SUPPORTING STATEMENT
United States Patent and Trademark Office
Patent Review and Derivation Proceedings
OMB CONTROL NUMBER 0651-0069
2022

A. JUSTIFICATION

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 Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011, provided for many changes to the procedures of the Patent Trial and Appeal Board ("PTAB" or "Board," formerly the Board of Patent Appeals and Interferences) procedures. These changes included the introduction of inter partes review, post-grant review, derivation proceedings, and the transitional program for covered business method patents. Under these administrative trial proceedings, third parties may file a petition with the PTAB challenging the validity of issued patents, with each proceeding having different requirements regarding timing restrictions, grounds for challenging validity, and who may request review.

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 the petitioner's application, and (2) the earlier application claiming such invention was filed without authorization. The transitional program for covered business method patents is a trial proceeding conducted at the Board to review the patentability of one or more claims in a covered business method patent. The covered business method program expired on September 16, 2020 and the Board no longer accepts new petitions related to this program, but continues to accept papers in previously-instituted proceedings.

This information collection covers information submitted by the public to petition the Board to initiate an inter partes review, post-grant review, derivation proceeding, and the transitional program for covered business method patents, as well as any responses to such petitions, and the filing of any motions, replies, oppositions, and other actions, after a review/proceeding has been instituted.

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

Table 1: Information Requirements for Patent Review and Derivation Proceedings

Item No.	Requirement	Statute	Regulation
1	Petitions for *Inter Partes* 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 *Inter Partes* 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	Other Motions, Replies, Surreplies, and Oppositions in *Inter Partes* 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	Other Motions, Replies, Surreplies, and Oppositions 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	Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings	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	Pro Hac Vice Motion	35 U.S.C. §§ 2(b)(2), 135, 316, 326	37 CFR 42.10
11	Request for Oral Hearing	35 U.S.C. §§ 2(b)(2), 316 (a)(10), and 326(a)(10)	37 CFR 42.70
12	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
13	Settlement	35 U.S.C. §§ 2(b)(2), 135(e), 317, and 327	37 CFR 42.73(b) and 42.74(b)
14	Arbitration Agreement and Award	35 U.S.C. § 135(f)	37 CFR 42.410
15	Request to Make a Settlement Agreement Available	35 U.S.C. §§ 135(e), 317(b), and 327(b)	37 CFR 42.74(c)
16	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. 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 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. These submissions are typically done by attorneys on behalf of a variety of clients. The USPTO also permits individuals to submit these items directly on their own behalf. This is rarely done, and the USPTO advises respondents to obtain counsel.

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. 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 information 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.

The information in this information collection is generally submitted through the USPTO's Web-based electronic filing system, called the Patent Trial and Appeal Board End-to-End System (PTAB E2E), when a party files a petition, motion, opposition, reply, sur-reply, or request. Parties may seek authorization to submit a filing by means other than electronic filing pursuant to 42 CFR 42.6(b)(2).

Table 2 outlines how this collection of information is used by the public and the USPTO.

Table 2: Needs and Uses for Patent Review and Derivation Proceedings

Item No.	Form and Function	Form No.	Needs and Uses

1	Petition for *Inter Partes* Review	No Form Associated	• Used by parties who are not the 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 an *inter partes* review of a patent. • 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. • Used by parties to demonstrate that they have standing to file the petition (i.e., the patent is available for *inter partes* review and the petitioner is not barred from requesting such review). • Used by the Board to determine whether to institute an *inter partes* 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.
2	Petition for Post-Grant Review or Covered Business Method Patent Review	No Form Associated	• 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. • 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. • 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 and the petitioner's real party-in-interest have not filed a civil action challenging the validity of a claim of the patent. • 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. • 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.

