

# Chapter 400 Representative of Applicant or Owner

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<b>403</b>	<b>Correspondence — With Whom Held; Customer Number Practice</b>	<b>409.05</b>	Application For Patent by an Assignee, Obligated Assignee, or a Person Who Otherwise Shows Sufficient Proprietary Interest – Application Filed On or After September 16, 2012
<b>403.01</b>	[Reserved]	<b>410</b>	<b>Representations to the U.S. Patent and Trademark Office</b>
<b>403.01(a)</b>	Correspondence in Applications Filed On or After September 16, 2012	<b>401</b>	<b>U.S. Patent and Trademark Office Cannot Aid in Selection of Patent Practitioner [R-11.2013]</b>
<b>403.01(b)</b>	Correspondence in Applications Filed Before September 16, 2012		<i>37 CFR 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.</i>
<b>403.02</b>	Two Patent Practitioners for Same Application		An applicant for patent may file and prosecute the applicant's own case, or the applicant may give power of attorney so as to be represented by one or more patent practitioners or joint
<b>404</b>	[Reserved]		
<b>405</b>	<b>Interviews With Patent Practitioner Not of Record</b>		
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inventors, except that a juristic entity (e.g., organizational assignee) must be represented by a patent practitioner even if the juristic entity is the applicant. The Office cannot aid in the selection of a patent practitioner.

An applicant who is a juristic entity must be represented by a patent practitioner. An applicant for patent, other than a juristic entity (e.g., organizational assignee), 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 11.18\(b\)](#), and may be subject to sanctions under [37 CFR 11.18\(c\)](#) for violations of [37 CFR 11.18\(b\)\(2\)](#). See [37 CFR 1.4\(d\)\(4\)](#). See also [MPEP §§ 402.03](#) and [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 4.10 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.

#### ¶ 4.10 Employ Services of Attorney or Agent

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an applicant may prosecute the application (except that a juristic entity must be represented by a patent practitioner, [37 CFR 1.31](#)), 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 skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available at <https://oedci.uspto.gov/OEDCI/>. Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

#### 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; Naming Representative [R-07.2015]

### 37 CFR 1.32 Power of attorney.

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(c) A power of attorney may only name as representative:

- (1) One or more joint inventors ([§ 1.45](#));
- (2) Those registered patent practitioners associated with a Customer Number;
- (3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

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### I. NAMING REPRESENTATIVE IN A POWER OF ATTORNEY

An applicant may give a power of attorney to one or more patent practitioners or one or more joint inventors. A power of attorney to a joint inventor will be recognized even though the one to whom it is given is not a registered practitioner. See [37 CFR 1.31](#) and [37 CFR 1.32\(c\)\(1\)](#).

Powers of attorney naming firms of attorneys or agents filed in patent applications will not be recognized. Furthermore, a power of attorney that names more than ten patent practitioners will only be entered if Customer Number practice is used or if such power of attorney is accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed. If a power of attorney is not entered because more than ten patent practitioners were named, a copy of the power of attorney should be refiled with the separate paper as set forth in [37 CFR 1.32\(c\)\(3\)](#).

Powers of attorney naming joint inventors, one or more registered individuals, or all registered practitioners associated with a Customer Number, may be made. See [MPEP § 403](#) for Customer Number practice. Where a power of attorney is given to ten or fewer patent practitioners, [37 CFR 1.32\(c\)\(3\)](#) requires the name and registration number of each patent practitioner to be stated in the power of attorney. If the name submitted on the power of attorney does not match the name associated with the registration number provided in the Office of Enrollment and Discipline records for patent practitioners, the person that the Office will recognize as being of record will be the person associated with the registration number provided, because the Office enters the registration number, not the name, when making the practitioner of record. Accordingly, if the wrong registration number is provided, a new power of attorney will be required to correct the error.

See [MPEP § 601.03\(a\)](#) for change of correspondence address in applications filed on or after September 16, 2012; see [MPEP § 601.03\(b\)](#) for change of correspondence address in applications filed before September 16, 2012. See [MPEP § 201.06\(c\)](#), [402.02\(a\)](#), and [402.02\(b\)](#) 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](#).

## II. REGISTERED PRACTITIONERS

For a power of attorney to be valid, the attorney or agent appointed must be registered to practice before the U.S. Patent and Trademark Office in accordance with [37 CFR 11.6](#). Note that under [37 CFR 11.6\(c\)](#), certain foreigners who are in good standing before the patent office of the country in which they reside and practice may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country.

Any power of attorney given to a practitioner who has been suspended or disbarred by the Office is ineffective, and does not authorize the person to

practice before the Office or to represent applicants or patentees in patent matters.

## III. INEFFECTIVE POWER OF ATTORNEY

When an application for patent is filed accompanied by a power of attorney to a person who is neither registered to practice before the United States Patent and Trademark Office nor named as the inventor or a joint inventor in the application, the Office of Patent Application Processing will send the official filing receipt directly to the first named applicant, together with an explanatory letter. A copy of the letter will be sent to the person named in the power and a copy placed in the file without being given a paper number. The name of the unregistered person will not be added to the list of patent practitioners of record for the application in the Office's electronic records.

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 neither registered to practice before the U.S. Patent and Trademark Office in patent matters nor named as an inventor in the application, contrary to the Code of Federal Regulations, [37 CFR 1.31](#) and [1.32](#). Therefore, the appointment is void, *ab initio*, and the Office will not recognize the appointment. All communications from the Office will be addressed to the first named applicant, unless specific instructions to the contrary are supplied by the applicant(s) for patent or owner(s).

For applications filed before September 16, 2012, in the absence of the appointment of a registered practitioner, all 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](#).

For applications filed on or after September 16, 2012, all papers must be signed by: (1) a patent practitioner of record; (2) a patent practitioner not of record who acts in a representative capacity under the provisions of [37 CFR 1.34](#); or (3) the applicant, except that papers submitted on behalf of a juristic entity applicant must be signed by a patent practitioner.

While an applicant (other than a juristic entity) 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, a list of attorneys and agents registered to practice before the U.S. Patent and Trademark Office is available at <https://oedci.uspto.gov/OEDCI/>. For assistance locating this information, contact the Office of Enrollment and Discipline at (571) 272-4097 or call the Inventors 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 of record should be promptly changed to that of the first named applicant 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.”

### 402.01 Limited Recognition in Patent Matters [R-07.2015]

#### *37 CFR 11.9 Limited recognition in patent matters.*

(a) Any individual not registered under §11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of §11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the United States Government to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall

automatically expire upon the nonimmigrant alien’s departure from the United States.

(c) An individual not registered under §11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in [PCT Art. 49, Rule 90](#) and § [1.455](#) of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to [PCT Rules 83.1 bis](#) and [90.1](#).

If a request for limited recognition under [37 CFR 11.9](#) accompanies the application, the Office of Patent Application Processing will forward the file to the Director of the Office of Enrollment and Discipline.

See [MPEP § 1807](#) for representation in international applications (PCT) and [MPEP § 2911](#) for representation in international design applications.

### 402.02 Appointment of Power of Attorney [R-11.2013]

For appointment of a power of attorney in applications filed on or after September 16, 2012, see [MPEP § 402.02\(a\)](#). For appointment of a power of attorney in applications filed before September 16, 2012, see [MPEP § 402.02\(b\)](#).

Note that effective June 25, 2004, the associate power of attorney practice was eliminated. See *Revision of Power of Attorney and Assignment Practice*, 69 FR 29865 (May 2004). The Office no longer accepts a power of attorney signed by a principal to name an associate power of attorney. An appointment of an associate power of attorney filed on or after June 25, 2004 will not be accepted. See also [MPEP § 406](#).

### 402.02(a) Appointment in Application Filed On or After September 16, 2012 [R-07.2015]

*[Editor Note: See [MPEP § 402.02\(b\)](#) for information pertaining to appointment of a power of attorney in an application filed before September 16, 2012.]*

*37 CFR 1.32 Power of attorney.*

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(b) A power of attorney must:

- (1) Be in writing;
- (2) Name one or more representatives in compliance with paragraph (c) of this section;
- (3) Give the representative power to act on behalf of the principal; and
- (4) Be signed by the applicant for patent (§ [1.42](#)) or the patent owner. A patent owner who was not the applicant under § [1.46](#) must appoint any power of attorney in compliance with §§ [3.71](#) and [3.73](#) of this chapter.

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(d) A power of attorney from a prior national application for which benefit is claimed under [35 U.S.C. 120, 121, 365\(c\)](#), or [386\(c\)](#) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

- (1) The power of attorney was granted by the inventor; and
- (2) The continuing application names an inventor who was not named as an inventor in the prior application.

(e) If the power of attorney was granted by the originally named inventive entity, and an added inventor pursuant to § [1.48](#) does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § [1.48](#) request. This provision does not preclude a practitioner from acting pursuant to § [1.34](#), if applicable.

## I. GENERAL REQUIREMENTS FOR POWERS OF ATTORNEY

For applications filed on or after September 16, 2012, [37 CFR 1.32\(b\)\(4\)](#) sets forth that a power of attorney must be signed by the applicant for patent or the patent owner (for reissue applications, reexamination proceedings and supplemental examination proceedings). An assignee who is not an applicant cannot revoke or appoint power of attorney in a patent application.

Pursuant to [37 CFR 1.42](#), the word “applicant” refers to the inventor or all of the joint inventors or to the person applying for a patent as provided in [37 CFR 1.43](#) (legal representative of a deceased or legally incapacitated inventor), [1.45](#) (joint inventor(s) on behalf of themselves and an omitted inventor) or [1.46](#) (assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest). As set forth in [37 CFR 1.42\(b\)](#), if a person is applying for a patent as provided in [37 CFR 1.46](#), that person

(which may be a juristic entity), and not the inventor, is the applicant. In this situation the Office would not accept a power of attorney from the inventor. An assignee or obligated assignee who is the applicant may appoint an effective power of attorney without the need to establish the right to take action under [37 CFR 3.71](#). See also [MPEP § 325](#). Persons who otherwise show sufficient proprietary interest in the matter may supply a power of attorney along with a petition under [37 CFR 1.46\(b\)\(2\)](#), which power would be effective once the petition is granted.

