Chapter 400 Representative of Inventor or Owner

401 Patent and Trademark Office Cannot Aid in Selection of Attorney

37 CFR 1.31. Applicants may be represented by a registered attorney or agent.

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases. See §§ 10.6 and 10.9 of this subchapter. The Patent and Trademark Office cannot aid in the selection of a registered 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. It is suggested that Form Paragraph 17.01 be incorporated in an Office action if the use of an attorney or agent is considered desirable and if patentable subject matter exists in the application.

¶ *17.01 Employ Services of Attorney or Agent*

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Examiner Note:

The examiner should not suggest that applicant employ an attorney or agent if the application appears to contain no patentable subject matter.

402 Power of Attorney

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 or her personal appearance or signature shall constitute a representation to the Patent and Trademark Office that under the provisions of this Subchapter 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 registered 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 an 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, in 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 filed after July 2, 1971, 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 July 2, 1971. Attention is called to the replacement of 37 CFR 1.34(a) that a paper filed by a registered patent attorney or agent in an application in which he or she is not of record should include both his or her signature and 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 authorizations 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. A person acting in a representative capacity may not sign a power of attorney or a document granting access to an application.

Usually a power of attorney is made a part of the application oath or declaration. In order that this power may be valid, the attorney or agent appointed must be registered. A power of attorney or authorization given to a registered Canadian patent agent, to be valid, must be given by the applicants, all of whom are located in Canada. See 37 CFR 10.6(c).

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 of 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 MPEP § 601.03. For a representative of a requester of reexamination see MPEP § 2213.

37 CFR 10.18. Signature and certificate of practitioner.

(a) Every paper filed by a practitioner representing an applicant or party to a proceeding in the Office must bear the signature of, and be personally signed by, such practitioner, except those papers which are required to be signed by the applicant or party. The signature of practitioner to a paper filed by him or her, constitutes a certificate that:

(1) The paper has been read by the practitioner;

(2) The paper's filing is authorized;

(3) To the best of his or her knowledge, information, and belief, there is good ground to support the paper, including any allegation of improper conduct contained or alleged therein; and

(4) It is not interposed for delay.

(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See § 10.23(c)(15).

37 CFR 10.18 emphasizes every paper filed by a practitioner must be personally signed by the practitioner except those required to be signed by the applicant, and that there must be a reasonable basis to support every allegation of improper conduct made by a registered practitioner in any Office proceeding. Although 37 CFR 10.18 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 37 CFR 10.23(c)(18) and 10.131 for a groundless allegation of improper conduct in a court proceeding.

37 CFR 10.11. Removing names from registers.

(a) Registered attorneys and agents shall notify the Director of any change of address. Any notification to the Director of any change of address shall be separate from any notice of change of address filed in individual applications.

(b) A letter may be addressed to any individual on the register, at the address of which separate notice was last received by the Director, for the purpose of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and names of individuals so removed will be published in the Official Gazette. The name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in § 1.21(a)(3) of this subchapter.

See also MPEP § 1702.

402.01 Exceptions as to Registration

37 CFR 10.9. Limited recognition in patent cases.

(a) Any individual not registered under § 10.6 may, upon a showing of circumstances which render it necessary or justifiable, be given limited recognition by the Director to prosecute as attorney or agent a specified application or specified applications, but limited recognition under this paragraph shall not extend further than the application or applications specified.

(b) When registration of a resident alien under paragraphs (a) or (b) of § 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section.

Sometimes in a joint application one of the co-inventors 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 Director of Enrollment and Discipline.

402.02 Appointment of Associate Attorney or Agent

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

402.05 Revocation

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 the 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 the assignee's own selection. See § 1.613(d) for withdrawal of an attorney or agent of record in an interference.

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 or her 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 or Agent Withdraws

See 37 CFR 1.36 in MPEP § 402.05. See also 37 CFR 10.40.

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the Group Director of the examining group where the application is assigned 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 37 CFR 1.36, the request should be submitted in triplicate (original and two copies) and indicate thereon the present mailing addresses of the attorney who is withdrawing and of the applicant. The examining group number should also appear on all such requests. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

The Commissioner of Patents and Trademarks usually requires that there be at least 30 days between *approval* of withdrawal and the later of the expiration date of a time response period 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). This is so that the applicant will have sufficient time to obtain other representation or take other action. If a period has been set for response and the period may be extended without a showing of cause pursuant to 37 CFR 1.136(a) by filing a petition for extension of time and fee, the practitioner will not be required to seek such extension of time for withdrawal to be approved. In such a situation, however, withdrawal will not be approved unless at least 30 days would remain between the date of approval and the last date on which such a petition for extension of time and fee could properly be filed.

For withdrawal during reexamination proceedings, see MPEP § 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 3.71. Prosecution by assignee.

