



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Proposed collection; comment request; “Rules for Patent Maintenance Fees”

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995, Public Law 104–13 (44 U.S.C. 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before *{INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER, IN THE FORMAT “MONTH, DAY, YEAR”}*.

ADDRESSES: Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651-0016 Rules for Patent Maintenance Fees” in the subject line of the message.
- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office (USPTO), P.O. Box 1450, Alexandria, VA 22313–1450; by telephone at 571–272–7728; or by email at Raul.Tamayo@uspto.gov with “Paperwork” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

Under 35 U.S.C. § 41 and 37 CFR 1.20(e)-(i) and 1.362-1.378, the United States Patent and Trademark Office (USPTO) charges fees for maintaining in force all utility patents based on applications filed on or after December 12, 1980. Payment of these maintenance fees is due at 3 1/2, 7 1/2, and 11 1/2 years after the date the patent was granted. If the USPTO does not receive payment of the appropriate maintenance fee and any applicable surcharge within a grace period of six months following each of the above due dates (at 4, 8, or 12 years after the date of grant), the patent will expire at

that time. After a patent expires, it is no longer enforceable. Maintenance fees are not required for design or plant patents, or for reissue patents if the patent being reissued did not require maintenance fees.

Payments of maintenance fees that are submitted during the six-month grace period before patent expiration must include the appropriate surcharge as indicated by 37 CFR 1.20(h). Submissions of maintenance fee payments and surcharges must include the relevant patent number and the corresponding United States application number in order to identify the correct patent and ensure proper crediting of the fee being paid.

If the USPTO refuses to accept and record a maintenance fee payment that was submitted prior to the expiration of a patent, the patentee may petition the Director to accept and record the maintenance fee under 37 CFR 1.377. This petition must be accompanied by the fee indicated in 37 CFR 1.17(g), which may be refunded if it is determined that the refusal to accept the maintenance fee was due to an error by the USPTO.

If a patent has expired due to nonpayment of a maintenance fee, the patentee may petition the Director to accept a delayed payment of the maintenance fee under 37 CFR 1.378. The Director may accept the payment of a maintenance fee after the expiration of the patent if the petitioner shows to the satisfaction of the Director that the delay in payment was unintentional. Petitions to accept unintentionally delayed payment must also be accompanied by the required maintenance fee and appropriate surcharge under 37 CFR 1.20(i). If the Director accepts the maintenance fee payment upon petition, then the patent is reinstated. If the USPTO denies a petition to accept

delayed payment of a maintenance fee in an expired patent, the patentee may petition the Director to reconsider that decision under 37 CFR 1.378(e). This petition must be accompanied by the fee indicated in 37 CFR 1.17(f), which may be refunded if it is determined that the refusal to accept the maintenance fee was due to an error by the USPTO.

The rules of practice (37 CFR 1.33(d) and 1.363) permit applicants, patentees, assignees, or their representatives of record to specify a “fee address” for correspondence related to maintenance fees that is separate from the correspondence address associated with a patent or application. A fee address must be an address that is associated with a USPTO customer number. Customer numbers may be requested by using the Request for Customer Number form (PTO/SB/125), which is covered under OMB control number 0651-0035. Maintaining a correct and updated address is necessary so that fee-related correspondence from the USPTO will be properly received by the applicant, patentee, assignee, or authorized representative. If a separate fee address is not specified for a patent or application, the USPTO will direct fee-related correspondence to the correspondence address of record.

The USPTO offers forms to assist the public with providing information covered by this collection, including the information necessary to submit a patent maintenance fee payment (PTO/SB/45) and to designate or change a fee address (PTO/SB/47). The USPTO offers a total of three different versions of the form for petitions to accept unintentionally delayed payment of maintenance fee in an expired patent under 37 CFR 1.378(c). In addition to (i) the basic PDF that may be filled out electronically and then printed and mailed (or submitted online) (Form PTO/SB/66), the USPTO offers (ii) an

enhanced PDF that is designed only to be submitted electronically through EFS-Web (PTO/SB/66 - EFS-Web), and (iii) a Web-based ePetition, which the public can complete on a computer using a Web browser and then click a submit button to send the information to the USPTO over the Internet (ePetition). No forms are provided for the petitions under 37 CFR 1.377 and 1.378(e).

Customers may submit maintenance fee payments and surcharges incurred during the six-month grace period before patent expiration by using the Maintenance Fee Transmittal Form (PTO/SB/45) or by paying online through the USPTO Web site. However, to pay a maintenance fee after patent expiration, the maintenance fee payment and the appropriate surcharge must be filed together with a petition to accept unintentionally delayed payment. The USPTO accepts online maintenance fee payments by credit card, deposit account, or electronic funds transfer (EFT). Otherwise, non-electronic payments may be made by check, credit card, or deposit account.

