

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
Patent Review and Derivation Proceedings
OMB Control Number 0651-0069

Background

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.

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.

This request is to update items in collection 0651-0069 (Patent Review and Derivation Proceedings) that are affected by the rulemaking RIN 0651-AD75 (Expanding Opportunities To Appear Before the Patent Trial and Appeal Board).¹ One item is being adjusted and another is being created by this rulemaking.

As part of its initiatives to expand access to practice before the United States Patent and Trademark Office (USPTO), the USPTO is amending the rules regarding admission to practice before the Board in proceedings under the Leahy-Smith America Invents Act (AIA proceedings) to excuse parties from the requirement to designate back-up counsel upon a showing of good cause such as a lack of resources to hire two counsel; establish a streamlined alternative procedure for recognizing counsel *pro hac vice* without paying a fee, which is available when counsel has previously been recognized *pro hac vice* in a different PTAB proceeding; and clarify that those recognized *pro hac vice* have a duty to inform the Board of subsequent events that render inaccurate or incomplete representations they made to obtain *pro hac vice* recognition.

This rulemaking allows for a streamlined alternative procedure for recognizing counsel *pro hac vice* (Item 17 in Table 2). The USPTO estimates that about half of the those who currently use the *pro hac vice* motion (Item 10) will use this alternative option. As the alternative procedures use information previously submitted through a full *pro hac vice* motion, the USPTO estimates that this second alternative procedure will take less time than a regular full motion. This results in an estimated time burden decrease in this information collection. Additionally, because of this alternative and no-fee procedure,

¹ <https://www.govinfo.gov/content/pkg/FR-2024-10-10/pdf/2024-23319.pdf>.

fewer individuals will file the *pro hac vice* motion and pay the accompanying fee for that action. This results in a decrease in the non-hourly cost burdens for this information collection.

Table 1: Total Burden Hours (current)

Item No.	Item	Estimated Annual Responses (a)	Estimated Time for Response (hours) (b)	Estimated Burden (hour/year) (a) x (b) = (c)
10	Pro Hac Vice Motion	950	0.5	475
	Totals	950	---	475

Table 2: Total Burden Hours (proposed)

Item No.	Item	Estimated Annual Responses (a)	Estimated Time for Response (hours) (b)	Estimated Burden (hour/year) (a) x (b) = (c)
10	Pro Hac Vice Motion	450	0.5	225
17	Notice of intent to designate provisionally recognized PTAB attorney as counsel	500	0.3	150
	Totals	950	---	375

Additionally, fewer individuals will be filling the *pro hac vice* motion and paying the accompanying fee for that action. This results in a decrease in the non-hourly cost burdens for this information collection.

Table 3: Non-hourly Cost to Respondents (current)

Item No.	Item	Estimated Annual Responses (a)	Filing Fee (\$) (b)	Estimated Non-Hourly Cost (a) x (b) = (c)
10	Pro Hac Vice Admission Fee	950	\$250	\$237,500
	Totals	950	---	\$237,500

Table 4: Non-hourly Cost to Respondents (proposed)

Item No.	Item	Estimated Annual Responses (a)	Filing Fee (\$) (b)	Estimated Non-Hourly Cost (a) x (b) = (c)
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10	Pro Hac Vice Admission Fee	450	\$250	\$112,500
	Totals	450	- - -	\$112,500

Summary of Changes

This final rule results in a decrease of 100 hours in hourly burden due to respondents use of the streamlined *pro hac vice* option. This also results in a decrease of \$125,000 in cost burdens; saving from individuals no longer having to fill out new *pro hac vice* motions.

Changes in Burden

Burden Type	Currently Approved	Proposed Change	New Estimate
Annual Hourly Burden	1,368,058	-100	1,367,958
Annual Non-hourly Cost Burden	\$69,638,370	-\$125,000	\$69,513,370

0651-0069's revised burden is as follows:

- 12,338 annual responses (unchanged)
- 1,367,958 annual hourly burden
- \$69,513,370 in annual non-hourly burden costs