The assignee of record of the entire right, title, and interest in an application for patent is entitled to conduct the prosecution of the patent application to the exclusion of the named inventor or previous assignee. The assignee of a registered trademark or a trademark for which an application to register has been filed is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee.

See 37 CFR 1.36 in MPEP § 402.05.

A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 CFR 3.73(b). See MPEP § 324. Ordinarily, the applicant will still have access to the application (MPEP § 106).

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 which is 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 registered to practice before the Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and § 10.10). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

(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 revocation 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.

For representation in international applications, see MPEP § 1807.

402.10 Appointment/Revocation by Less Than All Applicants or Owners

Papers giving or revoking a power of attorney in an application generally require signature by all the applicants or owners of the application. Papers revoking a power of attorney in an application (or giving a power of attorney) will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. The petition should be directed to the Office of Petitions. The acceptance of such papers by petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent responses submitted to the Office. See *In re Goldstein*, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). In applications accepted under 37 CFR 1.47, such a petition under 37 CFR 1.182 submitted by a previously nonsigning inventor who has now joined in the application will not be granted. See MPEP § 409.03(i). Upon accepting papers appointing and/or revoking a power of attorney that are signed by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent responses. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent responses and the paper number(s) where the split powers of attorney appear. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at least one applicant or owner prosecuting the

application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree. Each attorney or agent signing subsequent papers must indicate whom he or she represents.

The following are examples of who must sign responses when there is more than one person responsible for prosecuting the application:

(a) If co–inventor A has given a power of attorney and co–inventor B has not, responses must be signed by the attorney of A and by co–inventor B.

(b) If co–inventors A and B have each appointed their own attorney, responses must be signed by both attorneys.

403 Correspondence — With Whom Held [R–1]

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 and 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 §§ 10.5 and 10.11 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.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

37 CFR 1.33(a) provides for an applicant to supply an address to receive correspondence from the Patent and Trademark Office in addition to his or her 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.

37 CFR 1.33 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney unless some other correspondence address has been given. Double correspondence with an applicant and his or her attorney, or with two representatives, will not be undertaken. See MPEP § 403.01, § 403.02, and § 714.01(d).

If double correspondence is attempted, Form Paragraph 4.01 should be included in the next Office action.

¶ *4.01 Dual Correspondence*

Applicant has appointed an attorney or agent to conduct all business before the Patent and Trademark Office. Double correspondence with an applicant and applicant's attorney or agent will not be undertaken. Accordingly, applicant is required to conduct all future correspondence with this Office through the attorney or agent of record. See 37 CFR 1.33.

>Examiner Note:

1. The first time a response is received directly from applicant, include this paragraph in the Office action and send a copy of the action to the applicant. See MPEP § 403 and § 714.01.

2. Should applicant file additional responses, do not send copies of subsequent Office actions to the applicant.

3. Status letters from the applicant may be acknowledged in isolated instances.<

In a joint application with no attorney or agent, the applicant whose name first appears in the papers receives the correspondence, unless other instructions are given. All applicants must sign the responses. See MPEP § 714.01(a). If the assignee of the entire interest is prosecuting the application (MPEP § 402.07), the assignee may specify a correspondence address.

37 CFR 1.33(c) relates to which address communications for the patent owner will be sent in reexamination proceedings. See also MPEP § 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 MPEP § 601.03.

PATENT APPLICATION FILED WITHOUT CORRESPONDENCE ADDRESS

Effective February 27, 1983, in accordance with the provisions of 35 U.S.C. 111 and 37 CFR 1.53(b), a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the Patent and Trademark Office and which names the actual inventor or inventors pursuant to 37 CFR 1.41(a). If an application which has been accorded a filing date does not include the appropriate filing fee or oath or declaration, the applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

In order for the Office to so notify the applicant, a correspondence address must also be provided by the applicant. The address may be different from the Post Office address of the applicant. For example, the address of the applicant's registered attorney or agent may be used as the correspondence address. If the applicant fails to provide the Office with a correspondence address, the Office will be unable to provide the applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e). In such a case, the applicant will be considered to have constructive notice as of the filing date that the application must be completed and the applicant will have 2 months from the filing date in which to do so before abandonment occurs.

The periods of time within which the applicant must complete the application may be extended under the provisions of 37 CFR 1.136. Applications which are not completed in a timely manner will be abandoned.

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 (Comm'r Pat. 1911).

403.02 Two Attorneys for Same Application

If the applicant simultaneously appoints two principal attorneys, he or she should indicate with whom correspondence is to be conducted. If one is a local Washington Metropolitan area attorney and the 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 (Comm'r Pat. 1911)), 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 10.66.

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. Powers of attorney and documents granting access may not be signed by an attorney or agent not of record.

406 Death of Attorney [R-1]

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 Form Paragraph 4.02.