An assignee who is not the applicant may sign a power of attorney only if the assignee becomes the applicant per [37 CFR 1.46\(c\)](#) (which requires compliance with [37 CFR 3.71](#) and [3.73](#)). See [MPEP § 325](#). A patent owner who was not the applicant under [37 CFR 1.46](#) must appoint any power of attorney in compliance with [37 CFR 3.71](#) and [3.73](#). This covers a patent owner in a reissue application who was not the applicant under [37 CFR 1.46](#) in the application for the original patent, as well as a patent owner in a supplemental examination or reexamination proceeding who was not the applicant under [37 CFR 1.46](#).

The power of attorney must be signed by someone who is authorized to act on behalf of the assignee-applicant (i.e., a person with a title that carries apparent authority, or a person who includes a statement of authorization to act.). A patent practitioner is not authorized to act on behalf of an assignee simply by existence of authority to prosecute an application.

## II. POWERS OF ATTORNEY IN CONTINUING APPLICATIONS

Pursuant to [37 CFR 1.32\(d\)](#), a power of attorney from a prior national application for which benefit is claimed under [35 U.S.C. 120, 121, 365\(c\)](#), or [386\(c\)](#) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless: (1) The power of attorney was granted by the inventor; and (2) the continuing application names an inventor who was not named as an inventor in the prior application. Thus [37 CFR 1.32\(d\)](#) specifically requires that a



copy of the power of attorney from the prior application be filed in the continuing application to have effect (even where a change in power did not occur in the prior application).

### III. POWER OF ATTORNEY FORMS FOR APPLICATIONS FILED ON OR AFTER SEPTEMBER 16, 2012

Form PTO/AIA/80 should be used by assignees who want to become the applicant (see [37 CFR 1.46\(c\)](#)). The form may also be used by assignee-applicants who were named as the applicant when the application was filed, if desired. In either situation, this form must be accompanied by a statement under [37 CFR 3.73\(c\)](#) (form PTO/AIA/96 or equivalent). Where an assignee gives the practitioner specific authority to act on behalf of the assignee (e.g., authority given by organizational resolution), a practitioner may sign the PTO/AIA/80 on behalf of the assignee. Where an assignee is named as the applicant in the patent application (i.e., in a signed Application Data Sheet, form PTO/AIA/14 or equivalent), the assignee-applicant can appoint a power of attorney using the PTO/AIA/82 form. The forms are available on the USPTO website at [www.uspto.gov/patent/patents-forms](http://www.uspto.gov/patent/patents-forms). These forms should only be used in applications filed on or after September 16, 2012.

Note that the Office does not recommend that practitioners use a combined declaration and power of attorney document, and no longer provides such a form on the USPTO website.

#### 402.02(b) Appointment in Application Filed Before September 16, 2012 [R-07.2015]

*[Editor Note: See [MPEP § 402.02\(a\)](#) for information pertaining to appointment of a power of attorney in an application filed on or after September 16, 2012.]*

#### I. GENERAL REQUIREMENTS FOR POWERS OF ATTORNEY

*37 CFR 1.32 (pre-AIA) Power of attorney.*

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(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with paragraph (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent ([§ 1.41\(b\)](#)) or the assignee of the entire interest of the applicant.

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For applications filed before September 16, 2012, [pre-AIA 37 CFR 1.32\(b\)](#) sets forth that a power of attorney must be signed by the applicant for patent or the assignee of the entire interest of the applicant.

Pursuant to [pre-AIA 37 CFR 1.41\(b\)](#), the word “applicant” refers to the inventor or all of the joint inventors or to the person applying for a patent in place of the inventor under [pre-AIA 37 CFR 1.42](#) (legal representative of deceased inventor), [1.43](#) (legal representative of a deceased or legally incapacitated inventor), [1.47\(a\)](#) (joint inventor(s) on behalf of themselves and joint inventor(s) who refuse to join or cannot be reached or found after diligent effort) or [1.47\(b\)](#) (by assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest whenever all of the inventors refuse to sign or cannot be found or reached after diligent effort). Note that the Office does not recommend that practitioners use a combined declaration and power of attorney document, and no longer provides a combined declaration and power of attorney form on the USPTO website.

While a power of attorney may be signed by the inventor(s), the power of attorney should be signed by the assignee of the entire interest where one exists. Otherwise, the assignee may be paying the bill, while the inventor is providing the power of attorney, thereby possibly raising an issue as to who is the practitioner’s client. Additionally, relationships between an assignee and the inventors may deteriorate. It is not uncommon in these situations for inventors to stop cooperating and in some cases file powers of attorney in an attempt to control prosecution of the application. 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 [pre-AIA 37 CFR 3.71](#) and [pre-AIA 37 CFR 3.73\(b\)](#). See [MPEP § 324](#).

## II. POWERS OF ATTORNEY IN CONTINUING APPLICATIONS

When filing a continuation or divisional application with a copy of a declaration from the parent application in accordance with [pre-AIA 37 CFR 1.63\(d\)](#), applicants are required to identify in the continuation or divisional application any change in power of attorney that occurred after the filing of the parent application. See [pre-AIA 37 CFR 1.63\(d\)\(4\)](#). The Office suggests doing so by submitting a copy of the most recent power of attorney from the parent application in the continuing application to ensure that the Office recognizes the correct power of attorney.

## III. POWER OF ATTORNEY FORMS FOR APPLICATIONS FILED BEFORE SEPTEMBER 16, 2012

Form PTO/SB/80 or PTO/SB/81 (available at [www.uspto.gov/patent/patents-forms](http://www.uspto.gov/patent/patents-forms)) should be used for powers of attorney in applications filed before September 16, 2012. Note that the Office does not recommend that practitioners use a combined declaration and power of attorney document, and no longer provides such a form on the USPTO website.

### 402.03 Signature Requirements for Papers Filed in an Application [R-07.2015]

#### I. SIGNATURE AND CERTIFICATE

##### *37 CFR 11.18 Signature and certificate for correspondence filed in the Office.*

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § [1.4\(d\)](#) or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (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 Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully 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 any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

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

(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 any proceeding before the Office;

(ii) The 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 evidentiary 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 any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

(1) Striking the offending paper;

(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;

(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;

(4) Affecting the weight given to the offending paper; or

(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[37 CFR 11.18\(a\)](#) 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 11.18\(b\)](#) 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 11.18\(d\)](#) provides that any practitioner violating the provisions of [37 CFR 11.18](#) may also be subject to disciplinary action, 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 11.18\(c\)](#) for violations of [37 CFR 11.18](#). See also [37 CFR 1.4\(d\)\(4\)](#).

The certifications in [37 CFR 11.18\(b\)](#) apply to all papers filed in the Office, including allegations of improper conduct made by a registered practitioner in any Office proceeding.

## II. ACTING IN A REPRESENTATIVE CAPACITY

### *37 CFR 1.34 Acting in a representative capacity*

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. Further proof of authority to act in a representative capacity may be required.

In accordance with [37 CFR 1.34](#), a paper filed by a registered patent attorney or agent in an application in which he or she is not of record must include his or her name and registration number with his or her signature. 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 in individual applications or patents when there has been a change in composition of law firms or corporate patent staffs.

See [MPEP § 408](#) for information concerning interviews with an attorney or agent not of record.

Except as noted below, a person acting in a representative capacity may not sign (A) a power of attorney ([37 CFR 1.32](#)), (B) a document granting access to an application, (C) a change of correspondence address), (D) a terminal disclaimer ([37 CFR 1.321\(b\)\(1\)\(iv\)](#)), or (E) a request for an express abandonment without filing a continuing application ([37 CFR 1.138\(b\)](#)). In an application filed on or after September 16, 2012, a person acting in a representative capacity may sign a document granting access to an application or a change of correspondence address if (1) a power of attorney has not been appointed under [37 CFR 1.32\(b\)](#) and (2) the patent practitioner was named in the application transmittal papers. See [37 CFR 1.14\(c\)](#) and [1.33\(a\)](#). In an application filed before September 16, 2012, a person acting in a representative capacity may sign a document granting access to an application or a change of correspondence address if (1) an executed oath or declaration under [pre-AIA 37 CFR 1.63](#) has not been filed and (2) the patent practitioner was named in the application transmittal papers. See [pre-AIA 37 CFR 1.14\(c\)](#) and [pre-AIA 37 CFR 1.33\(a\)](#).

### 402.04 [Reserved]

### 402.05 Revocation of Power of Attorney [R-11.2013]

Revocation of a power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (not on the date of ACCEPTANCE). Upon revocation of the power of attorney, appropriate notification is sent by the Office. While an application is involved in an interference or derivation proceeding, any power of attorney or revocation of power of attorney should be forwarded to the Patent Trial and Appeal Board for consideration. See [MPEP § 402.08](#).

See [MPEP § 402.05\(a\)](#) for applicant revocation of powers of attorney in applications filed on or after September 16, 2012. See [MPEP § 402.05\(b\)](#) for applicant revocation of powers of attorney in applications filed before September 16, 2012. See



[MPEP § 402.07](#) for assignee revocation of a power of attorney.

### **402.05(a) Applicant Revocation - Application Filed On or After September 16, 2012 [R-11.2013]**

#### *37 CFR 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.*

(a) A power of attorney, pursuant to § [1.32\(b\)](#), may be revoked at any stage in the proceedings of a case by the applicant or patent owner. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all patent owners in a supplemental examination or reexamination proceeding) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § [1.17\(f\)](#). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ [1.32\(c\)\(2\)](#)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ [1.33](#)) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee may become the applicant under § [1.46\(c\)](#) and revoke any previous power of attorney and grant a power of attorney as provided in § [1.32\(b\)](#).