3	Petition for Derivation	No Form Associated	• Used by an applicant for patent to petition the Board to institute a derivation proceeding. • 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). • 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).
4	Patent Owner Preliminary Response to Petition for Initial *Inter Partes* Review	No Form Associated	• Used by patent owner to set forth reasons why no *inter partes* review should be instituted. • Used by the Board together with the petition for *inter partes* review to determine whether to institute an *inter partes* review.
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	No Form Associated	• Used by patent owner to set forth reasons why no post-grant review or covered business method review should be instituted. • 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.
6	Request for Rehearing	No Form Associated	• Used by the parties to request the Board or the Director to reconsider the decision not to institute a trial or another decision. • Used by the Board or the Director to review the original decision to not institute a trial or another decision.
7	Other Motions, Replies, Surreplies, and Oppositions in *Inter Partes* Review	No Form Associated	• 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, and motions to correct clerical or typographical mistakes in a petition for *inter partes* review. • Used by the opposing parties, such as the petitioner, to file a reply to the patent owner preliminary response, or by the patent owner to file a sur-reply thereto prior to institution • Used by the opposing parties, such as by a patent owner in response to a petition, by the petitioner in a reply thereto, or by the patent owner in a sur-reply thereto after institution, and to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the opposing parties and the public as amicus curiae in submissions to the precedential opinion panel • Used by the Board in issuing a decision on institution or in issuing a final written decision with respect to patentability of a challenged patent claim.

8	Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review	No Form Associated	• 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, and motions to correct clerical or typographical mistakes in a petition for post-grant review or covered business method patent review. • Used by the opposing parties, such as the petitioner, to file a reply to the patent owner preliminary response, or by the patent owner to file a sur-reply thereto prior to institution • Used by the opposing parties, such as by a patent owner in response to a petition, by the petitioner in a reply thereto, or by the patent owner in a sur-reply thereto after institution, and to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the opposing parties and the public as amicus curiae in submissions to the precedential opinion panel • Used by the Board in issuing a decision on institution or a final written decision with respect to patentability of a challenged patent claim.
9	Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings	No Form Associated	• 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, and motions to correct clerical or typographical mistakes in a petition for a derivation proceeding. • Used by the opposing parties, such as the petitioner, to file a reply to the patent owner preliminary response, or by the patent owner to file a sur-reply thereto prior to institution • Used by the opposing parties, such as by a patent owner in response to a petition, by the petitioner in a reply thereto, or by the patent owner in a sur-reply thereto after institution, and to set forth the reasons why the Board should not grant the relief sought in a motion. • Used by the opposing parties and the public as amicus curiae in submissions to the precedential opinion panel • Used by the Board in issuing a decision on institution or a final written decision with respect to the alleged derivation.
10	Pro Hac Vice Motion	No Form Associated	• Used by a party to request authorization to be represented by counsel who is not a registered practitioner, i.e., as back-up counsel where the lead counsel is a registered practitioner.
11	Request for Oral Hearing	No Form Associated	• Used by parties to request an oral hearing. • Used by the Board to schedule an oral hearing, if appropriate.
12	Request to Treat a Settlement as Business Confidential	No Form Associated	• Used by parties to request that the settlement agreement be kept confidential and be filed separately from the patent or application file. • 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.

13	Settlement	No Form Associated	• Used by parties to jointly request a termination of the proceeding. • Used by the Board to terminate the proceeding upon a joint request.
14	Arbitration Agreement and Award	No Form Associated	• Used by parties to give notice to the Office of the result of an arbitration between parties, e.g., in a derivation. • Used by the Board to update the records of an instituted derivation proceeding.
15	Request to Make a Settlement Agreement Available	No Form Associated	• Used by a requester to gain access to a settlement agreement. • Used by the Board to determine whether the requester may be granted access to the settlement agreement.
16	Notice of Judicial Review of a Board Decision (e.g., Notice of Appeal Under 35 U.S.C. § 142)	No Form Associated	• Used by parties to notify the USPTO that a party has filed a notice of appeal or election • Used by the Board to recognize that the final decision of the Board has been appealed.

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.

All of the patent review and derivation papers will be filed electronically, unless otherwise authorized by the Board. The USPTO currently utilizes the 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. 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.

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 information 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 and 322. For example, a patent owner may request that the Board consider a disclosure that was made in the patent application and would resubmit the material so that it can be considered in the AIA trial. 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. 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.

