

Paperwork Reduction Act:

**Does the U.S. Patent and Trademark Office Have
Valid OMB Control Numbers for the
Information Collection Requirements in Rules 111, 115, and 116?**

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Does the U.S. Patent and Trademark Office Have Valid OMB Control Numbers for the Information Collection Requirements in Rules 111, 115, and 116?

I. Background

A. The Paperwork Reduction Act Process

The Paperwork Reduction Act (“PRA”, 44 U.S.C. § 3501 *et seq.*) provides a comprehensive scheme to “minimize the paperwork burden for individuals, small businesses, educational and nonprofit institutions, Federal contractors, State, local and tribal governments, and other persons resulting from the collection of information by or for the Federal Government.” 44 U.S.C. § 3501(1). Agencies are required to “establish a process within the office headed by the Chief Information Officer,” one “that is sufficiently independent of program responsibility to evaluate fairly whether proposed collections of information should be approved” by the Office of Management and Budget (“OMB”). 44 U.S.C. § 3506(c)(1). Procedurally, agencies submit Information Collection Requests (“ICRs”) to OMB for review (5 C.F.R. §§ 1320.10-12) after conducting certain tasks prescribed by statute (44 U.S.C. § 3506(c) and OMB (5 C.F.R. §§ 1320.7-12)).

More specifically, prior to the submission of each ICR to OMB for review, this agency office must conduct a review, as set forth in 44 U.S.C. § 3506(c)(1)(A), and ensure that each collection of information adheres to certain enumerated requirements, as set forth in 44 U.S.C. § 3506(c)(1)(B), including the display of a valid OMB control number. An agency shall not conduct or sponsor a collection of information unless, in advance, it has conducted the § 3506(c)(1) review, evaluated public comments received under § 3506(c)(2), submitted to OMB the certifications required by § 3506(c)(3) along with records supporting such certifications, and published the notice required under § 3507(a)(1)(D). These procedures were first established in 1981 (Pub. L. 96-511) and were amended in 1995 (Pub. L. 104-13).

B. The PRA’s “Public Protection Provisions”

OMB is charged by statute with implementing the PRA; its decisions to approve or disapprove agency information collection requests are absolute and not judicially reviewable. 44 U.S.C. § 3507(d)(6). The PRA also contains certain “Public Protection Provisions” that can be invoked when agencies seek to enforce information collection requirements that were disapproved by OMB, never submitted for OMB approval, or lapsed. The PRA would have quickly failed without these provisions; agencies likely would not bother to seek and obtain prior OMB approval before imposing information collection requirements.

The Public Protection Provisions work by relieving the public of any obligation to comply with unapproved information collections. If an agency imposes a penalty on any person for failure to comply, 44 U.S.C. § 3512(a) requires that such penalty be vacated:

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Notwithstanding any other provision of law, no person shall be subject to any penalty for failing to comply with a collection of information that is subject to this subchapter if—

(1) the collection of information does not display a valid control number assigned by the Director in accordance with this subchapter; or

(2) the agency fails to inform the person who is to respond to the collection of information that such person is not required to respond to the collection of information unless it displays a valid control number.

Though the statute does not say so explicitly, the Public Protection Provisions also apply in the case where an agency displays an *invalid* OMB control number or falsely represents an information collection requirement as approved.

The PRA also provides, in 44 U.S.C. § 3512(b), a way to enforce this right:

The protection provided by this section may be raised in the form of a complete defense, bar, or otherwise at any time during the agency administrative process or judicial action applicable thereto.

Enforcement is not limited to certain venues, such as Executive branch agencies, nor is it time-limited such that it expires if not exercised within a specified period. Persons may invoke this defense in their dealings with the agency that conducted or sponsored the unapproved collection of information, a sister agency charged with enforcing such requirements, or in an Article III court.

C. Requesting Formal Determinations by OMB under 44 U.S.C. § 3517(b)

In cases where the penalty consists of an enforcement action or arises after a final agency administrative action, the mechanism for exercising this right is straightforward: appeal via the agency's administrative process and, if such appeals are exhausted without relief, to an Article III court.