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A power of attorney may be revoked only by the applicant or patent owner. An assignee who is not the applicant may revoke a power of attorney only if the assignee becomes the applicant per [37 CFR 1.46\(c\)](#) (which requires compliance with [37 CFR 3.71](#) and [3.73](#)).

If the power of attorney was granted by the originally named inventive entity and an added inventor pursuant to § [1.48](#) does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § [1.48](#) request. This provision does not preclude a practitioner from acting pursuant to [37 CFR 1.34](#), if applicable. See [MPEP § 402.03](#) for information pertaining to acting in a representative capacity.

A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under [37 CFR 1.63](#). However, [37 CFR 1.64\(f\)](#) provides that the submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under [37 CFR 1.43](#), [1.45](#) or [1.46](#) will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

See [MPEP § 402.02\(a\)](#) for appointment of a new power of attorney in an application filed on or after September 16, 2012.

When an original power of attorney is filed giving power of attorney to attorneys A, B, and C, and the same principal subsequently files another power of attorney, giving power of attorney to D without revoking all prior powers of attorney, the subsequently filed power of attorney will be treated as a revocation of the original power of attorney. Similarly, if the applicant signed the original power of attorney, and an assignee of the entire interest of the applicant later takes action and files a new power of attorney, the original power of attorney is revoked and replaced by the power of attorney filed by the assignee. In addition, if a power of attorney is given to the practitioners associated with a Customer Number, and a (second) power of attorney is later received giving power of attorney to patent practitioners associated with a different Customer Number, the second power of attorney will be processed, with the first Customer Number being replaced with the second. The power of attorney to the practitioners associated with the first Customer Number is automatically revoked in this situation. In all of these situations, the most recently filed power of attorney will control.

### **402.05(b) Applicant Revocation - Application Filed Before September 16, 2012 [R-11.2013]**

#### *37 CFR 1.36 (pre-AIA) Revocation of power of attorney; withdrawal of patent attorney or agent.*

(a) A power of attorney, pursuant to § [1.32\(b\)](#), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ [1.41\(b\)](#)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of

attorney previously given. Fewer than all of the applicants (or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent) may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

\*\*\*\*\*

See [MPEP § 402.07](#) for revocation of a power attorney by the assignee. Form PTO/SB/81 may be used to revoke a power of attorney in an application filed before September 16, 2012. See also [MPEP § 402.02\(b\)](#).

If the power of attorney was granted by the originally named inventive entity and an added inventor pursuant to § 1.48 does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of the § 1.48 request. This provision does not preclude a practitioner from acting pursuant to [37 CFR 1.34](#), if applicable. See [MPEP § 402.03](#) for information pertaining to acting in a representative capacity.

When an original power of attorney is filed giving power of attorney to attorneys A, B, and C, and the same principal subsequently files another power of attorney, giving power of attorney to D without revoking all prior powers of attorney, the subsequently filed power of attorney will be treated as a revocation of the original power of attorney. Similarly, if the applicant signed the original power of attorney, and an assignee of the entire interest of the applicant later takes action and files a new power of attorney, the original power of attorney is revoked and replaced by the power of attorney filed by the assignee. In addition, if a power of attorney is given to the practitioners associated with a Customer Number, and a (second) power of attorney is later

received giving power of attorney to patent practitioners associated with a different Customer Number, the second power of attorney will be processed, with the first Customer Number being replaced with the second. The power of attorney to the practitioners associated with the first Customer Number is automatically revoked in this situation. In all of these situations, the most recently filed power of attorney will control.

A nonsigning inventor may subsequently join in a [pre-AIA 37 CFR 1.47](#) application by submitting an oath or declaration under [pre-AIA 37 CFR 1.63](#). However, even if the nonsigning inventor joins in the application, he or she cannot revoke or give a power of attorney without agreement of the [pre-AIA 37 CFR 1.47](#) applicant.

#### **402.06 Attorney or Agent Withdraws [R-07.2015]**

*37 CFR 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.*

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(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Patent Trial and Appeal Board.

*37 CFR 11.116 Declining or terminating representation.*

(a) Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:

- (1) The representation will result in violation of the USPTO Rules of Professional Conduct or other law;
- (2) The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or
- (3) The practitioner is discharged.

(b) Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:

(1) Withdrawal can be accomplished without material adverse effect on the interests of the client;

(2) The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;

(3) The client has used the practitioner's services to perpetrate a crime or fraud;

(4) A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;

(5) The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;

(6) The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or

(7) Other good cause for withdrawal exists.

(c) A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.

(d) Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.

See [MPEP § 402.05\(a\)](#) for applicant revocation of power of attorney in applications filed on or after September 16, 2012. For revocation of power of attorney in applications filed before September 16, 2012, see [MPEP § 402.05\(b\)](#) for revocation by the applicant and [MPEP § 402.07](#) for revocation by the assignee. See [37 CFR 11.116](#) for information regarding permissive and mandatory withdrawal. When filing a request to withdraw as attorney or agent of record, the patent attorney or agent should briefly state the reason(s) for which he or she is withdrawing so that the Office can determine whether to grant the request. Among several scenarios addressed in [37 CFR 11.116\(b\)](#), subsections (5) and (6) permit withdrawal when after reasonable warning the client fails to compensate the practitioner, or when the representation "has been rendered unreasonably difficult by the client." When preparing a request for withdrawal for such reasons, the practitioner should also be mindful of [37 CFR](#)

[11.106](#), which requires a practitioner to maintain the confidentiality of client information (except in limited circumstances). Where withdrawal is predicated upon such reasons, the practitioner, rather than divulging confidential or secret information about the client, should identify the reason(s) for requesting to withdraw as being based on "irreconcilable differences." An explanation of and the evidence supporting "irreconcilable differences" should be submitted as proprietary material in accordance with [MPEP § 724.02](#) to ensure that the client's confidences are maintained.

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. The **withdrawal is effective when approved** rather than when received.

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 himself or herself and another. A withdrawal of another attorney or agent of record, without also withdrawing the attorney or agent signing the request is a revocation, not a withdrawal.

Pursuant to [37 CFR 11.116\(c\)](#), when terminating a representation a practitioner must provide notice to, or request permission from, a tribunal when required by applicable law. Pursuant to [37 CFR 11.116\(d\)](#), a practitioner is required to take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred.

The Request for Withdrawal As Attorney or Agent and Change of Correspondence Address forms (PTO/SB/83 or PTO/AIA/83, available at [www.uspto.gov/patent/patents-forms](http://www.uspto.gov/patent/patents-forms)) provide a section wherein practitioners may certify the completion of activities necessary for the request to withdraw from representation to be granted. A Request for Withdrawal As Attorney or Agent may alternatively be filed as a Web-based e-petition (see [www.uspto.gov/patents-application-process/applying-online/epetitions/epetitions-faqs](http://www.uspto.gov/patents-application-process/applying-online/epetitions/epetitions-faqs) for more information).

When the correspondence address will change as a result of withdrawal, the withdrawing practitioner(s) must request that the Office direct all future correspondence to (i) the first named inventor or assignee that has properly made itself of record pursuant to [37 CFR 3.71](#) (for applications filed before September 16, 2012), or (ii) the applicant (for applications filed on or after September 16, 2012) or (iii) the assignee of record (for proceedings involving issued patents). Practitioners may do so by specifying either the correspondence address of, or the address associated with the Customer Number of, any appropriate party as specified above. Withdrawing practitioner(s) cannot change the correspondence address to the address associated with the Customer Number of another law firm, or any other address except as noted above.

As long as the Request is filed prior to the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for extension of time under [37 CFR 1.136\(a\)](#), the Office will review the Request and render a decision, even if the decision on the Request is decided after the stated period for reply, after the application is abandoned, or after proceedings have terminated. In contrast, the Office will not decide requests to withdraw from representation as practitioner of record which are filed after the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for extension of time under [37 CFR 1.136\(a\)](#). These Requests will be

placed in the application but will not be treated on their merits. In a similar situation, a revocation of power of attorney filed after the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for an extension of time under [37 CFR 1.136](#) will simply be placed in the application file. The only exception will be a revocation and power of attorney accompanied with a petition to revive.

For withdrawal during reexamination proceedings, see [MPEP § 2223](#). Requests for withdrawal filed after a patent has issued will be placed in the file but will generally not be treated on their merits.

The Office will not approve requests from practitioners to withdraw from applications where the requesting practitioner is acting, or has acted, in a representative capacity pursuant to [37 CFR 1.34](#). In these situations, the practitioner is responsible for the correspondence the practitioner files in the application while acting in a representative capacity. As such, there is no need for the practitioner to obtain the Office's permission to withdraw from representation. However, practitioners acting in a representative capacity, like practitioners who have a power of attorney in the application, remain responsible for noncompliance with [37 CFR 1.56](#), as well as [37 CFR 11.18](#), with respect to documents they file.

Form PTO/AIA/83 may be used to request withdrawal of attorney or agent of record.



Doc Code: PET.POA.WDRW

Document Description: Petition to withdraw attorney or agent (SB83)

PTO/AIA/83 (04-13)

Approved for use through 01/31/2018. OMB 0651-0035

U.S. 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 WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Practitioner Docket Number	

To: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Please withdraw me as attorney or agent for the above-identified patent application, and

- all the practitioners of record;
- the practitioners (with registration numbers) of record listed on the attached paper(s); or
- the practitioners of record associated with Customer Number: \_\_\_\_\_

NOTE: The immediately preceding box should only be marked when the practitioners were appointed using the listed Customer Number.

