



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Patent Reexaminations and Supplemental Examinations

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995 invites comments on a proposed extension of an existing information collection: 0651-0064 (Patent Reexaminations and Supplemental Examinations).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: You may submit comments by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include "0651-0064 comment" in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Marcie Lovett, Director, Records and Information Governance Division, Office of the Chief Technology Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of the Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to Raul.Tamayo@uspto.gov with “0651-0064 comment” 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

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 patents or printed publications. Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from third parties. The rules 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 rules 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 rules outlining *inter partes* reexamination are found at 37 CFR 1.903-1.931.

Thus, the items included in this collection cover: (1) requests for *ex parte* reexamination, (2) requests for supplemental examination, and (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. The transmittal forms are used by a requester (patent owner or third party) as a checklist to ensure compliance with the requirements of the statutes and rules for *ex parte* reexaminations and supplemental examinations. The public uses this information collection to request *ex parte* reexamination and supplemental examination, to prosecute reexamination proceedings, and to ensure that the associated documentation is submitted to the USPTO.

II. Method of Collection

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

III. Data

OMB Number: 0651-0064.

IC Instruments and Forms: PTO/SB/57 and PTO/SB/59.

Type of Review: Renewal of an existing collection.

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

Estimated Number of Respondents: 1,540 responses per year.

Estimated Time Per Response: The USPTO estimates that it will take the public approximately between 18 minutes (0.30 hours) to 55 hours to gather the necessary information, prepare the appropriate form or other document, and submit the information to the USPTO.

Estimated Total Annual Hour Burden: 32,962.50 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$14,437,575.00 per year.

The USPTO expects that the information in this collection will be prepared by intellectual property attorneys. The professional hourly rate for intellectual property attorneys in private firms is \$438, as estimated in the 2017 Report on the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this collection is \$14,437,575.00.

| IC Number | Item | Estimated Time for Response (hours) (a) | Estimated Respondents (b) | Estimated Burden Hours (c) (a) x (b) | Rate (d) | Total Cost (e) (c) x (d) |
|-----------|---|---|---------------------------|--------------------------------------|----------|--------------------------|
| 1 | Request for Supplemental Examination Transmittal Form | 0.30 (18 minutes) | 75 | 22.50 | \$438.00 | \$9,855.00 |
| 2 | Request for Supplemental Examination | 25 | 75 | 1,875.00 | \$438.00 | \$821,250.00 |
| 3 | Request for <i>Ex Parte</i> Reexamination Transmittal Form | 0.30 (18 minutes) | 200 | 60.00 | \$438.00 | \$26,280.00 |
| 4 | Request for <i>Ex Parte</i> Reexamination | 55 | 200 | 11,000.00 | \$438.00 | \$4,818,000.00 |
| 5 | Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d)) | 23 | 200 | 4,600.00 | \$438.00 | \$2,014,800.00 |
| 6 | Patent Owner's 37 CFR 1.530 Statement | 8 | 85 | 680.00 | \$438.00 | \$297,840.00 |
| 7 | Third Party Requester's 37 CFR 1.535 Reply | 8 | 25 | 200.00 | \$438.00 | \$84,600.00 |
| 8 | Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination | 33 | 310 | 10,230.00 | \$438.00 | \$4,480,740.00 |
| 9 | Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination | 41 | 5 | 205.00 | \$438.00 | \$89,790.00 |

| | | | | | | |
|----|---|-------------------------|--------------|------------------|----------|------------------------|
| 10 | Response to Final Rejection in <i>Ex Parte</i> Reexamination | 17 | 200 | 3,400.00 | \$438.00 | \$1,489,200.00 |
| 11 | Patent Owner's 37 CFR 1.951 Resposne in <i>Inter Partes</i> Reexamination | 41 | 10 | 410,00 | \$438.00 | \$179,580.00 |
| 12 | Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination | 41 | 5 | 205.00 | \$438.00 | \$89,790.00 |
| 13 | Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination | 0.50 (30 minutes) | 150 | 75.00 | \$438.00 | \$32,520.00 |
| | Total | | 1,540 | 32,962.50 | | \$14,437,575.00 |

Estimated Total Annual Respondent (Non-hourly) Cost Burden: \$2,750,186.50 per year. There are no capital start-up, recordkeeping, or maintenance costs associated with this collection. However, the collection does have annual (non-hour) costs in the form of postage costs and filing fees.

