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301 Assignability of Patents and Applications [R-43]

35 U.S.C. 261. Ownership; assignment. Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

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 facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

35 U.S.C. 262. Joint owners. In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

Rule 331. Recording of assignments. (a) Assignments, including grants and conveyances, of patents or

applications for patents under 35 U.S.C. 261, will be recorded in the Patent and Trademark Office. Other instruments affecting title to a patent or application for patent, and licenses, even though the recording thereof may not serve as constructive notice under 35 U.S.C. 261, will be recorded as provided in this rule or in the discretion of the Commissioner.

(b) No instrument will be recorded which is not in the English language and which does not amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates, and which does not identify the patent or application to which it relates, except as ordered by the Commissioner.

(c) An instrument relating to a patent should identify the patent by number and date (the name of the inventor and title of the invention as stated in the patent should also be given); an instrument relating to an application should identify the application by serial number and date of filing (the name of the inventor and title of the invention as stated in the application should also be given) but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed or before its serial number and filing date are ascertained, it should adequately identify the application, as by its date of execution and name of the inventor and title of the invention; so that there can be no mistake as to the patent or application intended.

Rule 333. Conditional assignments. Assignments which are made conditional on the performance of certain acts or events, as the payment of money or other condition subsequent, if recorded in the Office are regarded as absolute assignments for Office purposes until cancelled with the written consent of both parties or by the decree of a competent court. The Office has no means for determining whether such conditions have been fulfilled.

301.01 Accessibility of Assignment Records [R-30]

Rule 12. Assignment records open to public inspection. The assignment records, relating to original or reissue patents, including digests and indexes, are open to public inspection and copies of any instrument recorded may be obtained upon payment of the fee therefor. Assignment records, digests and indexes, relating to any pending or abandoned application are not available to the public. Copies of any such assignment records and information with respect thereto shall be

obtainable only upon written authority of the applicant or his assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules. An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number of the application, an extra charge will be made for the time consumed in making a search for such assignment.

Assignments relating to applications for registration of trademarks are open to public inspection.

The Office will not open certain parts only of an assignment document to public inspection. If such a document contains two or more items, any one of which, if alone, would be open to such inspection, then the entire document will be open. Thus, if an assignment covers either a trademark or a patent in addition to one or more patent applications, it will be available to the public *ab initio*; and if it covers a number of patent applications, it will be so available as soon as any one of them is patented. Assignments relating only to one or more pending applications for patent will not be open to public inspection.

If the application on which a patent was granted is a division or continuation of an earlier case, the assignment records of that case will be open to public inspection; similar situations involving continuation-in-part applications will be considered on their individual merits.

Assignment records relating to reissue applications are open to public inspection.

302 Effect of Recording [R-43]

Rule 332. Receipt and recording. Assignments are recorded in regular order as promptly as possible, and then transmitted with the date and identification of the record stamped thereon to the persons entitled to them. The date of record is the date of the receipt of the assignment at the Office in proper form and accompanied by the full legal fee for recording specified in 35 U.S.C. 41(a)10.

The Patent and Trademark Office will accept and record legible certified copies of original assignments or other instruments.

The certified copy, if not in the English language, will not be recorded unless accompanied by a translation signed by the translator.

Certification shall be to the fact that the instrument submitted is a true copy of the original and shall be made by a notary public or, if

in a foreign country, by a consular officer of the United States or an officer authorized to administer oaths and authenticated by a consular officer of the United States. Certification may also be made in the form of a declaration (rule 68).

303 Endorsing Assignments on Pending Applications [R-43]

The file wrapper 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 Division for a title report. Therefore, the file wrapper *cannot be relied upon* to accurately reflect the assignment status of an application while it is pending before an examiner.

Certified copies of patent applications as filed, do not include an indication of assignments. Applicants desiring an indication of assignments of record should request separately certified copies of assignment documents.

When the determination of the assignment condition of an application is significant, as in the factual situations represented by §§ 304 and 305, or when forwarding a form PO-850 to the Board of Patent Interferences, it is necessary to submit the application to the Assignment Division for a title report.

304 Conflicting Subject Matter in Two Applications of Same Inventor, One of Which Is Assigned [R-43]

Where applicant has pending two applications with overlapping subject matter claimed therein, and assigns one of the applications in its entirety, which assignment is duly recorded in the Patent and Trademark 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 assignee.

305 Different Inventors, Common Ownership [R-30]

Where there is a common assignee of two or more applications by different inventors involving conflicting subject matter see § 804.03. Note, that in order to reject on the grounds of double patenting the cases must have the same inventive entity. See § 804.

305.02 Claimed Subject Matter the Same or Not Patentably Different [R-27]

Where the applications by different inventors but of common ownership claim the same subject matter or subject matter that is not patentably different, questions of interference therebetween and with third parties are handled as indicated in §§ 804.03 and 1101.01(b).

306 Assignment of Division, Continuation, Substitute and Continuation-in-Part in Relation to Parent Case [R-36]

After the payment of the issue fee, a divisional, continuation, or substitute application is sent to the Assignment Division where the assignment of the original application is applied without charge to the later application, provided the date of the assignment of the original application was before the filing of the later application.

In the case of a continuation-in-part, a prior assignment of the original application is not applied to the continuation-in-part application because the assignment of the original application gives the assignee only the subject matter common to both applications. Continuation-in-part applications require separate assignments if they are to be issued to an assignee.

The heading of the printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, substitute, and reissue applications. It should be noted, however, that inclusion of this information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

The Assignment Division has discontinued mailing notification in cases where there is a conflict in assignment between an original application and its divisional, continuation, substitute, or continuation-in-part application. Where there are conflicting assignments, the patent will normally issue to the applicant.

307 Issue to Assignee [R-43]

35 U.S.C. 152. Issue of patent to assignee. Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

Rule 334. Issue of patent to assignee. In case of an assignment of the entire interest in the invention and application, or of the entire interest in the patent to be granted, the patent will normally issue to the as-

signee. If the assignee should hold an undivided part interest, the patent will normally issue jointly to the inventor and the assignee. If it is desired that the patent so issue the assignment in either case must first have been recorded, and at a day not later than the date payment is made of the issue fee or portion thereof specified in the notice of allowance. At the time of payment of the issue fee, a statement must be furnished indicating whether or not an assignment has been filed with the Patent and Trademark Office. In the event an assignment has been filed, such statement must include the name of the assignee and indicate whether or not an acknowledgment of a recorded assignment has been received from the Patent and Trademark Office.

For the patent to normally issue to an assignee, the assignment must be recorded in the Patent and Trademark Office at a date not later than the day on which the issue fee is paid.

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to him unless there are conflicting assignments.

308 Notice of Allowance Where Application Is Assigned [R-43]

The Issue Fee Transmittal Form portion (POL-85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with rule 334 (37 CFR 1.334). Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form POL-85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of POL-85b will not be granted as a matter of course and will be subject to adherence to all the requirements of rule 323 (37 CFR 1.323).

309 Restrictions Upon Employees of Patent Office [R-43]

35 U.S.C. 4. Restrictions on officers and employees as to interest in patents. Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.