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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 facie 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 a 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 Assignment Branch segregates assignments relating to pending applications; and entry clerks from that branch locate the file of the application and endorse on it the name of the assignee.

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 Rejection Because of Common Ownership

Where there is a common assignee of two or more applications by different inventors these applications by reason of their common ownership are subject in general to the same treatment as to overlapping claimed subject matter as though they were all the applications of one and the same inventor. That is, when the question of interference involving this common subject matter arises, the owner of the applications must, in the absence of any good reason to the contrary, elect which one shall be placed in interference. Claims in a later filed application should be rejected if they conflict with claimed subject matter in an earlier filed case of common ownership. If claims in the second application read on unclaimed subject matter in the earlier filed case, 35 U. S. C. 102 (e) still applies. See 706.02.

Where applications of different inventors having a common assignee contain conflicting claims, no interference is ordinarily instituted, and elimination of such claims from all but one application should usually be required, Rule 78 (b), Section 1101.01 (b). The common assignee must elect the application in which the conflicting subject matter is to be claimed; when one such case becomes a patent, the other should be rejected thereon. This rejection cannot be avoided by filing under Rule 321 a disclaimer of the invention claimed in the patent.

306 Assignment of Division, Continuation, Substitute and Continuation-in-Part in Relation to Parent Case

When a divisional, continuation, or substitute application is ready for allowance, it is sent to the Assignment Branch where the assignment of the original application is applied 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 as a matter of course to the continuation-in-part application because the assignment of the original application gives the assignee only the subject matter common to both applications. However, when a continuation-in-part is ready for allowance, it also is sent to the Assignment Branch to check for any conflict between the assignment of the original application and the assignment of the continuation-in-part as far as concerns the common subject matter. If such a conflict does exist the Assignment Branch notifies the proper parties that it should be corrected. If the conflict is not corrected the continuation-in-part will issue to the applicant and not to the assignee.

307 Issue to Assignee

For the patent to normally issue to an assignee, the assignment must be recorded in the Patent Office at a date not later than the day on which the final fee is paid; in the case of an application for reissue, the assignment must be recorded before the case is allowed; in the case of an application for a design patent, the as-

signment must be recorded at least ten days before the case is allowed.

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

In writing the notice of allowance of an application in which there is an assignment of record, after the name of the applicant, a comma followed by the expression "Assor, etc." should be written. This will serve to notify the addressee that the patent will issue to the assignee.

309 Restrictions Upon Employees of Patent Office

35 U. S. C. 4. Restrictions on officers and employees as to interest in patents. Officers and employees of the Patent 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.