Postage Costs

The USPTO expects that most of the responses in this collection will be submitted electronically. However, it is estimated that roughly 18 mailed submissions will be submitted for Petitions to Request Extension of Time. In addition, the documentation for requests for supplemental examination and requests for *ex parte* reexamination will typically be mailed to the USPTO with the appropriate transmittal form, resulting in 550 unique mailings. The USPTO estimates that the average postage cost for a mailed submission will be \$0.50 for Petitions to Request Extension of Time and \$5.75 for all other mailed submissions. Therefore, the USPTO estimates that the total postage costs is approximately \$3,171.50 per year.

Filing Fees

There are nine filing fees associated with this collection, which are broken down by large entity, small entity, and micro entity. These fees are listed in the table below:

| IC Number | Item | Estimated Annual Responses (a) | Filing Fee (b) | Total Cost (c) (a) x (b) |
|-----------|--|--------------------------------|----------------|--------------------------|
| 2 | Supplemental Examination Request (large entity) | 55 | \$4,400.00 | \$242,000.00 |
| 2 | Supplemental Examination Request (small entity) | 15 | \$2,200.00 | \$33,000.00 |
| 2 | Supplemental Examination Request (micro entity) | 5 | \$1,100.00 | \$5,500.00 |
| 2 | Supplemental Examination Reexamination (large entity) | 35 | \$12,100.00 | \$423,500.00 |
| 2 | Supplemental Examination Reexamination (small entity) | 10 | \$6,050.00 | \$60,500.00 |
| 2 | Supplemental Examination Reexamination (micro entity) | 1 | \$3,025.00 | \$3,025.00 |
| 2 | Supplemental Examination document size fees, 21-50 documents (large entity) | 10 | \$180.00 | \$1,800.00 |
| 2 | Supplemental Examination document size fees, 21-50 documents (small entity) | 5 | \$90.00 | \$450.00 |
| 2 | Supplemental Examination document size fees, 21-50 documents (micro entity) | 1 | \$45.00 | \$45.00 |
| 2 | Supplemental examination document size fees, each additional 50 documents (large entity) | 10 | \$280.00 | \$2,800.00 |
| 2 | Supplemental examination document size fees, each additional 50 documents (small entity) | 1 | \$140.00 | \$140.00 |
| 2 | Supplemental examination document size fees, each additional 50 documents (micro entity) | 1 | \$70.00 | \$70.00 |
| 2 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (large entity) | 35 | \$460.00 | \$16,100.00 |
| 2 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity) | 10 | \$230.00 | \$2,300.00 |
| 2 | Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity) | 5 | \$115.00 | \$575.00 |
| 2 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (large entity) | 55 | \$100.00 | \$5,500.00 |
| 2 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity) | 20 | \$50.00 | \$1,000.00 |
| 2 | Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity) | 5 | \$25.00 | \$125.00 |
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (large entity) | 42 | \$6,000.00 | \$252,000.00 |
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (small entity) | 27 | \$3,000.00 | \$81,000.00 |
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (micro entity) | 1 | \$1,500.00 | \$1,500.00 |

| | | | | |
|---|--|------------|-------------|-----------------------|
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (large entity) | 78 | \$12,000.00 | \$936.00 |
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (small entity) | 51 | \$6,000.00 | \$306,000.00 |
| 4 | <i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (micro entity) | 1 | \$3,000.00 | \$3,000.00 |
| 5 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (large entity) | 180 | \$1,940.00 | \$349,200.00 |
| 5 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity) | 20 | \$970.00 | \$19,400.00 |
| 5 | Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity) | 1 | \$485.00 | \$485.00 |
| | Total | 680 | | \$2,747,015.00 |

Therefore, the USPTO estimates that the total annual (non-hour) cost burden for this collection, in the form of postage costs (\$3,171.5) and filing fees (\$2,747,015), is \$2,750,186.50 per year.

IV. Request for Comment

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

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;
 - 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, e.g., the use of automated collection techniques or other forms of information technology.

Marcie Lovett,

Director, Records and Information Governance Division, OCTO

United States Patent and Trademark Office.

BILLING CODE 3510-16-P

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