**JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE**

**Patent Reexaminations, Supplemental Examinations, and Post Patent Submissions**

**OMB Control Number 0651-0064**

Background

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. §§ 131 and 151 to examine applications and, when appropriate, allow applications and issue them as patents. Chapter 30 of Title 35 U.S.C. provides that any person at any time may file a request for reexamination by the USPTO of any claim of a patent on the basis of prior art cited under the provisions of 35 U.S.C. 301.  Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from third parties. The regulations outlining *ex parte* reexaminations are found at 37 CFR 1.510-1.570.

35 U.S.C. 257 permits a patent owner to request supplemental examination of a patent by the USPTO to consider, reconsider, or correct information believed to be relevant to the patent. The regulations outlining supplemental examination are found at 37 CFR 1.601-1.625.

The Leahy-Smith America Invents Act terminated *inter partes* reexamination effective September 16, 2012. However, *inter partes* reexamination proceedings based on *inter partes* reexamination requests filed before September 16, 2012, continue to be prosecuted. Therefore, this collection continues to include items related to the prosecution of *inter partes* reexamination proceedings. The regulations outlining *inter partes* reexaminations are found at 37 CFR 1.902-1.959.

The provisions of 35 U.S.C. 301 and 37 CFR 1.501 govern the ability of a person to submit into the file of an issued patent (1) prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the issued patent and (2) statements of the owner of the issued patent filed in a proceeding before a federal court or the USPTO in which the owner of the issued patent took a position on the scope of any claim of the issued patent.

Thus, the items included in this collection cover (1) requests for ex parte reexamination, (2) requests for supplemental examination, (3) information that may be submitted by patent owners and third-party requesters in relation to the prosecution of an ex parte or inter partes reexamination proceeding, (4) information submitted by the public to aid in ascertaining the patentability and/or scope of the claims of the issued patent, and (5) information submitted by patent owners regarding a position taken before the USPTO or a Federal court regarding the scope of any claim in their issued patent. The USPTO’s use of the statements of the patent owners ((5) above) will be limited to determining the meaning of a patent claim in ex parte reexamination proceedings that already have been ordered and in inter partes review and post grant review proceedings that already have been instituted.

In support of RIN 0651-AD64 (Setting and Adjusting Patent Fees During Fiscal Year 2025; 89 FRN 91898)[[1]](#footnote-2), the USPTO is changing 27 fees in this information collection.

**Table 1: Changes in Fee Amount**

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| **Item No.** | **Fee Code** | **Item** | **Current Fee** | **New Fee** | **Changes in Fee Amount** |
| **1** | 1826 | Supplemental Examination Request (undiscounted) | $4,620 | $4,965 | +$345 |
| **1** | 2826 | Supplemental Examination Request (small entity) | $1,848 | $1,986 | +$138 |
| **1** | 3826 | Supplemental Examination Request (micro entity) | $924 | $993 | +$69 |
| **1** | 1827 | Supplemental Examination Reexamination (undiscounted) | $12,700 | $13,655 | +$955 |
| **1** | 2827 | Supplemental Examination Reexamination (small entity) | $5,080 | $5,462 | +$382 |
| **1** | 3827 | Supplemental Examination Reexamination (micro entity) | $2,540 | $2,731 | +$191 |
| **1** | 1828 | Supplemental Examination document size fees, 21-50 documents (undiscounted) | $180 | $195 | +$15 |
| **1** | 2828 | Supplemental Examination document size fees, 21-50 documents (small entity) | $72 | $78 | +$6 |
| **1** | 3828 | Supplemental Examination document size fees, 21-50 documents (micro entity) | $36 | $39 | +$3 |
| **1** | 1829 | Supplemental examination document size fees, each additional 50 documents (undiscounted) | $300 | $325 | +$25 |
| **1** | 2829 | Supplemental examination document size fees, each additional 50 documents (small entity) | $120 | $130 | +$10 |
| **1** | 3829 | Supplemental examination document size fees, each additional 50 documents (micro entity) | $60 | $65 | +$5 |
| **2** | 1821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (undiscounted) | $480 | $600 | +$120 |
| **2** | 2821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity) | $192 | $240 | +$48 |
| **2** | 3821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity) | $96 | $120 | +$24 |
| **2** | 1822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (undiscounted) | $100 | $200 | +$100 |
| **2** | 2822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity) | $40 | $80 | +$40 |
| **2** | 3822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity) | $20 | $40 | +$20 |
| **2** | 1831 | Ex Parte Reexamination (§1.510(a)) Streamlined (undiscounted) | $6,300 | $6,775 | +$475 |
| **2** | 2831 | Ex Parte Reexamination (§1.510(a)) Streamlined (small entity) | $2,520 | $2,710 | +$190 |
| **2** | 3831 | Ex Parte Reexamination (§1.510(a)) Streamlined (micro entity) | $1,260 | $1,355 | +$95 |
| **2** | 1812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (undiscounted) | $12,600 | $13,545 | +$945 |
| **2** | 2812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (small entity) | $5,040 | $5,418 | +$378 |
| **2** | 3812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (micro entity) | $2,520 | $2,709 | +$189 |
| **3** | 1824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (undiscounted) | $2,040 | $2,195 | +$155 |
| **3** | 2824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity) | $816 | $878 | +$62 |
| **3** | 3824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity) | $408 | $439 | +$31 |

