



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

Patent Trial and Appeal Board (PTAB) Appeals

ACTION: Notice of renewal of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the renewal and revision of an existing information collection: 0651-0063 (Patent Trial and Appeal Board (PTAB) Appeals).

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 “0651-0063 comment” in the subject line of the message.
- Federal Rulemaking Portal: <http://www.regulations.gov>.
- Mail: Kimberly Hardy, Office of the Chief Administrative 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 Michael Tierney, Vice Chief Administrative Patent Judge, Patent Trial and Appeal Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-9797; or by email to Michael.Tierney@uspto.gov. Additional information

about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The Patent Trial and Appeal Board (PTAB or Board) is established by statute under 35 U.S.C. 6. This statute directs, in relevant part, that PTAB shall “on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a).” PTAB has the authority, under 35 U.S.C. 134 and 306 to decide appeals in applications and *ex parte* reexamination proceedings, and under pre-AIA sections of the Patent Act, i.e., 35 U.S.C. 134 and 315, to decide appeals in *inter partes* reexamination proceedings. In addition, 35 U.S.C. 6 establishes the membership of PTAB as the Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the Administrative Patent Judges. Each appeal is decided by a merits panel of at least three members of the Board. The Board’s responsibilities under the statute include the review of *ex parte* appeals from adverse decisions of examiners in those situations where a written appeal is taken by a dissatisfied applicant or patent owner. In *inter partes* reexamination appeals, PTAB reviews examiner’s decisions adverse to a patent owner or a third-party requester. PTAB’s opinions and decisions for publicly available files are published on the USPTO Website.

The items associated with this information collection include appeals in applications and *ex parte* reexamination proceedings, and appeals in *inter partes*

reexamination proceedings that are governed by the regulations in 37 CFR 41. Failure to comply with the appropriate regulations may result in dismissal of the appeal or denial of entry of the submission.

The name of this information collection is being changed from “PTAB Actions” to “PTAB Appeals” to better reflect the content of the information collection. In addition, this renewal adds three items currently approved in another information collection (0651-0031: Patent Processing) to include all items related to patent appeals in a single information collection. These three items are: Notice of Appeal, Amendment to Cancel Claims During an Appeal, and Request for Oral Hearing. A separate change request will be submitted to remove these three items from that information collection (0651-0031: Patent Processing).

II. Method of Collection

Items in this information collection may be submitted via mail, hand delivery, facsimile, or filed as attachments through the USPTO’s Web-based electronic filing system (EFS-Web).

III. Data

OMB Number: 0651-0063.

Form Number(s): (AIA= American Invents; SB = Specimen Book)

- PTO/AIA/31: (Notice of Appeal from the Examiner to the Patent Trial and Appeal Board).
- PTO/SB/31: (Notice of Appeal).

- PTO/AIA/32: (Request for Oral Hearing before the Patent Trial and Appeal Board).
- PTO/SB/32: (Request for Oral Hearing before the Patent Trial and Appeal Board).

Type of Review: Revision of a currently approved information collection.

Affected Public: Individuals or households; private sector. The USPTO estimates that the majority (95%) of respondents (i.e., applicants, patent owners, and requesters) will be from the private sector, but that about 5% will be individuals and households.

Estimated Number of Respondents: 22,664 respondents.

Estimated Number of Responses: 48,886 responses.

Estimated Time Per Response: The USPTO estimates that it takes the public approximately .5 to 32 hours to complete this information collection, depending on the complexity of the request. This includes the time to gather the necessary information, prepare the brief, petition, and other papers, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 565,927 hours.

Estimated Total Annual Respondent Cost Burden: \$226,370,800. The USPTO expects that all of the responses in this information collection will be prepared by an intellectual property attorney. The attorney rates are found in the 2019 Report of the Economic Survey of the America Intellectual Property Law Association (AIPLA)¹. Using the professional hourly rate of \$400 for attorneys in private

¹ The AIPLA 2019 rate of \$400, for attorneys in private firms, is lower than the 2017 rate; this difference explains some (or all) of any reductions in the total hourly cost burden.

firms, the USPTO estimates that the total respondent cost burden for this information collection is \$226,370,800 per year.

