

Training Module for Chapter 4 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 4: Representative of Inventor or Owner

Section 401 – Power of Attorney; Acting in a Representative Capacity

- “Patent practitioner” = registered patent attorney or registered patent Agent
- “Power of Attorney” = a signed written document by which a principle authorizes one or more named patent practitioners or joint inventors to act on his or her behalf. (A power of attorney can only be assigned to an individual – not a law firm or other organization. However, power of attorney can be given to a group of practitioners at a law firm that has a common Customer Number)
- “Principal” = applicant for a patent or the assignee of the entire interest of the application for patent (or in re-examination the assignee of the entire ownership of a patent).
- “Revocation” = cancelling by the principal of authority previously given to a patent practitioner to act on his behalf.
- “Juristic Entity” = an organizational entity such as Google, HP, etc.

NOTE: A practitioner can act in a representative capacity in a patent case without filing a power of attorney. However, if he appears before the USPTO in person or by signature, his signature constitutes a representation to the USPTO that he is authorized to represent the particular party on whose behalf he is acting. (The practitioner must set forth his name signature and registration number. Further proof or authority may be required.)

- A practitioner becomes “of record” in a patent application by having the inventors execute a power of attorney and it is filed with the USPTO. But the rules do not require the practitioner to submit one.
- A practitioner of record desiring to withdraw from representation must file a petition to withdraw. If he is not “of record” no such filing is required and the principle is free to select another practitioner to represent himself.
- An applicant who is a juristic entity must be represented by a patent practitioner. An applicant for a patent, other than a juristic entity may file and prosecute his or her own application and thus act as his or her own representative,

NOTE: Generally, the patent office will not communicate with suspended practitioners unless they have an ownership interest in the application.

Section 402 – Power of Attorney: Naming Representative

- 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.
- Powers of attorney naming firms of attorneys or agents filed in patent applications will not be recognized.

Section 403 – Correspondence – With Whom Held

- When filing an application, a correspondence address must be set forth in either an application data sheet, or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing.

- If the applicant fails to provide the Office (USPTO) 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 1.17(g) for provisional applications. In such cases, 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.
- Generally, only a patent practitioner of record, a patent practitioner acting in a representative capacity or all of the applicants (***all co-inventors must act together***) may file papers with the Patent Office.
- A practitioner of record may change the correspondence address. However, a practitioner acting in a representative capacity may not change the correspondence address. (The USPTO will trust a representative at his word on filings – so long as he doesn’t try to change the correspondence address. That requires proof that he is “of record”.)
- If multiple correspondence addresses are inadvertently received by the USPTO, only one will be selected for response following this priority chain:
 - (1) application data sheet (ADS) – [first choice, if available]
 - (2) application transmittal
 - (3) oath or declaration
 - (4) power of attorney.

Section 406 – Death of Patent Practitioner

- The power of attorney of a patent practitioner will be revoked or terminated by his/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 own will not be

recognized by the USPTO.

- If notice of the principal (or sole) practitioner's death comes to the USPTO from an applicant or assignee, future return correspondence will be to the address of whoever appointed the deceased practitioner.

Section 409 – Death, Legal Incapacity, Unavailability of Inventor

- In case an inventor is deceased or under legal incapacity, the legal representative (guardian, conservator, etc.) 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 or the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.
- If a joint inventor refuses to join in an application for a patent or can not be found or reached after diligent effort, the application may be made by the other inventor(s) on behalf of the non-signing inventor. The oath must clearly explain the circumstances. And the non-signing inventor may join at a later date by filing his oath.
- If a non-signing inventor has previously made an assignment of his rights to a patent, the assignee may act as an agent on behalf of the inventor to file an application. The details must be explained in the oath or declaration. In this case, the USPTO will send notice of the filing of the application to all inventors who have not joined in the application to the addresses provided by the petition from the assignee.
- A minor inventor (under the age of 18) may execute an oath or declaration as long as the minors is competent to sign (i.e. understands the documentation that he is signing).

Employees of the USP&TO are not permitted to sign an oath or declaration for a patent application while at this job and for 12 months after they leave

it.

Selected Questions and Answers for Chapter 4

NONE

In-Depth Review of Chapter 4

Chapter 4 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

[Chapter 4 MPEP](#)