

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, 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	\$20	\$40	+\$20

¹ <https://www.govinfo.gov/content/pkg/FR-2024-11-20/pdf/2024-26821.pdf>

		excess of the number of claims in the patent under reexamination (micro entity)			
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	1	\$65	\$65

		fees, each additional 50 documents (micro entity)			
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	\$22,176	\$23,832	+\$1,656

		entity)			
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-	\$226,800	\$243,810	+\$17,010

		Streamlined (small entity)			
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