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## **410 Representations to the Patent and Trademark Office**

## **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.

An applicant for patent may file and prosecute his or her own application, and thus act as his or her own representative (*pro se*) before the Office. See 37 CFR 1.31. In presenting (whether by signing, filing, submitting, or later advocating) papers to the Office, a *pro se* applicant is making the certifications under 37 CFR 10.18(b), and may be subject to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b)(2). See 37 CFR 1.4(d)(2). See also MPEP § 410.

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, or all registered practitioners associated with a Customer Number, may be made. See MPEP § 403 for Customer Number practice.

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 replies 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 Office of Initial Patent Examination 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 either the face of the file or the PALM bib-data sheet and the examiner will communicate only with the applicant directly at the correspondence address specified by the applicant 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.

Form Paragraph 4.09 may be used to notify applicant that the attorney or agent is not registered.

#### ¶ 4.09 Unregistered Attorney or Agent

An examination of this application reveals that applicant has attempted to appoint an attorney or agent who is not registered to practice before the U.S. Patent and Trademark Office, contrary to the Code of Federal Regulations, 37 CFR 1.31. Therefore, the appointment is void, *ab initio*. We will not recognize the appointment and all correspondence concerning this application must be signed by: 1) all named applicants (inventors), 2) all the owners of the rights to the invention, or 3) a registered attorney or agent duly appointed by the inventor(s) or the owner(s). Furthermore, all communications from the Office will be addressed to the first named inventor, unless specific instructions to the contrary are supplied by the named inventor(s) or owner(s).

While an applicant 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, therefore, encouraged to secure the services of a registered patent attorney or agent (i.e., registered to practice before the U.S. Patent and Trademark Office) to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.

The Office cannot aid you in selecting a registered attorney or agent, however, we do have a publication which lists all the patent attorneys and agents who are registered to practice before the Office. The publication, "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office," may be purchased from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. In addition, applicant may obtain this information: from the USPTO Internet Web Site [<http://www.uspto.gov/>]; by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231; by calling the Office of Enrollment and Discipline at (703) 306-4097; or, through the Patent Assistance Center toll free number, 1(800)786-9199.

#### Examiner Note:

This form paragraph is to be used ONLY after ensuring that the named representative is not registered with the Office. A PALM inquiry should be first made and if no listing is given, the Office of Enrollment and Discipline should be contacted to determine the current "recognition" status of the individual named by the applicant in a "power of attorney." If the named individual is NOT registered or otherwise recognized by the Office, the correspondence address on the face of the file should be promptly changed to that of the first named inventor unless applicant specifically provides a different "correspondence address." A copy of the

Office communication incorporating this form paragraph should also be mailed to the unregistered individual named by the applicant in the "power of attorney." If desired, you may include with your communication, a list of the registered practitioners from applicant's zip code copied from the above noted publication which should be available in the Director's Office.

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. See MPEP § 201.06(c) for change in the power of attorney in continuation or divisional applications filed under 37 CFR 1.53(b). See MPEP § 403 for the addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number. For a representative of a requester of reexamination see MPEP § 2213.

*37 CFR 10.18. Signature and certificate for correspondence filed in the Patent and Trademark Office.*

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that--

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that --

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have eviden-

tiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of --

- (1) Holding certain facts to have been established;
- (2) Returning papers;
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;
- (4) Imposing a monetary sanction;
- (5) Requiring a terminal disclaimer for the period of the delay;

or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

37 CFR 10.18(a) emphasizes that every paper filed by a practitioner must be personally signed by the practitioner, except those required to be signed by the applicant or party. 37 CFR 10.18(b) provides that, by presenting any paper to the Office, the party presenting such paper (whether a practitioner or nonpractitioner) is: (1) certifying that the statements made therein are subject to the declaration clause of 37 CFR 1.68; and (2) making the certifications required for papers filed in a federal court under Rule 11(b) of the Federal Rules of Civil Procedure. See MPEP § 410. 37 CFR 10.18(d) provides that any practitioner violating the provisions of 37 CFR 10.18 may also be subject to disciplinary action (see 37 CFR 10.23(c)(15)), thus clarifying that a practitioner may be subject to disciplinary action in lieu of, or in addition to, the sanctions set forth in 37 CFR 10.18(c) for violations of 37 CFR 10.18. See also 37 CFR 1.4(d)(2).

The certifications in 37 CFR 10.18(b) apply to all papers filed in the Office, including allegations of improper conduct made by a registered practitioner in any Office 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 coinventors gives to the other the power of attorney in the application. 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 Office of Initial Patent Examination will forward the file to the Director of the Office 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 technical support staff 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, Form PTO/SB/83 may be used. 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 period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). 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 reply 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.

# REPRESENTATIVE OF INVENTOR OR OWNER

402.06

Please type a plus sign (+) inside this box → ☐

PTO/SB/83 (11-96)  
Approved for use through 6/30/99. OMB 0651-0035  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

Application Number	
Filing Date	
First Named Inventor	
Group Art Unit	
Examiner Name	
Attorney Docket Number	

To: Assistant Commissioner for Patents  
Washington, DC 20231

I hereby apply to withdraw as attorney or agent for the above identified application.