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.

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. 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 information 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 published in the *Federal Register* on December 7, 2021 (86 FR 69228). The public comment period closed on February 7, 2022. No public comments were received at that time.

The 30-Day Notice published in the *Federal Register* on February 24, 2022 (87 FR 10343). The public comment period closed on March 28, 2022. One public comment was received by OMB.

By way of context, the comment relates to petitions for Director review under the Supreme Court's decision in *United States v. Arthrex*, 141 S. Ct. 1970 (2021). In that case, Arthrex presented a challenge under the Appointments Clause of the Constitution

to the authority of APJs (administrative patent judges) to issue final written decisions. The Supreme Court ultimately held that "the unreviewable authority wielded by APJs during inter partes review is incompatible with their appointment by the Secretary to an inferior office." *Arthrex*, 141 S. Ct. at 1985 (2021). As a remedy, the Court held that the statutory provision allowing only Board panels of at least three members to rehear Board decisions, 35 U.S.C. § 6(c), "is unenforceable as applied to the Director insofar as it prevents the Director from reviewing the decisions of the PTAB on his own." 141 S. Ct. at 1987. The Supreme Court "conclude[d] that the appropriate remedy is a remand to the Acting Director for him to decide whether to rehear" the Board's decision. *Id.*

The comment states that *Arthrex* related petitions represent a new information collection implemented by the U.S. Patent and Trademark Office (USPTO). The comment suggests in the alternative that this information collection (a) has been omitted from the Supporting Statement, or (b) is found in line item 6 of the Supporting Statement, but is imprecise and lists an implausibly low number of anticipated responses for the information collection. Line item 6 is listed as "Request for Rehearing" and described as "Used by the Board or Director to review the original decision to not institute a trial or another decision," with an estimated 350 responses for the future fiscal years. The comment states that "350 seems implausibly low as the number of responses for an entire class, when Director review alone is likely 250-400 responses all by itself." The comment states that 350 only represents a 9% increase over the previous Supporting Statement for Request for Rehearing (which had been 322).

The USPTO responds that this is not a new information collection because Director review requests are collected in the manner prescribed in 37 C.F.R. § 42.71 for rehearing requests, which were already part of the information collection.

The USPTO appreciates the commenter's input, and agrees with the commenter that Line item 6 includes the Director review procedure, where it states that it may be "Used by the . . . Director" to review a decision of the Board. The previous application for information collection had described Requests for Rehearing as being used by the Board, and the Director was added to the current description for Requests for Rehearing in the current submission. The USPTO reiterates that the current estimates (now 350 responses) reasonably account for the anticipated number of responses. The estimate of 350 anticipated responses is based on an estimate of receiving 250 petitions for rehearing by the Board and 100 petitions for Director review. In particular, the Board received approximately 250 requests for rehearing by the Board over the last year for which data was available, and estimates that it will receive 100 requests for Director rehearing based on historical trends. Although the USPTO received close to 200 requests for Director review in the early months of the Director review program, a large group of these requests arose from a group of litigations related to *Arthrex*, where similarly situated parties had made similar challenges in litigation, i.e., that the Board judges lacked the authority under the Appointments Clause to issue final written decisions in the absence of the availability of a Director review process, and for which the U.S. Court of Appeals for the Federal Circuit remanded the similarly situated cases for consideration by the Director. These cases represent several years of cases while

Arthrex was pending at the Federal Circuit and then the Supreme Court. The USPTO anticipates that in future years, where there is not the same group of litigations and case backlog regarding the availability of Director review, that approximately 100 individual parties will petition for Director review. This estimate is based on the number of historical petitions for review by the Board's Precedential Opinion Panel, which is the closest historical analog, and also based on the understanding that the initial group of petitions for Director review arose from a unique set of Appointments Clause challenges, which has been resolved by the Supreme Court. In the event that future data trends show a differing pattern, the USPTO will adjust the number of estimated requests for rehearing.

