

EXHIBIT K



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE CHIEF INFORMATION OFFICER

December 22, 2005

Memorandum

To: David Rostker, Desk Officer
Office of Information and Regulatory Affairs
Office of Management and Budget

From: Susan K. Brown, Records Officer *SKB*
Office of Data Architecture and Services
Data Administration Division

Subject: Submission of a proposed addition of a currently approved collection

We are submitting information collection package 0651-0031 Patent Processing (Updating), for OMB's consideration in accordance with your guidelines for revisions of existing information collections. This package is being submitted in support of a notice of proposed rulemaking, "Changes to Practice for the Examination of Claims in Patent Applications" (RIN 0651-AB94) and a notice of proposed rulemaking "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims" (RIN 0651-AB93), which will be forwarded to the *Federal Register* for publication.

ABSTRACT

This information is required by 35 U.S.C. § 101 et seq. and administered by the United States Patent and Trademark Office (USPTO) through various sections of the rules of practice in 37 CFR Part 1. The changes being proposed by the USPTO will allow the USPTO to apply the patent examining resources currently absorbed by applications containing an excessive number of claims and multiple continuing applications and requests for continued examination that simply recycle earlier applications to the examination of new applications and thus allow the USPTO to reduce the backlog of unexamined applications. The changes being proposed will mean faster, more efficient examination for the typical applicant without any additional work on the applicant's part, but a small minority of applicants who consume a disproportionate share of USPTO resources will be required to share the burden they place on the agency.

Thank you for your ongoing support.

Attachment

DATES: January 19, 2006.

Time: 8 a.m. Central Standard Time.

ADDRESSES: New Orleans Marriott, 555 Canal Street, New Orleans, Louisiana, 70130. This program will be physically accessible to people with disabilities. Requests for sign language interpretation or other auxiliary aids should be submitted no later than November 25, 2005, to J. Marc Chittum, U.S. Travel and Tourism Advisory Board, Room 4043, 1401 Constitution Avenue, NW., Washington, DC 20230, telephone (202) 482-4501, or e-mail Marc.Chittum@mail.doc.gov. Seating is limited and will be on a first come, first served basis.

FOR FURTHER INFORMATION CONTACT:

J. Marc Chittum, U.S. Travel and Tourism Advisory Board, Room 4043, 1401 Constitution Avenue, NW., Washington, DC 20230, telephone 202-482-4501, or e-mail Marc.Chittum@mail.doc.gov.

Dated: December 22, 2005.

J. Marc Chittum,

Designated Federal Officer, U.S. Travel and Tourism Advisory Board.

[FR Doc. 05-24594 Filed 12-28-05; 8:45 am]

BILLING CODE 3510-DR-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

**Submission for OMB Review;
Comment Request**

The United States Patent and Trademark Office (USPTO) has submitted to the Office of Management and Budget (OMB) for clearance the following proposal for collection of information under the provisions of the Paperwork Reduction Act (44 U.S.C. Chapter 35).

Agency: United States Patent and Trademark Office (USPTO).

Title: Patent Processing (Updating).

Form Number(s): PTO/SB/08, PTO/SB/171, PTO/SB/17P, PTO/SB/21-27, PTO/SB/24B, PTO/SB/30-32, PTO/SB/35-39, PTO/SB/42-43, PTO/SB/61-64, PTO/SB/64a, PTO/SB/67-68, PTO/SB/91-92, PTO/SB/96-97, PTO-2053-A/B, PTO-2054-A/B, PTO-2055-A/B, PTOL/413A.

Agency Approval Number: 0651-0031.

Type of Request: Revision of a currently approved collection.

Burden: 2,807,641 hours.

Number of Respondents: 2,317,539 responses.

Avg. Hours per Response: 1 minute 48 seconds to 12 hours. The USPTO estimates that it will take 12 hours to complete the examination support

document covering the independent claims and the designated dependent claims; 2 hours to complete the petition (filed in a continuation or continuation-in-part application) containing a showing as to why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the prior-filed application; 2 hours to complete the petition (filed with a request for continued examination) with a showing as to why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application; and 1 hour to complete the explanation (filed in a nonprovisional application) of either how the claims are patentably distinct or why there are patentably indistinct claims filed in multiple applications. This includes time to gather the necessary information, create the documents, and submit the completed request.

