

USPTO Discontinuing Use of PTO/SB/84 Form (Authorization to Act in a Representative Capacity in Patent Cases)

Summary

The United States Patent and Trademark Office (USPTO) provides standardized forms for use by patent applicants. As rules and practices change, a standardized form may be infrequently used or become obsolete. The USPTO is hereby providing notice that the PTO/SB/84 form, “Authorization to Act in a Representative Capacity,” is being discontinued effective as of the publication date of this notice. This change does not limit the ability of patent practitioners to act in a representative capacity pursuant to 37 CFR 1.34.

Background

Acting in a representative capacity in accordance with 37 CFR 1.34 allows a patent practitioner to file a paper in a patent application file so long as the practitioner is authorized by the applicant or patent owner to act on their behalf, and so long as the practitioner sets forth their registration number, name, and signature. As explained in the Manual of Patent Examining Procedure (MPEP) 402.04, this practice facilitates the filing of replies on behalf of parties by registered practitioners and obviates the need for filing a power of attorney in many instances. Acting in a representative capacity does not establish an ongoing representative status in patent matters. Change in Procedure for Requests to Withdraw from Representation in a Patent Application, 1329 OG 99 (April 8, 2008).

A practitioner may also conduct an interview or present oral arguments in an appeal proceeding while acting in a representative capacity. A registered practitioner acting in a representative capacity can establish the authorization to conduct the interview by filing an “Applicant Initiated Interview Request” form (PTOL-413A), as discussed in MPEP 713.05, or by using the “Automated Interview Request” (AIR) form. A registered practitioner acting in a representative capacity can also establish authorization to present oral arguments by filing a “Request for Oral Hearing Before the Patent Trial and Appeal Board” form (PTO/AIA/32). Filing a PTOL-413A form, AIR form, or PTO/AIA/32 form indicates the practitioner’s authorization to act in a representative capacity for purposes of the interview or the oral hearing, respectively, and eliminates the need to file a power of attorney. The AIR form is currently available at www.uspto.gov/InterviewPractice. The PTOL-413A and PTO/AIA/32 forms are currently available at www.uspto.gov/patents/apply/forms.

As discussed in MPEP 713.05, the PTO/SB/84 form has been available for use in establishing the authorization to conduct an interview, as an alternative to the PTOL-413A form and the AIR form. The PTO/SB/84 form has also been used to establish the authority to present oral arguments in appeal proceedings, as an alternative to the PTO/AIA/32 form. Patent Trial and Appeal Board, Oral Hearing Guide (August 2023).

It has come to the attention of the USPTO that the PTO/SB/84 form is used infrequently and is redundant with the PTOL-413A form and the AIR form for purposes of establishing the authorization to conduct an interview. It is also redundant with the PTO/AIA/32 form for purposes of establishing the authority to present oral arguments in an appeal proceeding. In addition, it may be causing some confusion regarding whether the effect of the form is different than that of other forms.

Process Change

The PTO/SB/84 form is being discontinued as of the publication date of this notice and will no longer be available as a standardized form. For any application in which a PTO/SB/84 form is in the application file, there will be no change in authorization, status, or the like. Because the USPTO does not recognize and has not recognized an ongoing representative capacity status, as discussed above, the discontinuation of the PTO/SB/84 form will have no effect on any patent or patent application.

Patent practitioners may continue to act in a representative capacity in accordance with 37 CFR 1.34, and may continue to use the PTOL-413A form or the AIR form to establish the authorization to conduct an interview when acting in a representative capacity. To request an oral hearing before the Patent Trial and Appeal Board, the PTO/AIA/32 form may be used. To request access to the USPTO file of an unpublished application in accordance with 37 CFR 1.14(c), a PTO/AIA/67 form may be used.

If a PTO/SB/84 form is filed in an application subsequent to the publication date of this notice, USPTO personnel will treat it as having no effect. The form is not on its face a request, is not an indication of representative capacity with respect to any other filing or activity, and therefore does not require a response.

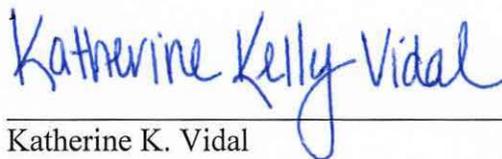
Important Reminders

A practitioner acting in a representative capacity in a pending application must have the authority to act from the applicant. Acting in a representative capacity under 37 CFR 1.34 is not a means of prosecuting a patent application on behalf of fewer than all the applicants. MPEP 402.04. Submissions or protests by a third party in a pending application must be compliant with 37 CFR 1.290 or 1.291, respectively. The USPTO may refer third-party filings or actions that are not specifically permitted by the rules of practice in patent matters to the Office of Enrollment and Discipline for appropriate action. MPEP 1134.

Contact Information

Any inquiry regarding this notice may be directed to Andrew St.Clair, Legal Advisor, Office of Patent Legal Administration, Office of the Commissioner for Patents, at 571-270-0238 or PatentPractice@uspto.gov.

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Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office