



DEPARTMENT OF COMMERCE

Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget for Review and Approval; Comment Request; Patent Review and Derivation Proceedings

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

ACTION: Notice of information collection; request for comments.

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: 0651-0069 (Patent Review and Derivation Proceedings). The purpose of this notice is to allow 60 days for public comments preceding submission of the information collection to the Office of Management and Budget (OMB).

DATES: To ensure consideration, you must submit comments regarding this information collection on or before **[INSERT DATE 60 DAYS AFTER THE 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. Include “0651-0069 comment” in the subject line of the message.

- Federal eRulemaking Portal: <http://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: Requests for additional information should be directed to Michael P. Tierney, Vice Chief Administrative Patent Judge, at: Patent Trial and Appeal Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; 571-272-4676; or Michael.Tierney@uspto.gov with “0651-0069 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The Leahy-Smith America Invents Act, which was enacted into law on September 16, 2011, changed the procedures of the Patent Trial and Appeal Board (“PTAB” or “Board,” formerly the Board of Patent Appeals and Interferences). These changes included the introduction of *inter partes* review, post-grant review, derivation proceedings, and the transitional program for covered business method patents. Under these administrative trial proceedings, third parties may file a petition with the PTAB challenging the validity of issued patents, with each proceeding having different requirements regarding timing restrictions, grounds for challenging validity, and who may request review.

Inter partes review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent but only on a ground that could be raised under 35 U.S.C. 102 or 103, and only on the basis of prior art consisting of patents or printed publications. Post-grant review is a trial proceeding conducted at the Board to review the patentability of one or more claims in a patent on any ground that could be raised under section 282(b)(2) or (3). A derivation proceeding is a trial proceeding conducted at the Board to determine whether: (1) an inventor named in an earlier application derived the claimed invention from an inventor named in the

petitioner's application, and (2) the earlier application claiming such invention was filed without authorization. The transitional program for covered business method patents is a trial proceeding conducted at the Board to review the patentability of one or more claims in a covered business method patent. The covered business method program expired on September 16, 2020, and the Board no longer accepts new petitions related to this program, but continues to accept papers in previously-instituted proceedings.

The USPTO's projections are based on data from the past year. The USPTO recognizes that the numbers may fluctuate given interim changes to the institution process. The USPTO has adjusted the estimated burden hours and the number of estimated filings based on recent changes to these proceedings.

This collection covers information submitted by the public to petition the Board to initiate an *inter partes* review, post-grant review, derivation proceeding, and the transitional program for covered business method patents, as well as any responses to such petitions, and the filing of any motions, replies, oppositions, and other actions, after a review/proceeding has been instituted.

II. Method of Collection

Applicants must submit the information electronically using Patent Trial and Appeal Case Tracking System filing system. Parties may seek authorization to submit a filing by means other than electronic filing pursuant to 42 CFR 42.6(b)(2).

III. Data

OMB Control Number: 0651-0069.

Forms: None.

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.

Frequency: On occasion.

Estimated Number of Annual Respondents: 7,897 respondents.

Estimated Number of Annual Responses: 11,947 responses.

Estimated Time per Response: The USPTO estimates that the responses in this information collection will take the public approximately 18 minutes (0.3 hours) to 170 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed item to the USPTO.

Estimated Total Annual Respondent Burden Hours: 590,630 hours.

Estimated Total Annual Respondent Hourly Cost Burden: \$264,011,610.

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

| Item No. | Item | Estimated Annual Respondents | Responses per Respondent | Estimated Annual Responses | Estimated Time for Response (hours) | Estimated Burden (hour/year) | Rate ¹ (\$/hour) | Estimated Annual Respondent Cost Burden |
|----------|--|------------------------------|--------------------------|----------------------------|-------------------------------------|------------------------------|-----------------------------|---|
| | | (a) | (b) | (a) x (b) = (c) | (d) | (c) x (d) = (e) | (f) | (e) x (f) = (g) |
| 1 | Petition for <i>Inter Partes</i> Review | 1,300 | 1 | 1,300 | 120 | 156,000 | \$447 | \$69,732,000 |
| 2 | Petition for Post-Grant Review or Covered Business Method Patent Review | 50 | 1 | 50 | 170 | 8,500 | \$447 | \$3,799,500 |
| 3 | Petition for Derivation | 10 | 1 | 10 | 170 | 1,700 | \$447 | \$759,900 |
| 4 | Patent Owner Preliminary Response to Petition for Initial <i>Inter Partes</i> Review | 975 | 1 | 975 | 90 | 87,750 | \$447 | \$39,224,250 |

¹ 2023 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association; pg. F-41. The USPTO uses the average billing rate for intellectual property work in all firms which is \$447 per hour (<https://www.aipla.org/home/news-publications/economic-survey>).