¶ *4.02 Death of Attorney, Notice Received From Attorney's Office*

In view of the notification of the death of the attorney of record, the power of attorney is terminated. A new attorney may be appointed.

>Examiner Note:

As the power of attorney has been terminated, Office correspondence is sent to the applicant or the assignee who originally appointed the deceased attorney or agent.<

If notification of the death of the sole principal attorney is received from the Office of Enrollment and Discipline or some other 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 Form Paragraph 4.03.

¶ *4.03 Death of Attorney, Notice From Other Source*

Notice of the death of the attorney of record has come to the attention of this Office. Since the power of attorney is therefore terminated, a copy of this action is being mailed to the [1].

Examiner Note:

In bracket 1, insert—applicant—or—assignee—if the assignee originally appointed the deceased attorney.

If notification of the death of the sole principal attorney is received from the Office of Enrollment and Discipline or some other 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 including the wording of Form Paragraph 4.04

¶ *4.04. Death of Attorney, Case is Ready for Allowance*

Notice of the death of the attorney of record has come to the attention of this Office. Since the 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.

Examiner Note:

A copy should also be mailed to the applicant or the assignee who originally appointed the attorney.

Note MPEP § 405.

The power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by him or her. 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 or her own will not be recognized by the Office.

407 Disbarred Attorney

See MPEP § 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 MPEP § 713.01 and § 713.05.

SPECIFIC TELEPHONE INTERVIEW SITUATIONS

Restriction of invention (MPEP § 812.01).
Multiplicity (MPEP § 706.03(l)).

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.

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 the 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, MPEP § 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 assignees is necessary if the attorney is to remain of record (but see MPEP § 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 (executor, administrator, etc.) of the deceased inventor may 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 the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 CFR 1.42. Proof of the applicant's authority as legal representative may be filed after the filing date of the application. If another person is appointed legal representative and the application has been accorded a filing date, an oath or declaration executed by the properly appointed legal representative must be submitted as soon as possible. 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 there is no will or the will did not appoint an executor and 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 or her appointment 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 so 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" on 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 or a notary public from a member country to the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents must authenticate the signature of the foreign officer attesting to the papers submitted as proof of authority. If documents are authenticated by a notary public in a member country, an apostille must be used. See MPEP § 602.04. Unusual situations may be referred to the Office of Special Program Examination.

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 the Federal Republic of Germany where no existing executor or administrator has been or will be appointed. 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, the administrator may carry on the prosecution on filing letters of administration unless and until the assignee intervenes (MPEP § 402.07).

409.01(f) Intervention of Executor Not Compulsory [R–1]

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 MPEP § 409.01.

409.02

> When a joint inventor of a *pro se* application dies after filing the application, the living joint inventors must submit proof that the joint inventor is dead. Upon submission of such proof, only the signatures of the living joint inventors are required on the papers filed with the PTO if the legal representative of the deceased inventor does not intervene. If the legal representative of the deceased inventor wishes to intervene, proof of authority complying with 37 CFR 1.44 must be submitted. Once the legal representative of the deceased inventor intervenes in the *pro se* application, the signatures of the living joint inventors and the legal representative are required on the papers filed with the PTO. <

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 make the necessary oath or declaration, and apply for and obtain the patent.

Where no legal representative has been appointed, one must be appointed by a court of competent jurisdiction for the purpose of execution of the oath or declaration of the application. MPEP § 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 when an inventor refuses to sign or cannot be reached.

(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 or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) 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 § 1.63. 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 or she 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. The oath or declaration in such an application must be accompanied by a petition including 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 by the required fee (§ 1.17(h)) 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 § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

35 U.S.C. 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

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 through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application 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 37 CFR 1.47 are forwarded by the Application Division to the Office of Special Program Examination for determination whether the papers are proper, complete, and acceptable under 37 CFR 1.47.

A *bona fide* attempt must be made to comply with the provisions of 37 CFR 1.47 at the time the oath or declaration is first submitted. If the oath or declaration, and evidence submitted with the oath or declaration, are not

found acceptable, the 37 CFR 1.47 applicant will be notified by the Office of Special Program Examination of the reasons why the papers are not acceptable. The 37 CFR 1.47 applicant may request reconsideration and file supplemental evidence in a case where a *bona fide* attempt was made to comply with 37 CFR 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, requires all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application."

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 37 CFR 1.47(a) must meet the following requirements:

(1) All the available joint inventors must (i) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and §1401.08) and (ii) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64.

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

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

409.03(b) No Inventor Available [R-1]

Filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only where no inventor is available to make application and allows 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 the application oath or declaration. The word "person" has been construed by the Patent and Trademark Office to include juristic entities, such as a corporation. Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b).