How to proceed is not obvious, however, when the agency conducting or sponsoring the unapproved collection of information requires compliance as a condition for obtaining a benefit to which a member of the public is otherwise entitled. Typically in such cases, the agency declines to complete its administrative action unless and until the person complies. Persons are effectively penalized simply by agency inaction, yet establishing standing absent final agency action can be problematic.

The PRA provides a little-known procedure that may offer a pathway for relief in such cases:

Any person may request the Director to review any collection of information conducted by or for an agency to determine, if, under this subchapter, a

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person shall maintain, provide, or disclose the information to or for the agency.

OMB is required to respond to all such requests; the PRA does not permit OMB to leave a request unanswered:

Unless the request is frivolous, the Director shall, in coordination with the agency responsible for the collection of information—

- (1) respond to the request within 60 days after receiving the request, unless such period is extended by the Director to a specified date and the person making the request is given notice of such extension; and
- (2) take appropriate remedial action, if necessary.

44 U.S.C. § 3512(b).

D. Determinations An Applicant Should Seek From OMB

During the examination of a patent application, the USPTO on numerous occasions may demand that an applicant produce and submit certain information (“Amendments and Responses”) pursuant to 37 C.F.R. §§ 1.111, 1.115, or 1.116 (“Rules 111, 115, or 116”). Failing to produce and submit this information within the stated time period may result in involuntary abandonment of the patent application. Involuntary abandonment is within the definition of “penalty” set forth in 44 U.S.C. § 3502(14) and 5 C.F.R. § 1320.3(j).

Any person (including an applicant who has been required to submit an Amendment or Response) may ask OMB to issue a formal determination pursuant to 44 U.S.C. § 3517(b) whether he is required to “maintain, provide, or disclose the information to or for the agency.” In particular, a person asking OMB for a formal opinion on the information collection requirements contained in Rules 111, 115, or 116 would ask OMB to issue the following determinations:

1. Persons who otherwise would have been covered by Rule 111 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.
2. Persons who otherwise would have been covered by Rule 115 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.
3. Persons who otherwise would have been covered by Rule 116 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.

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II. Applying 44 U.S.C. § 3517(b) to USPTO Rules 111, 115, and 116

The USPTO does not now have, and apparently has never had, a valid OMB control number for Amendments and Responses under Rules 111, 115, or 116. Subsection A summarizes the information collection requirements contained in these Rules. Subsection B shows that, on every instance in which the USPTO promulgated or amended one or more of these Rules, the Office falsely claimed that these information collection requirements had already been approved by OMB when in fact it had never submitted a contemporaneous request for approval. Subsection C recounts the history of OMB control number 0651-0031 (“Patent Processing (Updating)”), showing that at no time prior to January 2013 did the USPTO ever seek OMB approval of these information collection requirements. Finally, it is shown that the USPTO’s January 2013 Information Collection Request was misleading and deceptive. Having recognized that the Office had for decades failed to seek and obtain OMB approval, the Patent Office tried to cover up its error by misrepresenting the January 2013 request as a mere “program change.”

A. Rule Texts

For convenience, the information collection provisions in each of these Rules is summarized below.

1. Rule 111 (“Reply by applicant or patent owner to a non-final Office action”)

Rule 111 establishes information collection requirements for patent applicants or owners who have received nonfinal Office actions on their applications that are “adverse in any respect.” Generally, an adverse action consists of the rejection of one or more claims. Rule 111 says such patent applicant or owner “must reply and request reconsideration or further examination, with or without amendment ... reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action...” Rule 111(a)(1). Rule 111(a)(2) also includes certain provisions governing “supplemental replies.”

2. Rule 115 (“Preliminary amendments”)

Rule 115 establishes information collection requirements for preliminary amendments filed with the Patent Office on or before the mailing date of the first Office action. An applicant typically files a Preliminary amendment when some of the information necessary for an issuable patent is not available on the original filing date, and so is supplied shortly thereafter, before the examiner first examines the application. Rule 115 sets deadlines for when a Preliminary Amendment may be filed, and Rule 121 sets requirements for content and form.