II. Method of Collection

By mail, facsimile, hand delivery, or electronically to the USPTO.

III. Data

OMB Number: 0651–0016.

IC Instruments: The individual instruments in this collection, as well as their associated forms, are listed in the table below.

IC Number	Form and Function	Form #
1	Maintenance Fee Transmittal Form, electronic and paper	PTO/SB/45
2	Electronic Maintenance Fee Form, electronic	No Form Associated
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)), electronic and paper	PTO/SB/66
4	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) – EFS-Web, electronic	PTO/SB/66
5	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) – ePetition, electronic	ePetition
6	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377), electronic and paper	No Form Associated
7	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(e)), electronic and paper	No Form Associated
8	“Fee Address” Indication Form, electronic and paper	PTO/SB/47

Type of Review: Regular

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 525,309 responses per year. The USPTO estimates that approximately 25% of these responses will be from small entities.

Estimated Time per Response: The USPTO estimates that it will take the public approximately 20 seconds (0.006 hours) to 8 hours to submit the information in this collection, including the time to gather the necessary information, prepare the

appropriate form or petition, and submit the completed request to the USPTO. The time per response, estimated annual responses, and estimated annual hour burden associated with each instrument in this information collection is shown in the table below.

Estimated Total Annual Hour Burden: 18,123.42 hours.

Estimated Total Annual Cost Burden (Hourly): \$3,263,347.08. The USPTO expects that the petitions included in this collection will be prepared by attorneys and that the other items in this collection will be prepared by paraprofessionals. Using the professional rate of \$389 per hour for attorneys in private firms, the USPTO estimates that the respondent cost burden for attorneys submitting the petitions will total \$1,470,420 per year. Using the paraprofessional rate of \$125 per hour, the USPTO estimates that the respondent cost burden for paraprofessionals submitting the other items in this collection will total \$1,792,927.08 per year, for a total annual respondent cost burden of \$3,263,347.08.

IC Number	Item/Form No.	Minutes (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b) / 60	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
1	Maintenance Fee Transmittal Transactions (PTO/SB/45)	5	37,434	3,119.5	\$125.00	\$389,937.50
2	Electronic Maintenance Fee Transactions	0.333	375,555	2,086.42	\$125.00	\$260,802.08

IC Number	Item/Form No.	Minutes (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b) / 60	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) (PTO/SB/66)	60	1,000	1,000	\$389.00	\$389,000.00
4	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) (PTO/SB/66) – EFS-Web	60	500	500	\$389.00	\$194,500.00
5	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) (PTO/SB/66) – ePetition	60	1,000	1,000	\$389.00	\$389,000.00
6	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	240	20	80	\$389.00	\$31,120.00
7	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(e))	480	150	1,200	\$389.00	\$466,800.00
8	“Fee Address” Indication Form (PTO/SB/47)	5	109,650	9,137.5	\$125.00	\$1,142,187.50
	Totals	-----	525,309	18,123.42	-----	\$3,263,347.08

Estimated Total Annual Cost Burden (Non-Hourly): \$3,801.42. This information collection has annual (non-hour) cost burden in the form of postage costs.

The public may submit the forms and petitions in this collection to the USPTO by mail through the United States Postal Service. If the submission is sent by first-class

mail, the public may also include a signed certification of the date of mailing in order to receive credit for timely filing. The USPTO estimates that the average first-class postage cost for a mailed submission will be 49 cents and that approximately 7,758 submissions per year may be mailed to the USPTO, for a total postage cost of \$3,801.42 per year.

IC Number	Item	Responses (a)	Postage cost (b)	Total Non-hour Cost Burden (postage) (c) (a) x (b)
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c))	70	\$0.49	\$34.30
6	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	1	\$0.49	\$0.49
7	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(e))	11	\$0.49	\$5.39
8	"Fee Address" Indication Form	7,676	\$0.49	\$3,761.24
	Totals	7,758	\$3,801.42

The total (non-hour) respondent cost burden for this collection in the form of postage costs is estimated to be \$3,801.42 per year.

IV. Request for Comments

Comments are invited on: (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility; (b) the accuracy of the agency's estimate of

the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used; (c) ways to enhance the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Dated: February 20, 2015.

Marcie Lovett,

Records Management Division Director, USPTO,

Office of the Chief Information Officer.

BILLING CODE 3510-16-P

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