Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE JORGE A. GOLDSTEIN, PETITIONER
September 1, 1988

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Deputy Assistant Commissioner for Patents

Decision under 37 C.F.R. § 1.182 on Request to Continue Representation

***1** Jorge A. Goldstein, Esq., (hereafter "petitioner") filed on July 6, 1988 a paper entitled REQUEST TO CONTINUE AS REPRESENTATIVE OF RECORD in patent application Serial No. * * * filed * * * A REVOCATION AND POWER OF ATTORNEY and a RESPONSE TO REQUEST TO CONTINUE AS COUNSEL were filed on July 15, 1988 and July 28, 1988, respectively, by counsel representing an owner of an undivided part interest in the patent application.

The REQUEST is treated as a petition under 37 C.F.R. § 1.182. In his cover letter accompanying the REQUEST, petitioner authorized the Commissioner to charge any required fee to Deposit Account No. 19-0036. The petition fee of $140.00 (see 37 C.F.R. § § 1.17(h) and 1.182) is charged to that account.

I conclude, for the reasons given below, that petitioner may not continue as the sole representative of record. The REQUEST is denied. The record shows that petitioner alone cannot represent the interests of all the named inventors and those deriving title therefrom because the owners of an undivided part interest in the patent application have revoked petitioner's power of attorney and appointed new counsel to represent their interests.

In order to assure that all interests are properly and effectively represented, all further correspondence to the Patent and Trademark Office (PTO) must be signed by petitioner and by counsel for the ownership interest which canceled petitioner's power of attorney. Dual correspondence will not be permitted and the PTO will continue to correspond with petitioner, who will remain responsible for coordinating replies or submissions to the PTO.

Petitioner and counsel for the part interest are reminded that the statutory period for response in the patent application expires September 14, 1988.

BACKGROUND

Patent application Serial No. * * * entitled * * * was filed in the PTO by petitioner on January 8, 1987 in the names of Inventors A, B, C, D, E and F

The application was filed without oath. 37 C.F.R. § 1.53.

After the filing date, inventors A and B assigned their right, title, and interest in the invention to Company X [FN1] and the remaining inventors assigned their right, title, and interest in the invention to Company Y. [FN2] On July 17, 1987 petitioner filed a declaration signed by all the inventors appointing petitioner as their counsel. Petitioner also filed assignments for recordation transferring the appropriate interests of the inventors to Company X and Company Y, which assignments were duly recorded. [FN3] The record owners, therefore, are Company X and Company Y.

***2** At the time the patent application was prepared, Company X and Company Y were cooperating to develop new products. It appears however that later the previous good feelings between the companies were replaced with hostilities and during this time petitioner concluded that the inventive entity was in error. He concluded that the inventors who assigned their interests to Company Y were not inventors of the claimed subject matter. Company Y and the three inventors who assigned their interests to Company Y disagreed and maintained that all five individuals originally named as inventors are joint inventors here.

Petitioner filed his REQUEST setting out the above-indicated facts and asked for a PTO ruling that he be permitted to remain as attorney of record in the application. [FN4] Company Y and the three inventors associated therewith filed a revocation of the power of attorney of petitioner and appointed new counsel to represent their interests in the application. The same group also filed a response to the request--through new counsel--and advanced the position that the facts of this case call for dual correspondence with each of counsel for the Company X group (petitioner) and counsel for the Company Y group.

ANALYSIS

Although A and B transferred all of their interests in the application to Company X and C, D and E * * * transferred all of their interests in the application to Company Y, the interest of each Company X and Company Y is an undivided part interest in the application. By law, neither of the assignees is an owner of the entire interest in the application and may not control alone the prosecution of the application. The assignees may agree jointly on a common representative but the facts in this case show conclusively that there is disagreement.

Commissioner Robinson remarked in Ex parte Harrison, 1925 C.D. 122, 123 (Comm.Pat. 1924), "Under the [Patent Office] rules the assignee of an entire interest is entitled to control the prosecution of the application, but the assignee of the part interest is not." Since Company Y--as well as Company X-- is an assignee of a part interest only in the application, neither assignee has the sole right to control

the prosecution. The present rules contain no indication that the philosophy expressed by Commissioner Moore over sixty years ago is not applicable today. [FN5]

37 C.F.R. § 1.32 provides:

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

37 C.F.R. § 1.33(a) provides in part appropriate to this ruling:

Amendments and other papers filed in the application must be signed: (1) By the applicant, or (2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or (3) if there is an assignee of record of the entire interest, by such assignee, or (4) by an attorney or agent of record, or (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of [37 C.F.R.] § 1.34(a). Double correspondence ... with more than one attorney or agent ... will not be undertaken.

***3** In this case, even though the inventors have parted with all of their interests (and therefore have no right to prosecute the application), the ownership interest of each of Company X and Company Y is less than the entire interest in the application. Having less than the entire interest, neither Company X nor Company Y alone may control the case prosecution. The revocation by Company Y of petitioner's power of attorney, therefore, mandates that petitioner may not continue as the sole representative of the ownership interests in this case. Correspondence with the PTO must be signed by counsel for both ownership interests.

The petition is DENIED.

FN1. The assignment was executed by both inventors on and the paper was recorded in the PTO at * * * on * * *

FN2. The assignment was executed by all three inventors on * * * and recorded in the PTO at * * * on * * *

FN3. See footnotes 1 and 2.

FN4. The exhibits accompanying the REQUEST were not relied on for the present determination as none of the documents were signed or bore original signatures of all the indicated signatories.

FN5. See also Ex parte Sandstrom, 1904 C.D. 486, 487 (Comm.Pat.1904) where Commissioner Allen observed that "the inventor is permitted to prosecute the case to the exclusion of every one save the assignee of the entire interest." Here, of course, all inventors have assigned their interests to either Company X or Company Y, making Company X and Company Y the joint owners of the application.

16 U.S.P.Q.2d 1963

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