3. Rule 116 (“Amendments and affidavits or other evidence after final action and prior to appeal”)

Rule 116 establishes information collection requirements for amendments, affidavits, or other evidence that a patent applicant or owner may provide after a final

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Office action. These amendments may, for example, cancel claims or comply with any requirement of form expressly set forth in a previous Office action (Rule 116(b)(1)), present rejected claims in better form for consideration on appeal (Rule 116(b)(2)), or touch the merits of the application provided that the applicant makes a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented (Rule 116(c)).

B. The USPTO's Noncompliance with the Paperwork Reduction Act

In this section, the Patent Office's systematic noncompliance with the Paperwork Reduction Act is documented for each of the three Rules in question. Electronic access to the Federal Register begins with 1994, so the review below does not include the 1981 and 1987 actions.¹

1. Rule 111

Rule 111 was promulgated on May 29, 1981 (46 Fed. Reg. 29182) and amended on October 10, 1997 (62 Fed. Reg. 53192), September 8, 2000 (65 Fed. Reg. 54672), September 21, 2004 (69 Fed. Reg. 56542), and January 27, 2005 (70 Fed. Reg. 3891).

a) October 10, 1997, final rule²

This final rule amended Paragraph (a) to clarify the usage of certain terms, and amended Paragraph (b) to explicitly recognize that a reply must be reduced to a writing that points out the specific distinctions believed to render the claims, including any newly presented claims, patentable. The extent to which this final rule altered the information collection requirements contained in Rule 111 is not clear. The preamble clearly stated, however, that applicants have a duty to respond to be entitled to reconsideration or further examination. This duty translates into an information collection requirement.

The Paperwork Reduction Act section of the preamble identifies 10 different OMB control numbers affected by this final rule. 62 Fed. Reg. 53178-53180. These control numbers are listed in Table A below. The preamble indicates that the USPTO did not contemporaneously submit ICRs for any of these 10 OMB control numbers, stating that the "collections of information involved in this Final Rule have been reviewed and approved by OMB." 62 Fed. Reg. 53178/2.

A review of these OMB Control Numbers confirms that the USPTO did not seek approval of any information collection requirements related to Rule 111 in this final rule.

¹ OMB's electronic docket also is incomplete for ICRs predating the most recent update of reginfo.gov. For example, it does not include pre-update Supporting Statements, public comments, and similar documents.

² U.S. Patent and Trademark Office. 1997. Changes to Patent Practice and Procedure. 62 Fed. Reg. 53132-53204, <http://www.gpo.gov/fdsys/pkg/FR-1997-10-10/pdf/97-26339.pdf>.

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That includes the most plausible OMB control number among them—0651-0031 (“Patent Processing (Updating)”)—which is shown in Table A highlighted in *italics* and shaded in yellow. Without an ICR requesting the approval of information collections related to these amendments to Rule 111, changes in information collection requirements made via this final rule cannot have been approved by OMB.

b) September 8, 2000, final rule³

This final rule revised the business goals for the organizations reporting to the Commissioner for Patents for the stated purpose of “increase[ing] the level of service to the public by raising the efficiency and effectiveness of the Office’s business processes.” The rule “chang[ed] the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify the provisions of the rules of practice.”

The Paperwork Reduction Act section of the preamble identifies 11 different OMB control numbers that were affected by this final rule. 65 Fed. Reg. 54654-54656. These control numbers are listed in Table B below. The preamble indicates that the USPTO did not contemporaneously submit ICRs for these 11 OMB control numbers, stating that the “collections of information involved in this notice of proposed rulemaking [sic] have been reviewed and previously approved by OMB.” 65 Fed. Reg. 54654/3.⁴

A review of the schedule of ICRs submitted for these OMB control numbers confirms that the USPTO did not contemporaneously seek approval of any information collection requirements related to Rule 111 in this final rule. This includes the most plausible OMB control number among them—0651-0031 (“Patent Processing (Updating)”)—which is shown in Table B highlighted in *italics* and shaded in yellow. Without an ICR requesting the approval of information collections related to these amendments to Rule 111, changes in information collection requirements made via this final rule cannot have been approved by OMB.

