

Executive Summary of Revision of Power of Attorney and Assignment Practice
69 Fed. Reg. 29865 (May 26, 2004)

- § 1.1 Address for non-trademark correspondence with the United States Patent and Trademark Office: 1.1(a)(4) (which was added in the change of address rule package) is revised add “submitted by mail” and to delete “or under § 3.81 of this chapter.” 1.1 is also amended to remove paragraph (f), because Mail Stop Provisional Patent Application was determined to no longer be useful.
- § 1.12 Assignment records open to public inspection: The rule is revised to clarify that assignment documents are not available if the application is maintained in confidence, so that assignment documents related to applications that are not maintained in confidence (e.g., an abandoned parent of a patent) are available to the public.
- § 1.31 Applicants may be represented by a registered patent attorney or agent: The rules is amended to include the word “power of attorney” and to make other technical corrections.
- § 1.32 Power of Attorney (new): This new rule defines “power of attorney” and related phrases. A “power of attorney” as defined will also designate an agent to act for a principal. Also defines the term “Customer Number” which can be used to establish a Fee Address, a Correspondence Address, or a power of attorney to practitioners associated with the Customer Number. Paragraph (c) defines the requirements of a power of attorney, and limits the number the number of practitioners to 10 who can be individually appointed, otherwise a power of attorney to a Customer Number is required.
- § 1.33 Correspondence respecting patent applications, reexamination proceedings and other proceedings: The Office will use the customer number for a correspondence address, if both an address and a customer number are provided in the same document. Section 1.33(a) is amended to specifically provide for this default.
- § 1.34 Acting in a representative capacity: The title is revised to reflect the subject matter addressed by the rule. As revised, section 1.34 requires a patent attorney or patent agent who is acting in a representative capacity to provide his or her name and registration number, with his or her signature. 1.34(b) is deleted to eliminate associate power of attorney, which is obsolete in view of Customer Number practice.
- § 1.36 Revocation of power of attorney; withdrawal of patent attorney or patent agent: The title is revised and the rule divided into two new paragraphs, one paragraph for each subject. Paragraph (a) addresses revocation of power of attorney and clarifies that notice is given to the revoked patent attorney or patent agent, and to a Customer Number if it has been replaced by a different Customer Number, at the

correspondence address of record. Paragraph (b) addresses withdrawal and provides support in the rule for refusing a request to delete all the registered attorneys or agents associated with a Customer Number if insufficient time remains to respond to an outstanding Office action.

- § 1.53 1.53 is amended by removing paragraph (d)(9) and renumbering (d)(10) as (d)(9).
- § 1.363 Fee address for maintenance fee purposes: 1.363 is amended by adding paragraph (c) to require the use of a Customer Number when designating a fee address.
- § 3.1 Definitions: Revised to reflect a technical amendment to a definition related to Trademarks.
- § 3.21 Identification of patents and patent applications: The rule is revised to delete the phrase “its date of execution”. The date of execution of a declaration is no longer required (see MPEP § 602.05). Furthermore, the application could be executed on more than one date, and, thus, there may be no single date of execution.
- § 3.24 Requirements for documents and cover sheets relating to patents and patent applications: The rule is revised to provide that only copies of assignment documents may be submitted. The Office is moving to a process wherein all incoming papers will be scanned and electronically routed within the Office. After scanning, the Office shall store or dispose of the documents. Thus, the Office will discontinue (the current process of) returning original assignment documents to those applicants who submit their assignments by mail.
- This section is also revised to require 8½ by 11 or A4 paper. The original assignment can be on any size paper, but what is sent to the Office must be on 8½ by 11 or A4 with the correct margins (by reduction from legal to letter-sized paper, if needed).
- § 3.25 Recording Requirements for trademarks applications and registrations: The rule is revised along the same lines as § 3.24.
- § 3.27 Mailing Address for submitting documents to be recorded: The rule is revised to clarify that a mailing address is only required when the submission is by mailing. The Office prefers assignment documents to be faxed or electronically submitted, accordingly, the rule is revised remove the implication that mailing is required. Also, “or with a request under § 3.81” is deleted for the reason explained as to § 1.1.
- § 3.31 Cover Sheet Content: Section 3.31(a)(7) is revised to set forth the e-signature requirements for cover sheets that are filed electronically. A new paragraph 3.31(f) is added to require the citizenship in Trademark assignment cover sheets.

- § 3.34 Correction of Cover Sheet Errors: Section 3.34 is revised to delete “the originally recorded document or”. As explained above, the Office will be scanning and storing all incoming documents. The original document will not be available for routing to the applicant.
- § 3.41 Recording Fees: Section 3.41(b)(2) is revised to include electronic and facsimile submission as a means by which a statement of Government interest can be submitted for recording without incurring a fee. Currently the rule suggests that only mailed Government interest documents are recorded for free.
- § 3.81 Issue of Patent to Assignee: Section 3.81 is revised to require an assignment to have been recorded or submitted to be recorded before a patent can issue to an assignee. The rule is also revised to clarify that an assignment should not be submitted together with the issue fee payment and should be separately submitted to Assignments. Lastly, the rule is revised to require a request for a Certificate of Correction when a request to issue a patent to an assignee is filed after payment of the issue fee. There is no time to process these requests before a patent is issued, and they are best handled by a Certificate of Correction.
- § 5.1 Applications and correspondence involving national security: Section 5.1(a) is revised to add mail stop L&R (L&R is an abbreviation for Licensing and Review).