The commenter also states that the USPTO's (interim) webpage on Director review stands in violation of the rulemaking requirements of 5 U.S.C. §§ 552(a)(1)(B) and (C), 553(b), (c) and (d), 603, 604, 35 U.S.C. §§ 316(a)(4) and 326(a)(4), and 44 U.S.C. § 3507(a)(1)(D), as well as the requirements for comment, certification, OIRA submission, and public notice in 44 U.S.C. § 3506(c)(2)(B), § 3506(c)(3), § 3507(a)(1)(C), § 3506(c)(1)(B)(iii). The commenter also states that the USPTO should be directed to properly observe 5 C.F.R. § 1320.8, .9, .10, .11, and/or .12 for a new information collection. The USPTO disagrees that any process described for Director review conflicts with these statutory provisions. The USPTO also observes that in addition to the 60-Day Notice and the 30-Day Notice on this information collection, the USPTO has stated that it recently issued a Request for Comments on the Director Review procedure. 87 Fed. Reg. 43,249 (July 20, 2022).

The comment also states that the information collection is imprecise under 44 U.S.C. § 3506(c)(1)(b) because the public cannot ascertain which Director reviews are included in this process and in the information collection (0651-0069). The commenter states that Director review is available for reconsideration of a final written decision, and not for reconsideration of a decision not to institute a trial or any other interlocutory decision. The commenter also states that Director review does not arise under 35 U.S.C. § 2(b)(2), 316(a)(13), or 326(a)(12) or 37 C.F.R. § 42.71. The USPTO however, disagrees and confirms that the Director review follows the same rehearing procedures and timing requirements stated in 37 C.F.R. § 42.71. The Supporting Statement groups together all requests for rehearing, i.e., requests for rehearing by the Board and by the Director. As stated in the Supporting Statement, the line item is for any request for rehearing, i.e., to be "Used by the Board or the Director to review the original decision to not institute a trial or another decision."

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 its public search facilities. Their views are expressed in regularly scheduled meetings and considered in developing information collection requirements. There have been no comments or concerns expressed by these or similar organizations concerning the information required under this program.

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

This information collection does not include 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.

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 regulations, 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.

This information collection contains information that is subject to the Privacy Act.

PTAB records are covered by the COMMERCE/PAT-TM-6, Parties Involved in Patent Interference Proceedings, System of Records Notice (SORN) (published in the Federal Register on March 29, 2013 (78 FR 19247)). This SORN covers all records relating to the declaration, conduct, and termination of interference proceedings, including, but not limited to: preliminary statements, motions, testimony, and settlement agreements. The data contained in the records may include information relating to an applicant's, a patentee's, or a witness's name, age, citizenship, residence, educational and work background, physical and mental health, activities relating to conception of the contested subject matter, and other matters which may arise during the conduct of the interference proceeding or in connection with any agreements made by the parties relative to the interference proceeding.

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 for 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 management; 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.

Patent application files may be involved in PTAB decisions and procedures. These patent application files are covered under the COMMERCE/PAT-TM-7, Patent Application Files, SORN (published in the Federal Register on March 29, 2013 (78 FR 19243)).

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'.**

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 9,238 respondents to this information collection will submit 12,338 responses per year. These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected by these items.

- **Burden Hour Calculation Factors**
  The USPTO estimates that the responses in this information collection will take the public between 30 minutes (.05 hours) and 165 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO. Using these burden factors, USPTO estimates that the total respondent hourly burden for this information collection is 1,368,058 hours per year.

- **Cost Burden Calculation Factors**
  The USPTO uses a professional rate of $435 per hour for respondent cost burden calculations, published in the 2021 Report of the Economic Survey[1] from the Law Practice Management Committee of the American Intellectual Property Law Association (AIPLA). Using this hourly rate, the USPTO estimates that the total respondent cost burden for this information collection is $595,105,230 per year.