The reason(s) for this request are those described in 37 CFR:

- 11.116(a)(1)
- 11.116(a)(2)
- 11.116(a)(3)
- 11.116(b)(1)
- 11.116(b)(2)
- 11.116(b)(3)
- 11.116(b)(4)
- 11.116(b)(5)
- 11.116(b)(6)
- 11.116(b)(7) Please explain below:

**Certifications**

Check each box below that is factually correct. **WARNING: If a box is left unchecked, the request will likely not be approved.**

1.  I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.
2.  I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.
3.  I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:

[Page 1 of 2]

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



PTO/AIA/83 (04-13)

Approved for use through 01/31/2018. OMB 0651-0035

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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  
AND CHANGE OF CORRESPONDENCE ADDRESS**

Complete the following section only when the correspondence address will change. *Changes of address will only be accepted to an applicant.*

Change the correspondence address and direct all future correspondence to:

A.  The address of the applicant associated with Customer Number: \_\_\_\_\_

OR

B.  Applicant

Address

City	State	Zip	Country
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Telephone	Email
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I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature

Name	Registration No.
------	------------------

Address

City	State	Zip	Country
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Date	Telephone No.
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*NOTE: Withdrawal is effective when approved rather than when received.*

[Page 2 of 2]

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## 402.07 Assignee Revocation of Power of Attorney of Applicant and Appointment of New Power of Attorney [R-07.2015]

### I. APPLICATION FILED ON OR AFTER SEPTEMBER 16, 2012

In applications filed on or after September 16, 2012, any power of attorney must be signed by the applicant or patent owner. See [37 CFR 1.32\(b\)](#). For an assignee to revoke a previously given power of attorney and/or grant a power of attorney, the assignee must become the applicant under [37 CFR 1.46\(c\)](#). See [MPEP §§ 402.02\(a\)](#) and [402.05\(a\)](#). See [MPEP § 325](#) for details pertaining to establishing the right of an assignee to take action in an application filed on or after September 16, 2012.

### II. APPLICATION FILED BEFORE SEPTEMBER 16, 2012

In applications filed before September 16, 2012, 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 (pre-AIA) Prosecution by assignee.*

(a) *Patents — conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents — assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined.

A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents — Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with [§ 3.73\(b\)](#) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee’s trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with [§ 3.73\(b\)](#).

See [pre-AIA 37 CFR 1.36](#) in [MPEP § 402.05\(b\)](#).

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 [pre-AIA 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 [pre-AIA 37 CFR 1.47\(a\)](#), or for which status under [pre-AIA 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 (i.e., the applicant). See [pre-AIA 37 CFR 1.32\(b\)\(4\)](#). Rights of the assignee to take action may be established as provided in [pre-AIA 37 CFR 3.73\(b\)](#) and [MPEP § 324](#).

Form PTO/SB/80 may be used by an assignee of the entire interest of the applicant to revoke a power of attorney and appoint a new power of attorney. The assignee would sign the power of attorney, and a newly appointed practitioner, having authority to take action on behalf of the assignee would sign a statement under [pre-AIA 37 CFR 3.73\(b\)](#) for the application in which the general power of attorney is to be used.

PTO/SB/90 (11-09)

Approved for use through 11/30/2011. OMB 0651-0035

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

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**POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO**

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(b).

I hereby appoint:

Practitioners associated with the Customer Number:

OR

Practitioner(s) named below (if more than ten patent practitioners are to be named, then a customer number must be used):

Name	Registration Number	Name	Registration Number

as attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignment documents attached to this form in accordance with 37 CFR 3.73(b).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(b) to:

The address associated with Customer Number:

OR

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

Assignee Name and Address:

A copy of this form, together with a statement under 37 CFR 3.73(b) (Form PTO/SB/96 or equivalent) is required to be filed in each application in which this form is used. The statement under 37 CFR 3.73(b) may be completed by one of the practitioners appointed in this form if the appointed practitioner is authorized to act on behalf of the assignee, and must identify the application in which this Power of Attorney is to be filed.

**SIGNATURE of Assignee of Record**

The individual whose signature and title is supplied below is authorized to act on behalf of the assignee

Signature		Date	
Name		Telephone	
Title			

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## 402.08 Application in Interference or Derivation Proceeding [R-11.2013]

While an application is involved in an interference or derivation proceeding, any power of attorney of or revocation of power of attorney should be forwarded to the Patent Trial and Appeal Board for consideration.

## 402.09 International Application [R-11.2013]

### *37 CFR 11.9 Limited recognition in patent matters.*

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the United States Government to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 *bis* and 90.1.

### *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 United States Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and § 11.9). 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 applicant, in the Demand form, signed by applicant, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

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

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

For representation in international applications, see [MPEP § 1807](#).

## 402.10 Appointment/Revocation by Less Than All Applicants or Owners [R-11.2013]

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 under [37 CFR 1.36\(a\)](#) and fee under [37 CFR 1.17\(f\)](#) with a showing of sufficient cause (if revocation), or a petition under [37 CFR 1.183](#) and fee under [37 CFR 1.17\(f\)](#) (if appointment) demonstrating the extraordinary situation where justice requires waiver of the requirement of [37 CFR 1.32\(b\)\(4\)](#). The petition should be directed to the Office of Petitions. The appointment and/or revocation are not accepted until the petition under [37 CFR 1.36\(a\)](#) or [1.183](#) is granted. Therefore, the attorney or agent newly appointed by such papers is not permitted to submit any documents (such as an information disclosure statement (IDS)) into the application file until the petition under [37 CFR 1.36\(a\)](#) or [1.183](#) is granted. The acceptance of such papers by petition under [37 CFR 1.36\(a\)](#) or [1.183](#) 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 [pre-AIA 37 CFR 1.47\(a\)](#), an assignee of the entire interest of the available inventors (i.e., the applicant) who has signed the declaration may appoint or revoke a power of attorney without a petition under [37 CFR 1.36\(a\)](#) or [1.183](#). See [MPEP § 402.07](#). However, in applications accepted under [pre-AIA 37 CFR 1.47](#), such a petition under [37 CFR 1.36\(a\)](#) or [1.183](#) 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. 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 to a different correspondence address. 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 to a patent practitioner and coinventor B has not, replies must be signed by the patent practitioner of A and by coinventor B.

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

### **403 Correspondence — With Whom Held; Customer Number Practice [R-11.2013]**

[37 CFR 1.33](#) states that when an attorney or agent has been duly appointed to prosecute an application,

correspondence will be held with the attorney or agent unless some other correspondence address has been given. If an attorney or agent of record assigns a correspondence address which is different than an address where the attorney or agent normally receives mail, the attorney or agent is reminded that [37 CFR 11.106](#) requires the attorney or agent to keep information obtained by attorney/agent – client relationship in confidence. Double correspondence with an applicant and his or her attorney, or with two representatives, will not be undertaken. See [MPEP §§ 403.01\(a\)](#), [403.01\(b\)](#), [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.

See [MPEP § 403.01\(a\)](#) for additional information pertaining to correspondence in applications filed on or after September 16, 2012. See [MPEP § 403.01\(b\)](#) for additional information pertaining to correspondence in applications filed before September 16, 2012.

#### **I. CUSTOMER NUMBER PRACTICE**

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

- (A) designate the correspondence address of a patent application or patent such that the correspondence address for the patent application or patent would be the address associated with the Customer Number ([37 CFR 1.32\(a\)\(5\)\(i\)](#));

(B) designate the fee address ([37 CFR 1.363](#)) of a patent such that the fee address for the patent would be the address associated with the Customer Number ([37 CFR 1.32\(a\)\(5\)\(ii\)](#)); and

(C) submit a list of practitioners such that those practitioners associated with the Customer Number would have power of attorney ([37 CFR 1.32\(a\)\(5\)\(iii\)](#)).

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.

Applicant may use either the same or different customer number(s) for the correspondence address, the fee address and/or a list of practitioners. The customer number associated with the correspondence address is the Customer Number used to obtain access to the Patent Application Information Retrieval (PAIR) system at <http://pair.uspto.gov>. See [MPEP § 1730](#) for additional information regarding PAIR.

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; and

(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.

The Office will also accept requests on electronic storage media submitted electronically to 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. Instructions for submitting such requests are available on the “Customer Number Upload Spreadsheet” available at [www.uspto.gov/learning-and-resources/support-centers/patent-electronic-business-center](http://www.uspto.gov/learning-and-resources/support-centers/patent-electronic-business-center).

Such electronic requests must comply with the requirements 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).

With Customer Number practice, a patentee is also 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 by submitting a corresponding “Request for Customer Number Data Change” (PTO/SB/124) will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant or assignee of the entire interest of the 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 is optional, in that any applicant may continue to individually name those practitioners to represent the applicant in a patent application, so long as fewer than ten patent practitioners are named. See [37 CFR 1.32\(c\)\(3\)](#).

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 associated 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 that 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 will generally be resolved in favor of the address of the Customer Number or the application data sheet ([37 CFR 1.76\(d\)](#)). 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 for the correspondence address.

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. Furthermore, Office computer systems do not allow for entry of both a power of attorney to a list of practitioners associated with a Customer Number and a list of practitioners.

Although Customer Numbers are designed to designate both a correspondence address and to

associate one or more patent practitioners with an application, one Customer Number may be used for the correspondence address, and another Customer Number may be used for the power of attorney.

Applicants are strongly cautioned not to attempt to appoint more than one Customer Number for a particular purpose (e.g., correspondence address) in a single communication, as such action will **not** have a cumulative effect.

The Office has created a Mail Stop designation for correspondence related to a Customer Number (“Mail Stop EBC”), and all correspondence related to a Customer Number (e.g., requests for a Customer Number) should be addressed to this mail stop designation.

The following persons are authorized to change the information associated with an established Customer Number: (1) a registered practitioner associated with the Customer Number; and (2) the person who requested the Customer Number (signed the Request for Customer Number, Form PTO/SB/125).

