

To take over as a pro se representative of yourself (as an inventor) in the patent prosecution process, you need to follow a series of formal steps. Here's a step-by-step guide to help you navigate this process:

Steps to Become a Pro Se Representative of Yourself:

1. Review Your Current Situation

Identify Existing Power of Attorney (POA): If you signed a POA with your patent attorney, this gives them the authority to represent you in your patent applications. To take over, you'll need to formally revoke that authority.

Identify Ongoing Applications: Confirm how many applications you have pending, including the one in prosecution and the continuation-in-part in the examination queue. Ensure you have access to the details of these applications.

2. Notify Your Patent Attorney (Optional)

Contacting Your Attorney: While you are not legally required to contact your attorney before revoking their POA, it is considered professional courtesy to notify them of your intention to handle your application(s) independently. You can explain that you will be taking over representation going forward.

Attorney's Role Post-Revocation: After you revoke the POA, the attorney will no longer be authorized to communicate with the USPTO on your behalf regarding these applications. They may assist you in a limited role if you choose, but their formal role ends once the POA is revoked.

3. Revoke Power of Attorney with USPTO

Form PTO/AIA/96: Use the USPTO's Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address form (PTO/AIA/96) to revoke the existing POA. Since you're revoking the POA but not appointing a new attorney, you'll indicate that you're acting as your own representative.

Steps to File:

1. Download Form: Obtain Form PTO/AIA/96 from the USPTO website.

2. Complete the Form: Fill in the details of your application, including the application number, and indicate that you are revoking the current POA.

3. Filing: Submit the form to the USPTO via their Electronic Filing System (EFS-Web) or via paper filing. Filing electronically is recommended for speed and convenience.

4. Change the Correspondence Address

Form PTO/AIA/122: Use Change of Correspondence Address Form (PTO/AIA/122) to update the USPTO on where future communications should be sent. You'll need to ensure that the correspondence address is changed to your personal or business address.

Steps to File:

1. Download Form: Obtain Form PTO/AIA/122 from the USPTO website.
2. Complete the Form: Fill in the appropriate application numbers and your new correspondence address.
3. Filing: Submit the form via EFS-Web or paper filing.

5. Monitor Your Application(s) via PAIR

Public/Private PAIR: Once the POA is revoked and you've updated the correspondence address, you'll need to monitor your applications through Patent Application Information Retrieval (PAIR), specifically the Private PAIR system for confidential application information.

EFS-Web Login: If you don't already have access to EFS-Web or Private PAIR, you will need to register for a USPTO PKI Certificate (Public Key Infrastructure) or use USPTO's two-step authentication to gain access. This step is crucial for monitoring deadlines, communications, and actions related to your application.

6. Respond to Office Actions and Other Correspondence

Prepare Responses: Once you've taken over as your own representative, you'll be responsible for responding to any Office actions from the USPTO. These could include rejections, requests for amendments, or other procedural steps required to prosecute your patent.

File Responses: You can prepare and file responses to Office actions using EFS-Web. Ensure that your responses are clear, timely, and comply with USPTO guidelines.

7. Keep Track of Deadlines and Filing Requirements

Deadlines: It's critical to stay on top of USPTO deadlines for your applications. Missing a deadline can result in the abandonment of your patent application. Keep careful records of filing dates, response deadlines, and any communications from the USPTO.

Fee Payments: You will be responsible for paying maintenance fees and other fees related to the patent application(s) as needed.

8. Consider Additional Resources (Optional)

Patent Prosecution Assistance: If you run into issues, you can consult the USPTO's Pro Se Assistance Program for guidance on procedural matters.

Self-Education: Familiarize yourself with the Manual of Patent Examining Procedure (MPEP) to understand the legal requirements and procedures for patent prosecution.

Summary of Forms to File:

Form PTO/AIA/96: Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address.

Form PTO/AIA/122: Change of Correspondence Address (if not included in the revocation).

At What Point Should You Contact the Attorney?

You can contact your attorney before starting this process to inform them that you'll be handling your applications going forward. While it's not legally required to contact them, doing so could avoid any confusion.

or delays, as the attorney would then know to stop working on your behalf. After you revoke their POA, they will no longer have the authority to manage your application.

If you want to take over quickly and avoid any further billing or work on the attorney's end, it's best to contact them before you file the revocation form. You don't need to involve them beyond that unless you want additional guidance.