³ U.S. Patent and Trademark Office. 2000. Changes To Implement the Patent Business Goals; Final Rule. 65 Fed. Reg. 54604-54683, <http://www.gpo.gov/fdsys/pkg/FR-2000-09-08/pdf/00-22392.pdf>.

⁴ Notice the erroneous reference to a *notice of proposed rulemaking* even though this was a final rule. In the preamble to the actual notice of proposed rulemaking, the USPTO stated that the “collections of information involved in this notice have been reviewed and previously approved by OMB.” 64 Fed. Reg. 53817/1 (October 4, 2009). That is, both preambles state that the new information collection requirements contained in the proposed and final revisions to Rule 111, respectively, had already been approved by OMB. Neither preamble states *when* OMB issued this approval.

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c) September 21, 2004, final rule⁵

The stated purpose of this final rule was to “transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system.” It made changes to numerous information collection requirements, including Rule 111. 69 Fed. Reg. 56482-56547.

The Paperwork Reduction Act section of the preamble identifies seven different OMB control numbers that were affected by this final rule. 69 Fed. Reg. 56533-56535. They are listed in Table C below. The preamble indicates that the USPTO did not submit ICRs related to these seven OMB control numbers, stating that the “collections of information involved in this final rule have been reviewed and previously approved by OMB.” 65 Fed. Reg. 54533/2.⁶

A review of these OMB Control Numbers confirms that the USPTO did not seek approval of any information collection requirements related to Rule 111 in this final rule. That includes the most plausible OMB control number among them—0651-0031 (“Patent Processing (Updating)”)—which is shown in Table C highlighted in *italics* and shaded in yellow. Without an ICR requesting the approval of information collections related to these amendments to Rule 111, changes in information collection requirements made via this final rule cannot have been approved by OMB.

d) January 27, 2005, final rule⁷

This final rule revised the patent fees set forth in the rules of practice to conform them to the patent fees set forth in the Consolidated Appropriations Act of 2005. Rule 111 was affected by this rule only because a typographical error in subsection (a)(2)(i) related to supplemental replies was corrected. No significant changes in information collection requirements would be expected due to the correction of a typographical error.

⁵ U.S. Patent and Trademark Office. 2004. Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule. 69 Fed. Reg. 56482-56547. <http://www.gpo.gov/fdsys/pkg/FR-2004-09-21/pdf/04-20936.pdf>.

⁶ In the preamble to the notice of proposed rulemaking, the USPTO used identical stated that the “collections of information involved in this final rule [sic] have been reviewed and previously approved by OMB.” 68 Fed. Reg. 53844/3 (September 12, 2003). Notice the erroneous reference to a *final rule* even though this was a notice of proposed rulemaking. In any case, the USPTO asserted that neither the notice of proposed rulemaking nor the final rule materially altered the information collection requirements contained in Rule 111 beyond what had already been approved by OMB. The USPTO did not identify when that OMB approval was said to have occurred.

⁷ U.S. Patent and Trademark Office. 2005. Changes To Implement the Patent Fee Related Provisions of the Consolidated Appropriations Act, 2005; Final Rule. 70 Fed. Reg. 3880-3892, <http://www.gpo.gov/fdsys/pkg/FR-2005-01-27/pdf/05-1377.pdf>.

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Table A: OMB Control Numbers Affected by October 10, 1997 Final Rule⁸

OMB Control Number	ICR Title	Form Number(s)	Contemporaneous ICR Submissions? [5 CFR 1320.11(h)]
0651-0016	Rules for Patent Maintenance Fees	PTO/SB/45, 47, 65, 66	No
0651-0021	Patent Cooperation Treaty	PCT/RO/101; ANNEX/134/144; PTO-1382; PCT/IPEA/401; PCT/IB/32	No
0651-0022	Deposit of Biological Materials for Patent Purposes.	None	No; ICR Ref No 199710-0651-001 submitted 10/31/1997 as an extension without change
0651-0027	Changes in Patent and Trademark Assignment Practices	PTO-1618, 1619; PTO/SB/15, 41	No
<i>0651-0031</i>	<i>Patent Processing (Updating)</i>	<i>PTO/SB/08/21-27, 31, 42, 43, 61, 62, 63, 64, 67, 68, 91, 92, 96, 97</i>	<i>No</i>
0651-0032	Initial Patent Application	PTO/SB/01-07, 13; PCT/17-19, 29, 101-110	No
0651-0033	Allowance and Refiling	PTO/SB/13, 14, 44, 50-57; PTOL-85b	No
0651-0034	Secrecy/License to Export	None	No
0651-0035	Address-Affecting Provisions	PTO/SB/81-84, 121-125	No
0651-0037	Provisional Applications	PTO/SB/16	No