| Item No. | Item | Estimated Annual Respondents | Responses per Respondent | Estimated Annual Responses | Estimated Time for Response (hours) | Estimated Burden (hour/year) | Rate ¹ (\$/hour) | Estimated Annual Respondent Cost Burden |
|----------|--|------------------------------|--------------------------|----------------------------|-------------------------------------|------------------------------|-----------------------------|---|
| | | (a) | (b) | (a) x (b) = (c) | (d) | (c) x (d) = (e) | (f) | (e) x (f) = (g) |
| 5 | Patent Owner Preliminary Response to Petition for Initial Post-Grant Review or Covered Business Method Patent Review | 50 | 1 | 50 | 90 | 4,500 | \$447 | \$2,011,500 |
| 6 | Request for Rehearing | 50 | 1 | 50 | 80 | 4,000 | \$447 | \$1,788,000 |
| 7 | Request for Director Review | 150 | 1 | 150 | 80 | 12,000 | \$447 | \$5,364,000 |
| 8 | Response to a Request for Director Review | 150 | 1 | 150 | 40 | 6,000 | \$447 | \$2,682,000 |
| 9 | Other Motions, Replies, Surreplies, and Oppositions in <i>Inter Partes</i> Review | 2,600 | 2.5 | 6,500 | 40 | 260,000 | \$447 | \$116,220,000 |
| 10 | Other Motions, Replies, Surreplies, and Oppositions in Post-Grant Review or Covered Business Method Review | 100 | 2.5 | 250 | 40 | 10,000 | \$447 | \$4,470,000 |
| 11 | Other Motions, Replies, Surreplies, and Oppositions in Derivation Proceedings | 10 | 1 | 10 | 40 | 400 | \$447 | \$178,800 |
| 12 | <i>Pro Hac Vice</i> Motion | 450 | 1 | 450 | 0.5 (30 minutes) | 225 | \$447 | \$100,575 |
| 13 | Notice of intent to designate provisionally recognized PTAB attorney as counsel | 500 | 1 | 500 | 0.3 (18 minutes) | 150 | \$447 | \$67,050 |
| 14 | Request for Oral Hearing | 400 | 1 | 400 | 2 | 800 | \$447 | \$357,600 |
| 15 | Request to Treat a Settlement as Business Confidential | 375 | 1 | 375 | 2 | 750 | \$447 | \$335,250 |
| 16 | Settlement | 375 | 1 | 375 | 100 | 37,500 | \$447 | \$16,762,500 |

| 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 ¹ (\$/hour) (f) | Estimated Annual Respondent Cost Burden (e) x (f) = (g) |
|----------|---|-------------------------------------|---------------------------------|---|--|---|------------------------------------|--|
| 17 | Arbitration Agreement and Award | 1 | 1 | 1 | 4 | 4 | \$447 | \$1,788 |
| 18 | Request to Make a Settlement Agreement Available | 1 | 1 | 1 | 1 | 1 | \$447 | \$447 |
| 19 | Notice of Judicial Review of a Board Decision (e.g. Notice of Appeal Under 35 U.S.C. 142) | 350 | 1 | 350 | 1 | 350 | \$447 | \$156,450 |
| | Totals | 7,897 | - - - | 11,947 | - - - | 590,630 | - - - | \$264,011,610 |

Estimated Total Annual Respondent Non-hourly Cost Burden: \$76,099,956. There are no capital start-up costs, maintenance costs, recordkeeping costs, or postage costs associated with this information collection. However, the USPTO estimates that the total annual non-hour cost burden for this information collection, in the form of filing fees, is \$76,099,956.

Filing Fees

The filing fees for this information collection are listed in the table below.

Table 2: Filing Fees

| Item No. | Fee Code(s) | Item | Estimated Annual Responses (a) | Filing Fee (\$) (b) | Estimated Non-Hourly Cost Burden (a) x (b) = (c) |
|----------|-------------|---|-----------------------------------|------------------------|---|
| 1 | 1406 | <i>Inter Partes</i> Review Request Fee – Up to 20 Claims | 1,300 | \$23,750 | \$30,875,000 |
| | 1414 | <i>Inter Partes</i> Review Post-Institution Fee – Up to 20 Claims | 1,300 | \$28,125 | \$36,562,500 |
| | 1407 | <i>Inter Partes</i> Review Request of Each Claim in Excess of 20 | 3,700 | \$470 | \$1,739,000 |
| | 1415 | <i>Inter Partes</i> Post-Institution Request of Each Claim in Excess of 20 | 3,700 | \$940 | \$3,478,000 |
| 2 | 1408 | Post-Grant or Covered Business Method Review Request Fee – Up to 20 Claims | 50 | \$25,000 | \$1,250,000 |
| | 1416 | Post-Grant or Covered Business Method Review Post-Institution Fee – Up to 20 Claims | 50 | \$34,375 | \$1,718,750 |
| | 1409 | Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20 | 150 | \$595 | \$89,250 |
| | 1417 | Post-Grant or Covered Business Method Review Post-Institution Request of Each Claim in Excess of 20 | 150 | \$1,315 | \$197,250 |

| | | | | | |
|-----------|----------------------|--|---------------|-------|---------------------|
| 3 | 1412 | Petition for a Derivation Proceeding | 2 | \$452 | \$904 |
| 7 | 1419 1420 1421 | Request for Director Review | 150 | \$452 | \$67,800 |
| 12 | 1418 | <i>Pro Hac Vice</i> Admission Fee | 450 | \$269 | \$121,050 |
| 16 | 1411 | Request to Make a Settlement Agreement Available and Other Requests Filed in a Patent Trial Proceeding | 1 | \$452 | \$452 |
| | | Totals | 11,003 | - - - | \$76,099,956 |

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. The 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, the 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.

[FR Doc. 2025-09145 Filed: 5/20/2025 8:45 am; Publication Date: 5/21/2025]