



UNITED STATES PATENT AND TRADEMARK OFFICE

APR 20 2004

GENERAL COUNSEL

Mr. Robert J. Yarbrough
201 N. Jackson St.
Media, PA 19063

Re: Freedom of Information Act (FOIA) Request No. 04-123

Dear Mr. Yarbrough:

The Office of the General Counsel has received your e-mail dated March 23, 2004, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of: “[PTO] memoranda [submitted] to the SBA for each of the four rulemakings in question supporting the PTO’s conclusion of no significant effect on small business.”

The United States Patent and Trademark Office has identified seven pages of documents that are responsive to your request. A copy of this material is enclosed.

The processing fee has been waived. See 37 C.F.R. § 102.11(d)(4).

Sincerely,

A handwritten signature in black ink, appearing to read "Robert Fawcett".

Robert Fawcett
Paralegal Specialist


Enclosure



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

MEMORANDUM FOR: Thomas M. Sullivan
Chief Counsel for Advocacy
Small Business Administration

FROM: Bernard J. Knight, Jr. 
Deputy General Counsel for General Law

SUBJECT: Certification Under Section 605(b) of the
Regulatory Flexibility Act

The United States Patent and Trademark Office (USPTO) is proposing to amend its rules of practice before the Board of Patent Appeals and Interferences to consolidate and simplify such rules and to reflect developments in case law, legislation, and administrative practice.

The provisions of the Regulatory Flexibility Act relating to the preparation of an initial Regulatory Flexibility Act analysis do not apply to this rulemaking because the proposed rules will not have a significant economic impact on a substantial number of small entities. Almost all of the proposed rules are procedural and thus exempt from the rule making requirements of section 553 of the Administrative Procedure Act. The exception, proposed 37 C.F.R. § 41.203(a), recodifies existing practice relating to how the Director of the USPTO exercises discretion in declaring patent interferences. At present, fewer than 150 patent interferences are declared annually. The recodification of the standard for declaring a patent interference should not affect either the number of patent interferences declared nor the cost associated with patent interferences.

Accordingly, I certify under the provisions of section 605(b) of the Regulatory Flexibility Act that this proposed rule making will not have a significant economic impact on a substantial number of small entities.

Attachment

MEMORANDUM FOR: Thomas M. Sullivan
Chief Counsel for Advocacy
Small Business Administration

FROM: Bernard J. Knight, Jr. *BJK*
Deputy General Counsel for General Law

SUBJECT: Certification Under 605(b) of the
Regulatory Flexibility Act

The United States Patent and Trademark Office (USPTO) is amending its rules in 37 CFR Part 11, Changes to Representation of Others Before The United States Patent and Trademark Office. (RIN: 0651-AB55).

The provisions of the Regulatory Flexibility Act relating to the preparation of an initial flexibility analysis are not applicable to this rulemaking because the rules will not have a significant economic impact on substantial number of small entities. The primary purpose of the rule is to codify enrollment procedures and bring the USPTO's disciplinary rules for practitioners into line with the American Bar Association Model Rules, which have been adopted by most states. This will ease both the procedures for processing registration applications and practitioners' burden in learning and complying with USPTO regulations.

The rule establishes a new annual registration fee of \$100 per year for practitioners. The average salary of a practitioner is over \$100,000, and an annual fee of less than one tenth of one percent of that amount will not have a significant economic impact on a substantial number of practitioners. The rule also establishes a fee of \$130 for petitions to the Director of the Office of Enrollment and Discipline. As with the annual fee, this fee is insignificant.

Further, the rule requires registered practitioners to complete a computer-based continuing legal education (CLE) program once every one to three years. The program, which will consist primarily of a review of recent changes to patent statutes, regulations and policies, will take one to two hours to complete. This dedication of a small amount of time to CLE every one to three years will not have a significant impact on practitioners. Further, the CLE will substitute for or reinforce practitioners' independent efforts to keep their knowledge of relevant provisions current and avoid time-consuming and costly errors.


The rule imposes a \$1600 fee for a petition for reinstatement for a suspended or excluded practitioner and removes the \$1500 cap on disciplinary proceeding costs that can be assessed against such a practitioner as a condition of reinstatement. Approximately 5 of the 28,000 practitioners petition for reinstatement each year, and approximately 2 of these petitions occur under circumstances where disciplinary proceeding costs may be assessed. These changes therefore will not affect a substantial number of practitioners.

Accordingly, I certify under the provisions of the Regulatory Flexibility Act, 5 U.S.C. § 605(b) that this rulemaking will not have a significant economic impact on a substantial number of small entities.