**Table 2: Proposed Burden**

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| **Item No.** | **Fee Code** | **Item** | **Reponses**  **(a)** | **New Fee**  **(b)** | **New Non-hour Cost Burden**  **(a) x (b) = (c)** |
| **1** | 1826 | Supplemental Examination Request (undiscounted) | 17 | $4,965 | $84,405 |
| **1** | 2826 | Supplemental Examination Request (small entity) | 12 | $1,986 | $23,832 |
| **1** | 3826 | Supplemental Examination Request (micro entity) | 1 | $993 | $993 |
| **1** | 1827 | Supplemental Examination Reexamination (undiscounted) | 10 | $13,655 | $136,550 |
| **1** | 2827 | Supplemental Examination Reexamination (small entity) | 1 | $5,462 | $5,462 |
| **1** | 3827 | Supplemental Examination Reexamination (micro entity) | 1 | $2,731 | $2,731 |
| **1** | 1828 | Supplemental Examination document size fees, 21-50 documents (undiscounted) | 19 | $195 | $3,705 |
| **1** | 2828 | Supplemental Examination document size fees, 21-50 documents (small entity) | 12 | $78 | $936 |
| **1** | 3828 | Supplemental Examination document size fees, 21-50 documents (micro entity) | 1 | $39 | $39 |
| **1** | 1829 | Supplemental examination document size fees, each additional 50 documents (undiscounted) | 1 | $325 | $325 |
| **1** | 2829 | Supplemental examination document size fees, each additional 50 documents (small entity) | 3 | $130 | $390 |
| **1** | 3829 | Supplemental examination document size fees, each additional 50 documents (micro entity) | 1 | $65 | $65 |
| **2** | 1821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (undiscounted) | 112 | $600 | $67,200 |
| **2** | 2821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity) | 49 | $240 | $11,760 |
| **2** | 3821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity) | 1 | $120 | $120 |
| **2** | 1822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (undiscounted) | 1,626 | $200 | $325,200 |
| **2** | 2822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity) | 298 | $80 | $23,840 |
| **2** | 3822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity) | 1 | $40 | $40 |
| **2** | 1831 | Ex Parte Reexamination (§1.510(a)) Streamlined (undiscounted) | 23 | $6,775 | $155,825 |
| **2** | 2831 | Ex Parte Reexamination (§1.510(a)) Streamlined (small entity) | 67 | $2,710 | $181,570 |
| **2** | 3831 | Ex Parte Reexamination (§1.510(a)) Streamlined (micro entity) | 2 | $1,355 | $2,710 |
| **2** | 1812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (undiscounted) | 195 | $13,545 | $2,641,275 |
| **2** | 2812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (small entity) | 45 | $5,418 | $243,810 |
| **2** | 3812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (micro entity) | 1 | $2,709 | $2,709 |
| **3** | 1824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (undiscounted) | 87 | $2,195 | $190,965 |
| **3** | 2824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity) | 25 | $878 | $21,950 |
| **3** | 3824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity) | 3 | $439 | $1,317 |
|  |  | **Totals** | **2,614** | **- - -** | **$4,129,724** |