## II. 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 filed in the U.S. Patent and Trademark Office, if it includes at least a specification prescribed by [35 U.S.C. 112](#) containing a description pursuant to [37 CFR 1.71](#) and at least one claim pursuant to [37 CFR 1.75](#), and any drawing required by [37 CFR 1.81\(a\)](#). If a nonprovisional application which has been accorded a filing date does not include the appropriate basic filing fee, search fee, examination fee, or inventor’s 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\(f\)](#) 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\(g\)](#) 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\(f\)](#) for nonprovisional applications and [37 CFR 1.16\(g\)](#) 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 [Reserved]

### 403.01(a) Correspondence in Applications Filed On or After September 16, 2012 [R-07.2015]

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

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ [1.76](#)), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ [1.76\(b\)\(1\)](#) and [1.63\(b\)\(2\)](#)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified, the Office will select one of the specified addresses for use as

the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed by the parties set forth in paragraph (b)(1) or (b)(3) of this section. Prior to the appointment of any power of attorney under § [1.32\(b\)](#), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of § [1.34](#).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § [1.27\(c\)\(2\)\(iii\)](#) or [\(c\)\(2\)\(iv\)](#), filed in the application must be signed by:

- (1) A patent practitioner of record;
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § [1.34](#); or
- (3) The applicant (§ [1.42](#)). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination or supplemental examination proceeding will be directed to the correspondence address in the patent file. Amendments filed in a reexamination proceeding, and other papers filed in a reexamination or supplemental examination 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](#). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(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.

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § [11.11](#) of this title.

(f) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(g) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of



correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

[37 CFR 1.33\(a\)](#) specifies that if an applicant provides more than one correspondence address (in a single paper or in different papers), the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the correspondence address associated with a Customer Number over a typed correspondence address. However, the hierarchy provided in [37 CFR 1.76\(d\)](#) for inconsistencies between an application data sheet and other documents will still apply.

[37 CFR 1.33\(a\)](#) also provides that the correspondence address may be changed by the parties set forth in [37 CFR 1.33\(b\)\(1\)](#) (a patent practitioner of record) or [37 CFR 1.33\(b\)\(3\)](#) (the applicant under [37 CFR 1.42](#)). Prior to the appointment of any power of attorney under [37 CFR 1.32\(b\)](#), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of [37 CFR 1.34](#). While a practitioner acting in a representative capacity cannot change the correspondence address in an application after a power of attorney has been appointed, [37 CFR 1.33\(g\)](#) provides that a practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

Amendments and other papers, except for written assertions pursuant to [37 CFR 1.27\(c\)\(2\)\(iii\)](#) or [\(c\)\(2\)\(iv\)](#), filed in the application must be signed by: (1) A patent practitioner of record; (2) a patent practitioner not of record who acts in a representative capacity under the provisions of [37 CFR 1.34](#); or (3) the applicant ([37 CFR 1.42](#)). Pursuant to [37 CFR 1.33\(b\)\(3\)](#), unless otherwise specified (e.g., terminal disclaimers and [37 CFR 3.73\(c\)](#) statements; see [MPEP § 325](#)), all papers submitted on behalf of a juristic entity must be signed by a patent practitioner, as [37 CFR 1.31](#) provides that a juristic entity may prosecute a patent application only through a patent practitioner.

Where application papers (e.g., the inventor's oath or declaration) from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. See [37 CFR 1.33\(f\)](#). Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

#### **403.01(b) Correspondence in Applications Filed Before September 16, 2012 [R-11.2013]**

##### *37 CFR 1.33 (pre-AIA) Correspondence respecting patent applications, reexamination proceedings, and other proceedings.*

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ [1.76](#)), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ [1.76\(b\)\(1\)](#) and [1.63\(c\)\(2\)](#)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of § 1.63 oath or declaration by any of the inventors.* If a § [1.63](#) oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § [1.63](#) oath or declaration has been

filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § [1.27\(c\)\(2\)\(ii\)](#) of this part, filed in the application must be signed by:

- (1) A patent practitioner of record appointed in compliance with § [1.32\(b\)](#);
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § [1.34](#);
- (3) An assignee as provided for under § [3.71\(b\)](#) of this chapter; or
- (4) All of the applicants (§ [1.41\(b\)](#)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § [3.71](#) of this chapter.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. 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](#). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(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.

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § [11.11](#) of this title.

[Pre-AIA 37 CFR 1.33\(a\)](#) provides for an applicant to supply an address to receive correspondence from the U.S. Patent and Trademark Office so that the 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.

[Pre-AIA 37 CFR 1.33\(a\)](#) provides that when filing a patent application the applicant must specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. The correspondence address must appear either in an application data

sheet ([37 CFR 1.76](#)) or in a clearly identifiable manner elsewhere in any papers submitted with an application filing. Where more than one correspondence address is specified, the Office will select one of the correspondence addresses for use as the correspondence address. This is intended to cover, for example, the situation where an application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying [pre-AIA 37 CFR 1.63](#) oath or declaration, or other similar situations. The Office will select which of the multiple correspondence addresses to use according to the following order: (A) application data sheet (ADS); (B) application transmittal; (C) oath or declaration (unless power of attorney is more current); and (D) power of attorney. If more than one correspondence address is specified in a single document, the Office will select the address associated with a Customer Number over a typed correspondence address.

[Pre-AIA 37 CFR 1.33\(a\)](#) requests the submission of a daytime telephone number of the party to whom correspondence is to be addressed. While business is to be conducted on the written record ([37 CFR 1.2](#)), a daytime telephone number would be useful in initiating contact that could later be reduced to writing. The telephone number would be changeable by any party who could change the correspondence address.

[Pre-AIA 37 CFR 1.33\(a\)\(1\)](#) provides that any party filing the application and setting forth a correspondence address could later change the correspondence address provided that a [pre-AIA 37 CFR 1.63](#) oath/declaration by any of the inventors has not been submitted. If one joint inventor filed an application, the person who may change the correspondence address would include only the one inventor who filed the application, even if another inventor was identified on the application transmittal letter. If two of three inventors filed the application, the two inventors filing the application would be needed to change the correspondence address. Additionally, any registered practitioner named in the application transmittal letter, or a person who has the authority to act on behalf of the party that will be the assignee (if the application was filed by the party that will be the assignee), could change the

correspondence address. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. A company (to whom the invention has been assigned, or to whom there is an obligation to assign the invention) who files an application, is permitted to designate the correspondence address, and to change the correspondence address, until such time as a (first) [pre-AIA 37 CFR 1.63](#) oath/declaration is filed. The mere filing of a [pre-AIA 37 CFR 1.63](#) oath/declaration that does not include a correspondence address does not affect any correspondence address previously established on the filing of the application, or changed per [pre-AIA 37 CFR 1.63\(a\)\(1\)](#), even if the application was filed by a company that is only a partial assignee. The expression “party that will be the assignee,” rather than assignee, is used in that until a declaration is submitted, inventors have only been identified, and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, if the application transmittal letter indicates that the application is being filed on behalf of XYZ company, with an assignment to be filed later, XYZ company would be allowed to change the correspondence address without resort to [pre-AIA 37 CFR 3.73 \(b\)](#) until an executed oath or declaration is filed, and with resort to [pre-AIA 37 CFR 3.73\(b\)](#) after the oath or declaration is filed.

Where a correspondence address was set forth or changed pursuant to [pre-AIA 37 CFR 1.33\(a\)\(1\)](#) (prior to the filing of a [pre-AIA 37 CFR 1.63](#) oath or declaration), that correspondence address remains in effect upon filing of a [pre-AIA 37 CFR 1.63](#) declaration and can then only be changed pursuant to [pre-AIA 37 CFR 1.33\(a\)\(2\)](#).

In a joint application with no power of attorney to either a registered practitioner or joint inventor, 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 §§ 402](#) and [714.01\(a\)](#). If the assignee of the entire interest of the applicant is prosecuting the application ([MPEP § 402.07](#)), the assignee may specify a correspondence address.

[Pre-AIA 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 are not recognized by the U.S. Patent and Trademark Office. See [MPEP § 402](#). However, the firm’s address may be used for 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

Patent practitioners are reminded that the attorney and agent roster must be updated separately from and in addition to any change of address filed in individual patent applications.

See [MPEP § 601.03](#) for change of correspondence address.

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

#### **403.02 Two Patent Practitioners for Same Application [R-11.2013]**

If the applicant simultaneously appoints two patent practitioners, applicant should indicate with whom correspondence is to be conducted by specifying a correspondence address. See [MPEP §§ 403, 403.01\(a\)](#), and [MPEP § 403.01\(b\)](#).

If, after one patent practitioner is appointed, a second patent practitioner is later appointed without revocation of the power of the first patent practitioner, correspondence will be mailed to the

latest correspondence address of record. See [37 CFR 1.33](#) and [1.76](#)

#### **404 [Reserved]**

#### **405 Interviews With Patent Practitioner Not of Record [R-07.2015]**

Papers may be filed in patent applications and reexamination proceedings by registered attorneys or agents not of record under [37 CFR 1.34](#). 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. See [MPEP § 402.03](#). Interviews may be conducted with a registered practitioner who has proper authority from the applicant or attorney or agent of record in the form of a power of attorney or authorization to act in a representative capacity, whether or not the

practitioner has a copy of the application file. See [MPEP § 713.05](#). Registered practitioners, when acting in a representative capacity, can alternatively show authorization to conduct an interview by completing, signing and filing an Applicant Initiated Interview Request Form (PTOL-413A). See [MPEP §§ 713.01](#) and [713.05](#). This eliminates the need to file a power of attorney or authorization to act in a representative capacity before having an interview. However, an interview concerning an application that has not been published under [35 U.S.C. 122\(b\)](#) with an attorney or agent not of record who obtains authorization through use of the interview request form will be conducted based on the information and files supplied by the attorney or agent in view of the confidentiality requirements of [35 U.S.C. 122\(a\)](#). Such a paper may be a Form/PTO/SB/84, "Authorization to Act in a Representative Capacity," which is available from the USPTO website at [www.uspto.gov/sites/default/files/web/forms/sb0084.pdf](http://www.uspto.gov/sites/default/files/web/forms/sb0084.pdf).

