

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Representative and Address Provisions
OMB CONTROL NUMBER 0651-0035
(September 2012)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0035, "Representative and Address Provisions." The USPTO is submitting seven new forms in this collection related to power of attorney and change of correspondence address:

- (1) Power of Attorney to Prosecute Applications Before the USPTO (PTO/AIA/80)
- (2) Power of Attorney to One or More of the Joint Inventors and Change of Correspondence Address (PTO/AIA/81)
- (3) Reexamination or Supplemental Examination – Patent Owner Power of Attorney or Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address for Reexamination or Supplemental Examination and Patent (PTO/AIA/81B)
- (4) Transmittal for Power of Attorney to One or More Registered Practitioners (PTO/AIA/82A)
- (5) Power of Attorney by Applicant (PTO/AIA/82B)
- (6) Change of Correspondence Address (Application) (PTO/AIA/122)
- (7) Change of Correspondence Address (Patent) (PTO/AIA/123)

Section 4 of the Leahy-Smith America Invents Act (AIA) amends 35 U.S.C. 118 to change the practice regarding the filing of an application by a person other than the inventor. First, 35 U.S.C. 118 is amended to provide that a person to whom the inventor has assigned, or is under an obligation to assign, the invention may make an application for patent. Second, 35 U.S.C. 118 is amended to provide that a person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. The changes to 35 U.S.C. 118 in the AIA are effective on September 16, 2012, but apply only to patent applications filed on or after September 16, 2012.

The changes to 35 U.S.C. 118 impact who may give a power of attorney and who may change a correspondence address. The USPTO currently provides forms (e.g., PTO/SB/80, PTO/SB/81, PTO/SB/122, PTO/SB/123) for giving a power of attorney and changing a correspondence address. For consistency with the change in practice concerning who may be an applicant for patent, the USPTO is providing new forms for giving power of attorney and changing the correspondence address.

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The changes to 35 U.S.C. 118 in the AIA do not apply to applications filed prior to September 16, 2012. Thus, the USPTO plans to provide new forms for use with applications filed on or after September 16, 2012, but still continue to make the existing power of attorney and change of correspondence address forms (legacy forms) available until applications filed prior to September 16, 2012, are no longer pending before the USPTO.

Summary of Changes

In order to accommodate the revised procedure, the following forms are added to this information collection:

- PTO/AIA/80: Power of Attorney to Prosecute Applications Before the USPTO: This form is nearly identical to the current PTO/SB/80 and may be used by an assignee to give a power of attorney to registered practitioners (either by individual name(s) or to those registered practitioners who are associated with a customer number). The reference to "3.73(b)" in PTO/SB/80 has been changed to "3.73(c)" in PTO/AIA/80 for consistency with the change to 37 CFR 3.73, and the instruction as to who may complete the accompanying statement under 37 CFR 3.73(c) has been updated in PTO/AIA/80 for consistency with newly added 37 CFR 3.73(d).
- PTO/AIA/81: Power of Attorney to One or More of the Joint Inventors and Change of Correspondence Address: This form is similar to the current PTO/SB/81, except that it is specifically designed to (i) be filed by *pro se* inventors (*i.e.*, prosecuting the application without a registered patent practitioner) who are identified as the applicant in the corresponding application and (ii) give power to one or more of the joint inventors.
- PTO/AIA/81B: Reexamination or Supplemental Examination – Patent Owner Power of Attorney or Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address for Reexamination or Supplemental Examination and Patent: This form is similar to the current PTO/SB/81B, except that it may be used for either a reexamination or supplemental examination proceeding.
- PTO/AIA/82A and B: Transmittal for Power of Attorney to One or More Registered Practitioners/Power of Attorney by Applicant: Taken together, new forms PTO/AIA/82A and B are similar to the current PTO/SB/81, except that they are specifically designed to (i) be filed by the applicant for patent, taking into account the changes in practice concerning who the applicant for patent may be, and (ii) give power to one or more registered practitioners.
- PTO/AIA/122: Change of Correspondence Address (Application): This form is nearly identical to the current PTO/SB/122. The instruction as to who may complete and sign the PTO/AIA/122 has been updated for consistency with the changes to 37 CFR 1.33.

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- PTO/AIA/123: Change of Correspondence Address (Patent): This form is nearly identical to the current PTO/SB/123. The instruction as to who may complete and sign the PTO/AIA/123 has been updated for consistency with the changes to 37 CFR 1.33.

Changes in Burden

The proposed addition of these seven forms will not result in a substantive change in the burden for this collection. The seven new forms proposed to be added to this collection require only information that is currently collected via this collection (e.g., via forms PTO/SB/80, PTO/SB/81, PTO/SB/122, PTO/SB/123).