

Chapter 400 Representative of Inventor or Owner

- 401 Patent and Trademark Office Cannot Aid in Selection of Attorney
- 402 Power of Attorney
 - 402.01 Exceptions as to Registration
 - 402.02 Appointment of Associate Attorney
 - 402.05 Revocation
 - 402.06 Attorney Withdraws
 - 402.07 Assignee Can Revoke Power of Attorney of Applicant
 - 402.08 Application in Interference
 - 402.09 International Application
- 403 Correspondence—With Whom Held
 - 403.01 Correspondence Held With Associate Attorney
 - 403.02 Two Attorneys for Same Application
- 404 Conflicting Parties Having Same Attorney
- 405 Attorney Not of Record
- 406 Death of Attorney
- 407 Disbarred Attorney
- 408 Telephoning Attorney
- 409 Death, Insanity, or Unavailability of Inventor
 - 409.01 Death of Inventor
 - 409.01(a) Prosecution by Administrator or Executor
 - 409.01(b) Proof of Authority of Administrator or Executor
 - 409.01(c) After Administrator or Executor has been Discharged
 - 409.01(d) Exception in Some Foreign Countries
 - 409.01(e) If Applicant of Assigned Application Dies
 - 409.01(f) Intervention of Executor Not Compulsory
 - 409.02 Insanity or Other Legal Incapacity
 - 409.03 Unavailability of Inventor
 - 409.03(a) At Least One Joint Inventor Available
 - 409.03(b) No Inventor Available
 - 409.03(c) Legal Representatives of Deceased Inventor Not Available
 - 409.03(d) Proof of Unavailability or Refusal
 - 409.03(e) Statement of Last Known Address
 - 409.03(f) Proof of Proprietary Interest
 - 409.03(g) Proof of Irreparable Damage
 - 409.03(h) Acceptance of a Section 1.47 Application
 - 409.03(i) Rights of an Omitted Inventor
 - 409.03(j) Action Following Acceptance of a Section 1.47 Application

401 Patent and Trademark Office Cannot Aid in Selection of Attorney

37 CFR 1.31. Applicants May Be Represented by an Attorney or Agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent and Trademark Office in patent cases. The Patent and Trademark Office cannot aid in the selection of an attorney or agent.

If patentable subject matter appears to be disclosed in a pro se application and it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications, the examiner may suggest to the applicant that it may be desirable to employ a registered patent attorney or agent. The following language is suggested for incorporation in an Office action:

[1] "Since the value of a patent is largely dependent upon the skillful preparation of the specification and claims, applicant may consider it desirable to employ the services of a registered patent attorney or agent. The Patent and Trademark Office cannot aid in the selection of an attorney or agent."

402 Power of Attorney [R-6]

37 CFR 1.34. Recognition for representation. (a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent and Trademark Office in a patent case, his personal appearance or signature shall constitute a representation to the Patent and Trademark Office that under the provisions of this part and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When an attorney or agent shall have filed his or her power of attorney, or authorization, duly executed by the person or persons entitled to prosecute the application or a patent involved in a reexamination proceeding, he or she is a principal attorney of record in the case. A principal attorney or agent, so appointed,

may appoint an associate attorney or agent who shall also then be of record.

The Patent and Trademark Office will continue to give effect to powers of attorney and authorizations of agent naming firms filed, with respect to patent applications, before July 2, 1971 and in all divisions and continuations thereof not requiring execution by the applicant. Powers of attorney or authorizations of agent naming firms of attorneys or agents filed in patent applications after July 2, 1971 will not be recognized. However, the Patent and Trademark Office will construe any such powers or authorizations as a direction to consider the address of the firm as the correspondence address for the application.

The privilege afforded by 37 CFR 1.34(a) as to recognition of registered attorneys and agents not of record will apply to all applications and reexamination proceedings whether filed before or after the effective date. Attention is called to the requirement of 37 CFR 1.34(a) that a paper filed by a registered patent attorney or agent in an application in which he is not of record should include both his or her signature and registration number.

Powers of attorney and authorizations of agent under 37 CFR 1.34(b) naming one or more registered individuals may be made.