Attachment

AUG 29 2003

MEMORANDUM FOR: Thomas M. Sullivan
Chief Counsel for Advocacy
Small Business Administration

FROM: Bernard J. Knight, Jr. 
Deputy General Counsel for General Law

SUBJECT: Certification Under 605(b) of the
Regulatory Flexibility Act

The United States Patent and Trademark Office (USPTO) is amending its rules in 37 CFR Parts 1 and 5, January 2004 Changes to the Rules of Practice to Support Implementation of the 21st Century Strategic Plan (RIN: 0651-AB64).

The 21st Century Strategic Plan seeks to transform the USPTO into a quality-focused, highly productive, responsive organization supporting a market-drive intellectual property system.

The provisions of the Regulatory Flexibility Act relating to the preparation of a flexibility analysis are not applicable to this rulemaking because the rule will not have a significant economic impact on a substantial number of small entities. The primary impact of the changes proposed in this rule are to: (1) permit electronic signatures on a number of electronically-filed documents; (2) streamline the requirements for incorporation by reference of prior-filed applications; and (3) clarify the qualifications for claiming small entity status for purposes of paying reduced patent fees. With regard to (1) and (2), these changes to the rules of practice (if adopted) will simplify the patent application process, and as such, will benefit all patent applicants (including small entities). With regard to (3), the proposed rule will merely revise the regulations to make the qualifications for claiming small entity status consistent with current practice. This clarification simply provides additional guidance to small entities.

In addition, the rule proposes to adjust certain petition fees to be in alignment with the actual average costs of deciding patent petitions. Approximately 7,500 petitions per year would be affected by this proposed patent fee change. This represents an impact on fewer than 2% of patent applications (over 400,000 patent applications were filed in fiscal year 2002).

Accordingly, I certify under the provisions of the Regulatory Flexibility Act, 5 U.S.C. § 605(b) that this rulemaking will not have a significant economic impact on a substantial number of small entities.

Attachment




UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

MAR 26 2004

MEMORANDUM FOR: Thomas M. Sullivan
Chief Counsel for Advocacy
Small Business Administration

FROM: Bernard J. Knight, Jr. 
Deputy General Counsel for General Law

SUBJECT: Certification Under 605(b) of the
Regulatory Flexibility Act

The United States Patent and Trademark Office (USPTO) is amending its rules under 35 U.S.C. §154(b), Revision of Patent Term Extension and Patent Term Adjustment Provisions (RIN: 0651-AB71).

In the notice of proposed rulemaking, the USPTO certified that an initial Regulatory Flexibility Act analysis was not required. No comments were received which referenced any impact of the changes on small entities or which altered the USPTO's assessment that a Regulatory Flexibility Act analysis is not required.

37 C.F.R. §1.703 amends a provision to be consistent with 35 U.S.C. §154(b)(2)(A). 37 C.F.R. §1.704 clarifies that the 30 day time period runs from the first citation of information by a foreign patent office, and that a subsequent citation of the same information by another foreign patent office would not start a new 30 day period. 37 C.F.R. §1.705 concerns the procedure for requesting reconsideration of the patent term adjustment determination printed on the patent.

This rule also changes the manner in which the USPTO calculates patent term extension and patent term adjustment determinations in certain situations, and revises the time period (from 30 days to two months) for requesting reconsideration of the patent term adjustment determination printed on the patent. Specifically, the changes in 37 C.F.R. §1.701 and §1.702 set forth the circumstances under which the USPTO will consider a remand by the Board of Patent Appeals and Interferences to be a decision in the review reversing an adverse determination of patentability for purposes of patent term extension and patent term adjustment.

Of the 3,843 decisions in *ex parte* appeals in Fiscal Year 2003, 454 of these decisions remanded the application without affirming or reversing any of the rejections on appeal. Based upon the current small entity filing rate (approximately 25%), the USPTO

estimates that approximately 114 small entities applicants may be affected by the change to §1.701 and §1.702. Because the USPTO received over 350,000 nonprovisional applications in Fiscal Year 2003, the change to §1.701 and §1.702 in this final rule would impact relatively few (less than 0.1%) patent applicants. As such, this rule does not affect a substantial number of small entities.

The changes in this rule would impose no additional fees or requirements on patent applicants. Thus, there is no significant economic impact on small entities.

Accordingly, I certify under the provisions of the Regulatory Flexibility Act, 5 U.S.C. §605(b), that this rulemaking will not have a significant economic impact on a substantial number of small entities.

Attachment