In addition to other requirements of law (35 U.S.C. 111 and 115), an application deposited pursuant to 37 CFR 1.47(b) must meet the following requirements:

(1) The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted ,or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf, *Staeger* v. *Commissioner*, 189 USPQ 272 (D.D.C. 1976); *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the ** >declaration required by 37 CFR 1.63 must state the citizenship, post office address, and residence of the non-signing inventor and must also state the post office address of the person signing on behalf of the non-signing inventor.< Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

(2) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

(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 MPEP § 409.03(d).

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

(5) The 37 CFR 1.47(b) applicant must make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the application. See MPEP § 409.03(f).

(6) The 37 CFR 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 MPEP § 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 "canot be found or reached after diligent effort" has no rea-sonable application to a deceased inventor, *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 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 MPEP§ 409.03(e)), and proof of the power or authority of the legal representative must be established before the grant of a patent, 37 CFR 1.44. Also, in hardship situations where time or circumstances do not permit appointment of a legal representative to make application, 37 CFR 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 a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts 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 certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning 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 37 CFR 1.47 applicant should explain 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, 37 CFR 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 MPEP § 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 those instances where the nonsigning inventor later becomes available, joinder papers are best submitted as soon as possible, preferably before the 37 CFR 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 37 CFR 1.47 application papers. The later submission of joinder papers is not prejudicial to an earlier filing date under 37 CFR 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 nonsigning 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 37 CFR 1.47 applicant that a nonsigning 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 a nonsigning inventor gives a reason for refusing to

sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

409.03(e) Statement of Last Known Address

An application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor.

That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor. A post office box is insufficient.

Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.

409.03(f) Proof of Proprietary Interest

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 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 the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant 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 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). 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 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 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 (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she 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 be the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand 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 on 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 to the oath or declaration must be made (see MPEP § 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 37 CFR 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 37 CFR 1.47 Application

A filing date is assigned to an application deposited pursuant to 37 CFR 1.47 provided the requirements of 37 CFR 1.53(b) are complied with. A filing receipt will be sent to the applicant when the application is found acceptable by the Office of Special Program Examination.

When papers deposited pursuant to 37 CFR 1.47 are found acceptable, the Office of Special Program Examination enters a memorandum or letter to that effect in the file, the Application Division is authorized to mail a filing receipt, and a notice is normally sent to the nonsigning inventor (inventor designee) at his or her 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 Nonsigning Inventor

The nonsigning inventor (also referred to as an "inventor designee") may protest his or her designation as an inventor. The nonsigning inventor is entitled to inspect any paper in the application as of the date the Office of Special Program Examination authorizes the Application Division to accept the application, order copies thereof at the price set forth in 37 CFR 1.19, and make his or her position of record in the file wrapper of the application. Alternatively, the nonsigning 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 nonsigning inventor access to the application, *inter partes* proceedings will not be instituted in 37 CFR 1.47 case, *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955). A nonsigning 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.

A nonsigning inventor may join in a 37 CFR 1.47 application. To join in the application, the nonsigning inventor must file an appropriate 37 CFR 1.63 oath or declaration. Even if the nonsigning inventor joins in the application, he or she cannot revoke or give a power of attorney without agreement of the 37 CFR 1.47 applicant.

The rights of a nonsigning 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 37 CFR 1.47(a) and 35 U.S.C. 116, the inventor has the same rights that he or she would have if he or she had joined in the application, *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955).

If a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, the nonsigning inventor may file his or her own application and request that his or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared.

409.03(j) Action Following Acceptance of a 37 CFR 1.47 Application

After an application deposited pursuant to 37 CFR 1.47 is found acceptable by the Office of Special Program Examination, 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 37 CFR 1.47 status, will be forwarded with the file wrapper to the Office of Special Program Examination for consideration.

In the event joinder papers are filed, the Office of Special Program Examination will determine whether such papers meet the requirements of 37 CFR 1.63 including the requirement in that rule that the oath or declaration be made on the basis of actual knowledge of the application papers on file. Unless it is clear from the oath or declaration that it was made with actual knowledge of the contents of the application papers, this knowledge may be demonstrated by attaching a copy of the application papers to the oath or declaration and making 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 37 CFR 1.47 application, or a file wrapper continuing application (37 CFR 1.62) thereof, is allowable, he or she should forward the file with a brief memorandum of that fact to the

Office of Special Program Examination. The 37 CFR 1.47 aspects of the case will then be reviewed. If it appears that the originally nonsigning 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 37 CFR 1.47 correspondence. On the other hand, if the inventor designee has shown some interest in the case short of proper joinder, he or she may be notified of imminent allowance and given a further opportunity to take any action he or she deems appropriate. Where there has been no proper joinder, a patent on a 37 CFR 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. 1958). 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 37 CFR 1.47 will be indicated on the patent unless a proper joinder has been made.