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6. REPRESENTATIVE OF INVENTOR OR OWNER

6-1. Attorney

6-1-1. Patent Office Cannot Aid In Selection of Attorney

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.

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 must be filed in that particular application or proceeding.

6-1-2. Power of Attorney

Usually a power of attorney is made a part of the petition. In order that this power may be valid, the attorney or agent appointed must be registered. If the designated attorney is not registered, the Chief of the Application Branch stamps a notice to that effect on the margin, and such legend is also stamped beneath the name of the attorney on the file wrapper. In such case, and where, for any other reason, the power of attorney is invalid, a statement of that fact should be made, and the reason for the invalidity pointed out in the first Office letter. This letter is sent to the attorney, but he is informed that unless his power is validated no further correspondence will be held with him nor will any communication from him in relation to the case be accepted.

6-1-3. Unregistered Attorney May Appoint A Registered Attorney

An unregistered attorney may, however, appoint a registered attorney to act as his associate.

6-1-4. Exceptions As to Registration

Special recognition may be given a person or firm, not registered, to prosecute certain specified application or applications upon a showing of circumstances that justify such recognition.

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.

6-1-5. 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.

6-1-6. Examiner Must Notify Associate of Revocation

Associate attorneys whose powers have been revoked, must be formally notified of such revocation by the Examiner.

6-1-7. "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. In any case where the membership of a firm of attorneys is changed and the new firm is substituted for the old, the original firm name may be cancelled from the file.

6-1-8. Power of Attorney Filed After Application is Filed

Powers of principal and associated 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.

6-1-9. Assignee Can Revoke Power of Attorney of Applicant

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

6-1-10. Revocation

Upon revocation of the power of the principal attorney appropriate notification is sent by the Docket Branch.

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).

6-1-11. Conflicting Parties Having Same Attorney

Rule 23.8 Conflicting parties having same attorney. Whenever it shall be found that two or more parties whose interests appear to be in conflict are represented by the same attorney or agent, the Examiner shall notify each of said principal parties and the attorney or agent of this fact, and shall also call the matter to the attention of the Commissioner. If conflicting interests appear the attorney or agent will not be recognized to represent the parties whose interest are in conflict in further proceedings before the Patent Office.

6-1-12. Two Attorneys for Same Application

If applicant simultaneously appoints two principal attorneys he should indicate with which correspondence is to be conducted. If one is a local attorney and applicant fails to indicate either attorney, correspondence will be conducted with local attorney. If 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 Egan, 1911 O.D. 213; 172 O.G. 1091) with notation that the Office letters are to be sent to him.

6-1-13. 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 or assigns. Such an amendment may, however, save the case from abandonment. It is therefore entered and ratification is called for together with proof of authority of the one ratifying the action. See In re Maculath, 1912 O.D. 499, 179 O.G. 853

6-1-14. Attorney withdraws

When an attorney withdraws from a case, the applicant (or assignee, if he has intervened) should be notified of the fact and, where the case is awaiting action by applicant, also informed when next action by applicant will be necessary to save the case from being abandoned.

6-1-15. Taking Files or Papers from A Division

Attorneys and other authorized persons may have the file and drawing sent to the Record Room for their inspection, but care must be taken that the persons so ordering the files and drawings have proper authority. In this connection, it is to be noted that no references, files, drawings, or papers pertaining thereto are to be taken out of the division by one who is not a member of the division without a charge being left therefor on the Clerk's desk; nor may one not employed in the Patent Office be permitted to take from the division any such official document, whatever may be his authority in the case

6-1-16. 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.

If the ratification is promptly filed, the amendment should be entered as of the date on which the amendment was filed. 610 O.G. 503.

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 ratification 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.

6-1-17. Disbarred Attorney

Patent Office employees are forbidden to hold either oral or written communication with a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. Power to inspect given a disbarred attorney will not be accepted by the Examiner.

6-1-18. Attorney Not of Record

When an amendment is filed, signed by an attorney whose power is not of record, see 10-2-6.

6-1-19.            Power of Attorney To A Firm

Where a power of attorney is given to a firm, see 10-2-8.

6-1-20.            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 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.

6-1-21.            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 should call the attorney in the case by telephone and ask him to come to the Office. An informal list of Washington representatives of out-of-town attorneys is kept in the Office of the Clerk in charge of the attorney's roster.

6-2.                Prosecution by Administrator or Executor

6-2-1.             Proof of Authority to be of Record

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 said executor or administrator has been appointed and 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 of administration in such case 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 record 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.

6-2-2.           Abstract of Title in Reissue

Before passing a reissue application to issue, the file is forwarded to the Assignment Branch in order that the abstract of title forming part of the file record may be brought down to the latest date so that the examiner may ascertain therefrom whether the chain of title in the same is complete and to insure the granting of the reissue to the legal owner as required by Sec. 4916 R.S. This applies also to cases of insane persons arising under Sec. 4896 R. S.

6-2-3.           After Administrator  
Or Executor Has Been Discharged

When an Administrator or Executor has performed his functions and 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 may file a new application of the deceased inventor. Since the law requires that the application to be made by the inventor or, by his legal representative, the heirs merely as such are not legally competent to sign the application.

6-2-4.           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.



6-2-5. 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.

6-2-6. 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.