Acceptance of papers filed in patent applications and reexamination proceedings by registered attorneys and agents upon a representation that the attorney or agent is authorized to act in a representative capacity is for the purpose of facilitating responses on behalf of applicants in patent applications, and, further, to obviate the need for filing powers of attorney or authorization of agent in individual applications or patents when there has been a change in composition of law firms or corporate patent staffs. Interviews with a registered attorney or agent not of record will, in view of 35 U.S.C. 122, be conducted only on the basis of information and files supplied by the attorney or agent.

Usually a power of attorney is made a part of the application oath or declaration, see § 601.02. In order that this power may be valid, the attorney or agent appointed must be registered.

When an application for patent is filed accompanied by a power of attorney or authorization of agent to a person not registered to practice before the United States Patent and Trademark Office, the Application Division will send the official filing receipt directly to the applicant, together with an explanatory letter. A copy of the letter will be sent to the person named in the power or authorization and a copy placed in the file without being given a

paper number. The name of the unregistered person will not be placed on the face of the file, and the examiner will communicate only with the applicant directly unless and until the applicant appoints a recognized practitioner. An associate power of attorney or authorization from the unregistered person will not be recognized or accepted.

In the event of a need to file a change in the power of attorney in a plurality of applications or patents or a common assignee or inventive entity, a single, original paper may be used provided that a reproduction of this original paper is supplied in each of the affected applications or patents. The copy of the original paper must identify in which application or patent the original paper is located and authorize the public to inspect and copy the original paper in the event one of the applications containing a copy matures into or is a patent and the application containing the original paper is pending or has become abandoned. See § 601.03. For a representative of a requester of reexamination see § 2213.

37 CFR 1.346. Signature and certificate of attorney.

Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent and Trademark Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits or declarations required of applicants). The signature of an attorney or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief, there is good ground to support it, including any allegations of improper conduct contained therein; and that it is not interposed for delay.

37 CFR 1.346 emphasizes that there must be a reasonable basis to support every allegation of improper conduct made by a registered practitioner in any Office proceeding. Although § 1.346 is limited to papers filed in Office proceedings, this is not intended to imply that disciplinary action never will be taken against a registered practitioner under § 1.348 for a groundless allegation of improper conduct in a court proceeding.

37 CFR 1.347. Removing names from registers. Attorneys and agents, registered to practice before the Patent and Trademark Office, should notify the Office of any change of address for entry on the register, by letter separate from any notice of change of address filed in individual applications. The Office may address a letter to any person on the registers, at the address of which separate notice for the register was last received, for the purpose of ascertaining whether such

person desires to remain on the register. The name of any person failing to reply and give the information requested within a time limit specified will be removed from the register, and the names so removed published in the Official Gazette. Any name so removed may be reinstated, either on the register of attorneys or the register of agents, as may be appropriate.

See also § 1702.

402.01 Exceptions as to Registration

37 CFR 1.342. Limited recognition. Any person not registered and not entitled to be recognized under § 1.341 as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent a specified application or applications, but this limited recognition shall not extend further than the application or applications specified.

Sometimes in a joint application one of the coinventors gives to the other the power of attorney in the case. Such power will be recognized even though the one to whom it is given is not registered.

If a request for special recognition accompanies the application, the Application Division will forward the file to the Chairman of the Committee on Enrollment.

402.02 Appointment of Associate Attorney

The principal attorney may appoint an associate attorney as provided in 37 CFR 1.34. The associate attorney may not appoint another attorney. See also § 406.

→ **402.05 Revocation [R-6]**

37 CFR 1.36. Revocation of power of attorney or authorization; withdrawal of attorney or agent. A power of attorney or authorization of agent may be revoked at any stage in the proceedings of a case, and an attorney or agent may withdraw, upon application to and approval by the Commissioner. An attorney or agent, except an associate attorney or agent whose address is the same as that of the principal attorney or agent, will be notified of the revocation of his or her power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the attorney or agent. An assignment will not itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by an attorney or agent of his or her own selection.

Upon revocation of the power of attorney, appropriate notification is sent by the clerk of the examining group.

Revocation of the power of the principal attorney revokes powers granted by him to other attorneys.

Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (in contradistinction to the date of ACCEPTANCE).

402.06 Attorney Withdraws [R-6] ←

See 37 CFR 1.36 in § 402.05.

