Chapter 400 Representative of Inventor or Owner

401 Patent Office Cannot Aid in Selection of Attorney

Rule 31. Applicants May Be Represented By an Attorney or Agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. The Patent Office cannot aid in the selection of an attorney or agent.

[Old Rule 17]

402 Power of Attorney

Rule 34. Power of attorney or authorization. Before any attorney or agent, original or associate, will be allowed to inspect papers or take action of any kind in any application or proceeding, a written power of attorney or authorization, from the person or persons entitled to prosecute the application or from the principal attorney or agent in the case of an associate attorney or agent, must be filed in that particular application or proceeding.

[Old Rule 18]

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

When an application for patent is filed accompanied by a power of attorney or authorization of agent to a person not registered to practice before the United States Patent Office, the Application Branch 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 of authorization and a copy placed in the file without being given a paper number. The name of the unregistered person will not be placed on the face of the file, and the examiner will communicate only with the applicant directly unless and until the applicant appoints a recognized practitioner. An associate power of attorney or authorization from the unregistered person will not be recognized or accepted. If a request for special recognition accompanies the application, the Application Branch will forward the file to the Chairman of the Committee on Enrollment. (Notice of March 29, 1949)

A power appointing new or associate attorneys in an application subject to a "Secrecy Order" should be submitted to Division 70, for consideration of the propriety of the disclosure indicated by the power, before the power is entered in the application. (Extract from Notice of Aug. 22, 1949)

402.01 Exceptions as to Registration

Rule 342 Limited recognition. Any person not registered and not entitled to be recognized under rule 341 as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent a specified application or applications, but this limited recognition shall not extend further than the application or applications specified.

[Old Rule 17g]

Sometimes in a joint application one of the co-inventors gives to the other the power of attorney in the case. Such power will be recognized even though the one to whom it is given is not registered. If the legend "unregistered" is applied on the file jacket, it should be ignored by the Examiner.

402.02 Appointment of Associate Attorney

The principal attorney may appoint an associate attorney. The associate attorney cannot appoint another attorney; this being indicated by the portion of Rule 34 which states that the power of attorney or authorization must be "from the principal attorney or agent in the case of an associate attorney or agent".

402.03 "Substitute" Will Be Considered Associate

When the attorney appointed by an applicant appoints a "substitute" attorney, such "substitute" attorney shall be considered the associate of the principal attorney. The name of the principal attorney will be left on the file and his responsibility to the applicant shall not be considered as having been discharged. (Extract from Notice of July 19, 1948)

402.04 Power of Attorney Filed After Application Is Filed

Powers of principal and associate attorneys filed after the receipt of the application in the examining divisions are entered on the face of the file by the Clerk of the Division.

402.05 Power of Attorney to a Firm

Rule 346 Signature and certificate of attorney. Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits required of applicants). The signature of an attorney or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief there is good ground to support it; and that it is not interposed for delay. When an applicant or party is represented by a registered firm such papers must carry the signature of an individual member of the firm or an individual registered attorney or agent employed by the firm and duly authorized to sign on behalf of the firm, in addition to the firm name, and the certification shall be a certification by and on behalf of the firm and by the individual.

The rule states that certain papers must bear the signature of the attorney or agent representing the applicant or party. There is no statement of what constitutes a signature and consequently any mode of affixing the signature of an individual which has been practiced and considered acceptable in the past may be continued.

In the case of a power of attorney given to a firm, the new rule states that the paper "must carry the signature of an individual member of the firm or an individual registered attorney or agent employed by the firm and duly authorized to sign on behalf of the firm, in addition to the firm name." The name of the firm may be written or typed and the signature of the individual may be the acceptable signature of the individual as stated in the preceding paragraph. The names of the members of the firm must all appear in the registration of the firm, see Rule 341 (d), but it is not necessary to supply a list of attorneys and agents employed by the firm and authorized to sign for the firm, although the Committee on Enrollment will receive and file such papers. When a registered attorney or agent employed by the firm signs his own name, his registration number *may* be placed after signature. The name of the firm may be used on the drawing, as in the past. (Notice of March 7, 1949.)

402.05 (a) Firm of Attorneys Changes Name

Where a firm having power of attorney in a case changes its firm name, due to the addition of a new member or the withdrawal or death of one of the members for example, the prosecution of the case may be continued in the name of the original firm, where desired, thus obviating the necessity of filing a new power of attorney. (Notice of Sept. 4, 1894, Revised.)

402.06 Revocation

Extract from Rule 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; and when it is so revoked, or the attorney or agent so withdrawn, the Office will communicate directly with the applicant, or with such other attorney or agent as he may appoint. An attorney or agent will be notified of the revocation of his power of attorney or authorization and the applicant will be notified of the withdrawal of the attorney or agent.

[Old Rule 20]

Upon revocation of the power of the principal attorney, appropriate notification is sent by the Docket Branch. Note: The Examiner notifies associate attorney of his revocation, see 402.06 (a).

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

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

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402.06 (a) Examiner Must Notify Associate of Revocation

An associate attorney whose powers have been revoked shall be formally notified of such revocation by the Examiner unless the case is in interference. In the latter event, the Docket Branch notifies the attorney, the reason being that all parties to the interference must be notified. Such notice addressed to the associate attorney will take the form of the usual letter from the examiner on blank (POL–90) and will be in the following language:

You are hereby informed that the associate power of attorney to _____ in the above-entitled case was revoked _____ by _____

_____
Examiner.

This letter will not be counted as an action on the application in which it is entered. (Order No. 2024, Revised).

Note: Docket Branch always notifies principal attorney of his revocation, see 402.06.

