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301 Assignability of Patents and Applications

Extract from 35 U.S.C. 261. A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima face evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

302 Effect of Recording

Extract from 35 U.S.C. 261. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for valuable consideration, without notice, unless it is recorded in the Patent Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

303 Endorsing Assignments on Pending Applications

The file jacket of an application ordinarily does *not* display the endorsement of an assignment during the period an application is before an Examiner.

The name of the assignee is endorsed on the file of an application only when it is submitted to the Assignment Branch for a title report. Therefore, the file jacket *cannot be relied upon* to accurately reflect the assignment status of an application while it is pending before an Examiner. Title searches are automatically made

in all applications after the payment of the issue fee.

When the determination of the assignment condition of an application is significant, as in the factual situations represented by Sections 304 and 305, it is necessary to submit the application to the Assignment Branch for a title report.

304 Conflicting Subject Matter in Two Applications of Same Inventor, One of Which Is Assigned

Where applicant has pending two applications with overlapping subject matter therein, and assigns one of the applications in its entirety, which assignment is duly recorded in the Patent Office, the assigned application at once may become a reference against the second application for all common subject matter disclosed, irrespective of the dates of filing of the two applications, and also of any subsequent assignment of the second case to another.

305 Different Inventors, Common Ownership

Where there is a common assignee of two or more applications by different inventors, these applications are subject by reason of their common ownership to treatment in general the same as though they were all the applications of the same inventor that were voluntarily separately filed; see Chapter 800 and *In re Stanley et al.*, 102 USPQ 234. Note, that in order to reject on the grounds of double patenting the cases must have the same inventive entity. See 804.

Where the applications disclose and claim patentably different inventions, there being no overlap of claims, or where the earlier filed application has issued as a patent and has become a statutory bar before filing of the other application, no problems arise.

305.01 Unclaimed Subject Matter in the Earlier Filed Application

If the second filed application claims subject matter disclosed but not claimed in the earlier filed application, 35 U.S.C. 102(e) applies and the earlier filed application is a reference (Section 706.02) unless it is removed (Section 715).