The reasons for this request are:

- ☐ The correspondence address is NOT affected by this withdrawal.
- ☐ Change the correspondence address and direct all future correspondence to:

### CORRESPONDENCE ADDRESS

<input type="checkbox"/> Customer Number	<input type="text"/>	→	Place Customer Number Bar Code Label here
--	----------------------	---	--

<input type="checkbox"/> Firm or Individual Name					
Address					
Address					
City		State		ZIP	
Country					
Telephone		Fax			

This request is enclosed in triplicate.

Name	
Signature	
Date	

*NOTE: Withdrawal is effective when approved rather than when received.  
Unless there are at least 30 days between approval of withdrawal and the expiration date of a time  
period for response or possible extension period, the request to withdraw is normally disapproved.*

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## 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 application 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).

In an application that has been accorded status under 37 CFR 1.47(a), or for which status under 37 CFR 1.47(a) has been requested, a power of attorney given by the inventors who have signed the declaration (available inventors) may be revoked by an assignee of the entire interest of the available inventors. Rights of the assignee to take action may be established as provided in 37 CFR 3.73(b) and MPEP § 324.

## 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 technical support staff of the examining group.

If a power of attorney or revocation is received for an application which is in interference, it should be forwarded to the Service Branch of the Board of Patent Appeals and Interferences 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 replies submitted to the Office. See *In re Goldstein*, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). In an application filed under 37 CFR 1.47(a), an assignee of the entire interest of the available inventors who have signed the declaration may appoint or revoke a power of attorney without a petition under 37 CFR 1.182. See MPEP § 402.07. However, 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 replies. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent replies 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 replies when there is more than one person responsible for prosecuting the application:

(A) If coinventor A has given a power of attorney and coinventor B has not, replies must be signed by the attorney of A and by coinventor B.

(B) If coinventors A and B have each appointed their own attorney, replies must be signed by both attorneys.

## 403 Correspondence — With Whom Held

*37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.*

(a) The applicant, the assignee(s) of the entire interest (see §§ 3.71 and 3.73) or an attorney or agent of record (see § 1.34(b)) may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the application 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, so long as a post office address has been furnished in the application. Double correspondence with an applicant and an attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

(b) Amendments and other papers filed in the application must be signed by:

(1) An attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;

(4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or

(5) All of the applicants (§§ 1.42, 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.

(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 attor-

ney 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 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 reply 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 replies, 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 replies. 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.

See MPEP § 201.06(c) regarding change of correspondence address in continuation or divisional applications filed under 37 CFR 1.53(b).

### CUSTOMER NUMBER PRACTICE

A Customer Number (previously a “Payor Number”) may be used to:

(A) designate the correspondence address of a patent application by a Customer Number such that the correspondence address for the patent application would be the address associated with the Customer Number;

(B) designate the fee address (37 CFR 1.363) of a patent by a Customer Number such that the fee address for the patent would be the address associated with the Customer Number; and

(C) submit a list of practitioners by Customer Number such that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.

Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number.

The following forms are suggested for use with the Customer Number practice:

(A) the “Request for Customer Number” (PTO/SB/125) to request a Customer Number;

(B) the “Request for Customer Number Data Change” (PTO/SB/124) to request a change in the data (address or list of practitioners) associated with an existing Customer Number;

(C) the “Change of Correspondence Address, Application” (PTO/SB/122) to change the correspondence address of an individual application to the address associated with a Customer Number;

(D) the “Change of Correspondence Address, Patent” (PTO/SB/123) to change the correspondence address of an individual patent to the address associated with a Customer Number; and

(E) the “Correspondence Address Indication Form” (PTO/SB/121) to change the correspondence address of a list of applications or patents to the address associated with a Customer Number.

The Office will also accept requests submitted electronically *via* a computer-readable diskette to:

(A) change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number; and

(B) submit a power of attorney in a list of applications or patents to the registered practitioners associated with the Customer Number.

Such electronic requests must be submitted in the manner set forth in the Notice entitled “Extension of the Payor Number Practice (through “Customer Numbers”) to Matters Involving Pending Patent Applications,” published in the *Federal Register* at 61 FR 54622, 54623-24 (October 21, 1996), and in the *Official Gazette* at 1191 O. G. 187, 188-89 (October 29, 1996).

The Customer Number practice does not affect the current practice of permitting a patentee to provide a “fee address” for the receipt of maintenance fee correspondence. A patentee will be able to designate a “fee address” for the receipt of maintenance fee correspondence, and a different address for the receipt of all other correspondence. The designation of a “fee address” by reference to a Customer Number will not affect or be affected by the designation of a correspondence address by reference to another Customer Number, in that the Office will send maintenance fee correspondence to the address associated with the Customer Number designated as the “fee address” and will send all other correspondence to the address associated with the Customer Number designated as the correspondence address.

The association of a list of practitioners with a Customer Number will permit an applicant to appoint all of the practitioners associated with the Customer Number merely by reference to the Customer Number in the Power of Attorney (i.e., without individually listing the practitioners in the Power of Attorney). The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant who appointed all of the practitioners associated with such Customer Number. This will avoid the necessity for the filing of additional papers in each patent application affected by a change in the practitioners of the law firm prosecuting the application. The appointment of practitioners associated with a Customer Number will be optional, in that any applicant may continue to individually name those practitioners to represent the applicant in a patent application.

