

Change in Procedure for Requests to Withdraw from Representation In a Patent Application

Summary: The U.S. Patent and Trademark Office (Office) is revising its procedures for handling requests to withdraw from representation by a practitioner of record in a patent application. This notice also clarifies how requests to withdraw from representation by a practitioner who is not of record, but who has acted in a representative capacity under 37 CFR 1.34, are handled by the Office. Under the revised procedure, the Office will no longer require that there be at least 30 days between approval of the request to withdraw as a practitioner of record (Request) in a patent application and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). Instead, pursuant to 37 CFR 10.40, the Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond. The *Request for Withdrawal As Attorney or Agent and Change of Correspondence Address* (Form PTO/SB/83) will be changed to provide a section wherein practitioners may certify the completion of the above-listed activities necessary for the request to withdraw from representation to be granted. This deviates from the practice currently set forth in the Manual of Patent Examining Procedure (MPEP) 402.06, which will be amended to reflect this change.

Provided the Request is filed prior to the expiration of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a), the Office will review the Request and render a decision. However, any Request that is filed after an application is abandoned or after a patent has issued will be placed in the application but generally will not be treated on the merits.

The Office will also no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Form PTO/SB/83 will be modified to indicate that the Office will only accept changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71 or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. This change has been made in order to avoid subsequent correspondence being directed to an incorrect address or to a practitioner who has not been appointed as practitioner of record by the applicant.

Effective Date: The change in practice in this notice applies to Requests filed on or after May 12, 2008.

Background: In 2006, the Office of Petitions began to process the majority of the Requests to withdraw as a practitioner of record in a patent application. In an effort to

promote consistency and efficiency within the Office, the Office has changed the procedures in handling the Requests.

A practitioner is permitted to withdraw from representation as the practitioner of record upon approval by the Director as set forth in 37 CFR 1.36(b). Under the previous procedure, the practitioner(s) should have provided reasons for the withdrawal and a new correspondence address to send subsequent correspondence in order for the Request to be approved. The practitioner(s) requesting withdrawal should have also been given power of attorney in the application or there must have been some indication that the practitioner was acting in a representative capacity under 37 CFR 1.34. Unless there was at least thirty (30) days between approval of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which could be obtained by a petition and fee for extension of time under 37 CFR 1.136(a), the Director would generally not have approved the Request.

On many occasions, the submitted Requests provided either no reason requesting withdrawal or a reason that did not conform with 37 CFR 10.40(b) or (c). The practitioner requesting withdrawal as the practitioner of record from an application often requested a change of address to either a law firm whose practitioner(s) had not been appointed by the applicant or assignee in accordance with 37 CFR 1.32(b) or to an assignee who had not established ownership and the right to take action in accordance with 37 CFR 3.71. The Office also has been unable to approve requests because less than thirty (30) days remained between approval of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which could be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). For these reasons, the Office has decided to modify its procedures.

Revised Procedure: Under the revised procedure, the Office will no longer require at least thirty (30) days between approval of the request to withdraw from representation and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). Instead, the Office will require the practitioner(s) requesting withdrawal as practitioner of record to make specific certifications prior to withdrawal. Section 10.40(a) of Title 37 of the Code of Federal Regulations requires the practitioner to take "reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with all applicable laws and rules." In In re Slack, 54 USPQ2d 1504 (Comm'r Pat. 2000), the Office reviewed several statements in a practitioner's request to withdraw from representation to determine if the practitioner had taken reasonable steps to avoid foreseeable prejudice to the client's rights before permitting the practitioner to withdraw. In contrast, the Office did not permit the practitioner to withdraw in In re Legendary Inc., 26 USPQ2d 1478 (Comm'r Pat. 1992), finding that the practitioner had failed to take the reasonable steps to avoid foreseeable prejudice to the client's rights. In an effort to be consistent with these holdings and 37 CFR 10.40, the Office will require the practitioner(s) requesting withdrawal to: (1) give reasonable notice to the client, prior

to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) deliver to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notify the client of any responses that may be due and the time frame within which the client must respond. The failure to do so may subject the practitioner to discipline. See, e.g., In re Hierl, <http://www.uspto.gov/web/offices/com/sol/foia/oed/disc/D2006-19.pdf>. The updated version of Form PTO/SB/83 will include a certification section allowing the practitioner requesting withdrawal to certify that he or she has performed the above activities.

