (a)	Frequency (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time For Response (Hours) (d)	Estimated Hourly Burden (hour/year) (c) x (d) = (e)	Rate ³ (\$/hour) (f)	Estimated Annual Respondent Hourly Cost Burden (e) x (f) = (g)
1	Third-Party Submissions in Non-issued Applications	60	1	60	10	600	\$400	\$240,000
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	1	1	1	10	10	\$400	4,000
	Totals	61		61		610		\$244,000

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**

³ 2019 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/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

be incurred. Capital and start-up costs include, among other items, preparations for collecting information such as purchasing computers and 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.

There are no capital start-up, recordkeeping, or maintenance costs associated with this information collection. This information collection does have non-hourly cost burdens in both fees paid by the public and postage costs for items mailed to the USPTO. The total respondent cost burden for this information collection is estimated to be \$80,613, with \$80,345 in filing fees and \$268 in postage costs.

Fees

37 CFR 1.290 requires payment of the fee set forth in 37 CFR 1.17(o) (\$180 for a large entity, \$90 for a small or micro entity) for every ten documents, or a fraction thereof, listed in each third-party submission. The USPTO provides an exemption from the 1.17(o) fee requirement where a third-party submission listing three or fewer total documents is the first third-party submission submitted in an application by the third-party, or a party in privity with the third-party. The effect of this is that the first three documents submitted by a third-party are exempt from the fee requirement.

There are no fee for filing protests under 37 CFR 1.291 unless the filed protests is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(i) fee (\$140 for an undiscounted entity, \$70.00 for a small entity, and \$35 for a micro entity) must be included. The USPTO estimates that only 1 out of every 10 protests filed per year will require this fee.

The fees associated with this information collection total \$80,345 per year, as outlined in Table 5 below.

Table 5: Filing Fee/Non-hour Cost Burden to the Respondents

Item No.	Item	Estimated Annual Responses	Filing Fees (\$)	Total Filing Fee Costs
		(a)	(b)	(a) x (b) = (c)
1	Third-Party Submissions in Non-Issued Applications (undiscounted entities)	390	\$180	\$70,200
1	Third-Party Submissions in Non-issued Applications (small and	110	\$90	\$9,900

	micro entities)			
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291—second or subsequent protest by the same real party in interest (undiscounted entities)	1	\$140	\$140
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291—second or subsequent protest by the same real party in interest (small entities)	1	\$70	\$70
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291—second or subsequent protest by the same real party in interest (micro entities)	1	\$35	\$35
Total				\$80,345

Postage Cost

The non-electronic items in this information collection have associated first-class postage costs when submitted by mail. Customers may incur postage costs when submitting the instruments contained within this information collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that the average first class Priority Mail postage for a one-pound submission mailed in a flat-rate envelope to be \$6.70. The USPTO estimates that the vast majority of all paper submissions will be delivered by mail. The USPTO estimates that approximately 40 submissions will require postage. Therefore, the estimated postage cost for this information collection will be \$268.

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 employs a [GS-7](#) to process the submissions for this information collection. The USPTO estimates that the cost of a [GS-7](#), step 1 is \$30.65 per hour (GS hourly rate of \$23.55 with 30% (\$7.1) added for benefits and overhead). The USPTO estimates that it takes an employee 30 minutes (0.50 hours) to process the protests under 37 CFR 1.291 and the third-party submissions.

Table 6 calculates the processing hours and costs of this information collection to the Federal Government.

Table 6: Burden Hour/Cost to the Federal Government

Item No.	Item	Responses (a)	Time per response (b)	Burden (c) (a) x (b)	Rate (\$) (d)	Total Cost (e) (c) x (d)
1	Third-Party Submissions in Non-issued Applications	860	.5	440	\$30.65	\$13,486
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	19	.5	10	\$30.65	\$307
Total		880		450		\$13,793

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	880	0	0	-570	0	1,450
Annual Time Burden (Hr)	8,800	0	0	-5,700	0	14,500
Annual Cost Burden (\$)	80,613	0	0	-8,885	0	89,498

The requested burden, as outlined in the table above, seeks to modify the existing information collection burden. The requested information collection contains an estimated:

- 880 annual responses
- 8,800 annual burden hours
- \$80,613 annual (non-hour) costs

Changes in Responses and Burden Hours

For this renewal, the USPTO estimates that the annual responses will decrease by 570 (from 1,450 to 880) and the total burden hours will decrease by 5,700 (from 14,500 to 8,800) from the currently approved burden for this information collection. These adjustments are due to updated Agency estimates that forecast declines in public submissions/responses of these items which in turn decreases the annual burden hours.

Changes in Annual (Non-hour) Cost

For this renewal, the USPTO estimates that the total annual (non-hour) costs will decrease by \$8,885 (from \$89,498 to \$80,613). The decrease in the annual cost burden is a result of the decrease in the annual responses. Additionally, fewer mailing to USPTO result in a reduction in postage costs. However, a slight increase in the fees

associated with these submissions/responses and increasing postage rates are more than offset by the overall decline in the number of responses/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.

The USPTO does not plan to publish this information for statistical use. However, patent and trademark assignment records are available to the public at the USPTO Public Search Facilities and on the USPTO Website.

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.

The forms in this information collection will display the OMB Control Number and the expiration date of OMB approval.

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.