The Customer Number practice does not affect the prohibition against and does not amount to an appointment of a law firm (rather than specified practitioners). The Office prohibits an appointment of a specified law firm because the Office cannot ascertain from its records whether a particular practitioner submitting a paper to the Office is asso-



ciated with the law firm specified in an appointment. The Office will permit an appointment of all of the practitioners associated with a specified Customer Number because the Office can ascertain from its records for the specified Customer Number whether a particular practitioner is associated with such Customer Number.

As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners, such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration numbers from plural sources. Customer Numbers are designed to serve the dual purpose in an application of providing a correspondence address, and

providing the list of practitioners appointed with a power of attorney. Due to the prohibition against dual correspondence in an application (37 CFR 1.33(a)), an applicant will be permitted to provide only a single number at a time as the Customer Number, and thus correspondence address, for the application. In an instance in which an applicant provides more than one Customer Number as the correspondence address, the last provided Customer Number is controlling. Thus, the appointment of a plurality (much less a large number) of Customer Numbers will result in the Office recognizing only the last mentioned Customer Number. Applicants are strongly cautioned not to attempt to appoint more than one Customer Number in a single communication, as such action will **not** have a cumulative effect.


The Office has created a box designation for correspondence related to a Customer Number ("Box CN"), and all correspondence related to a Customer Number (e.g., requests for a Customer Number) should be addressed to this box designation.

PTO/SB/121 (11-96)  
Approved for use through 6/30/99. OMB 0651-0035  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
Please type a plus sign (+) inside this box → ☐  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



<b>CORRESPONDENCE ADDRESS INDICATION FORM</b>	<b>Address to:</b>  Assistant Commissioner for Patents Box CN Washington, DC 20231
---	--

Please recognize the following address as the correspondence address:

☐ Customer Number  

**OR** *Type Customer Number here*

*Place Customer Number  
Bar Code Label here*

☐ Request for Customer Number (PTO/SB/125) submitted herewith.

---

**in the following listed application(s) or patent(s) :**

Patent Number (if appropriate)	Application Number	Patent Date (if appropriate)	U.S. Filing Date

Please type a plus sign (+) inside this box → ☐

PTO/SB/122 (11-96)  
Approved for use through 6/30/99. OMB 0651-0035  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# **CHANGE OF CORRESPONDENCE ADDRESS Application**

Address to:  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Application Number

Filing Date

First Named Inventor

Group Art Unit

Examiner Name

Attorney Docket Number

Please change the Correspondence Address for the above-identified application to:

☐

Customer Number

Type Customer Number here

Place Customer  
Number Bar Code  
Label here

OR

☐

Firm or  
Individual Name

Address

Address

City

State

ZIP

Country

Telephone

Fax

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the :

☐

Applicant.

☐

Assignee of record of the entire interest.  
Certificate under 37 CFR 3.73(b) is enclosed.

☐

Attorney or agent of record .

Typed or  
Printed Name

Signature

Date

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box →

PTO/SB/123 (8-96)  
Approved for use through 6/30/99. OMB 0651-0035  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<p align="center"><b>CHANGE OF CORRESPONDENCE ADDRESS</b></p> <p align="center"><i>Patent</i></p> <p>Address to: Assistant Commissioner for Patents Washington, D.C. 20231</p>	Patent Number	
	Issue Date	
	Application Number	
	Filing Date	
	First Named Inventor	

Please change the Correspondence Address for the above-identified application to:					<div style="border: 1px solid black; padding: 5px; width: fit-content; margin: 0 auto;"> <i>Place Customer Number Bar Code Label here</i> </div>
<input type="checkbox"/>	Customer Number	<div style="border: 1px solid black; width: 100px; height: 20px; margin: 0 auto;"></div> <i>Type Customer Number here</i>			
OR					
<input type="checkbox"/>	Firm or Individual Name				
Address					
Address					
City			State		ZIP
Country					
Telephone			Fax		
<p>This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).</p> <p>This form will not affect any "fee address" provided for the above-identified patent. To change a "fee address" use the "Fee Address Indication Form" (PTO/SB/47).</p>					
<p>I am the :</p> <p><input type="checkbox"/> Patentee.</p> <p><input type="checkbox"/> Assignee of record of the entire interest. Certificate under 37 CFR 3.73(b) is enclosed.</p> <p><input type="checkbox"/> Attorney or agent of record .</p>					
Typed or Printed Name					
Signature					
Date					

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box → ☐

PTO/SB/124A (8-96)  
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Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## Request for Customer Number Data Change

### Address to:

Assistant Commissioner for Patents  
Box CN  
Washington, DC 20231

To the Commissioner of Patents and Trademarks:

Please record the following data changes to **Customer Number**:

Type Customer Number here

Place Customer Number  
Bar Code Label here

☐ Please change Correspondence Address to:

<b>Firm or Individual Name</b>				
<b>Address</b>				
<b>Address</b>				
<b>City</b>		<b>State</b>		<b>ZIP</b>
<b>Country</b>				
<b>Telephone</b>		<b>Fax</b>		

☐ Please **delete** the following practitioner registration number(s) from the Customer Number indicated above:

<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>

☐ Please **add** the following practitioner registration number(s) to the Customer Number indicated above:

<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>

☐ Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto

### Request Submitted by:

<b>Firm Name (if applicable)</b>			
<b>Name of Person submitting request</b>			
<b>Signature</b>			
<b>Telephone Number</b>		<b>Date</b>	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