In the event that a notice of withdrawal is filed by the attorney or attorneys of record, the file will be forwarded to the Office of the Solicitor where appropriate procedure will be followed pertaining to the withdrawal. The withdrawal is effective when approved rather than when received.

To expedite the handling of requests for permission to withdraw as attorney, under § 1.36, the request should be submitted in triplicate (original and two copies) and indicate thereon the present mailing address of the attorney who is withdrawing. The examining group number should also appear on all such requests.

The Commissioner of Patents and Trade marks usually requires that there be at least thirty days between approval of withdrawal and the expiration date of a time response period so that the applicant will have sufficient time to obtain other representation or take other action. If less than thirty days remain in a running response period, a request to withdraw is normally disapproved.

For withdrawal during reexamination proceedings see § 2223. ↗ ↘

402.07 Assignee Can Revoke Power of Attorney of Applicant

The assignee of record of the entire interest can revoke the power of attorney of the applicant unless an "irrevocable" right to prosecute the case had been given as in some government owned applications.

37 CFR 1.32. Prosecution by assignee. The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor.

See 37 CFR 1.36 in § 402.05.

A power of attorney by the assignee of the whole interest, if the assignment is recorded in the Office, revokes all powers given by applicant and prior assignees.

402.08 Application in Interference

While an application is involved in interference, no power of attorney of any kind should be entered in such application by the clerk of the group.

If a power of attorney or revocation is received for an application while in interference, it should be forwarded to the Interference Service Branch because all parties to the interference must be notified.

402.09 International Application

37 CFR 1.455. Representation in international applications. (a) Applicants of international applications may be represented by attorneys or agents licensed to practice before the Patent and Trademark Office or by a common representative (PCT Art. 49, Rules 4.8 and 90 and § 1.341).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by all applicants, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in Section 108 of the Administrative Instructions.

403 Correspondence—With Whom Held [R-6]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings. (a) The residence and post office address of the applicant must appear in the oath or declaration if not stated elsewhere in the application. The applicant may also specify an attorney or agent of record may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the case will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see § 1.34 (b)), or, if no attorney or agent is of record, to the applicant, or to any assignee of record of the entire interest if the applicant or such assignee so requests, or to an assignee of an undivided part if the applicant so requests, at the post office address of which the Office has been notified in the case. Amendments and other papers filed in the application must be signed: (1) By the applicant, or (2) if there is an assignee of record of an undivided part interest, by the applicant

and such assignee, or (3) if there is an assignee of record of the entire interest, by such assignee, or (4) by an attorney or agent of record, or (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34 (a). Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent be made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

(b) An applicant who has not made of record a registered attorney or agent may be required to state whether he received assistance in the preparation or prosecution of his application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. This includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 1.341 and 1.347 or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

Section 1.33(a) provides for an applicant to supply an address to receive correspondence from the Patent and Trademark Office concerning his application, in addition to his residence address, so that the Patent and Trademark Office may direct mail to any address of applicant's selection, such as a corporate patent department, a firm of attorneys or agents, or an individual attorney, agent, or other person.

Section 1.33 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney. Double correspondence with an ap-

plicant and his or her attorney, or with two representatives, will not be undertaken. See §§ 403.01, 403.02 and 714.01(d).

In a joint application with no attorney, the applicant whose name first appears in the papers receives the correspondence, unless other instructions are given. All applicants must sign the responses. See § 714.01(a).

→ Section 1.33(c) relates to which address communications for the patent owner will be sent in reexamination proceedings. See also § 2224.

→ Powers of attorney to firms filed in executed applications filed after July 2, 1971 are not recognized by the Patent and Trademark Office. However, the firm's address will be considered to be the correspondence address. The address should appear as follows:

John Doe (inventor)

In care of Able, Baker and Charlie (firm)

1234 Jefferson Davis Highway

Arlington, Virginia 22202

See § 601.03

403.01 Correspondence Held With Associate Attorney

Where the attorneys bear relation of principal attorney and associate attorney, the correspondence will be had with the associate attorney unless the principal attorney directs otherwise. Ex parte Eggan, 1911 C.D. 213; 172 O.G. 1091.