PTO/SB/84 (11-08)

Approved for use through 11/30/2011. OMB 0651-0035

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

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**AUTHORIZATION TO ACT IN A REPRESENTATIVE CAPACITY**

In re Application of:	
Application No.	
Filed:	
Title:	
Attorney Docket No.	Art Unit:

The practitioner named below is authorized to conduct interviews and has the authority to bind the principal concerned. (Note: pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure.) Furthermore, the practitioner is authorized to file correspondence in the above-identified application pursuant to 37 CFR 1.34:

Name	Registration Number

**This is not a Power of Attorney to the above-named practitioner.** Accordingly, the practitioner named above does **not** have authority to sign a request to change the correspondence address, a request for an express abandonment, a disclaimer, a power of attorney, or other document requiring the signature of the applicant, assignee of the entire interest or an attorney of record. If appropriate, a separate Power of Attorney to the above-named practitioner should be executed and filed in the United States Patent and Trademark Office.

**SIGNATURE of Practitioner of Record**

Signature		Date
Name		Registration No., if applicable
Telephone		

This collection of information is required by 1.31, 1.32 and 1.34. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

See [MPEP § 402.03](#) for information regarding when a change of correspondence address or a document granting access (i.e., a power to inspect) may be signed by an attorney or agent who is not of record.

#### **406 Death of Patent Practitioner [R-11.2013]**

The power of attorney of a patent practitioner will be revoked or terminated by his or her death. The patent practitioner may not appoint a “substitute” and any attempt by the patent practitioner to appoint a “substitute” patent practitioner whose power is intended to survive his or her own will not be recognized by the Office.

If notification of the death of the sole practitioner of record is received by the Office, correspondence continues to be held with the office of the deceased practitioner but a copy of the Office action is also mailed to the person who originally appointed the practitioner. In such an Office action, the examiner should add form paragraph 4.03.

##### **¶ 4.03 Death of Patent Practitioner**

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, this action is being mailed to the office of the patent practitioner and to the party who originally appointed the deceased patent practitioner. A new registered attorney or agent may be appointed.

Note [MPEP § 405](#).

#### **407 Suspended or Excluded Patent Practitioner [R-11.2013]**

Any power of attorney given to a practitioner who has been suspended or disbarred by the Office is ineffective, and does not authorize the person to practice before the Office or to represent applicants or patentees in patent matters.

See [MPEP § 105](#).

Form paragraphs 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.

##### **¶ 4.07 Attorney/Agent Suspended (Sole Practitioner)**

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 applicant first named in the application. Applicant(s) may 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, for applications filed before September 16, 2012, all 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](#).

For applications filed on or after September 16, 2012, all papers must be signed by: (1) a patent practitioner of record; (2) a patent practitioner not of record who acts in a representative capacity under the provisions of [37 CFR 1.34](#); or (3) the applicant, except that papers submitted on behalf of a juristic entity applicant must be signed by a patent practitioner.

Applicants may obtain a list of registered patent attorneys and agents located in their area by consulting the USPTO website, <https://oedci.uspto.gov/OEDCI/>, or by calling the Office of Enrollment and Discipline at (571) 272-4097.

##### **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.
4. The Office action is to be mailed only to the applicant first named in the application at that applicant's current 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 applicant first named in the application. 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 form paragraph 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 applicant first named in the application at that applicant's current address of record.

#### **408 Interviews With Patent Practitioner of Record [R-07.2015]**

The Office encourages the use of interviews to expedite prosecution. When the examiner believes the progress of the application would be advanced by an interview, he or she may contact the patent practitioner of record in the application (in accordance with [MPEP § 502.03](#)) and suggest a telephonic, personal, or video conference interview. Registered attorneys or agents not of record in a patent application and acting in a representative capacity under [37 CFR 1.34](#) should not be contacted for restriction requirements or approval of examiner's amendments. In addition, non-registered representatives of the practitioner of record should not be contacted for such actions, even if apparently authorized by the attorney or agent of record. See [MPEP § 812.01](#) for telephone restriction practice. See [MPEP § 405](#) for interviews with a patent practitioner not of record. See also [MPEP §§ 101-104](#) for information regarding access to application information by persons other than a patent practitioner of record.

When applicant is initiating a request for an interview, an "Applicant Initiated Interview Request" form (PTOL-413A) should be submitted to the

examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. See [MPEP §§ 713.01](#) and [713.05](#).

#### **409 Death, Legal Incapacity, or Unavailability of Inventor [R-11.2013]**

For information regarding applications for patent filed on or after September 16, 2012 on behalf of a deceased or legally incapacitated inventor, see [MPEP § 409.01\(a\)](#). For information regarding applications for patent filed on or after September 16, 2012 where the inventor or at least one joint inventor is unavailable, see [MPEP § 409.02](#), [604](#), and [605](#).

For information regarding applications for patent filed before September 16, 2012 on behalf of a deceased inventor or legally incapacitated inventor, see [MPEP § 409.01\(b\)](#). For information regarding applications for patent filed before September 16, 2012 where at least one inventor is unavailable, see [MPEP §§ 409.03 – 409.03\(j\)](#).

#### **409.01 [Reserved]**

#### **409.01(a) Deceased or Legally Incapacitated Inventor - Application Filed on or After September 16, 2012 [R-11.2013]**

*[Editor Note: See [MPEP § 409.01\(b\)](#) for information pertaining to a deceased or legally incapacitated inventor in an application filed before September 16, 2012.]*

#### **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 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.*

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent

on behalf of the inventor. If an 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. See § 1.64 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an 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. See 35 U.S.C. 117. See 37 CFR 1.64 and MPEP § 604 concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

#### **409.01(b) Deceased or Legally Incapacitated Inventor- Application Filed Before September 16, 2012 [R-11.2013]**

*[Editor Note: See MPEP § 409.01(a) for information pertaining to a deceased or legally incapacitated inventor in an application filed on or after September 16, 2012.]*

##### **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 (pre-AIA) 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.

##### **37 CFR 1.43 (pre-AIA) 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.

#### **I. TERMINATION OF POWER OF ATTORNEY – DECEASED INVENTOR**

Unless a power of attorney is coupled with an interest (i.e., a patent practitioner 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 in an application filed before September 16, 2012. 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. See also [pre-AIA 37 CFR 1.422](#).

#### **II. PROSECUTION BY LEGAL REPRESENTATIVE, ADMINISTRATOR OR EXECUTOR**

When an inventor becomes legally incapacitated prior to the filing of an application and prior to executing the oath or declaration required by [pre-AIA 37 CFR 1.63](#) and 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.

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 [pre-AIA 37 CFR 1.42](#).

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 the estate was under the sum required by state law for the appointment of an administrator. The heirs should identify themselves as the legal representative of the deceased inventor in the oath or declaration submitted pursuant to [pre-AIA 37 CFR 1.63](#) and [1.64](#).

#### **III. PROOF OF AUTHORITY OF ADMINISTRATOR OR EXECUTOR**

The Office no longer requires proof of authority of the legal representative of a deceased or incapacitated inventor. Although the Office does not require proof of authority to be filed, any person acting as a legal representative of a deceased or

incapacitated inventor should ensure that he or she is properly acting in such a capacity.

#### IV. 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 for an invention of the deceased inventor.

#### V. EXCEPTION IN SOME FOREIGN COUNTRIES

The terms “Executor” and “Administrator” do not have exact counterparts in all foreign countries, and therefore, those terms must be construed 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.

#### VI. IF INVENTOR OF ASSIGNED APPLICATION DIES

When an inventor who has prosecuted an application after assignment, dies, the administrator of the deceased inventor’s estate may carry on the prosecution upon filing letters of administration unless and until the assignee intervenes (see [MPEP § 402.07](#)).

#### VII. INTERVENTION OF EXECUTOR NOT COMPULSORY

When an inventor dies after filing an application and executing the oath or declaration required by [pre-AIA 37 CFR 1.63](#), 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 inventor(s) must submit proof that the other 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 USPTO if the legal representative of the deceased inventor does not intervene. If the legal representative of the deceased inventor wishes to intervene, the legal representative must submit an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [1.64](#) (e.g., stating that he or she is the legal representative of the deceased inventor and his or her residence, citizenship and post office address). 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 USPTO.

#### 409.02 Unavailable Joint Inventor – Application Filed on or after September 16, 2012 [R-11.2013]

*[Editor Note: See [MPEP § 409.03](#) et seq. for information pertaining to the unavailability of an inventor in an application filed on or after September 16, 2012.]*

##### *37 CFR 1.45 Application for patent by joint inventors.*

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by § [1.63](#), except as provided for in § [1.64](#). If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See § [1.64](#) concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

\*\*\*\*\*

Joint inventors must apply for a patent jointly, and each joint inventor must make the inventor’s oath or declaration required by [37 CFR 1.63](#), except as provided for in [37 CFR 1.64](#). See [35 U.S.C. 116\(a\)](#) (“[w]hen 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.”). [37 CFR 1.45\(a\)](#) provides



that if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor(s) may make the application for patent on behalf of themselves and the omitted inventor. [37 CFR 1.45\(a\)](#) also cross-references [37 CFR 1.64](#) concerning the execution of a substitute statement by the other joint inventor(s) in lieu of an oath or declaration. See [MPEP § 604](#) for additional information pertaining to substitute statements

### **409.03 Unavailability of Inventor - Application Filed Before September 16, 2012 [R-11.2013]**

*[Editor Note: [MPEP §§409.03 – 409.03\(j\)](#) are not applicable to patent applications filed under [35 U.S.C. 111\(a\)](#), [363](#), or [35 U.S.C. 385](#) on or after September 16, 2012. See [MPEP § 409.02](#) for information pertaining to the unavailability of an inventor in an application filed on or after September 16, 2012.]*

#### **35 U.S.C. 116 (pre-AIA) 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 Director, 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 Director may permit the application to be amended accordingly, under such terms as he prescribes.

#### **35 U.S.C. 118 (pre-AIA) 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 Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

#### ***37 CFR 1.47 (pre-AIA) 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\(g\)](#), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by 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\(g\)](#), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § [1.63](#).