PTO/SB/124B (8-96)

Approved for use through 6/30/99. OMB 0651-0035

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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<b>Request for Customer Number Data Change</b>	<b>Practitioner Registration Number Supplemental Sheet</b>
	Page          of          Pages

To the Commissioner of Patents and Trademarks:

Please record the following data changes to **Customer Number**:  → Place Customer Number  
Bar Code Label here

☐ Please **delete** the following practitioner registration number(s) from the Customer Number indicated above:


☐ Please **add** the following practitioner registration number(s) to the Customer Number indicated above:


Firm Name	
Date	<input type="checkbox"/> Additional supplemental sheet(s) attached hereto

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

# REPRESENTATIVE OF INVENTOR OR OWNER

403

Please type a plus sign (+) inside this box → ☐

PTO/SB/125A (8-96)  
Approved for use through 6/30/99. OMB 0651-0035  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h2>Request for Customer Number</h2>	<b>Address to:</b>  Assistant Commissioner for Patents Box CN Washington, DC 20231
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To the Commissioner of Patents and Trademarks:  
Please assign a Customer Number to the Correspondence Address indicated below.

Firm or Individual Name				
Address				
Address				
City		State		ZIP
Country				
Telephone		Fax		

Please associate the following practitioner registration number(s) with the Customer Number assigned to the Correspondence Address cited above.

<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>

☐ Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto

Request Submitted by:

Firm Name (if applicable)			
Name of person submitting request			
Signature			
Telephone Number		Date	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

PTO/SB/125B (8-96)

Approved for use through 6/30/99. OMB 0651-0035

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>Request for Customer Number</b>	<b>Practitioner Registration Number Supplemental Sheet</b>
	Page                  of                  Pages

Please associate the following practitioner registration number(s) with the Customer Number assigned to the Correspondence Address cited on Request for Customer Number form attached.


Firm Name			
Date		<input type="checkbox"/>	Additional supplemental sheet(s) attached hereto

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.



## PATENT APPLICATION FILED WITHOUT CORRESPONDENCE ADDRESS

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53, a filing date is granted to a nonprovisional 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. If a nonprovisional 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. If a provisional application which has been accorded a filing date does not include the appropriate filing fee, or the cover sheet, 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(l) 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) for nonprovisional applications and 37 CFR 1.16(l) for provisional applications. 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 Egan*, 1911 C.D. 213, 172 O.G. 1091 (Comm'r Pat. 1911). The associate attorney may specify or change the correspondence address to which communications about the application are to be directed.

### 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 either the face of the file or the PALM bib-data sheet (*Ex parte Egan*, 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, change of correspondence address, and documents granting access may not be signed by an attorney or agent not of record.

### 406 Death of 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 or agent of record, the power of attorney is terminated. A new registered attorney or agent 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 or agent 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 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 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 or agent 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 or agent 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 or agent.

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 Suspended or Excluded Practitioner

See MPEP § 105.

Form Paragraphs 4.06, 4.07, and 4.08 should be used where power of attorney is given to an attorney or agent who has been suspended from practice before the office.

¶ 4.06 *Attorney/Agent Suspended (Sole Practitioner, Sole Inventor)*

The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to you as the inventor.

Applicant may, of course, file a new power of attorney in the application to have a registered attorney or agent represent you before the Office. In the absence of an attorney or agent of record, all amendments and other papers filed in the application must be signed: (1) by you; or (2) if there is an assignee of record of an undivided part interest, by you and such assignee; or (3) if there is an assignee of the entire interest, by such assignee; or (4) by a registered patent attorney or agent, not of record, who acts in a representative capacity under the provisions of 37 CFR 1.34(a). The Office will not hold telephone interviews with or send communications to a registered patent attorney or agent, acting in a representative capacity under 37 CFR 1.34, i.e., who is not of record in the application.

Applicant may obtain a list of registered patent attorneys and agents located in your area by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231, or by calling the Office of Enrollment and Discipline at (703) 306-4097.

**Examiner Note:**

1. In bracket 1, insert name of suspended or excluded practitioner.
2. In bracket 2, insert either --suspended-- or --excluded--.
3. This form paragraph should be used when a suspended or excluded practitioner is the only practitioner of record and there is only a single inventor. Use form paragraph 4.07 if there are joint inventors.
4. The Office action is to be mailed only to the inventor at his/her current address of record.

¶ 4.07 *Attorney/Agent Suspended (Sole Practitioner, Joint Inventors)*

The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to the address of the inventor first named in the application.

Applicants may, of course, file a new power of attorney in the application to have a registered attorney or agent represent them before the Office. In the absence of an attorney or agent of record, all amendments and other papers filed in the application must be signed: (1) by all named applicants unless one named applicant has been given a power of attorney to sign on behalf of the remaining applicants, and the power of attorney is of record in the application; or (2) if there is an assignee of record of an undivided part interest, by all named applicants retaining an interest and such assignee; or (3) if there is an assignee of the entire interest, by such assignee; or (4) by a registered patent attorney or agent not of record who acts in a representative capacity under the provisions of 37 CFR 1.34(a). The Office will not hold telephone interviews with or send communications to a registered patent attorney or agent, acting in a representative capacity under 37 CFR 1.34, i.e., who is not of record in the application.