403.02 Two Attorneys for Same Application

If applicant simultaneously appoints two principal attorneys he should indicate with which correspondence is to be conducted. If one is a local Washington Metropolitan area attorney and applicant fails to indicate either attorney, correspondence will be conducted with the local attorney.

If, after one attorney is appointed, a second attorney is later appointed without revocation of the power of the first attorney, the name of

the second attorney is entered on the face of the file (Ex parte Eggan, 1911 C.D. 213; 172 O.G. 1091), with notation that the Office letters are to be sent to him. This applies also to associate attorneys.

404 Conflicting Parties Having Same Attorney

See 37 CFR 1.208 in § 1101.01(k).

405 Attorney Not of Record

Papers may be filed in patent applications by registered attorneys or agents not of record under 37 CFR 1.34(a). Filing of such papers is considered to be a representation that the attorney or agent is authorized to act in a representative capacity on behalf of applicant. However, interviews with a registered attorney or agent not of record will be conducted only on the basis of information and files supplied by the attorney or agent in view of 35 U.S.C. 122.

406 Death of Attorney

SOLE ATTORNEY

If notification is received from the applicant or assignee of the death of the sole principal attorney and the application is up for action by the examiner, correspondence is held with the applicant or assignee who originally appointed the deceased attorney.

If notification is received from the office of the deceased attorney and the application is up for action, the examiner when preparing the Office action should add a paragraph such as:

[1] "In view of the notification of the death of the attorney of record, his power is terminated. A new attorney may be appointed."

If notification of the death of the sole principal attorney is received from the Attorney's Roster or some outside source, there will be no paper of record in the file wrapper to indicate that the attorney is deceased. Correspondence therefore continues to be held with the office of the deceased attorney but a copy of the Office action is also mailed to the person who originally appointed the attorney. In such an Office action where the application is not ready for allowance the examiner should add a paragraph similar to the following:

[2] "Notice of the death of the attorney of record has come to the attention of this Office. Since his power of attorney is terminated, a copy of this action is being mailed to applicant (or assignee if he originally appointed the deceased attorney). A new attorney may be appointed."

If notification of the death of the sole principal attorney is received from the Attorney's Roster or some outside source and the application is ready for allowance, the examiner prepares the application for allowance and writes a letter to the office of the deceased attorney with a copy to the person who originally appointed the deceased attorney stating:

[3] "Notice of the death of the attorney of record has come to the attention of this Office. Since his power of attorney is thus terminated, and this application is now ready for allowance, the Notice of Allowance will be mailed to the office of the deceased attorney in the absence of a new power of attorney."

Note § 405.

The power of a principal attorney will be revoked, or terminated by his death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by him. Thus, a principal attorney may appoint an associate attorney but such a power terminates with that of the principal. The principal attorney may not appoint a "substitute" and any attempt by the principal to appoint a "substitute" attorney whose power is intended to survive his own will not be recognized by the Office.

407 Disbarred Attorney

See § 105.

408 Telephoning Attorney

Present Office policy places great emphasis on telephone interviews initiated by the examiner. For this reason, it is not necessary for an attorney to request a telephone interview. Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interviews would not be considered effective to advance prosecution. However, it is desirable for an attorney to call the examiner if the attorney feels the call will be beneficial to advance prosecution of the case. See §§ 713.01 and 713.05.

SPECIFIC TELEPHONE INTERVIEW SITUATIONS

Restriction of invention (§ 812.01).

Multiplicity (§ 706.03(1)).

Many attorneys have offices or representatives in the Washington area and it sometimes expedites business to interview them concerning an application. When the examiner believes the progress of the application would be advanced thereby, he or she may call the attorney in the case by telephone and ask the attorney to come to the Office. Listings of Washington representa-

tives of out-of-town attorneys are kept in each examining group.

Registered attorneys or agents not of record in a patent application and acting in a representative capacity under 37 CFR 1.34(a) should not be telephoned for restriction requirements, approval of examiner's amendments or given any information relative to such patent application by telephone unless the telephone number of such attorney or agent appears in a paper signed by applicant or an attorney or agent of record.

Examiners should place all long distance telephone calls through the FTS (Federal Telecommunications System), even though collect calls may have been authorized by the attorney.

To facilitate any telephone calls that may become necessary, it is strongly recommended that amendments, letters of transmittal and powers of attorney include the complete telephone number, with area code and extension, of the person with whom the interview should be held, preferably near the signature.