**Table 3: Changes in Cost**

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| **Item No.** | **Fee Code** | **Items** | **Current Cost**  **(a)** | **New Cost**  **(b)** | **Change in Non-hour Cost Burden**  **(b) – (a) = (c)** |
| **1** | 1826 | Supplemental Examination Request (undiscounted) | $78,540 | $84,405 | +$5,865 |
| **1** | 2826 | Supplemental Examination Request (small entity) | $22,176 | $23,832 | +$1,656 |
| **1** | 3826 | Supplemental Examination Request (micro entity) | $924 | $993 | +$69 |
| **1** | 1827 | Supplemental Examination Reexamination (undiscounted) | $127,000 | $136,550 | +$9,550 |
| **1** | 2827 | Supplemental Examination Reexamination (small entity) | $5,080 | $5,462 | +$382 |
| **1** | 3827 | Supplemental Examination Reexamination (micro entity) | $2,540 | $2,731 | +$191 |
| **1** | 1828 | Supplemental Examination document size fees, 21-50 documents (undiscounted) | $3,420 | $3,705 | +$285 |
| **1** | 2828 | Supplemental Examination document size fees, 21-50 documents (small entity) | $864 | $936 | +$72 |
| **1** | 3828 | Supplemental Examination document size fees, 21-50 documents (micro entity) | $36 | $39 | +$3 |
| **1** | 1829 | Supplemental examination document size fees, each additional 50 documents (undiscounted) | $300 | $325 | +$25 |
| **1** | 2829 | Supplemental examination document size fees, each additional 50 documents (small entity) | $360 | $390 | +$30 |
| **1** | 3829 | Supplemental examination document size fees, each additional 50 documents (micro entity) | $60 | $65 | +$5 |
| **2** | 1821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (undiscounted) | $53,760 | $67,200 | +$13,440 |
| **2** | 2821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity) | $9,408 | $11,760 | +$2,352 |
| **2** | 3821 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity) | $96 | $120 | +$24 |
| **2** | 1822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (undiscounted) | $162,600 | $325,200 | +$162,600 |
| **2** | 2822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity) | $11,920 | $23,840 | +$11,920 |
| **2** | 3822 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity) | $20 | $40 | +$20 |
| **2** | 1831 | Ex Parte Reexamination (§1.510(a)) Streamlined (undiscounted) | $144,900 | $155,825 | +$10,925 |
| **2** | 2831 | Ex Parte Reexamination (§1.510(a)) Streamlined (small entity) | $168,840 | $181,570 | +$12,730 |
| **2** | 3831 | Ex Parte Reexamination (§1.510(a)) Streamlined (micro entity) | $2,520 | $2,710 | +$190 |
| **2** | 1812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (undiscounted) | $2,457,000 | $2,641,275 | +$184,275 |
| **2** | 2812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (small entity) | $226,800 | $243,810 | +$17,010 |
| **2** | 3812 | Ex Parte Reexamination (§1.510(a)) Non-Streamlined (micro entity) | $2,520 | $2,709 | +$189 |
| **3** | 1824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (undiscounted) | $177,480 | $190,965 | +$13,485 |
| **3** | 2824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity) | $20,400 | $21,950 | +$1,550 |
| **3** | 3824 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity) | $1,224 | $1,317 | +$93 |
|  |  | **Totals** | **$3,680,788** | **$4,129,724** | **+$448,936** |

Summary of Changes

The aforementioned rulemaking results in the revision of 27 fees, with an increase of $448,936 in annual non-hourly costs to collection 0651-0064.

Changes in Burden

|  |  |  |  |
| --- | --- | --- | --- |
| **Burden Type** | **Currently Approved** | **Proposed Change** | **New Estimate** |
| Non-hourly Cost Burden | $3,680,879 | +$448,936 | $4,129,815 |

0651-0064’s revised burden is as follows:

* 890 annual responses (unchanged)
* 25,714 annual hourly burden (unchanged)
* $4,129,815 annual non-hourly burden costs

1. <https://www.govinfo.gov/content/pkg/FR-2024-11-20/pdf/2024-26821.pdf> [↑](#footnote-ref-2)