**From:** Sergey Vernyuk [<mailto:SV@etblaw.com>]   
**Sent:** Wednesday, December 06, 2017 5:06 PM  
**To:** Information Collection  
**Subject:** 0651-0035 comment

Dear Sir or Madam,

On October 18, 2017, the USPTO published a notice of proposed collection and comment request in the Federal Register (82 Fed. Reg. 48489).  This collection relates to Representative and Address Provisions.  I am a registered practitioner with the USPTO and regularly prosecute patent applications.  While I am affiliated with Emerson Thomson Bennett, LLC, these comments represent my personal views.

First, there appears to be a typographical error in the list of Form Numbers in §III of the Notice: PTO/SB/124 appears twice.  Also, while PTO/AIA/81 and PTO/AIA/81B are listed, PTO/AIA/81A is not; is that omission intentional?

Second, I’d like to suggest that the USPTO consider consolidating some of the power-of-attorney (POA) forms.  My suggestion focuses on forms PTO/AIA/80 (Form 80) and PTO/AIA/82 (Form 82), but perhaps other POA forms (e.g., PTO/AIA/81, 81A, 81B, 81C) could also be consolidated.  The Instructions for Form 80 (<https://www.uspto.gov/sites/default/files/forms/Oath_Decl_Form_Instructions_AIA80_19dec2012.pdf>) indicate that either Form 80 or Form 82 could be used by an assignee-applicant named as applicant when the application was filed (although the Instructions state that Form 82 is recommended).  (Comparing these two Forms, Form 80 appears to correspond to Form 82B, while a §3.73(c) statement (e.g., Form PTO/AIA/96 (Form 96)) appears to correspond to Form 82A in the information they request.)

Both Forms 80 and 82 can be used to accomplish the same objective, and they ask for mostly the same information, but not the same: Form 80 requires a §3.73(c) statement with all of its details on assignments, while Form 82B does not (Form 82A asks for only a subset of the information requested by Form 96); Form 80 requires the address of the assignee-applicant, while Form 82B does not; Form 80 requires the assignee-applicant’s telephone, while Form 82B does not.

While either Form 80 or Form 82 may be used for an assignee-applicant named as applicant when the application was filed, it appears that only Form 80 may be used when an assignee becomes an applicant mid-prosecution.  These differences unnecessarily complicate prosecution (e.g., which form can be used when, and which information is requested by one form but not the other).  I suggest creating just one POA form that can consistently be used throughout prosecution and require the same information for the same type of applicant.  Checkboxes could be used to select different options.

Consolidating the POA to just one form (whether just between Forms 80 and 82, or among all POA forms) would minimize the burden of determining the proper form to use for the same task and collecting the appropriate information (which varies per form).  Because the same action can be accomplished with different forms that ask for slightly different information (as discussed above), this shows that at least some of the collected information is not necessary for the proper performance of the USPTO.  Finally, by having just one form with consistently requested information, the collected information’s utility would be enhanced.

Third, I’d like to make a suggestion regarding correspondence addresses and Customer Numbers (both of which are discussed in the notice, 82 Fed. Reg. 48489).  37 C.F.R. §1.34 allows a practitioner to represent a client in a representative capacity without obtaining a POA, and many (including me) often take advantage of this provision.  Even though practitioners often try to get a POA, sometimes a client forgets to return one, and the practitioner can prosecute the entire application without needing one (by virtue of §1.34).

In such a case (where the practitioner is acting in a representative capacity with no POA filed), the practitioner “named in the application transmittal papers” may change the correspondence address per §1.33(a).  Frequently, patent applications are filed with no labeled “Transmittal Letter” (since such a letter is not required; in any case, the Utility Patent Application Transmittal (PTO/AIA/15) does not have a dedicated box to name multiple practitioners), in which case the only practitioner “named in the application transmittal papers” is the practitioner who signs the Application Data Sheet (ADS).  If a law firm with multiple practitioners filed such an application but did not receive an executed POA, only one practitioner (the one who filed the application originally) can change the correspondence address in such a case (unless the applicant itself changes it).  Because applications often take several years to go through prosecution, it is not uncommon for the practitioner who filed the application to no longer be associated with the prosecuting firm (which is still prosecuting that application).  In that case, it appears that no one from that firm can change the correspondence address and is at the mercy of the applicant.  The USPTO has previously recognized this problem, where practitioners acting in a representative capacity could not change the correspondence address and where the client has refused to do so despite repeated requests from the practitioner.  77 Fed. Reg. 48775, 48783.  The USPTO has provided a solution for this situation after a patent issues by virtue of §1.33(g), but the problem still remains for this situation before patent issuance.  If a law firm (with practitioners acting in a representative capacity) withdraws from representing a client (per §11.116), the only way that law firm can change the correspondence address is if the original practitioner who filed the application is still with the firm.  If not (and the client-applicant refuses to change the address itself), the firm may still have to keep forwarding all notices to the client-applicant.  See MPEP 2222.

To address this situation, I suggest the following.  Section 1.33(a) does not explain what it means by “any patent practitioner named in the application transmittal papers.”  The ADS (PTO/AIA/14) has a Correspondence Information field and a Representative Information field that can accept a Customer Number.  I suggest entry of a Customer Number in an ADS (in either above-mentioned field, or perhaps a specific one of them) submitted on filing of an application to be interpreted as “naming in the application transmittal papers” of all practitioners associated with that Customer Number, such that any such practitioner could subsequently change the correspondence address even without a POA.  I suggest applying this interpretation to other similar documents (that have a Correspondence Address or Representative Information field that accepts a Customer Number) submitted on filing of an application (e.g., Provisional Application Cover Sheet, Utility/Design/Plant/Reissue Patent Application Transmittals, etc.).

Customer Number practice was introduced, in part, to facilitate reference to multiple attorneys of the same firm, where the correspondence address or POA would not need to be immediately changed for any applications prosecuted by the firm just because a new practitioner joins or an existing one leaves the firm.  However, in the case explained above, using the Customer Number (rather than actually listing multiple practitioners) works an inconvenience (as apparently none get recognized for the purpose of allowing changing the correspondence address per §1.33(a)).  The above-proposed interpretation of “any patent practitioner named in the application transmittal papers” would not require changing any rules (it is consistent with the rules); is consistent with the purpose of, and improves the functionality of, Customer Numbers; and would reduce the burdens on existing practitioners and law firms in such situations.

If this suggestion is not adopted, I suggest at least adding another field in the ADS form specifically for individually naming patent practitioners.  While this solution would add some redundancy (which is why the previous solution is preferred), this would allow the use of a Customer Number per current usage but also allow the naming of individual practitioners, which would increase the available practitioners that could subsequently change the correspondence address even if no POA is granted and the applicant-client itself refuses to change the address.

Thank you for considering my comments.  Please contact me if I can be of any further assistance.

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