Applicants may obtain a list of registered patent attorneys and agents located in their area by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231, or by calling the Office of Enrollment and Discipline at (703) 306-4097.

**Examiner Note:**

1. In bracket 1, insert the name of the suspended or excluded practitioner.
2. In bracket 2, insert either --suspended-- or --excluded--.

3. This form paragraph should be used when the suspended or excluded practitioner is the only practitioner of record and there are joint inventors. Use form paragraph 4.06 if there is a single inventor.

4. The Office action is to be mailed only to the inventor first named in the declaration at his or her current post office address of record.

**¶ 4.08 Attorney/Agent Suspended (Plural Practitioners)**

The present application was filed containing a power of attorney to [1] and [2]. A correspondence address was supplied for [3]. No address was supplied for [4].

[5] was [6] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice.

As a correspondence address, other than to [7], is not of record, this Office action is being mailed to [8] at his/her last known address as listed on the register of patent attorneys and agents. To ensure that a copy of this Office action is received in a timely manner to allow for a timely reply, a copy of the Office action is being mailed directly to the address of the inventor first named in the declaration or oath. Any reply by applicant(s) should be by way of the remaining practitioner(s) of record and should include a new correspondence address.

**Examiner Note:**

1. In brackets 1,3,5 and 7 insert the name of the suspended or excluded practitioner.
2. In brackets 2, 4 and 8, insert the name of the first named unsuspended (unexcluded) registered practitioner of record.
3. In bracket 6, insert either --suspended-- or --excluded--.
4. This form paragraph should be used when there is at least one registered practitioner still of record who has not been suspended or excluded from practice. Use one of form paragraphs 4.06 or 4.07 if there are no remaining registered attorneys or agents of record.
5. The Office action is to be mailed both to the first named registered attorney or agent of record (who is not suspended or excluded) at the address currently listed in the Attorney's Roster, and to the inventor first named in the declaration at his or her current post office address of record.

**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 application. See MPEP § 713.01 and § 713.05.

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 application 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.

**SPECIFIC TELEPHONE INTERVIEW SITUATIONS**

For restriction of invention, see MPEP § 812.01.

For multiplicity, see MPEP § 2173.05(n).

**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 37 CFR 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 given by the deceased inventor. A new power from the heirs, administrators, executors, or assignees is necessary if the deceased inventor is the sole inventor or all powers of attorney in the application have been terminated (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.

If a court certificate is not available, then a legal memorandum prepared and signed by an attorney at law familiar with the law of the jurisdiction involved may be submitted to demonstrate that the persons signing the declaration on behalf of the deceased inventor are all the heirs of the deceased inventor and are authorized to act on behalf of the deceased inventor. A copy (in the English language) of any statute or any court decision relied upon should be made of record.

#### **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.

It is the responsibility of the examiner of the application to ensure that proof of authority of the legal representative has been submitted and to determine whether the proof of authority is sufficient. The proof of authority may either be recorded or filed in the application. If proof of authority is missing from the application, form paragraph 4.05 should be used to notify applicant that proof of authority of the legal representative must be submitted.

##### *¶ 4.05 Representative for Dead or Insane Inventor*

Proof of authority of the legal representative under 37 CFR 1.44 has been omitted and must be provided.

If applicant responds with an indication that the proof of authority documents have been recorded, then the assignment records should be checked to determine whether the recorded documents comply with 37 CFR 1.44.

Deficiencies in the proof of authority should be pointed out to applicant by the examiner in the next Office action in order to avoid printer rush inquiries. In a national stage application filed under 35 U.S.C. 371, if after reviewing the submitted proof of authority the examiner ultimately determines that the authority to execute the application does not lie with the person(s) who executed the oath or declaration of the inventors on behalf of the deceased inventor, the application must be forwarded to the PCT Legal Office. See MPEP § 1893.01(e).

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 Special Program Law Office.

The examiner should acknowledge the filing of sufficient proof of authority as soon as possible in an Office action by stating that proof of authority of the legal representative in compliance with 37 CFR 1.44 has been submitted.

### 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

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.

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. See MPEP § 409.01(b) regarding

proof of authority. 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 nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(i) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the *Official Gazette*. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an 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 all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the *Official Gazette*. An inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

### 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 Office of Initial Patent Examination (OIPE) to the Special Program Law Office for determination whether the papers are proper, complete, and acceptable under 37 CFR 1.47 and for a decision on the petition under 37 CFR 1.47 before the application is sent to the Examining Groups. Since an application without an oath or declaration executed by all of the inventors may be an incomplete application, an examiner should not mail an Office action in an application without a fully executed oath or declaration under 37 CFR 1.63 unless the application has been accorded status under 37 CFR 1.47 by the Special Program Law Office.

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 Special Program Law Office 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(a) and 115), an application deposited in the Patent and

Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

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

#### 409.03(b) No Inventor Available

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(a) and 115), an application deposited pursuant to 37 CFR 1.47(b) must meet the following requirements:

(A) 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 (President, Vice-President, Secretary, or Treasurer) 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 full name, residence, post office address, and citizenship of the nonsigning 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).

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

(C) The application must be accompanied by proof that the inventor (1) cannot be found or reached after a diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

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

(E) The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. See MPEP § 409.03(f).

