Final Rule: Power of Attorney Practice and Assignment Rules


Prepared June 3, 2004 by:
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Significant Changes Made to Certain Rules

§ 1.32 (New Rule) Power of attorney.
§ 1.33 Correspondence Address; Signature Requirements.
§ 1.34 Acting in a Representative Capacity.
§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.
§ 3.25 Recording requirements for trademark applications and registrations.
§ 3.73 Establishing right of assignee to take action
§ 3.81 Issue of patent to assignee.
Main Changes

- Power of Attorney related changes:
  - Limit of ten patent practitioners will be made of record if Customer Number practice is not used. § 1.32 (new)
  - Elimination of Associate Power of Attorney practice. § 1.34

- Assignment changes:
  - Original assignment document must not be submitted for recordation because the document submitted for recordation will no longer be returned. §§ 3.24 & 3.25
37 CFR 1.32(a) sets forth the following definitions:

- Power of attorney,
- Principal,
- Revocation, and
- Customer Number (CN)

37 CFR 1.32(b) sets forth power of attorney requirements:

- Must be in writing,
- Name one or more representatives in compliance with § 1.32(c),
- Give the representative power to act on behalf of the principal, and
- Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.
A power of attorney must name as representative either:

(1) one or more joint inventor;

(2) up to ten registered patent attorneys or registered patent agents; or

(3) those registered patent practitioners associated with a Customer Number.

A Power of Attorney cannot be to both a list of practitioners and to a Customer Number.
Power of Attorney; New 37 CFR 1.32(c)

If a power of attorney names more than ten patent practitioners:
- Power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.
- If no separate paper, no power of attorney will be entered.
- The separate paper can be signed by one of the attorneys or agents of record, by a patent attorney or agent acting in a representative capacity, the assignee, acting pursuant to 37 CFR 3.73(b) or by all of the applicants.
- The separate paper cannot request that a Customer Number be used instead, only the applicant or assignee can give power of attorney to a Customer Number.
Correspondence Address §1.33(a)

- The Office will use the address associated with a Customer Number if given, over a typed correspondence address, when more than one correspondence address is given.

- The Correspondence address given in an Application Data Sheet (§ 1.76) is given priority over any other correspondence address given.
Correspondence to the Office must be signed by:

- A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b)
- A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34
- An assignee as provided for under § 3.71(b) (unchanged)
- All of the applicants for patent (unchanged)
Paragraph (b) of § 1.34 has been deleted.

§ 1.34 is now a single paragraph (revising prior § 1.34(a)) limited to acting in a representative capacity.

A registered patent attorney or patent agent not of record but acting in a representative capacity must specify his/her:

- Registration number
- Name (new requirement)
- Signature
Acting in a Representative Capacity § 1.34

- Associate Power of Attorney practice has been eliminated (prior § 1.34(b))
  - Customer Number practice allows the list of patent practitioners associated with an application to be changed easily
  - Use **sample form** “Authorization to Act in a Representative Capacity” to expressly authorize another practitioner to conduct an interview (available at [www.uspto.gov](http://www.uspto.gov), on the forms page; [http://www.uspto.gov/web/forms/sb0084.pdf](http://www.uspto.gov/web/forms/sb0084.pdf)).
    - As many practitioners can be given an express authorization to act in a representative capacity as is necessary.

- Associate Powers of Attorney filed before the effective date of the rule change will continue to have effect.
Assignment: Only Copies Should be Submitted for Recordation

- 37 CFR 3.24 (patents) and 3.25 (trademarks) are amended to provide:
  - Only a copy of an original assignment document may be submitted for recording
  - Electronic filing of assignment documents permitted

- The Notice of Recordation returned to the applicant has been revised to reflect the title of the invention and docket number stored in the Office’s electronic records, if the notice of recordation is for a single property (application or patent)

- Assignment documents must be submitted on 8.5 x11 inch paper or DIN size A4
§ 3.81 is amended to modify the practice relating to issuance of a patent to an assignee

- after payment of an issue fee, a request for a certificate of correction must be filed in order to obtain issuance of the patent to an assignee.
- if assignment information is submitted after payment of the issue fee, the patent document will not include the assignment information.
  - assignment information will be included in a certificate of correction.

The practice of allowing a patent to issue to an assignee when an assignment has not been recorded but a statement under 37 CFR 3.73(b) has been filed is discontinued.
What is a Customer Number?

- A Customer Number is a number that may be used to:
  1. Designate the correspondence address of a patent application (the address associated with the Customer Number will be used for the correspondence address);
  2. Designate the fee address (§ 1.363) of a patent (the fee associated with the Customer Number will be used for the fee address); and
  3. Designate the power of attorney (a list of registered patent practitioners associated with the Customer Number will be recognized as having the power of attorney).
Why Use A Customer Number?

- Using a Customer Number for the Correspondence Address will allow *pro se* applicants, or an applicant’s representatives, access to private PAIR.

- The Office highly recommends that all patent practitioners and applicants have access to private PAIR.

- To learn how to obtain a customer number and access private PAIR contact the Electronic Business Center (EBC)
  - **Website:** www.uspto.gov/ebc;
  - **Toll Free:** (800)786-9199 or (703) 305-3028
  - **Fax:** (703) 308-2840
  - **E-mail:** ebc@uspto.gov
Why Use Private PAIR?

Private PAIR includes:

- **IFW Access** (added in June 2003) (Coming to public PAIR in Summer 2004)
- **View Outgoing Correspondence Notifications** (added in August 2003)
  - Display a list of patent application correspondence, by date, with links to IFW images
- **Pre-Grant Publication Review**
  - Submit request for bibliographic data changes online for Pre-Grant Publication purposes
- **Download Cited US References**
  - E-Patent Reference (added in December 2003)
- **Search applications by Customer Number or Attorney Docket Number**
- **Customer Number for Correspondence Address**
  - Submit request for CN Address or Practitioner change online (added in November 2003)
- **Examiner Name Link**
  - Examiner’s name in application display links to Employee Locator contact information
Why Use PAIR?

- In addition private PAIR includes (as does public PAIR):
  - View bibliographic data and file history
  - View continuity, foreign priority, Pre-Grant Publication numbers and dates, PTA/PTE history
  - Link to Full-Text and Images on the web for patents and published applications
  - Link to Office of Finance website for maintenance fee statements and payment information
  - Search by Class/Subclass/GAU to display associated Class/Subclass and Group Art Unit.
  - Search Employee Locator to display name, phone number and organization
Questions?
Contact Electronic Business Center (EBC)

1. Customer Number
   ✓ How to obtain a customer number?
   ✓ Which form do I use?
   ✓ How will I receive my customer number?

2. PKI Certificate
   ✓ How do I get access to private PAIR?
   ✓ How long does it take to get my codes?
   ✓ How to create or recover a profile?

3. Electronic Filing System (EFS)
   ✓ I can’t download this software from the website, how do I get this software?
   ✓ How do I resolve the errors that I get when I validate in Epave?
   ✓ I have XP, how do I do my specification if PASAT is not compatible?

   ✓ Why do I get an invalid error when I enter in my case number?
   ✓ I forgot my password, how can I gain access to PAIR?
   ✓ My company uses proxys on our server, how can I connect to PAIR?

See also PAIR Frequently Asked Questions:
Thank You

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