

of this migration, all papers received in the Office on paper will be scanned and transmitted electronically within the Office. With this new procedure, the Office will be unable to forward some paper copies of documents to one part of the Office (e.g., assignments to Assignment Services Division) and otherwise store other papers (e.g., retain the paper copies of amendments according to the retention schedule). All documents will need to be processed in the same manner; as a result, the Office cannot accept 8½ by 14-inch paper for assignment documents but only 8½ by 11-inch paper for all other correspondence.

Currently, an assignment document cannot be faxed to the Office unless the patent application number or patent number, trademark serial number or trademark registration number is provided. As a result, on filing a patent application, applicants routinely include a copy of an assignment with the original application papers. Under the proposed new practice, applicants may continue to file a copy of the assignment document with the application papers, but should not anticipate a return of the submitted copy of the assignment document; only a Notice of Recordation will be transmitted to the party requesting recordation by the Office. To assist applicants in matching the Notice of Recordation transmitted by the Office with applications known to have been filed on a certain day, the Notice of Recordation will be revised to indicate the title of invention.

Discussion of Specific Rules

Section 1.1: The Office proposes to revise § 1.1(a)(4) to delete “or under § 3.81 of this chapter.” Under the proposed rule, the Office will no longer permit the submission of an assignment document together with the issue fee payment or a request to issue a patent to an assignee. Instead, the assignment documents (with cover sheets) should be faxed to (703) 306–5995, submitted through one of the electronic filing systems, or submitted in a separate envelope and be sent to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313–1450. This will permit the assignment document to be recorded more quickly as it will be directly routed to the appropriate area of the Office for recording.

Section 1.12: The Office proposes to amend § 1.12(b) to replace “has not been published under 35 U.S.C. 122(b) are not available to the public” with “is open to the public pursuant to § 1.11 or

for which copies or access may be supplied pursuant to § 1.14 are available to the public” in order to clarify the assignment records that are available to the public. Paragraph (b) of § 1.12 is further proposed to be amended to provide that copies of any such assignment records and related information that are not available to the public shall be obtainable only upon written authority of the applicant or applicant’s assignee, patent attorney, or patent agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in part 1.

As proposed to be revised, § 1.12(b) more clearly provides, for example, for an application that is relied upon under 35 U.S.C. 120 in an application that has issued as a patent, any assignment records relating to the parent application could be considered to relate to the patent. Without the amendment to § 1.12(b), the rule suggests that the assignment records for the parent application are not available to the public. This was not the intended construction, and it is inconsistent with MPEP § 301.01. Under proposed § 1.12(b), the assignment records for the parent application of a patent, or an application that has published under 35 U.S.C. 122(b), would be open to public inspection.

Section 1.31: The Office proposes to revise the title to refer to “registered patent attorney or patent agent” and to revise § 1.31 to introduce the term “power of attorney.”

Section 1.32: The Office proposes a new § 1.32 to define “power of attorney” and “Customer Number,” among other things, and to set forth the requirements for a power of attorney. “Power of attorney” is defined in paragraph (a)(1) of § 1.32 as a written document by which a principal designates an agent to act on his or her behalf. A power of attorney includes an authorization of an agent. “Principal” is defined in paragraph (a)(2) of § 1.32 as either the applicant for patent (§ 1.41(b)) or the assignee of the entire interest, and the entity who executes a power of attorney designating one or more agents to act on his or her behalf. “Revocation” is defined in paragraph (a)(3) of § 1.32 as the cancellation by a principal of the authority previously given by the principal to an agent. “Customer Number” is defined in paragraph (a)(4) of § 1.32 to be a number that may be used to: (i) Designate the correspondence address of a patent

application such that the correspondence address for the patent application would be the address associated with the Customer Number; (ii) designate the fee address (37 CFR 1.363) of a patent by a Customer Number such that the fee address for the patent would be the address associated with the Customer Number; and (iii) specify, in a power of attorney, that each of the practitioners associated with a Customer Number have a power of attorney.

Paragraph (b) of proposed § 1.32 sets forth the requirements for a power of attorney, other than a power of attorney in an international application (see § 1.455 for the power of attorney in an international application and note that Customer Number practice cannot be used in an international application). To be valid, the power of attorney, in an application other than an international application, must: (1) Be in writing; (2) name as agent either: (i) One or more joint inventor (see § 1.45), (ii) up to ten registered patent attorneys, registered patent agents, or other individuals authorized to practice before the United States Patent and Trademark Office in patent cases (see § 10.6 and § 10.9(a) and (b) of this subchapter), or (iii) those registered patent practitioners associated with a Customer Number; (3) give the agent power to act on behalf of the principal; and (4) be executed by the principal.

The new § 1.32 is proposed to set a limit on the number of patent practitioners who can be given a power of attorney without using Customer Number practice because it is extremely burdensome for the Office to manually enter a long list of patent practitioners, particularly where the same list of patent practitioners is to be entered for a large number of applications. Applicants desiring to appoint a large number of patent practitioners may continue to do so, but to appoint more than ten, use of Customer Number practice will be required. If a power of attorney is submitted listing more than ten patent practitioners, and the rules are revised as proposed, no patent practitioners will be entered into the Office’s computer systems because the power of attorney would not comply with the rules. Furthermore, the power of attorney would not be “partially accepted” so as to only accept, for example, the first ten patent practitioners. This policy is consistent with the Office practice of not entering just a part of a paper that complies with the rules. As a result, if the power of attorney lists more than ten patent practitioners and does not give power of attorney to a Customer Number, then