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Table B: OMB Control Numbers Affected by September 8, 2000 Final Rule⁹

OMB Control Number	ICR Title	Form Number(s)	Contemporaneous ICR Submissions? [5 CFR 1320.11(h)]
0651-0016	Rules for Patent Maintenance Fees	PTO/SB/45, 47, 65, 66	No
0651-0020	Patent Term Extension	None	No
0651-0021	Patent Cooperation Treaty	PCT/RO/101; ANNEX/134/144; PTO-1382 PCT/IPEA/401; PCT/IB/32	No; ICR Ref No 200008-0651-001 submitted 8/21/2000 as a revision; no ICs relevant to Rule 111 in the collection
0651-0022	Deposit of Biological Materials for Patent Purposes	None	No; ICR Ref No 200010-0651-001 submitted 10/17/2000 as an extension without change
0651-0024	Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures	None	No
0651-0027	Changes in Patent and Trademark Assignment Practices	PTO-1618, 1619; PTO/SB/15/41	No; ICR Ref No 200008-0651-005 submitted 8/11/2000 with no material or nonsubstantive changes only
<i>0651-0031</i>	<i>Patent Processing (Updating)</i>	<i>PTO/SB/08/21-27, 31, 42, 43, 61, 62, 63, 64, 67, 68, 91, 92, 96, 97</i>	<i>No</i>
0651-0032	Initial Patent Application	PTO/SB/01-07, 13; PCT/17-19, 29, 101-110	No
0651-0033	Allowance and Refiling	PTO/SB/13, 14, 44, 50-57; PTOL-85b	No; ICR Ref No. 200010-0651-002 submitted 10/26/2000 as a revision; no ICs relevant to Rule 111
0651-0034	Secrecy/License to Export	None	No
0651-0035	Address-Affecting Provisions	PTO/SB/81-84, 121-125	No

⁹ Data obtained from reginfo.gov.

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Table C: OMB Control Numbers Affected by September 21, 2004 Final Rule¹⁰

OMB Control Number	ICR Title	Form Number(s)	Contemporaneous ICR Submissions? [5 CFR 1320.11(h)]
0651-0016	Rules for Patent Maintenance Fees	PTO/SB/45, 47, 65, 66	No
0651-0020	Patent Term Extension	None	No; ICR Ref No 200408-0651-001 submitted 8/6/2004 as an extension without change
<i>0651-0031</i>	<i>Patent Processing (Updating)</i>	<i>PTO/SB/08A, 08B, 17i, 17P, 21-27, 30-37, 42-43, 61-64, 67-68, 91-92, 96-97, 2053-A/B, 2054-A/B, 2055-A/B; PTOL-413A</i>	<i>No; ICR Ref No 200407-0651-002 submitted 7/15/2004 as a revision; no ICs relevant to Rule 111</i>
0651-0032	Initial Patent Application	PTO/SB/01-07, 13PCT, 16-19, 29, 29A, 101-110	No
06510-0033	Allowance and Refiling	PTO/SB/44, 50-51, 51S, 52-53, 56-58; PTOL-85B	No
0651-0034	Secrecy/License to Export	None	No
0651-0036	Statutory Invention Registration	PTO/SB/94	No

¹⁰ Data obtained from reginfo.gov.