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

Item No.	Item	Estimated Annual Respondents (a)	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 ($/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Petition for *Inter Partes* Review	1,450	1	1,450	124	179,800	$435	$78,213,000
2	Petition for Post-Grant Review or Covered Business Method Patent Review	100	1	100	165	16,500	$435	$7,177,500
3	Petition for Derivation	10	1	10	165	1,650	$435	$717,750
4	Patent Owner Preliminary Response to Petition for Initial *Inter Partes* Review	1,175	42,6251	1,175	91	106,925	$435	$46,512,375
5	Patent Owner Preliminary Response to Petition for	100	1	100	91	9,100	$435	$3,958,500

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

	Initial Post-Grant Review or Covered Business Method Patent Review							
6	Request for Rehearing	350	1	350	80	28,000	$435	$12,180,000
7	Other Motions, Replies, Surreplies, and Oppositions in *Inter Partes* Review	2,900	2	5,800	158	916,400	$435	$398,634,000
8	Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review	200	2	400	148	59,200	$435	$25,752,000
9	Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings	10	1	10	120	1,200	$435	$522,000
10	Pro Hac Vice Motion	950	1	950	0.5	475	$435	$206,625
11	Request for Oral Hearing	575	1	575	2	1,150	$435	$500,250
12	Request to Treat a Settlement as Business Confidential	450	1	450	2	900	$435	$391,500
13	Settlement	450	1	450	100	45,000	$435	$19,575,000
14	Arbitration Agreement and Award	1	1	1	4	4	$435	$1,740
15	Request to Make a Settlement Agreement Available	1	1	1	1	1	$435	$435
16	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	500	1	500	1	500	$435	$217,500
	Total	**9,222**		**12,322**		**1,366,805**		**$594,560,175**

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

Item No.	Item	Estimated Annual Respondents (a)	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 ($/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Petition for *Inter Partes* Review	1	1	1	124	124	$435	$53,940
2	Petition for Post-Grant Review or Covered Business Method Patent Review	1	1	1	165	165	$435	$71,775
3	Petition for Derivation	1	1	1	165	165	$435	$71,775
4	Patent Owner Preliminary Response to Petition for Initial *Inter Partes* Review	1	1	1	91	91	$435	$39,585
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	1	1	1	91	91	$435	$39,585
6	Request for Rehearing	1	1	1	80	80	$435	$34,800
7	Other Motions, Replies, Surreplies, and Oppositions n in *Inter Partes* Review	1	1	1	158	158	$435	$68,730
8	Other Motions, Replies, Surreplies, and Oppositions n in Post-Grant Review or Covered Business Method Review	1	1	1	148	148	$435	$64,380
9	Other Motions, Replies,	1	1	1	120	120	$435	$52,200

	Surreplies, and Oppositions in Derivation Proceedings							
10	Pro Hac Vice Motion	1	1	1	0.5	1	$435	$435
11	Request for Oral Hearing	1	1	1	2	2	$435	$870
12	Request to Treat a Settlement as Business Confidential	1	1	1	2	2	$435	$870
13	Settlement	1	1	1	100	100	$435	$43,500
14	Arbitration Agreement and Award	1	1	1	4	4	$435	$1,740
15	Request to Make a Settlement Agreement Available	1	1	1	1	1	$435	$435
16	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	1	1	1	1	1	$435	$435
	Total	**16**		**16**		**1,253**		**$545,055**

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 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, or postage costs associated with this information collection. However, this information collection has non-hourly cost in the form of fees paid to the USPTO. The total (non-hour) respondent cost burden for this information collection is estimated to be $69,638,370 per year, which covers the filing fees associated with this information collection.

Fees

The filing fees associated with this information collection are listed in Table 5 below.

