



## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### **Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Patent Trial and Appeal Board (PTAB) Appeals**

**AGENCY:** United States Patent and Trademark Office, Department of Commerce.

**ACTION:** Notice 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 extension and revision of an existing information collection: 0651-0063 Patent Trial and Appeal Board (PTAB) Appeals. The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

**DATES:** To ensure consideration, comments regarding this information collection must be received on or before **[INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

**ADDRESSES:** Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include "0651-0063 comment" in the subject line of the message.
- *Federal Rulemaking Portal:* <https://www.regulations.gov>.
- *Mail:* Justin Isaac, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

**FOR FURTHER INFORMATION CONTACT:** Request 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, 135, and 315, to decide appeals in *inter partes* reexamination proceedings and interferences. 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 and interference 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 Web site. The Board also conducts interference proceedings.

The items associated with this information collection include appeals in applications and *ex parte* reexamination proceedings, and appeals in *inter partes* reexamination proceedings and interference proceedings that are governed by the regulations in 37 CFR part 41. Failure to comply with the appropriate regulations may result in dismissal of the appeal or denial of entry of the submission.

This revision and extension of the information collection includes a line item to expressly specify certain filings made to the Board related to interference proceedings, including statements, motions, oppositions, and replies in preliminary and priority phases of an interference.

## **II. Method of Collection**

Items in this information collection may be submitted via mail, hand delivery, facsimile, filed as attachments through the USPTO's patent electronic filing system, or through the Patent Trial and Appeal Board End-to-End System (PTAB E2E), a separate electronic filing system.

## **III. Data**

*OMB Control Number:* 0651-0063.

*Forms:* (AIA= America Invents Act; 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:* Extension and revision of a currently approved information collection.

*Affected Public:* Private sector.

*Respondent's Obligation:* Required to Obtain or Retain Benefits.

*Estimated Number of Respondents:* 12,529 respondents.

*Estimated Number of Responses:* 22,149 responses.

*Estimated Time Per Response:* The USPTO estimates that the responses in this information collection will take the public approximately 0.5 to 120 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO.

*Estimated Total Annual Respondent Burden Hours:* 238,999 hours.

*Estimated Total Annual Respondent Hourly Cost Burden:* \$103,964,565.

**Table 1: Total Burden Hours and Hourly Costs to Private Sector Respondents**

Item No.	Item	Estimated Annual Respondents (a)	Responses per Respondent (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time For Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate <sup>1</sup> (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Notice of Appeal	12,312	1	12,312	0.5	6,156	\$435	\$2,677,860
2	Appeal Brief	6,768*	1	6,768	32	216,576	\$435	\$94,210,560
3	Amendment to Cancel Claims	112*	1	112	2	224	\$435	\$97,440
4	Reply Brief	2,197*	1	2,197	5	10,985	\$435	\$4,778,475
5	Petitions to the Chief Administrative Patent Judge Under 37 CFR 41.3	46*	1	46	4	184	\$435	\$80,040
6	Request for Oral Hearing	477*	1	477	0.5	239	\$435	\$103,965
7	Request for Rehearing Before the PTAB	207	1	207	5	1,035	\$435	\$450,225
8	Statements, Motions, Oppositions, and Replies in Preliminary and Priority Phases of an Interference	10	3	30	120	3,600	\$435	\$1,566,000
	<b>Totals</b>	<b>12,529</b>	<b>---</b>	<b>22,149</b>	<b>---</b>	<b>238,999</b>	<b>---</b>	<b>\$103,964,565</b>

\*These lines (2-6) are subsets of the respondents from line 1, and not included in the total for this column. USPTO includes these numbers to show how the values in column C are calculated.

<sup>1</sup> 2021 Report of the Economic Survey published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); pg. F-27. The USPTO uses the average billing rate for attorneys in private firms which is \$435 per hour.

*Estimated Total Annual Respondent Non-hourly Cost Burden: \$17,185,623.*

There are no capital start-up, maintenance cost, or recordkeeping costs associated with this information collection. However, USPTO estimates that the total annual (non-hour) cost burden for this information collection, in the form of filing fees (\$17,183,424) and postage (\$2,199) is \$17,185,623.

### Filing Fees

The 12 filing fees associated with this information collection as outlined in the table below:

**Table 2: Filing Fees**

Item No.	Fee Code	Item	Estimated Annual Responses (a)	Fee (\$) (b)	Total Cost (\$) (a) x (b) = (c)
1	1401	Notice of appeal (undiscounted)	8,737	\$840	\$7,339,080
1	2401	Notice of appeal (small)	3,230	\$336	\$1,085,280
1	3401	Notice of appeal (micro)	345	\$168	\$57,960
2	1404	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (undiscounted)	1	\$2,100	\$2,100
2	2404	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (small)	1	\$840	\$840
2	3404	Filing a brief in support of an appeal in an <i>inter partes</i> reexamination proceeding (micro)	1	\$420	\$420
4	1413	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (undiscounted)	3,131	\$2,360	\$7,389,160
4	2413	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (small)	797	\$944	\$752,368
4	3413	Forwarding an Appeal in an Application or <i>Ex Parte</i> Reexamination Proceeding to the Board (micro)	91	\$472	\$42,952
6	1403	Request for oral hearing (undiscounted)	319	\$1,360	\$433,840
6	2403	Request for oral hearing (small)	134	\$544	\$72,896
6	3403	Request for oral hearing (micro)	24	\$272	\$6,528
		<b>Totals</b>	<b>16,811</b>	<b>---</b>	<b>\$17,183,424</b>

### Postage Costs

Although the USPTO prefers that the items in this information collection be submitted electronically, responses may be submitted by mail through the United States Postal Service (USPS). The USPTO estimates that 1% of the 22,149 items will be submitted in the mail resulting in 221 mailed items. The USPTO estimates that the average postage cost for a mailed submission, using a Priority

Mail 2-day flat rate legal envelope, will be \$9.95. Therefore, the USPTO estimates the total mailing costs for this information collection at \$2,199.

#### **IV. Request for Comments**

The USPTO is soliciting public comments to:

- (a) Evaluate whether the collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the collection of information, including the validity of the methodology and assumptions used;
- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personally identifiable information (PII) in a comment, be aware that the entire comment—including PII—may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

**Justin Isaac,**

*Information Collections Officer,*

*Office of the Chief Administrative Officer,*

*United States Patent and Trademark Office.*