In new applications, the telephone number may appear on the letter of transmittal or in the power of attorney, oath or declaration, next to the attorney's name and address.

409 Death, Insanity, or Unavailability of Inventor

If the inventor is dead, insane or otherwise legally incapacitated, refuses to execute an application, or cannot be found, an application may be made by someone other than the inventor, as specified in 37 CFR 1.42-1.47, and 1.423, §§ 409.01-409.03(j).

409.01 Death of Inventor

Unless a power of attorney is coupled with an interest (i.e., an attorney is assignee or part-assignee), the death of the inventor (or one of the joint inventors) terminates the power of attorney and a new power from the heirs, administrators, executors or assigns is necessary if the attorney is to remain of record (but see § 409.01(f)). See also 37 CFR 1.422.

409.01(a) Prosecution by Administrator or Executor

35 U.S.C. 117 Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

37 CFR 1.42. When the inventor is dead. In case of the death of the inventor, the legal representative (ex-

ecutor, administrator, etc.) of the deceased inventor may sign the application papers and make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention by him.

One who has reason to believe that he will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 CFR 1.42. Such application will be considered as having been made on the date of receipt of all its required parts, or of the part which renders it complete (37 CFR 1.51 and 1.53), provided proof of applicant's authority as legal representative is subsequently filed. The filing date corresponding to said date of receipt will be canceled if another person is appointed legal representative. In the latter case, the application will be given an application date no earlier than the date on which the properly appointed legal representative actually executed the papers. The foregoing applies to the legal representative of a deceased sole or deceased joint inventor.

Application may be made by the heirs of the inventor, as such, if accompanied by a certificate from the court that they are all the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

If the court papers are in a language other than English, an English translation of such papers is required. The translation need not be sworn or affirmed.

409.01(b) Proof of Authority of Administrator or Executor

37 CFR 1.44. Proof of authority. In the cases mentioned in §§ 1.42 and 1.43, proof of the power or authority of the legal representative must be recorded in the Patent and Trademark Office or filed in the application before the grant of a patent.

Whenever because of the death of an inventor, the right of applying for and obtaining a patent for an invention devolves upon an executor or administrator, or whenever an executor or administrator desires to intervene prior to the granting of a patent, proof of the authority of such executor or administrator should in all cases be made of record in the Patent and Trademark Office by filing in the application or recording in the assignment records a certificate of the clerk of a competent court or the register of wills that his appoint-

ment is still in full force and effect. Such certificate shall be signed by an officer and authenticated by the seal of the court by which the same was issued. The authority of other legal representatives of the inventor must be similarly established. If the certificate is not in the English language, an English translation is also required.

Should such certificate of appointment be found to be insufficient for any reason, there may be required to be filed or recorded a certified and properly authenticated copy of the letters testamentary or of the letters of administration, in order that the scope of authority of the persons who seek to intervene may be a matter of record in this Office.

All applications filed by an executor or administrator are initially referred to the Assignment Division to ascertain whether proper authority has been recorded or "filed in the application" (37 CFR 1.44) and for suitable endorsement on the file. If the authority is insufficient, a notation is made under "other" or a form PTO-152. When a reply is received to such a notation and also in cases where the executor or administrator intervenes (after filing) the case should be sent immediately to the Assignment Division.

In any case in which the Chief of the Assignment Division reports that the authority of the executor or administrator of record in the case is insufficient, the examiner will require the filing in the application or the recording in the Assignment Division of a certificate of such appointment or a certified copy of letters testamentary or of letters of administration in such case before finally passing the case to issue.

In the case of foreign executors or administrators, a consular officer of the United States may authenticate the signature of the foreign officer attesting to the papers submitted as proof of authority. Unusual situations may be referred to the Office of the Solicitor.

409.01(c) After Administrator or Executor Has Been Discharged

When an administrator or executor has performed his or her functions and has been discharged and it is desired to make an application for an invention of the deceased, it is necessary for the administrator or executor to take out new letters of administration in order that he or she may file a new application of the deceased inventor.