Table 5: Filing Fees/Non-Hourly Cost to Respondents

Item No.	Item	Estimated Annual Responses (a)	Filing Fee ($) (d)	Estimated Non-Hourly Cost (a) x (b) = (c)
1	*Inter Partes* Review Request Fee – Up to 20 Claims	1,450	$19,000	$27,550,000
1	*Inter Partes* Post-Institution Fee – Up to 15 Claims	1,450	$22,500	$32,625,000
1	*Inter Partes* Review Request of Each Claim in Excess of 20	3,500	$375	$1,312,500
1	*Inter Partes* Post-Institution Request of Each Claim in Excess of 15	3,500	$750	$2,625,000
2	Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims	100	$20,000	$2,000,000
2	Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 15 Claims	100	$27,500	$2,750,000
2	Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	350	$475	$166,250
2	Post-Grant or Covered Business Method Review Post-Institution Fee of Each Claim in Excess of 15	350	$1,050	$367,500
3	Petition for Derivation	10	$420	$4,200

10	Pro Hac Vice Admission Fee	950	$250	$237,500
15	Request to Make a Settlement Agreement Available	1	$420	$420
	Total			$69,638,370

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 $32,683,269. USPTO estimates that it takes administrative patent judges and other staff from approximately 15 minutes (0.25 hours) to 60 hours on average to process and administer the items in this information collection.

Generally, 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 information collection are processed by administrative patent judges. The notices of judicial review of a Board decision are processed by USPTO staff at approximately a GS-15, step 5 level.

The USPTO estimates that the hourly rate (with benefits and overhead) for an administrative patent judge is $117, based upon the Department of Commerce 2021 Pay Scale.

The USPTO estimates that the cost of a GS-15, step 5 employee is $105 (GS hourly rate of $80.63 with 30% ($24.19) added for benefits and overhead).

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

Table 6: Burden Hours and Hourly Cost to the Federal Government for Patent Review and Derivation Proceedings

Item No.	Item	Estimated Annual Responses (a)	Estimated Time for Response (hour) (d)	Estimated Burden (hour/year) (a) x (b) = (c)	Rate ($/hour) (d)	Estimated Annual Federal Government Cost Burden (c) x (d) = (e)
1	Petition for *Inter Partes* Review	1,451	50	72,550	$117	$8,488,350
2	Petition for Post-Grant Review or Covered Business Method Patent Review	101	60	6,060	$117	$709,020

3	Petition for Derivation	11	60	660	$117	$77,220
4	Patent Owner Preliminary Response to Petition for Initial *Inter Partes* Review	1,176	50	58,800	$117	$6,879,600
5	Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review	101	60	6,060	$117	$709,020
6	Request for Rehearing	351	20	7,020	$117	$821,340
7	Other Motions, Replies, Surreplies, and Oppositions in *Inter Partes* Review	5,801	20	116,020	$117	$13,574,340
8	Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review	401	20	8,020	$117	$938,340
9	Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings	11	20	220	$117	$25,740
10	Pro Hac Vice Motion	951	1	951	$117	$111,267
11	Request for Oral Hearing	576	4	2,304	$117	$269,568
12	Request to Treat a Settlement as Business Confidential	451	1	451	$117	$52,767
13	Settlement	451	0.25	113	$117	$13,221
14	Arbitration Agreement and Award	2	0.5	1	$117	$117
15	Request to Make a Settlement Agreement Available	2	1	2	$117	$234
16	Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. §142)	501	0.25	125	$105	$13,125
	Total					$32,683,269

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	12,338	0	951	-607	0	11,994
Annual Time Burden (Hr)	1,368,058	0	476	-106,867	0	1,474,449
Annual Cost Burden ($)	69,638,370	0	237,500	1,305,022	0	68,095,848

Program Change Due to Agency Discretion in Annual Number of Responses, Annual Time Burden, and Annual Cost Burden

With this renewal, USPTO is adding in a new item (Pro Hac Vice Motion) which adds +951 responses and +476 burden hours to this information collection. This item also has a related fee which adds +$237,500 annual cost burden to this information collection.

Change Due to Adjustment in Agency Estimate in Annual Number of Responses, Annual Time Burden, and Annual Cost Burden

For this renewal, the USPTO estimates that the items in this information collection will naturally fluctuate based on respondent need. Overall USPTO is estimating that these adjustments result in fewer responses (-607) and fewer associated time burden (-106,867). At the same time, USPTO is estimating that total annual (non-hour) costs will increase due to respondents filling more items that have associated fees (+$1,305,022).

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.

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.