Table 1: Burden Hour/Burden Cost to Respondents (Private Sector)

Item #	Item	Respondents	Responses (yr) (a)	Hours (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
1	Notice of Appeal	21,531	21,531	.5	10,766	\$400	\$4,306,400
2	Appeal Brief	Same as item 1	15,188	32	486,016	\$400	\$194,406,400
3	Amendment to Cancel Claims	Same as item 1	1,495	2	2,990	\$400	\$1,196,000
4	Reply Brief	Same as item 1	7,060	5	35,300	\$400	\$14,120,000
5	Request for Rehearing Before the PTAB	Same as item 1	390	5	1,950	\$400	\$780,000
6	Petitions to the Chief Administrative Patent Judge Under 37 CFR 41.3	Same as item 1	65	4	260	\$400	\$104,000
7	Request for Oral Hearing	Same as item 1	712	.5	356	\$400	\$142,400
	Totals	21,531	46,441		537,638		\$215,055,200

Table 2: Burden Hour/Burden Cost to Respondents (Individuals and Households)

Item #	Item	Respondents	Responses (yr) (a)	Hours (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
1	Notice of Appeal	1,133	1,133	.5	567	\$400	\$226,800
2	Appeal Brief	Same as item 1	799	32	25,568	\$400	\$10,227,200
3	Amendment to Cancel Claims	Same as item 1	79	2	158	\$400	\$63,200
4	Reply Brief	Same as item 1	372	5	1,860	\$400	\$744,000
5	Request for Rehearing Before the PTAB	Same as item 1	21	5	105	\$400	\$42,000
6	Petitions to the Chief Administrative Patent Judge Under 37 CFR 41.3	Same as item 1	3	4	12	\$400	\$4,800

7	Request for Oral Hearing	Same as item 1	38	.5	19	\$400	\$7,600
	Totals	1,133	2,445		28,289		\$11,315,600

Estimated Total Annual Non-hour Respondent Cost Burden: \$48,712,078

(\$48,704,205 in fees and \$7,873 in postage costs). There are no maintenance, operation, capital start-up, or recordkeeping costs associated with this information collection. However, this information collection does have annual (non-hour) costs in the form of postage costs and fees, which are explained below.

Table 3: Filing Fees

Item #	Item	Estimated Annual Responses	Fee (\$)	Total Cost (\$)
1	Notice of appeal (large)	16,092	\$840	\$13,517,280
1	Notice of appeal (small)	5,439	\$420	\$2,284,380
1	Notice of appeal (micro)	1,133	\$210	\$237,930
2	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (large)	7	\$2,100	\$14,700
2	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (small)	2	\$1,050	\$2,100
2	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (micro)	1	\$525	\$525
2	Filing a Brief in Support of an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board	15,987	\$0	\$0
4	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (large)	11,351	\$2,360	\$26,788,360
4	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (small)	3,837	\$1,180	\$4,527,660
4	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (micro)	799	\$590	\$471,410
7	Request for oral hearing (large)	533	\$1,360	\$724,880
7	Request for oral hearing (small)	180	\$680	\$122,400
7	Request for oral hearing (micro)	37	\$340	\$12,580
	Total	55,398	---	\$48,704,205

The briefs, petitions, and other papers may be submitted by mail through the United States Postal Service (USPS). The USPTO expects that about 2% of

items in this information collection will be mailed by Express Mail using the flat rate envelope, resulting in an estimated postage cost of \$7,873.

IV. Request for Comments

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

The USPTO invites public comments 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.

Kimberly Hardy,

Information Collections Officer,

Office of the Chief Administrative Officer,

United States Patent and Trademark Office.

BILLING CODE 3510-16-P

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