409.01(d) Exception in Some Foreign Countries

The terms "Executor" and "Administrator" do not find an exact counterpart in all foreign countries and the procedure is governed by the necessity of construing those terms to fit the circumstances of the case. Hence the person or persons having authority corresponding to that of executor or administrator are permitted to make application as, for example, the heirs in Germany. The authority of such persons must be proved by an appropriate certificate. If the certificate is not in the English language, an English translation thereof is also required.

409.01(e) If Applicant of Assigned Application Dies

Where an applicant, carrying on the prosecution of an application after assignment, dies, his administrator may carry on the prosecution on filing letters of administration unless and until the assignee intervenes.

409.01(f) Intervention of Executor Not Compulsory

When an inventor dies after filing an application the executor or administrator should intervene, but the allowance of the application will not be withheld nor the application withdrawn from issue if the executor or administrator does not intervene.

This practice is applicable to an application which has been placed in condition for allowance or passed to issue prior to notification of the death of the inventor. See § 409.01.

409.02 Insanity or Other Legal Incapacity

37 CFR 1.43. When the inventor is insane or legally incapacitated. In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may sign the application papers and make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(b) is also applicable in case of insanity or other legal incapacity of an inventor.

409.03 Unavailability of Inventor

37 CFR 1.47. Filing by other than inventor. (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. Such

application must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.65. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. Such application must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.65. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

35 U.S.C. 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error,

and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make 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 necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

Application papers submitted pursuant to § 1.47 are forwarded by the Application Division to the Office of the Solicitor for determination whether the papers are proper, complete, and acceptable under § 1.47.

A *bona fide* attempt must be made to comply with the provisions of § 1.47 at the time application papers are first submitted. If the application papers, and evidence submitted with the application papers, are not found acceptable, the § 1.47 applicant will be notified by the Office of the Solicitor of the reasons why the papers are not acceptable. The § 1.47 applicant may request reconsideration and file supplemental evidence in a case where a *bona fide* attempt was made to comply with § 1.47 from the outset.

409.03(a) At Least One Joint Inventor Available

37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, permit a joint inventor to file an application "on behalf of" himself and a joint inventor who "cannot be found or reached after diligent effort" or who refuses to sign application papers. The person making application pursuant to § 1.47(a) is referred to as a "§ 1.47 (a) applicant."

In addition to other requirements of law (35 U.S.C. §§ 111 and 115), an application deposited in the Patent and Trademark Office pursuant to § 1.47(a) must meet the following requirements:

(1) The § 1.47(a) applicant must (i) make oath or declaration on his own behalf as required by § 1.65(a) or § 1.75 (see §§ 602, 605.01, and 1401.08) and (ii) make oath or declaration on behalf of the omitted joint inventor as required by § 1.65(b).

(2) The application must be accompanied by proof that the omitted inventor (i) cannot be found or reached after diligent effort or (ii) refuses to execute the application papers. See § 409.03(d).

(3) The last known address of the omitted joint inventor must be stated. See § 409.03(e).

409.03(b) No Inventor Available

37 CFR 1.47(b) and 35 U.S.C. 118 allow a "person" with a demonstrated proprietary interest to make application "on behalf of and as agent for" an inventor who "cannot be found or reached after diligent effort" or who refuses to sign application papers. The word "person" has been construed by the Patent and Trademark Office to include juristic entities, such as a corporation. The person making application pursuant to § 1.47(b) is referred to as a "§ 1.47(b) applicant."

In addition to other requirements of law (35 U.S.C. §§ 111 and 115), an application deposited pursuant to § 1.47(b) must meet the following requirements:

(1) The § 1.47(b) applicant must make the oath required by § 1.65(b) or § 1.175. Where a corporation is the § 1.47(a) applicant, an officer thereof should normally make the necessary oath or declaration and sign the application. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application papers on its behalf. Where application papers are signed by a registered attorney or agent on behalf of a corporation, proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted. An inventor may not authorize another individual to act as his agent to sign application papers on his behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976); *In re Striker*, 182 USPQ 507 (Comm'r. Pat. 1973).

(2) The § 1.47(b) applicant must state his relationship to the inventor as required by § 1.65(b).

(3) The application must be accompanied by proof that the inventor (i) cannot be found or reached after a diligent effort or (ii) refuses to execute the application papers. See § 409.03(d).

(4) The last known address of the inventor must be stated. See § 409.03(e).