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

Application papers submitted pursuant to [pre-AIA 37 CFR 1.47](#) are forwarded by the Office of Patent Application Processing (OPAP) to the Office of Petitions for a determination of whether the papers are proper, complete, and acceptable under [pre-AIA 37 CFR 1.47](#) and for a decision on the petition under [pre-AIA 37 CFR 1.47](#) before the application is sent to the Technology Center. 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 [pre-AIA 37 CFR 1.63](#) unless the application has been accorded status under [pre-AIA 37 CFR 1.47](#) in a written decision on the petition.

A *bona fide* attempt must be made to comply with the provisions of [pre-AIA 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 acceptable, the [pre-AIA 37 CFR 1.47](#) applicant will be notified of the reasons why the papers are not acceptable. The [pre-AIA 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 [pre-AIA 37 CFR 1.47](#) from the outset.

A decision granting a petition under [pre-AIA 37 CFR 1.47](#) does not alter the ownership interest or title of the application. If the nonsigning inventor has not signed an assignment document which has been recorded in the USPTO, then the [pre-AIA 37 CFR 1.47](#) applicant (the company that files the petition under [pre-AIA 37 CFR 1.47\(b\)](#) and establishes proprietary interest in the application) is NOT the assignee of the entire interest of the application.

#### **409.03(a) At Least One Joint Inventor Available [R-11.2013]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

[Pre-AIA 37 CFR 1.47\(a\)](#) and [pre-AIA 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 ([pre-AIA 35 U.S.C. 111\(a\)](#) and [115](#)), an application deposited in the U.S. Patent and Trademark Office pursuant to [pre-AIA 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 [pre-AIA 37 CFR 1.63](#) or [1.175](#) (see [MPEP §§ 602, 605.01, 602.09, and 1414](#)) and (2)

make oath or declaration on behalf of the nonsigning joint inventor as required by [pre-AIA 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 [R-08.2012]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

Filing under [pre-AIA 37 CFR 1.47\(b\)](#) and [pre-AIA 35 U.S.C. 118](#) is permitted only when no inventor is available to make application. These provisions allow a “person” with a demonstrated proprietary interest to make application “on behalf of and as agent for” an inventor who “cannot be found or reached after diligent effort” or who refuses to sign the application oath or declaration. The word “person” has been construed by the U.S. Patent and Trademark Office to include juristic entities, such as a corporation. Where [pre-AIA 37 CFR 1.47\(a\)](#) is available, application cannot be made under [pre-AIA 37 CFR 1.47\(b\)](#).

In addition to other requirements of law ([pre-AIA 35 U.S.C. 111\(a\)](#) and [115](#)), an application deposited pursuant to [pre-AIA 37 CFR 1.47\(b\)](#) must meet the following requirements:

(A) The [pre-AIA 37 CFR 1.47\(b\)](#) applicant must make the oath required by [pre-AIA 37 CFR 1.63](#) and [1.64](#) or [1.175](#). Where a corporation is the [pre-AIA 37 CFR 1.47\(b\)](#) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. 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 [pre-AIA 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 [pre-AIA 37 CFR 1.47\(b\)](#).

(B) The [pre-AIA 37 CFR 1.47\(b\)](#) applicant must state his or her relationship to the inventor as required by [pre-AIA 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 [pre-AIA 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 [pre-AIA 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) Unavailable Legal Representative of Deceased Inventor [R-11.2013]**

*[Editor Note: This MPEP section is not applicable to applications filed on or after September 16, 2012.]*

[Pre-AIA 37 CFR 1.47](#) should not be considered an alternative to [pre-AIA 37 CFR 1.42](#) or [pre-AIA 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 [pre-AIA 37 CFR 1.42](#) and [MPEP § 409.01](#). However, [pre-AIA 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\(e\)](#)).

### **409.03(d) Proof of Unavailability or Refusal [R-07.2015]**

*[Editor Note: This MPEP section is not applicable to applications filed on or after September 16, 2012.]*

#### **I. INVENTOR CANNOT BE REACHED**

Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under [pre-AIA 37 CFR 1.47](#), a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under [pre-AIA 37 CFR 1.47](#).

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under [pre-AIA 37 CFR 1.47](#). [Pre-AIA 37 CFR 1.43](#) may be available under these circumstances. See [MPEP § 409.01\(b\)](#). Such a petition under [pre-AIA 37 CFR 1.47](#) will be dismissed as inappropriate.

The statement 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 Internet searches, certified mail return receipts, cover letters of

instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

## II. REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. 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. The fact that an application may contain proprietary information does not relieve the [pre-AIA 37 CFR 1.47](#) applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See [MPEP § 106](#). It is reasonable to require that the inventor be presented with the application papers before a petition under [pre-AIA 37 CFR 1.47](#) is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof 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, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the [pre-AIA 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 the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, 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 petition. See also [MPEP § 1702](#).

### **409.03(e) Statement of Last Known Address [R-08.2012]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

An application filed pursuant to [pre-AIA 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 § 602.08\(a\)](#). Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

Inasmuch as a nonsigning inventor is notified that an application pursuant to [pre-AIA 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 [R-08.2012]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012. See [MPEP §§ 325, 409.05, and 605](#) for information pertaining to applications for patent filed on or after September 16, 2012 by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.]*

When an application is deposited pursuant to [pre-AIA 37 CFR 1.47\(b\)](#), the [pre-AIA 37 CFR 1.47\(b\)](#) applicant must prove that

- (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 [pre-AIA 37 CFR 1.47\(b\)](#) application was assigned to the [pre-AIA 37 CFR 1.47\(b\)](#) applicant. A statement under [pre-AIA 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 [pre-AIA 37 CFR 1.47\(b\)](#) applicant for the sole purpose of obtaining a filing date for a [pre-AIA 37 CFR 1.47\(b\)](#) application is not considered an assignment within the meaning of [pre-AIA 35 U.S.C. 118](#) and [pre-AIA 37 CFR 1.47\(b\)](#).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to [pre-AIA 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 a statement of facts by someone with first hand knowledge of the circumstances in which 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 ([pre-AIA 37 CFR 1.47\(b\)](#) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the [pre-AIA 37 CFR 1.47\(b\)](#) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the [pre-AIA 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 other 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 [pre-AIA 37 CFR 1.47\(b\)](#) applicant. The facts in support of any conclusion that a court would award title to the [pre-AIA 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 [R-11.2013]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

Irreparable damage may be established by a [pre-AIA 37 CFR 1.47\(b\)](#) applicant by a showing (a statement)



that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.

#### **409.03(h) Processing and Acceptance of a Pre-AIA 37 CFR 1.47 Application [R-08.2012]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

A filing date is assigned to an application deposited pursuant to [pre-AIA 37 CFR 1.47](#) provided the requirements of [37 CFR 1.53\(b\)](#) are met. A filing receipt will be sent to the applicant and the application, or an electronic message concerning the petition under [pre-AIA 37 CFR 1.47](#), will be forwarded to the Office of Petitions, for consideration of the petition filed under [pre-AIA 37 CFR 1.47](#).

When papers deposited pursuant to [pre-AIA 37 CFR 1.47](#) are found acceptable, the Office of Petitions enters a decision 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 U.S. 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 [pre-AIA 37 CFR 1.47](#) by sending a letter to the last known address of the nonsigning inventor(s) or legal representative(s). In a continuation or divisional application filed under [37 CFR 1.53\(b\)](#) of an application accorded status under [pre-AIA 37 CFR 1.47](#), if a copy of a declaration from a prior application and a copy of a decision according status under [pre-AIA 37 CFR 1.47](#) are filed as permitted by [pre-AIA 37 CFR 1.63\(d\)\(3\)\(i\)](#), the notice will not be repeated. See [pre-AIA 37 CFR 1.47\(c\)](#). In addition, the notice is not repeated in continued prosecution applications filed under [37 CFR 1.53\(d\)](#).

#### **409.03(i) Rights of the Nonsigning Inventor [R-08.2012]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

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 U.S. Patent and Trademark Office will grant the nonsigning inventor access to the application, *inter partes* proceedings will not be instituted in a [pre-AIA 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 [pre-AIA 37 CFR 1.47](#) has been accorded, or if proprietary interest of the [pre-AIA 37 CFR 1.47\(b\)](#) applicant has been shown to the satisfaction of the U.S. Patent and Trademark Office.

A nonsigning inventor may join in a [pre-AIA 37 CFR 1.47](#) application. To join in the application, the nonsigning inventor must file an appropriate [pre-AIA 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. See [MPEP § 402.10](#).

The rights of a nonsigning inventor are protected by the fact that the patent resulting from an application filed under [pre-AIA 37 CFR 1.47\(b\)](#) and [pre-AIA 35 U.S.C. 118](#) must issue to the inventor, and in an application filed under [pre-AIA 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 [pre-AIA 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

[pre-AIA 37 CFR 1.47](#) application. If the claims in both the nonsigning inventor's application and the [pre-AIA 37 CFR 1.47](#) application are otherwise found allowable, an interference may be declared.

#### **409.03(j) Action Following Acceptance of a Pre-AIA 37 CFR 1.47 Application [R-11.2013]**

*[Editor Note: This MPEP section is **not applicable** to applications filed on or after September 16, 2012.]*

After an application deposited pursuant to [pre-AIA 37 CFR 1.47](#) is found acceptable by the 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 [pre-AIA 37 CFR 1.47](#) status, will be placed in the file wrapper.

In the event the previously nonsigning inventor decides to join in the application by filing an executed oath or declaration complying with [pre-AIA 37 CFR 1.63](#), the oath or declaration will be placed in the application file.

When an examiner receives an application in which a petition under [pre-AIA 37 CFR 1.47](#) has been filed, he or she must check the file to determine that the petition has been decided by the Office of Petitions. If the petition has not been decided by the Office of Petitions, the application, or an electronic message concerning the petition, must be forwarded to the Office of Petitions for appropriate action.

An application filed under [pre-AIA 37 CFR 1.47](#) can be published as a Statutory Invention Registration (provided the request for a Statutory Invention Registration was filed before March 16, 2013).