Needs and Uses: The proposed examination support document covering the independent claims and designated dependent claims will assist the applicant in preparing a schedule of claims that are patentable (i.e., novel and non-obvious) over the prior art, and will assist the USPTO in the examination process in determining whether the claims are patentable over the prior art. The proposed petition for a continuation or continuation-in-part application showing why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application will assist the USPTO in determining whether the continuation or continuation-in-part application or request for continued examination is a bona fide attempt to advance the application to final agency action or is simply being filed to delay examination. The proposed explanation in nonprovisional applications, when multiple applications having a common inventor and a common assignee have been filed on the same day, of either how the claims are patentably distinct or why there are patentably indistinct claims filed in multiple applications, will assist the USPTO in determining whether double patenting exists and whether the USPTO should merge the applications. The USPTO is submitting this collection in support of a notice of proposed rulemaking entitled "Changes to Practice for the Examination of Claims in Patent Applications" (RIN 0651-AB94); and a notice of proposed rulemaking entitled "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing

Patentably Indistinct Claims" (RIN 0651-AB93). There are no forms associated with this final rulemaking.

Affected Public: Individuals or households; business or other for-profit; not-for-profit institutions; farms, the Federal Government, and State, Local or Tribal Governments.

Frequency: On occasion.

Respondent's Obligation: Required to obtain or retain benefits.

OMB Desk Officer: David Rostker, (202) 395-3897.

Copies of the above information collection proposal can be obtained by any of the following methods:

• *E-mail:* Susan.Brown@uspto.gov.

Include "0651-0031 copy request" in the subject line of the message.

• *Fax:* 571-273-0112, marked to the attention of Susan Brown.

• *Mail:* Susan K. Brown, Records Officer, Office of the Chief Information Officer, Office of Data Architecture and Services, Data Administration Division, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Written comments and recommendations for the proposed information collection should be sent on or before January 30, 2006, to David Rostker, OMB Desk Officer, Room 10202, New Executive Office Building, 725 17th Street, NW., Washington, DC 20503.

Dated: December 22, 2005.

Susan K. Brown,

Records Officer, USPTO, Office of Data Architecture and Services, Data Administration Division.

[FR Doc. E5-8018 Filed 12-28-05; 8:45 am]

BILLING CODE 3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

**Submission for OMB Review;
Comment Request**

The United States Patent and Trademark Office (USPTO) has submitted to the Office of Management and Budget (OMB) for clearance the following proposal for collection of information under the provisions of the Paperwork Reduction Act (44 U.S.C. Chapter 35).

Agency: United States Patent and Trademark Office (USPTO).

Title: Patent and Trademark Financial Transactions (formerly Payment of Patent and Trademark Office Fees by Credit Card).

Form Number(s): PTO-2038, PTO-2231, PTO-2232, PTO-2233, PTO-2234, PTO-2236.

Agency Approval Number: 0651-0043.

**SF-83 SUPPORTING STATEMENT
PAPERWORK REDUCTION ACT – OMB CONTROL NUMBER 0651-0031
Proposed addition to
PATENT PROCESSING (Updating)**

A. JUSTIFICATION

1. Necessity of Information Collection

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. § 101 et seq. to examine an application for patent and, when appropriate, issue a patent. Also, the USPTO is required to publish patent applications, with certain exceptions, promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under Title 35, United States Code (“eighteen-month publication”). Certain situations may arise that require additional information to be supplied in order for the USPTO to further process the patent or application. The USPTO administers the statutes through various sections of the rules of practice in 37 CFR Part 1.

The USPTO will be forwarding a notice of proposed rulemaking entitled “Changes to Practice for the Examination of Claims in Patent Applications” (RIN 0651-AB94) (Attachment A), and a notice of proposed rulemaking entitled “Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims” (RIN 0651-AB93) (Attachment B) to the Federal Register. In support of these proposed rulemakings, the USPTO is submitting this information collection to introduce the following new information requirements:

Under the patent statute (35 U.S.C. § 112, ¶ 1), a nonprovisional patent application must include a specification containing a written description of the invention and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and setting forth the best mode contemplated by the inventor of carrying out the invention. The specification must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention (35 U.S.C. § 112, ¶ 2). A claim may be written in independent (does not refer to any other claim) or dependent form (refers back to and further limits a previous claim) (35 U.S.C. § 112, ¶ 3). The patent statute (35 U.S.C. § 131) further provides that the Director of the USPTO shall cause an examination to be made of the nonprovisional application and the invention as defined in the claims; and if, on such examination, it appears that the application is entitled to a patent under the law, the Director shall issue a patent. Part of the examination process involves determining whether the invention, as defined by the claims, is novel and non-obvious over the prior art, as is required by the patent statute

for an applicant to be entitled to a patent (35 U.S.C. §§ 102 and 103). Copies of the relevant provisions of the patent code are included as Attachment C.