(5) The § 1.47(b) applicant must make out a *prima facie* case (i) that the invention has been assigned to him or (ii) that the inventor has agreed in writing to assign the invention to him or (iii) otherwise demonstrate a proprietary interest in the subject matter of the application. See § 409.03(f).

(6) The § 1.47(b) applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See 409.03(g).

409.03(c) Legal Representatives of Deceased Inventor Not Available

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117, since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r. Pat. 1955). See § 1.42 and § 409.01. However, § 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see § 409.03(e)), and proof of the power or authority of the legal representative must be established before the grant of a patent, § 1.44. Also, in hardship situations where time or circumstances do not permit appointment, of a legal representative to make application § 1.47 may apply. *In re Schwarz*, 147 USPQ 394 (Comm'r. Pat. 1960). In such situations, however, subsequent joinder of a properly authorized legal representative will normally be required before the grant of a patent.

409.03(d) Proof of Unavailability or Refusal

Where inability to find or reach an omitted inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration should be submitted which fully describes the exact facts which are relied upon to establish that a diligent effort was made. The diligent effort must have been made before the application is deposited in the Patent and Trademark Office.

The affidavit or declaration must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as letters, telegrams, etc., which support a finding that an omitted inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In cases where priority under 35 U.S.C. 119 is to be claimed, the § 1.47 applicant should ex-

plain what efforts, if any, were made during the Convention year to prepare the application and obtain the inventor's signature thereon. The period allowed by the Convention year should "be sufficient for the preparation and deposit of an application . . . (in the United States) in the form required by the rules." Ex parte Sassin, 1906 C.D. 205 (Comm'r. Pat. 1906). Accordingly, section 1.47 may not be used "to save the parties from the consequences of their delay." Ex parte Sassin, supra. Attention is directed to the material in § 608.01 entitled "Filing of Non-English Language Applications", for guidance in those instances where a foreign language specification attached to a declaration executed by all named inventors is received from abroad by counsel in this country. In many instances where the omitted inventor is temporarily unavailable, his joinder papers are best submitted as soon as possible, preferably before the § 1.47 application is formally accepted. Such joinder papers should be filed with a brief explanatory letter, requesting that they be incorporated with the earlier § 1.47 application papers. The later submission of joinder papers is not prejudicial to an earlier filing date under § 1.47 if acceptance of the application under that rule would otherwise be warranted.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the omitted inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the § 1.47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

Whenever an omitted inventor gives a reason for refusing to sign application papers, that reason should be stated in the affidavit or declaration.

409.03(e) Statement of Last Known Address

An application filed pursuant to § 1.47 must state the last known address of the omitted inventor. That address should be the last known address at which the inventor customarily receives his mail. See § 605.03. Ordinarily, the last known address will be the last known residence of the omitted inventor.

Inasmuch as an omitted inventor is notified that an application pursuant to § 1.47 has been filed on his behalf, other addresses at which the omitted inventor may be reached should also be given.

409.03(f) Proof of Proprietary Interest

When an application is deposited pursuant to § 1.47(b), the § 1.47(b) applicant must prove, that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to him or (2) the inventor has agreed in writing to assign the invention to him or (3) he otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the § 1.47(b) application was assigned to the § 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. In re Gray, 115 USPQ 80 (Comm'r. Pat. 1956). An assignment to a § 1.47(b) applicant for the sole purpose of obtaining a filing date for a § 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and § 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to § 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (omitted inventor) agrees to assign to his employer (§ 1.47(b) applicant) all inventions made during employment. When such an agreement is relied upon, it must be established by the affidavit or declaration of a person having first-hand knowledge of the facts that the in-

vention was made by the employee while he was employed by the § 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the § 1.47(b) applicant must demonstrate that he otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the § 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the § 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having first-hand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied upon to demonstrate a proprietary interest should be made of record.

409.03 (g) Proof of Irreparable Damage

Irreparable damage may be established by showing that a filing date is necessary to (1) avoid an imminent statutory bar (35 U.S.C. 102) or (2) make a claim for priority (35 U.S.C. 119, 120, and 121). If a statutory bar is involved, the act or publication which is believed to constitute the bar should be identified. If a claim for priority is involved, the prior application or applications should be identified. A diligent effort to prepare the application and obtain the inventor's signature thereon must be made (see § 409.03(d)) even if the application is being filed to avoid a bar or to claim priority.

