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OFFICE OF PETITIONS

In re Application of
Peter Palese et al.
Application No. 12/480,410
Filed: June 8, 2009
Attorney Docket No. REDL-1406

DECISION ON PETITION

This is a decision on the second renewed petitions under 37 CFR 1.181, 1.182 and/or 1.183, filed June 15, 2012.

The petitions under 37 CFR 1.181, 1.182 and 1.183 are **DENIED**¹

Petitioner requests reconsideration of the petition decision mailed July 14, 2012 which dismissed the petitions filed under 37 CFR 1.181, 1.182 and 1.183 to allow the Jones Day law firm (Jones Day) to be patent counsel for Mount Sinai School of Medicine of New York University (MSSM) in the instant application. For the first time, petitioner is also requesting that the Office not allow prosecution of the instant application to proceed because to do so would be a waste of agency resources.

As to the petition under 37 CFR 1.181:

The first issue raised by petitioner is that the Office not allow prosecution of the instant application to proceed as it is a waste of agency resources. Petitioner then presents a discussion of contested inventorship of the instant application and the prior applications upon which priority is claimed. However, priority of invention between a pending application and one or more pending applications and/or one or more unexpired patents is determined in an interference proceeding conducted before the Board of Patent Appeals and Interferences (see MPEP, chapter 2300). There is no basis to not allow prosecution based on inventorship disputes. Prosecution of a patent application cannot be characterized as a "waste of agency resources" regardless of any arguments presented concerning ownership.

The second issue raised by petitioner is reconsideration of the petition decision mailed July 14, 2012. The basis of this request is that MSSM is one of two assignees of the instant application

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

and therefore Jones Day, as the properly appointed counsel for MSSM, has the right to participate in the prosecution of this application.

Review of the assignment history shows that of the five (5) co-inventors, Peter Palese, Adolfo Garcia-Sastre and Thomas Muster assigned 100% of their rights to the instant application to MSSM and this assignment was recorded on February 3, 2010. Co-inventors, Andrej Egorov, Sabine Brandt and Thomas Muster assigned 100% of their rights of the instant application to Avir Green Hills Biotechnology Research Development Trade AG (Avir) and this assignment was recorded on June 11, 2010. Avir is represented by Loza & Loza LLP (Loza). It is noted that Thomas Muster assigned 100% of his rights to MSSM and by a later assignment assigned 100% of his rights to Avir. It is clear that there is a question of ownership of this application. However, the issue as to ownership is a question for a court of competent jurisdiction, see the decision mailed July 14, 2011, which is incorporated by reference.

Of the five co-inventors of the instant application, inventors Palese and Garcia-Sastre have Rule 47(a) status as non-signing inventors as granted in the petition decision mailed June 30, 2010.

Petitioner argues that since co-inventors Palese and Garcia-Sastre assigned their rights of the above-identified application to MSSM, that MSSM has the right to participate in the prosecution of the instant application through their attorneys, Jones Day. Petitioner recites 37 CFR 3.71(b) as support that partial assignees may together conduct prosecution of an application. MSSM and Avir are partial assignees who together own the entire right of the application. However, MPEP 402.10 specifically sets forth that in an application filed under 37 CFR 1.47(a) the assignee of the entire interest of the available inventors, that is, the inventors who have signed the declaration, may appoint or revoke a power of attorney. The three inventors who signed the declaration, Egorov, Brandt and Muster, assigned their entire interest to Avir and it is Avir who has the authority to appoint or revoke power of attorney in this application. The preceding petition decision took this position and the instant petition presents no rebuttal to this point.

As to the petitions under 37 CFR 1.182 and 1.183:

This second renewed petition is also filed under 37 CFR 1.182 which provides that in all situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation. As shown above, there are specific rules in place for determining who the assignee represents in situations where some applicants have signed the declaration and other inventors have Rule 47 status. Therefore, the rules of practice and the procedures before the USPTO provide for specific determination of who has power of attorney in the current fact pattern without relying upon extraordinary measures. For this reason, the petition cannot be granted and is denied. The petition is filed additionally under 37 CFR 1.183 which provides that in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner. The petition does not identify any requirement of the regulations for which waiver is requested and it is thus not clear from the petition what requirements of the rules need to be suspended. Therefore, this petition cannot be granted and is denied.

Telephone inquiries regarding this communication should be directed to Carl Friedman at (571) 272-6842.

A handwritten signature in dark ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Director
Office of Petitions/
Petitions Officer

Cc: Jones Day
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