(F) The 37 CFR 1.47(b) applicant must prove that the filing of the application is necessary (1) to preserve the rights of the parties or (2) 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 "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 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 submit-

ted 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*, 1906 C.D. 205. 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. A copy of the application papers should be sent

to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

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,

(A) the invention has been assigned to the applicant, or

(B) the inventor has agreed in writing to assign the invention to the applicant, or

(C) 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 by 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 (A) avoid an imminent statutory bar (35 U.S.C. 102) or (B) 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 inven-



tor'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) Processing and 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 and the application will be forwarded to the Office of Patent Legal Administration, Special Program Law Office, for consideration of the petition filed under 37 CFR 1.47.

When papers deposited pursuant to 37 CFR 1.47 are found acceptable, the Special Program Law Office enters a memorandum or letter to that effect in the file. A notice will be published in the *Official Gazette* identifying the application number, filing date, the title of the invention and the name(s) of the nonsigning inventor(s). The Patent and Trademark Office will notify the nonsigning inventor(s) or, if the inventor is deceased, the legal representative(s), of the filing of an application under 37 CFR 1.47 by sending a letter to the last known address of the nonsigning inventor(s) or legal representative(s).

#### **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, 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*, 464 F.2d 747, 173 USPQ 389 (D.C. Cir. 1972)), and is not entitled to prosecute the application if status under 37 CFR 1.47 has been accorded, or if proprietary interest of the 37 CFR 1.47(b) applicant has been shown to the satisfaction of the Patent and Trademark Office.

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 in 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 Special Program Law Office, the examiner will act on the application in the usual manner. 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 placed in the file wrapper.

In the event joinder papers are filed, the oath or declaration under 37 CFR 1.63 will be placed in the application file.

When the examiner determines that a 37 CFR 1.47 application, or either a continued prosecution application (CPA) filed under 37 CFR 1.53(d) or a file wrapper continuing application filed under former 37 CFR 1.62 thereof, is allowable, he or she must check the file wrapper or the PALM bib-data sheet to make sure that the phrase “Rule 47” appears under the filing date. If the phrase “Rule 47” does not appear under the filing date, the examiner must write in black ink the phrase “Rule 47” under the filing date. The examiner will then prepare the application for allowance in accordance with MPEP Chapter 1300. It will not be necessary to forward the application to the Special Program Law Office.

Patents granted on applications accepted under 37 CFR 1.47 will have an indication on the face of the patent that the application was filed under 37 CFR 1.47, regardless of whether proper joinder of the previously nonsigning inventor has been made.

An application filed under 37 CFR 1.47 can be published as a Statutory Invention Registration.

## 410 Representations to the Patent and Trademark Office

37 CFR 1.4(d)(2) provides that the presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or nonpractitioner, constitutes a certification under 37 CFR 10.18(b), and that violations of 37 CFR 10.18(b)(2) may subject the party to sanctions under 37 CFR 10.18(c). Thus, by presenting a paper to the Office, the party is making the certifications set forth in 37 CFR 10.18(b), and is subject to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b)(2), regardless of whether the party is a practitioner or nonpractitioner. A practitioner violating 37 CFR 10.18(b) may also be subject to disciplinary action in lieu of or in addition to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b).

37 CFR 10.18(b) provides that, by presenting any paper to the PTO, the party presenting such paper is making two certifications: (1) the first certification is that the statements made therein are subject to the declaration clause of 37 CFR 1.68; (2) the second certification is the certification required for papers filed in a federal court under Rule 11(b) of the Federal Rules of Civil Procedure.

The first certification has permitted the PTO to eliminate the separate verification requirement previously contained in 37 CFR 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 1.805, 3.26, and 5.4 for statements of facts by persons who are not registered to practice before the PTO. As statements submitted to the PTO by any person are now, by operation of 37 CFR 10.18(b)(1), verified statements, a separate verification requirement is no longer necessary. The PTO, however, has retained the requirement for a statement to be submitted under oath or declaration (37 CFR 1.68) in a number of sections (e.g., 37 CFR 1.63, 1.130, 1.131, 1.132, 1.494(e), 1.495(f), and 5.25).

The second certification is based upon Rule 11(b) of the Federal Rules of Civil Procedure (1993). This provision is promulgated pursuant to the Commissioner's authority under 35 U.S.C. 6(a) to establish regulations for the conduct of proceedings in the PTO, and is intended to discourage the filing of frivolous papers by practitioners or nonpractitioners in the PTO. Rule 11(b) of the Federal Rules of Civil Procedure provides:

**Representations to Court.** By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, --

(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;

(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

Fed. R. Civ. P. 11(b)(1993).

37 CFR 10.18(b)(2) tracks the language of Fed. R. Civ. P. 11(b). The advisory committee notes to Fed. R. Civ. P. 11(b) provide, in part, that:

[Fed. R. Civ. P. 11(b) and (c)] restate the provisions requiring attorneys and *pro se* litigants to conduct a reasonable inquiry into the law and facts before signing pleadings, written motions, and other documents, and prescribing sanctions for violations of these obligations. The [1993] revision in part expands the responsibilities of litigants to the court, while providing greater constraints and flexibility in dealing with infractions of the rule. The rule continues to require litigants to "stop-and-think" before initially making legal or factual contentions. It also, however, emphasizes the duty of candor by subjecting litigants to potential sanctions for insisting upon a position after it is no longer tenable and by generally providing protection against sanctions if they withdraw or correct contentions after a potential violation is called to their attention.