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1. Rule 115

The September 8, 2000 final rule cited above in the discussion of Rule 111 (65 Fed. Reg. 54604), also amended Rule 115 to set timing deadlines. Rule 115 was further amended in the September 21, 2004 final rule cited above in the discussion of Rule 111 (69 Fed. Reg. 56543), largely to expressly state legal effects of Preliminary Amendments that had previously been assumed.

As noted above in the discussions of the final rules dated September 8, 2000 and September 21, 2004, the Paperwork Reduction Act sections of the preambles identify 11 and seven different OMB control numbers, respectively, which are listed in Table B and Table C. Also as previously noted, both preambles state that the USPTO did not submit an ICR for any changes in information collection requirements related to these OMB control numbers as a result of this rulemaking. Without an ICR requesting the approval of information collections related to these amendments to Rule 115, changes in information collection requirements made via this final rule cannot have been approved by OMB.

2. Rule 116

Rule 116 was amended on August 12, 2004, as part of a larger rulemaking that revised the Rules of Practice before the Board of Patent Appeals and Interferences.¹¹ The Paperwork Reduction Act section of the preamble states as follows (59 Fed. Reg. 49996/3):

Paperwork Reduction Act: This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501et seq.).

Currently approved forms include PTO/SB/31 (Notice of appeal) and PTO/ SB/32 (Request for hearing), both of which were cleared under the OMB 0651-0031 collection, which will expire at the end of July 2006.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

¹¹ U.S. Patent and Trademark Office. 2004. Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule. 69 Fed. Reg. 49960-50020. The America Invents Act of 2011 renamed the Board of Patent Appeals and Interferences to the Patent Trial and Appeal Board.

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This text does not indicate that the USPTO submitted an ICR to seek approval of the information collection requirements contained in amendments to Rule 116. The online docket shows no submission of any contemporaneous ICR for any OMB control number, including 0651-0031.¹² Without an ICR requesting the approval of information collections related to 2004 amendments to Rule 116, changes in information collection requirements made via this final rule cannot have been approved by OMB. The two forms mentioned are merely administrative notices estimated by the USPTO to require only a few minutes to prepare. Neither of them are related in any way to Rule 116.

C. OMB Control Number 0651-0031 (“Patent Processing (Updating)”)

A review of the history of this OMB control number indicates that the USPTO never sought approval of Amendments and Responses related to Rules 111, 115, or 116 until January 29, 2013.¹³ In the January 2013 ICR submission, which is still under review at OMB, there are two rows for Amendments and Responses in the IC list.¹⁴ Unlike most other information collection items, which include within their titles a reference to the specific rule(s) to which they apply, these information collection items include no such references. Thus, it is not obvious to the casual reader (or perhaps to the harried OMB desk officer) what these items entail. Nonetheless, they should attract attention because the USPTO sought approval of 960,000 new responses estimated to impose 7,680,000 new burden-hours at a monetized cost exceeding \$2.8 billion per year. U.S. Patent and Trademark Office, 2013. *Supporting Statement; Patent Processing (Updating); OMB Control Number 0651-0031; January 28, 2013*, Table 3.¹⁵

Clicking on the internal links for these two information collection items on [reginfo.gov](http://www.reginfo.gov) reveals tables that are supposed to disclose information concerning the

¹² All but one contemporaneous ICR submission is designated either “no material or nonsubstantive change” or “emergency extension.” The single contemporaneous ICR submission designated “revision of collection” (200407-0651-002) relates to an unrelated rulemaking.

¹³ ICR Reference No. 201301-0651-002, http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201301-0651-002.

¹⁴ http://www.reginfo.gov/public/do/PRAICList?ref_nbr=201301-0651-002. This section convincingly shows that the January 2013 ICR was highly misleading in numerous ways. The delay in issuing an approval suggests that OMB is well aware of this fact, either due to its own review or because it was revealed by public comments on the 30-day Notice. (Any such public comments are not publicly available on the [reginfo.gov](http://www.reginfo.gov) website OMB uses as its electronic docket. See http://www.reginfo.gov/public/do/PRAViewDocument?ref_nbr=201301-0651-002, which includes only public comments on the 60-day Notice.)

¹⁵

<http://www.reginfo.gov/public/do/DownloadDocument?documentID=375112&version=0>.