The patent statute and rules of practice do not limit the number of claims (independent or dependent) that may be presented in an application. A small but significant minority (about two percent) of patent applications contain an excessive number of claims. These applications absorb an inordinate amount of patent examining resources, as they are extremely difficult to properly process and examine. The extra time and effort spent on these applications has a negative ripple effect, resulting in delays in the processing and examination of all applications, which, in turn, results in an increase in pendency for all applications.

With respect to examination of claims in patent applications, the USPTO is proposing to require that applications containing ten or more independent claims, and applications in which the number of independent claims plus the number of dependent claims designated for initial examination is greater than ten, include an examination support document covering the independent claims and the designated dependent claims.

Under the statute (35 U.S.C. §§ 111(a), 120, 365(c)), an applicant may file a nonprovisional application (filed under 35 U.S.C. § 111(a)) and claim the benefit of a prior-filed nonprovisional application (under 35 U.S.C. § 120) or claim the benefit of a prior-filed international application (under 35 U.S.C. § 365(c)). These applications are referred to as "continuing applications." A continuing application may be a continuation application, a divisional application, or a continuation-in-part application. Under the statute (35 U.S.C. § 132(b)), an applicant may also request continued examination of a nonprovisional application.

Continuing application practice and request for continued examination practice permit applicants to obtain further examination and advance an application to final agency action. Unfortunately, a small minority of applicants has misused these practices by filing multiple continuing applications and requests for continued examination in order to delay the conclusion of examination. This usage of continuing applications and requests for continued examination skirts the applicant's duty to make a bona fide attempt to advance the application to final agency action and has a negative impact on the ability of the USPTO to examine new and existing applications. It also negatively impacts the public by permitting applicants to keep applications in pending status while awaiting developments in similar or parallel technology and then later amending the pending application to cover the developments to the detriment of the public.

With respect to continuing application practice and request for continued examination practice, the USPTO is proposing to revise the rules of practice to require that second or subsequent continuation or continuation-in-part applications and second or subsequent requests for continued examination of an application include a showing as to why the amendment, argument, or evidence presented were not previously submitted. The USPTO is also proposing to revise the rules of practice to provide that where applications have the same effective filing date, overlapping disclosure, a

common inventor, and common assignee, the applicant must provide an explanation of either how the claims are patentably distinct or why there are patentably indistinct claims filed in multiple applications.

The changes being proposed by the USPTO will allow the USPTO to apply the patent examining resources currently absorbed by applications containing an excessive number of claims and multiple continuing applications and requests for continued examination that simply recycle earlier applications to the examination of new applications, and thus allow the USPTO to reduce the backlog of unexamined applications. The changes being proposed will mean faster, more efficient examination for the typical applicant without any additional work on the applicant's part, but a small minority of applicants who consume a disproportionate share of USPTO resources will be required to share the burden they place on the agency.

Table 1 identifies the proposed statutory and regulatory provisions that require the USPTO to collect this information:

Table 1: Information Requirements for Changes to Practice for the Examination of Claims in Patent Applications, and for Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims

Requirement	Statute	Rule
Examination support document filed in certain nonprovisional applications covering the independent claims and the designated dependent claims	35 U.S.C. §§ 2(b) and 131	37 CFR 1.75(b) (proposed)
Petition for a second continuation or continuation-in-part application showing why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the prior-filed application	35 U.S.C. § 2(b)	37 CFR 1.78(d)(1)(iv) (proposed)
Petition for a second request for continued examination showing why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application	35 U.S.C. §§ 2(b) and 132(b)	37 CFR 1.114(f) (proposed)
Explanations filed in certain nonprovisional applications of either how the claims are patentably distinct or why there are patentably indistinct claims filed in multiple applications	35 U.S.C. § 2(b)	37 CFR 1.78(f)(2) (proposed)

2. Needs and Uses

During the processing for an application for a patent, the applicant or applicant's representative may be required or desire to submit additional information to the USPTO concerning the examination of a specific application. The specific information required or which may be submitted includes: information disclosure statement and citation, examination support documents, requests for extension of time, the establishment of small entity status, abandonment and revival of abandoned applications, disclaimers, appeals, petitions, expedited examination of design applications, transmittal forms, requests to inspect, copy and access patent applications, publication requests, and