The rule applies only to assertions contained in papers filed with or submitted to the court. It does not cover matters arising for the first time during oral presentations to the court, when counsel may make statements that would not have been made if there had been more time for study and reflection. However, a litigant's obligations with respect to the contents of these papers are not measured solely as of the time they are filed with or submitted to the court, but include reaffirming to the court and advocating positions contained in those pleadings and motions after learning that they cease to have any merit. For example, an attorney who during a pretrial conference insists on a claim or defense should be viewed as "presenting to the court" that contention and would be subject to the obligations of [Rule 11(b)] measured at that time. Similarly, if after a notice of removal is filed, a party urges in federal court the allegations of a pleading filed in state court (whether as claims, defenses, or in disputes regarding removal or remand), it would be viewed as "presenting"--and hence certifying to the district court under Rule 11--those allegations.

The certification with respect to allegations and other factual contentions is revised in recognition that sometimes a litigant may have good reason to believe that a fact is true or false but may need discovery, formal or informal, from opposing parties or third persons to gather and confirm the evidentiary basis for the allegation. Tolerance of factual contentions in initial plead-

ings by plaintiffs or defendants when specifically identified as made on information and belief does not relieve litigants from the obligation to conduct an appropriate investigation into the facts that is reasonable under the circumstances; it is not a license to join parties, make claims, or present defenses without any factual basis or justification. Moreover, if evidentiary support is not obtained after a reasonable opportunity for further investigation or discovery, the party has a duty under the rule not to persist with that contention. [Rule 11(b)] does not require a formal amendment to pleadings for which evidentiary support is not obtained, but rather calls upon a litigant not thereafter to advocate such claims or defenses.

The certification is that there is (or likely will be) “evidentiary support” for the allegation, not that the party will prevail with respect to its contention regarding the fact. That summary judgment is rendered against a party does not necessarily mean, for purposes of this certification, that it had no evidentiary support for its position. On the other hand, if a party has evidence with respect to a contention that would be sufficient to defeat a motion for summary judgment based thereon, it would have sufficient “evidentiary support” for purposes of Rule 11.

Denials of factual contentions involve somewhat different considerations. Often, of course, a denial is premised upon the existence of evidence contradicting the alleged fact. At other times a denial is permissible because, after an appropriate investigation, a party has no information concerning the matter or, indeed, has a reasonable basis for doubting the credibility of the only evidence relevant to the matter. A party should not deny an allegation it knows to be true; but it is not required, simply because it lacks contradictory evidence, to admit an allegation that it believes is not true.

The changes in [Rule 11(b)(3) and (4)] will serve to equalize the burden of the rule upon plaintiffs and defendants, who under Rule 8(b) are in effect allowed to deny allegations by stating that from their initial investigation they lack sufficient information to form a belief as to the truth of the allegation. If, after further investigation or discovery, a denial is no longer warranted, the defendant should not continue to insist on that denial. While sometimes helpful, formal amendment of the pleadings to withdraw an allegation or denial is not required by [Rule 11(b)].

Arguments for extensions, modifications, or reversals of existing law or for creation of new law do not violate [Rule 11(b)(2)] provided they are “nonfrivolous.” This establishes an objective standard, intended to eliminate any “empty-head pure-heart” justification for patently frivolous arguments. However, to the extent to which a litigant has researched the issues and found some support for its theories even in minority opinions, in law review articles, or through consultation with other attorneys should certainly be taken into account in determining whether [Rule 11(b)(2)] has been violated. Although arguments for a change in law are not required to be specifically so identified, a contention that is so identified should be viewed with greater tolerance under [Rule 11].

*Amendments to the Federal Rules of Civil Procedure* at 50-53 (1993), reprinted in 146 F.R.D. 401, 584-87. The “inquiry reasonable under the circumstances” requirement of 37 CFR 10.18(b)(2) is identical to that in Fed. R. Civ. P.

11(b). The Federal courts have stated in regard to the “reasonable inquiry” requirement of Fed. R. Civ. P. 11:

In requiring reasonable inquiry before the filing of any pleading in a civil case in federal district court, Rule 11 demands “an objective determination of whether a sanctioned party’s conduct was reasonable under the circumstances.” In effect it imposes a negligence standard, for negligence is a failure to use reasonable care. The equation between negligence and failure to conduct a reasonable precomplaint inquiry is . . . that “the amount of investigation required by Rule 11 depends on both the time available to investigate and on the probability that more investigation will turn up important evidence; the Rule does not require steps that are not cost-justified.”

*Hays v. Sony Corp. of Am.*, 847 F.2d 412, 418, 7 USPQ2d 1043, 1048 (7th Cir. 1988)(citations omitted)(decided prior to the 1993 amendment to Fed. R. Civ. P. 11, but discussing a “reasonable under the circumstances” standard).

37 CFR 1.4(d)(2) and 10.18 do not require a practitioner to advise the client (or third party) providing information of this certification effect (or the sanctions applicable to non-compliance), or question the client (or third party) when such information or instructions are provided. When a practitioner is submitting information (e.g., a statement of fact) from the applicant or a third party, or relying upon information from the applicant or a third party in his/her arguments, the Office will consider a practitioner’s “inquiry reasonable under the circumstances” duty under 37 CFR 10.18 met so long as the practitioner has no knowledge of information that is contrary to the information provided by the applicant or third party or would otherwise indicate that the information provided by the applicant or third party was so provided for the purpose of a violation of 37 CFR 10.18 (e.g., was submitted to cause unnecessary delay).