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nature of these new information collection burdens. These tables are reproduced below as

Table D and Table E.

Furthermore, unless and until OMB approves the pending ICR, there will be no valid OMB control number for Amendments and Responses contained in Rules 111, 115, or 116. If or when such an approval is issued, all Amendments and Responses related to Rules 111, 115, or 116 submitted by patent applicants and owners prior to the date of approval will have been unapproved collections of information.

These tables confirm that OMB had never previously approved these information collection items; the numbers of previously approved responses and burden-hours are reported as zeroes. This is consistent with the analysis reported above, showing that the USPTO had not previously sought OMB approval for Amendments and Responses related to Rules 111, 115, or 116.

However, these tables also state that the new burdens associated with Amendments and Responses are attributable to a “program change due to administrative discretion.” To understand how this could be so, one must review the explanation in the Supporting Statement. But the explanation in the Supporting Statement includes two demonstrably false claims.

1. Rule 111, 115, and 116 Amendments and Responses Are Not “Program Changes,” as the Supporting Statement Claims

On page 28 of the Supporting Statement, the USPTO claims that Amendments and Responses contained in Rules 111, 115, and 116 are program changes due to the exercise of administrative discretion (boldface in the original):

Program Changes:

...

- The USPTO is separately accounting for the requirement Amendments and Responses that was separated out from the Transmittal Form. The USPTO estimates that it will take 8 hours to complete this item and it will receive 960,000 responses per year. **Therefore, this submission takes a burden increase of 7,680,000 hours as a program change.**

The assertion that Amendments and Responses contained in Rules 111, 115, and 116 are merely “program changes” is not corroborated anywhere in the Supporting Statement. Further, a “program change” of this magnitude would have

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been part of a major rulemaking, and there has not been *any* relevant rulemaking for several years.

2. Rule 111, 115, and 116 Amendments and Responses Are Not a Subset of Transmittal Forms, as the Supporting Statement Claims

On page 22 of the Supporting Statement, the USPTO claims that Amendments and Responses previously were a subset of another IC—the Transmittal Form (italics in the original):

1 One requirement has been separated into two items

Two items being separately accounted for in this collection are (i) Rule 1.130, 1.131, and 1.132 Affidavits or Declarations; and (ii) Amendments and Responses. (p. 22.)

and at page 28:

Program Changes:

...

- The USPTO is separately accounting for the requirement Amendments and Responses that was **separated out from the Transmittal Form**. The USPTO estimates that it will take 8 hours to complete this item and it will receive 960,000 responses per year. Therefore, this submission takes a burden increase of 7,680,000 hours as a program change.

These statements are false.

Rule 111, 115, and 116 Amendments and Responses, estimated by the USPTO to entail 960,000 responses and 7,680,000 burden-hours per year, cannot have been “separated out from the Transmittal Form.” The subset is about four times larger than its alleged superset. Similarly, each Transmittal Form is estimated by the USPTO to require on average two hours to prepare, but the USPTO estimates that each Amendment or Response takes an average of eight hours to prepare. It is impossible to “separate out” an 8-hour task from a 2-hour task.

Further proof that the explanation in the Supporting Statement is false can be gleaned from comparing the burden estimates for Transmittal Forms in the January 2013 Supporting Statement and its most recent predecessor, dated April 2008. This comparison is provided in

Table F. Notice that burden-hours per response are unchanged, and that the estimates differ only because USPTO’s projection of the number of Transmittal Forms expected to be submitted per year increased by 61,500 (5.9%).

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Does the U.S. Patent and Trademark Office Have Valid OMB Control Numbers for the Information Collection Requirements in Rules 111, 115, and 116?

D. The Information Collection Items Described by the USPTO as “Amendments and Responses” in the January 2013 ICR Are Unapproved Collections of Information

The USPTO’s characterizations of paperwork burdens related to “Amendments and Responses” in the January 2013 Supporting Statement are incorrect and deceptive. The most recent regulatory actions taken by the USPTO that include information collection requirements contained to Rules 111, 115, or 116 occurred in 2004 and 2005. The USPTO did not seek approval of the incremental burdens associated with these rulemakings. There appears to be no evidence that the USPTO has ever sought OMB approval of information collection requirements contained in these Rules. The numbers of respondents, burden-hours, and non-burden hour costs in

Table D and Table E belong in the column labeled “Change Due to Potential Violation of the PRA.” The adjective “Potential” is superfluous.