402.07 Attorney Withdraws

See Extract from Rule 36 in 402.06.

In the event that a notice of withdrawal is filed by the attorney or attorneys of record, the file will be forwarded to the Docket Branch where appropriate procedure will be followed pertaining to the withdrawal. (Notice of May 15, 1934, Revised).

402.08 Assignee Can Revoke Power of Attorney of Applicant

The assignee of the entire interest can revoke the power of attorney of the applicant under the provisions of Rule 32.

Rule 32. Prosecution by assignee. The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor.

[Old Rule 5]

Extract from Rule 36. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke provious powers and be represented by an attorney or agent of his own selection.

[Old Rule 20]

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

403 Correspondence—With Whom Held

Rule 35 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney. Double correspondence with an applicant and his attorney, or with two representatives, will not be undertaken. See 403.01 and 403.02.

403.01 Correspondence Held With Associate Attorney

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

403.02 Two Attorneys for Same Applications

In applicant simultaneously appoints two principal attorneys he should indicate with which correspondence is to be conducted. If one is a local (D. C.) attorney and applicant fails to indicate either attorney, correspondence will be conducted with the local attorney.

If after one attorney is appointed a second attorney is later appointed by applicant, without revocation of the power of the first attorney, the name of the second attorney is entered on the face of the file (Ex parte Eggan, 1911 C. D. 213; 172 O. G. 1091), with notation that the Office letters are to be sent to him.

404 Conflicting Parties Having Same Attorney

See Rule 208 in 1101.01 (k).

405 Attorney Not of Record

When an amendment is filed, signed by an attorney whose power is not of record, see 714.01 (c).

406 Death of Attorney

When, after the death of the attorney of record, an amendment is filed by an attorney whose power is not of record, the amendment should be placed in the file and the applicant and the attorney who filed the amendment should be notified that it cannot be entered unless it is promptly ratified by the applicant or by an attorney whose power has been made of record at the time of such ratification.

An amendment signed by an assistant in the office of the attorney, the latter having died, may be admitted, subjected to future ratification.

If the ratification is promptly filed, the amendment should be entered as of the date on which the amendment was filed. (Notice of May 3, 1948, Revised.)

In carrying out these instructions, Primary Examiners should not set a definite time within which ratification must be filed, but the word "promptly" as used above should be used in the notification. The question of promptness or undue delay in ratifi-

cation should be left for determination when the ratification is filed and the question of entry of the amendment arises. In forming a judgment as to whether any particular ratification has been filed promptly, consideration should be given to the place of residence of the applicant and other pertinent circumstances. (Memorandum of June 28, 1948.)

407 Disbarred Attorney

See 105.

408 Representatives of Out-of-Town Attorneys

Many attorneys have offices or representatives in Washington 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 may call the attorney in the case by telephone and ask him to come to the Office. Listings of Washington representatives of out-of-town attorneys are kept by the Clerk in charge of the Attorney's Roster.

409 Death of Inventor

Generally speaking, the death of the inventor terminates the power of attorney. Hence, an amendment signed by the attorney after the death of the inventor should be ratified by the heirs, administrators, executors or assigns. Such an amendment may, however, save the case from abandonment. Therefore ratification is called for together with proof of authority of the one ratifying the action. See In re Matullath, 1912 C. D. 490; 179 O. G. 853. See following paragraphs.

409.01 Prosecution by Administrator or Executor

Rule 42 When the inventor is dead. In case of the death of the inventor, the executor or administrator of the deceased inventor may sign the application papers and make the necessary oath, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent may be issued to the executor or administrator upon proper intervention by him.

[Old Rule 25, par. 1]

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

Rule 43 When the inventor is insane. In case an inventor becomes insane, the legally appointed guardian, conservator, or representative of the insane inventor may sign the application papers and make the necessary oath, and apply for and obtain the patent.

[Old Rule 25, par. 2]

409.01 (a) Proof of Authority To Be of Record

Rule 44 Proof of authority. In the cases mentioned in Rules 42 and 43, proof of the power or authority of the executor or administrator, or of the guardian, conservator, or representative, must be recorded in the Patent Office 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 assignment records of this office by recording a certificate of the clerk of a competent court or of the register of wills that his 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.

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

In order to insure the proper issuance of patents and in the interest of uniformity of practice, all applications filed by an executor or administrator or in which an executor or administrator has intervened or in which the death of the inventor has been suggested, are referred to the Assignment Branch to ascertain whether proper authority is of record, and for suitable endorsement on the file before finally passing the case to issue.

In any case in which the Chief of the Assignment Branch reports that the authority of the executor or administrator of records in the case is insufficient, the examiner will require the recording in the Assignment Branch of a certificate of such appointment or a certified copy of letters testamentary or of letters of administration in such case before finally passing the case to issue. (Extract from Order No. 1838)

409.01 (b) After Administrator or Executor Has Been Discharged

When an Administrator or Executor has performed his 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 let-

ters of administration in order that he may file a new application of the deceased inventor.

409.01 (c) Exception in Some Foreign Countries

The terms "Executor" and "Administrator" do not find an exact counterpart in all foreign countries and the procedure is governed by the necessity of construing those terms to fit the circumstances of the case. Hence the person or persons having authority corresponding to that of Executor or Administrator are permitted to make application as, for example, the heirs in Germany. The authority of such person or persons must be proved by certificate of a diplomatic or consular officer of the United States.

409.01 (d) If Applicant of Assigned Application Dies

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

409.01 (e) 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 the issue if the executor or administrator does not intervene. (Order No. 2076)