Preservation of the rights of the parties may be demonstrated by a showing that the inventor may reasonably be expected to enter into competition with the § 1.47(b) applicant, or that a firm plan for commercialization of the subject matter of the application has been adopted.

409.03 (h) Acceptance of a Section 1.47 Application

A filing date is not assigned to an application deposited pursuant to 37 CFR 1.47 until the application is found acceptable by the Office of the Solicitor.

When papers deposited pursuant to § 1.47 are found acceptable, the Office of the Solicitor enters a memorandum or letter to that effect in the file, the Application Division, is authorized to assign the application a filing date, and notice is normally sent to the omitted inventor (inventor designee) at his last known address. If such a notice is returned to the Patent and Trademark Office by the United States Postal Service as being undeliverable, and the application is thereafter determined to be allowable by the examiner, a notice will be published in the Official Gazette.

409.03 (i) Rights of the Omitted Inventor

The omitted inventor (also referred to as an "inventor designee") may protest his designation as an inventor. The omitted inventor is entitled to inspect any paper in the application as of the date the Office of the Solicitor authorizes the Application Division to accept the application, order copies thereof (at a prepaid cost of 30 cents per page) and make his position of record in the file wrapper of the application. Alternatively, the omitted inventor may arrange to do any of the preceding through a registered patent attorney or agent.

While the Patent and Trademark Office will grant the omitted inventor access to the application, inter partes proceedings will not be instituted in § 1.47 case, *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955). An omitted inventor is not entitled to a hearing (*Cogar v. Schuyler*, 173 USPQ 389 (D.C. Cir. 1972)) and is not entitled to prosecute the application.

An omitted inventor may join in a § 1.47 application. To join in the application, the omitted inventor must file an appropriate § 1.65(a) oath or declaration attached to a copy of the application as originally filed.

The rights of an omitted inventor are protected by the fact that the patent resulting from an application filed under 37 CFR 1.47(b) and 35 U.S.C. 118 must issue to the inventor, and an application filed under § 1.47(a) and 35 U.S.C. 116, the inventor has the same rights that he would have if he had joined in the application, *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955).

If an omitted inventor feels that he is the sole inventor of an invention claimed in a § 1.47 application naming him as a joint inventor, the omitted inventor may file his own application and request that his application be placed in interference with the § 1.47 application. If the claims in both the omitted inventor's application and the § 1.47 application are otherwise

found allowable, an interference may be declared.

409.03(j) Action Following Acceptance of a Section 1.47 Application

After an application deposited pursuant to 37 CFR 1.47 is found acceptable by the Office of the Solicitor, the examiner will act on the application in the usual manner, except that papers filed by an inventor who did not originally join in the application, and papers relating to its § 1.47 status, will be forwarded with the file wrapper to the Office of the Solicitor for consideration.

In the event joinder papers are filed, the Office of the Solicitor will determine whether such papers meet the requirements of § 1.65 including the requirement implicit in that rule that the oath or declaration be made on the basis of actual knowledge of the application papers on file. This knowledge may be demonstrated by reference in the oath or declaration to an attached copy of the application, *In re Bernard*, 123 USPQ 387 (Comm'r Pat. 1959).

When the examiner determines that a § 1.47 case is allowable, he should forward the file wrapper with a brief memorandum of that fact to the Office of the Solicitor. The § 1.47 aspects of the case will then be reviewed. If it appears that the originally non-signing inventor has joined in the application, or has received notice and not replied in any way, the file wrapper is generally returned to the examiner for allowance without further § 1.47 correspondence. On the other hand, if the inventor designee has shown some interest in the case short of proper joinder, he may be notified of imminent allowance and given a further opportunity to take any action he deems appropriate. Where there has been no proper joinder, a patent on a § 1.47 (b) application must be granted to the inventor, notwithstanding any recorded assignment by the inventor, *In re Schuyler*, 119 USPQ 97 (Comm'r Pat. 1957). Hence, it is generally advisable for an applicant to effect the inventor's proper joinder as soon as practicable. The fact that the application was made under § 1.47 will be indicated on the patent unless a proper joinder has been made.