Nevertheless, it is highly advisable for a practitioner to advise a client or third party that any information so provided must be reliable and not misleading. The submission by an applicant of misleading or inaccurate statements of facts during the prosecution of applications for patent has resulted in the patents issuing on such applications being held unenforceable. See, e.g., *Refac Int’l Ltd. v. Lotus Development Corp.*, 81 F.3d 1576, 38 USPQ2d 1665 (Fed. Cir. 1996); *Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc.*, 984 F.2d 1182, 25 USPQ2d 1561 (Fed. Cir. 1993); *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 200 USPQ 289 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *Ott v. Goodpasture*, 40 USPQ2d 1831 (D.N. Tex. 1996); *Herman v. William Brooks Shoe Co.*, 39 USPQ2d 1773 (S.D.N.Y. 1996); *Golden Valley Microwave Food Inc. v. Weaver Popcorn Co.*, 837 F. Supp. 1444, 24 USPQ2d 1801 (N.D. Ind. 1992), aff’d, 11 F.3d 1072 (Fed. Cir. 1993)(table), cert. denied, 511 U.S. 1128 (1994). Likewise, false statements by a practitioner in a paper submitted to the Office during the prosecution of an application for

patent has resulted in the patent issuing on such application also being held unenforceable. See *General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 30 USPQ2d 1149 (Fed. Cir. 1994)(false statement in a petition to make an application special constitutes inequitable conduct, and renders the patent issuing on such application unenforceable).

In addition, an applicant has no duty to conduct a prior art search as a prerequisite to filing an application for patent. See *Nordberg, Inc. v. Telsmith, Inc.*, 82 F.3d 394, 397, 38 USPQ2d 1593, 1595-96 (Fed. Cir. 1996); *FMC Corp. v. Hennessy Indus., Inc.*, 836 F.2d 521, 526 n.6, 5 USPQ2d 1272, 1275-76 n.6 (Fed. Cir. 1987); *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1415, 5 USPQ2d 1112, 1115 (Fed. Cir. 1987); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1362, 220 USPQ 763, 772 (Fed. Cir.), *cert. denied*, 469 U.S. 821, 224 USPQ 520 (1984). The “inquiry reasonable under the circumstances” requirement of 37 CFR 10.18 does not create any new duty on the part of an applicant for patent to conduct a prior art search. See MPEP 609; cf. *Judin v. United States*, 110 F.3d 780, 42 USPQ2d 1300 (Fed. Cir. 1997)(the failure to obtain and examine the accused infringing device prior to bringing a civil action for infringement violates the 1983 version of Fed. R. Civ. P. 11). The “inquiry reasonable under the circumstances” requirement of 37 CFR 10.18, however, will require an inquiry into the underlying facts and circumstances when a practitioner provides conclusive statements to the Office (e.g., a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional).

37 CFR 10.18(c) specifically provides that violations of 37 CFR 10.18(b)(1) may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom, and that violations of any of 37 CFR 10.18(b)(2)(i) through (iv) are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of:

- (A) holding certain facts to have been established;
- (B) returning papers;
- (C) precluding a party from filing a paper, or presenting or contesting an issue;
- (D) imposing a monetary sanction;
- (E) requiring a terminal disclaimer for the period of the delay; or
- (F) terminating the proceedings in the Patent and Trademark Office.

The Office has amended 37 CFR 1.4(d)(2) and 10.18 with the objective of discouraging the filing of frivolous or patently unwarranted correspondence in the Office, not to routinely review correspondence for compliance with 37 CFR 10.18(b)(2) and impose sanctions under 37 CFR 10.18(c).

Where the circumstances of an application or other proceeding warrant a determination of whether there has been a violation of 37 CFR 10.18(b), the file or the application or other proceeding will be forwarded to the Office of Enrollment and Discipline (OED) for a determination of whether there has been a violation of 37 CFR 10.18(b). In the event that OED determines that a provision of 37 CFR 10.18(b) has been violated, the Commissioner, or the Commissioner's designee, will determine what (if any) sanction(s) under 37 CFR 10.18(c) is to be imposed in the application or other proceeding. In addition, if OED determines that a provision of 37 CFR 10.18(b) has been violated by a practitioner, OED will determine whether such practitioner is to be subject to disciplinary action (see 37 CFR 1.4(d)(2) and 10.18(d)). That is, OED will provide a determination of whether there has been a violation of 37 CFR 10.18(b), and if such violation is by a practitioner, whether such practitioner is to be subject to disciplinary action; however, OED will not be responsible for imposing sanctions under 37 CFR 10.18(c) in an application or other proceeding.

37 CFR 10.18(d) provides that any practitioner violating the provisions of this section may also be subject to disciplinary action. 37 CFR 10.18(d) (and the corresponding provision of 37 CFR 1.4(d)(2)) clarifies that a practitioner may be subject to disciplinary action in lieu of, or in addition to, the sanctions set forth in 37 CFR 10.18(c) for violations of 37 CFR 10.18.