By performing the acts noted in the above-cited certifications, the practitioner must provide the client with adequate time to file a reply, and the practitioner must take reasonable steps to avoid foreseeable prejudice to the rights of the client. In most situations, a practitioner will not be permitted to withdraw from representation as practitioner of record unless all the certifications are made. Certain exceptions, however, may exist. For example, a practitioner requesting to withdraw because they have been terminated by the client may not be required to certify to above item (1). However, if the practitioner cannot make all of the certifications, an explanation detailing why the certification cannot be made must be included with the Request. It is also noted that submitting a false certification may violate a practitioner's duty under 37 CFR 10.23(b)(4) and (b)(5).

As long as the Request is filed prior to the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a), the Office will review the Request and render a decision, even if the decision on the Request is decided after the stated period for reply, after the application is abandoned, or after proceedings have terminated. In contrast, the Office will not decide requests to withdraw from representation as practitioner of record which are filed after the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). These Requests will be placed in the application but will not be treated on their merits. In a similar situation, a revocation of power of attorney filed after the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for an extension of time under 37 CFR 1.136 will simply be placed in the application file. The only exception will be a revocation and power of attorney accompanied with a petition to revive.

Similarly, Requests filed after a patent has issued will be placed in the file but will generally not be treated on their merits. Sections 2540 and 2542 of the Manual of Patent Examining Procedure (MPEP) explain that a practitioner does not have to request permission to withdraw as practitioner of record under 37 CFR 1.36 in order to change the address in a patented file and to direct notices, receipts and other communications relating to maintenance fees. Sections 2540 and 2542 of the MPEP recommend the designation of a "fee address" or the submission of a change in the correspondence address in the patented file for directing correspondence relating to maintenance fee payments and other correspondences after issuance. See Form PTO/SB/47, entitled,

"Fee Address" Indication Form and Form PTO/SB/123, entitled, Change of Correspondence Address, Patent.

The Office will also no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). This includes address changes to law firms, where no new power of attorney has been filed in the application. Instead, the Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor. Practitioners requesting withdrawal as practitioner of record are strongly encouraged to provide the Office with the most current address information related to the first named inventor or the assignee of the entire interest, so that the Office can direct future correspondence to the proper place. Alternatively, if the applicant wishes future correspondence to be mailed to a new law firm, a new power of attorney should be submitted in the application and should include the desired change of correspondence address. If a proper new power of attorney has been submitted in the application or patent revoking all previous powers of attorney, the request to withdraw from representation as practitioner of record will be rendered moot.

The Office will no longer approve requests from practitioners to withdraw from applications where the requesting practitioner is acting, or has acted, in a representative capacity pursuant to 37 CFR 1.34. In these situations, the practitioner is responsible for the correspondence the practitioner files in the application while acting in a representative capacity. As such, there is no need for the practitioner to obtain the Office's permission to withdraw from representation. However, practitioners acting in a representative capacity, like practitioners who have a power of attorney in the application, remain responsible for noncompliance with 37 CFR 1.56, as well as 37 CFR 10.18, with respect to documents they file.

As a reminder, 37 CFR 10.40 permits withdrawal from representation before the Office for the reasons set forth in 37 CFR 10.40(b) and (c). If the reasons for withdrawal do not conform to one of the mandatory or permissive reasons set forth in 37 CFR 10.40, the Office will not approve the Request. The updated version of Form PTO/SB/83 will include a section for practitioners to set forth the appropriate reasons under 37 CFR 10.40(b) and (c) for requesting withdrawal as practitioner of record.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number. If the practitioner(s) was appointed by a specific designation, then the Request should ask that each specified practitioner be withdrawn and should list each practitioner(s) in the Request. Otherwise, the Request may not be approved. Similarly, if the practitioner(s) was appointed by a

Customer Number, the practitioner(s) should ensure that the correct Customer Number is provided in the Request, or the Request may not be approved. Ensuring the Request has the correct Customer Number or lists the correctly appointed practitioner(s) will assist the Office in reviewing the Request and expedite the process. Additionally, as set forth in MPEP 403(I), the addition or deletion of a practitioner from the list of persons associated with a Customer Number should be done by way of a *Request for Customer Number Data Change* (PTO/SB/124) and not a *Request for Withdrawal As Attorney or Agent and Change of Correspondence Address* (Form PTO/SB/83).

The procedure set forth in this Notice applies to national applications. The Patent Cooperation Treaty and the Regulations and procedures thereunder will govern withdrawal of an attorney or agent in an international application.

Appropriate sections of the Manual of Patent Examining Procedure will be revised accordingly in due course.

Questions regarding this notice may be directed to David Bucci at (571) 272-7099 or Anthony Knight at (571) 272-3687.

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