#### **409.04 [Reserved]**

#### **409.05 Application For Patent by an Assignee, Obligated Assignee, or a Person Who Otherwise Shows Sufficient Proprietary**

#### **Interest – Application Filed On or After September 16, 2012 [R-07.2015]**

*[Editor Note: This MPEP section is **only applicable** to applications filed on or after September 16, 2012.]*

*37 CFR 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.*

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an 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 appropriate to preserve the rights of the parties.

(b) If an application under [35 U.S.C. 111](#) is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § [1.76](#) specifying in the applicant information section (§ [1.76\(b\)\(7\)](#)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under [35 U.S.C. 371](#), or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in § [1.17\(g\)](#)

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

*37 CFR 1.64 Substitute statement in lieu of an oath or declaration.*

(a) An applicant under § [1.43](#), [1.45](#) or [1.46](#) may execute a substitute statement in lieu of an oath or declaration under §

[1.63](#) if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under § [1.63](#), or cannot be found or reached after diligent effort.

(b) A substitute statement under this section must:

(1) Comply with the requirements of § [1.63\(a\)](#), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state;

(2) Identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with § [1.76](#), the residence and mailing address of the person signing the substitute statement;

(3) Identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under § [1.63](#), namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under § [1.63](#); and

(4) Unless the following information is supplied in an application data sheet in accordance with § [1.76](#), also identify:

(i) Each inventor by his or her legal name; and

(ii) The last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

## I. ASSIGNEE OR OBLIGATED ASSIGNEE

An assignee or obligated assignee may file a patent application as the applicant. An assignee or obligated assignee doing so should record documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for an obligated assignee) as provided for in 37 CFR part 3 no later than the date the issue fee is paid in the application. See [37 CFR 1.46\(b\)\(1\)](#).

See [37 CFR 1.64](#) concerning the execution of a substitute statement by an assignee or obligated assignee in lieu of an inventor's oath or declaration (available when an inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under [37 CFR 1.63](#)). See also [MPEP § 604](#).

## II. SUFFICIENT PROPRIETARY INTEREST

[37 CFR 1.46\(a\)](#) provides that a person who otherwise shows sufficient proprietary interest in the matter may make an 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 appropriate to preserve the rights of the parties. The ability for a person who otherwise shows sufficient proprietary interest in the matter to make an application for patent is not limited to situations in which all of the inventors refuse to execute the application, or cannot be found or reached after diligent effort.

Section 1.46(b)(2) provides that if the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including: (1) The fee set forth in § [1.17\(g\)](#); (2) a showing that such person has sufficient proprietary interest in the matter; and (3) a statement that making the application for patent by a person who otherwise shows sufficient proprietary interest on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties. See [37 CFR 1.64](#) concerning the execution of a substitute statement by a person who otherwise shows sufficient proprietary interest in the matter in lieu of an inventor's oath or declaration. See also [MPEP § 604](#).

A proprietary interest obtained other 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 1.46](#) applicant. The facts in support of any conclusion that a court would award title to the [37 CFR 1.46](#) 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.

## 410 Representations to the U.S. Patent and Trademark Office [R-07.2015]

### 37 CFR 1.4 Nature of correspondence and signature requirements.

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(d)

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#### (4) Certifications—

(i) *Certification as to the paper presented.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter. Violations of § 11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this subchapter. Any practitioner violating § 11.18(b) of this subchapter may also be subject to disciplinary action. See § 11.18(d) of this subchapter.

(ii) *Certification as to the signature.* The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. A person submitting a document signed by another under paragraph (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. Violations of the certification as to the signature of another or a person's own signature as set forth in this paragraph may result in the imposition of sanctions under § 11.18(c) and (d) of this chapter.

(5) *Forms.* The Office provides forms for the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (e.g., oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 37 CFR 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.

(e) The following correspondence must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent:

(1) Correspondence requiring a person's signature and relating to registration to practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings; and

(2) Payments by credit cards where the payment is not being made via the Office's electronic filing systems.

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### 37 CFR 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d) or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (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 Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully 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 any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

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

(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 any proceeding before the Office;

(ii) The 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 evidentiary 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 any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

- (1) Striking the offending paper;
  - (2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
  - (3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
  - (4) Affecting the weight given to the offending paper;
- or
- (5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[37 CFR 1.4\(d\)\(4\)](#) and [\(5\)](#) provide that the presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper or Office form by a party, whether a practitioner or nonpractitioner, constitutes a certification under [37 CFR 11.18\(b\)](#), and that violations of [37 CFR 11.18\(b\)\(2\)](#) may subject the party to sanctions under [37 CFR 11.18\(c\)](#). Thus, by presenting to the Office a paper or Office form, the party is making the certifications set forth in [37 CFR 11.18\(b\)](#), and is subject to sanctions under [37 CFR 11.18\(c\)](#) for violations of [37 CFR 11.18\(b\)\(2\)](#), regardless of whether the party is a practitioner or nonpractitioner. A practitioner violating [37 CFR 11.18\(b\)](#) may also be subject to disciplinary action in lieu of or in addition to sanctions under [37 CFR 11.18\(c\)](#) for violations of [37 CFR 11.18\(b\)](#). See [37 CFR 11.18\(d\)](#).

Additional certifications provided in [37 CFR 1.4\(d\)\(4\)](#) and [\(5\)](#) include that a person inserting a signature into a document under [37 CFR 1.4\(d\)\(2\)](#) certifies that the inserted signature appearing in the document is his or her own signature. Also, a person filing a document signed by another under [37 CFR 1.4\(d\)\(2\)](#) is obligated to have a reasonable basis to believe that the signature present on the document was actually inserted by that person. The person filing the document should retain evidence of the authenticity of the signature. See [37 CFR 1.4\(h\)](#).

[37 CFR 11.18\(b\)](#) provides that, by presenting any paper to the USPTO, 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. [37 CFR 1.4\(d\)\(5\)](#) makes clear that presenting a completed Office form to the USPTO constitutes a specific certification under [37 CFR 11.18\(b\)](#).

The first certification has permitted the USPTO to eliminate the separate verification requirement previously contained in several rules for statements of facts by persons who are not registered to practice before the USPTO. As statements submitted to the USPTO by any person are now, by operation of [37 CFR 11.18\(b\)\(1\)](#), verified statements, a separate verification requirement is no longer necessary. The USPTO, however, has retained the verification 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](#), [1.64](#), [1.130](#), [1.131](#), [1.132](#), [1.495\(f\)](#), and [5.25](#)).

The second certification is based upon Rule 11(b) of the Federal Rules of Civil Procedure (2007). This provision is promulgated pursuant to the Director's authority under [35 U.S.C. 2\(b\)\(2\)](#) to establish regulations for the conduct of proceedings in the USPTO, and is intended to discourage the filing of frivolous papers by practitioners or non-practitioners in the USPTO. Rule 11(b) of the Federal Rules of Civil Procedure provides:

**Representations to Court.** By presenting to the court a pleading, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney or unrepresented party certifies 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, cause unnecessary delay, or needlessly increase the cost of litigation;
- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;



(3) the factual contentions have evidentiary support or, if specifically so identified, will likely 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 belief or a lack of information.

Fed. R. Civ. P. 11(b)(2007).

[37 CFR 11.18\(b\)\(2\)](#) includes the same substantive requirements as Fed. R. Civ. P. 11(b). The advisory committee notes to the 1993 revision of 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 as of 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 pleadings 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 suffice 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). An “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\(d\)\(4\)](#) and [\(5\)](#) and [11.18](#) do not require a practitioner to advise the client (or third party) providing information of this certification effect (or the sanctions applicable to noncompliance), 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 11.18](#) 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 11.18](#) (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 have 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).

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). Thus, the “inquiry reasonable under the circumstances” requirement of [37 CFR 11.18](#) 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 11.18](#), 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\(a\)](#) was unintentional).

[37 CFR 11.18\(c\)](#) specifically provides that violations of [37 CFR 11.18\(b\)\(1\)](#) 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 11.18\(b\)\(2\)\(i\)](#) through [\(iv\)](#) are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of:

- (1) Striking the offending paper;
- (2) Referring a practitioner’s conduct to the Director of Enrollment and Discipline for appropriate action;
- (3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
- (4) Affecting the weight given to the offending paper; or
- (5) Terminating the proceedings in the Office

The Office has amended [37 CFR 1.4\(d\)\(4\)](#) and [11.18](#) with the objective of discouraging the filing of frivolous or clearly unwarranted correspondence in the Office, not to routinely review correspondence for compliance with [37 CFR 11.18\(b\)\(2\)](#) and impose sanctions under [37 CFR 11.18\(c\)](#).

Where the circumstances of an application or other proceeding warrant a determination of whether there has been a violation of [37 CFR 11.18\(b\)](#), 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 11.18\(b\)](#). In the event that OED determines that a provision of [37 CFR 11.18\(b\)](#) has been violated, the USPTO Director will determine what (if any) sanction(s) under [37 CFR 11.18\(c\)](#) is to be imposed in the application or other proceeding.

In addition, if OED determines that a provision of [37 CFR 11.18\(b\)](#) has been violated by a practitioner, OED will determine whether such practitioner is to be subject to disciplinary action (see [37 CFR 1.4\(d\)\(4\)](#) and [11.18\(d\)](#)). That is, OED will provide a determination of whether there has been a violation of [37 CFR 11.18\(b\)](#), 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 11.18\(c\)](#) in an application or other proceeding.

[37 CFR 11.18\(d\)](#) provides that any practitioner violating the provisions of this section may also be subject to disciplinary action. [37 CFR 11.18\(d\)](#) (and the corresponding provision of [37 CFR 1.4\(d\)\(4\)](#)) clarifies that a practitioner may be subject to disciplinary action in lieu of, or in addition to, the sanctions set forth in [37 CFR 11.18\(c\)](#) for violations of [37 CFR 11.18](#).