Table D: IC Detail for Amendments and Responses in ICR Reference No. 201301-0651-002 (January 28, 2013)¹⁶

	Requested	Program Change Due to New Statute	Program Change Due to Agency Discretion	Change Due to Adjustment in Agency Estimate	Change Due to Potential Violation of the PRA	Previously Approved
Annual Number of Responses for this IC	67,000	0	67,000	0	0	0
Annual IC Time Burden (Hours)	536,000	0	536,000	0	0	0
Annual IC Cost Burden (Dollars)	87,100	0	87,100	0	0	0

¹⁶ http://www.reginfo.gov/public/do/PRAViewIC?ref_nbr=201301-0651-002&icID=205524.

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Does the U.S. Patent and Trademark Office Have Valid OMB Control Numbers for the Information Collection Requirements in Rules 111, 115, and 116?

Table E: IC Detail for Electronic Amendments and Responses in ICR Reference No. 201301-0651-002 (January 28, 2013)¹⁷

	Requested	Program Change Due to New Statute	Program Change Due to Agency Discretion	Change Due to Adjustment in Agency Estimate	Change Due to Potential Violation of the PRA	Previously Approved
Annual Number of Responses for this IC	893,000	0	893,000	0	0	0
Annual IC Time Burden (Hours)	7,144,000	0	7,144,000	0	0	0
Annual IC Cost Burden (Dollars)	0	0	0	0	0	0

Table F: Comparative Burden Estimates for the Transmittal Form, April 2008 vs. January 2013

ICR Estimates	April 2008 Supporting Statement*	January 2013 Supporting Statement**
Responses/Year	1,038,500	1,100,000
Burden-hours/Response	2	2
Burden-hours/Year	2,079,000	2,200,000
<p>* U.S. Patent and Trademark Office, <i>SF-83 Supporting Statement; Patent Processing (Updating); OMB Control Number 0651-0031; April 24, 2008, Table 3.</i> ** U.S. Patent and Trademark Office. 2013. <i>Supporting Statement; Patent Processing (Updating); OMB Control Number 0651-0031; January 28, 2013, Table 3.</i></p>		

¹⁷ http://www.reginfo.gov/public/do/PRAViewIC?ref_nbr=201301-0651-002&icID=205523.

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Does the U.S. Patent and Trademark Office Have Valid OMB Control Numbers for the Information Collection Requirements in Rules 111, 115, and 116?

Furthermore, unless and until OMB approves the pending ICR, there will be no valid OMB control number for Amendments and Responses contained in Rules 111, 115, or 116. If or when such an approval is issued, all Amendments and Responses related to Rules 111, 115, or 116 submitted by patent applicants and owners prior to the date of approval will have been unapproved collections of information.

III. Specific Requests for Formal OMB Opinions that Affected Applicants Might Make

Based on the analysis provided here, and pursuant to 44 U.S.C. § 3517(b), affected persons can request that OMB make the following three determinations:

1. Persons who otherwise would have been covered by Rule 111 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.
2. Persons who otherwise would have been covered by Rule 115 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.
3. Persons who otherwise would have been covered by Rule 116 are not required to have maintained, provided, or disclosed the collections of information contained therein at any time since January 1, 1994 [or other date] because there was no valid OMB control number.

In accordance with 44 U.S.C. § 3517(b), affected persons making such a request should ask OMB to respond within 60 days. If OMB believes that the answers to any of these questions is negative, they should ask that OMB include in its response the specific ICR Reference Number(s) through which OMB approval was granted, along with copies of (or URLs linking to) the relevant 60- and 30-day Notices, ICR submissions, Notices of OMB Action, and Supporting Statements showing where Rules 111, 115, or 116 collections of information are explicitly identified as having been approved.