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301 Assignability of Patents and Applications

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, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in 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.

37 CFR 1.331. Recording of assignments.

(a) Assignments, including grants and conveyances, of patents, national applications, or international applications which designate the United States of America, will be recorded in the Patent and Trademark Office under 35 U.S.C. 261. Other instruments affecting title to a patent, a national application, or an international application which designates the United States of America, 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 section or in the discretion of the Commissioner. Any instrument to be recorded, except those under Part 7 of this title, must be accompanied by the fee set forth in § 1.21(h).

(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 a national application, or an international application which designates the United States of America should identify the application by serial number or international application 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 or international application 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.

37 CFR 1.333. 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-11]

37 CFR 1.12. Assignment records open to public inspection.

(a) The assignment records, relating to original or reissue patents, including digests and indexes, and assignment records relating to pending or abandoned trademark applications and to trademark registrations, are open to public inspection and copies of any instrument recorded may be obtained upon request and payment of the fee set forth in § 1.19(a)(3)(*).

(b) Assignment records, digests, and indexes, relating to any pending or abandoned patent 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 applicant's 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.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in secrecy under § 1.14, or any information with respect thereto, must

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i)>(1)< or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee for attorney or agent of record.

(d) 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 or international application number of the application, an extra charge as set forth in § 1.21(f) 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 ****Recording >of Assignments< [R-11]**

37 CFR 1.332. 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 fee set forth in § 1.21(h).

>302.01 Assignment Document Must be Original or Certified for Recording [R-11]<

The Patent and Trademark Office will accept and record >only an original, or a legible certified copy of an original assignment or other instrument<.**

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 (37 CFR 1.68).

>302.02 Translation of Assignment [R-11]

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

>302.03 Identifying Patent or Application [R-11]

The patent or patent application involved in the assignment should be identified by patent number or application number. If the assignment is executed concurrently with or subsequent to the execution of the application but before the application number is ascertained, the application should be identified by the date of execution, and the name(s) of the inventors, and the title of the invention.

For accuracy of identification, the issue date of the patent or the filing date of the application should be included, as well as the patent number or application number.<

>302.04 Foreign Assignee May Designate Domestic Representative [R-11]

35 U.S.C. 293 Nonresident patentee; service and notice.

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

An assignee not domiciled in the United States may by written document signed by such assignee designate a domestic representative.

The designation of domestic representative should always be a paper *separate from* the assignment document, in order that the paper of designation can be retained in the appropriate application or patent file. Also, there should be a separate paper of designation of representative for each patent or application to which an assignment pertains, so that a designation paper can be placed in each file which is identified in the assignment document. The designation of a domestic representative should be directed to the Office of the Solicitor for processing.<

>302.05 Address of Assignee [R-11]

The address of the assignee or assignee's representative should either be recited in the assignment document or given in a separate paper.

Failure to furnish an address will interfere in the sending of mail to the assignee concerning the assignment.<

>302.06 Fee for Recording [R-11]

An assignment must identify within itself the property which is being assigned, that is, identify by number the patent or an application. See MPEP § 302.03. The recording fee set forth in 37 CFR 1.21(h) is charged for each item identified in the assignment.<

303 Endorsing Assignments on Pending Applications [R-11]

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 and submit the fees required by 37 CFR 1.19(b)(1) and (2).

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

305 Different Inventors, Common Ownership [R-11]

Where there is a common assignee of two or more applications by different inventors involving conflicting subject matter see § 804.03. **

305.02 Claimed Subject Matter the Same or Not Patentably Different [R-11]

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 >MPEP< §§ 804.03 and *>2302<.

306 Assignment of Division, Continuation, Substitute and Continuation-in-Part in Relation to Parent Case [R-11]

>In the case of a division or continuation, a prior assignment of the original application is applied to the division or continuation application because the assignment of the original application gives the assignee rights to the subject matter common to both applications. <

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

The front page of the printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, and reissue applications. It should be noted, however, that inclusion of this information 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. **

307 Issue to Assignee [R-11]**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.

37 CFR 1.334. Issue of patent to assignee.

(a) 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 assignee. 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.

(b) 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 and address of the assignee and indicate whether or not an acknowledgment of a recorded assignment has been received from the Patent and Trademark Office.

(c) If the assignment is recorded after the date of payment of the issue fee, the assignee may petition that the patent issue to the assignee as recorded. Any such petition must be accompanied by the fee set forth in § 1.17(i)>(1)<.

>Normally,< for the patent to* 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. >If the assignment is submitted for recording after the day on which the issue fee is paid, the patent may issue to an assignee upon granting a petition filed under 37 CFR 1.334(c).<

Only the first appearing name of an assignee will be printed on the patent where multiple names for the same party are identified on the Issue Fee Transmittal form, PTOL-85b. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the existing practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85b should still be completed to indicate the assignment data as recorded in the

Office. For example, the assignment filed in the Office and therefore the PTOL-85b assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85b.

308 Notice of Allowance Where Application Is Assigned [R-11]

The Issue Fee Transmittal Form portion (PTOL-85b) of the Notice of Allowance provides a space (item 5*) for assignment data which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 5* of the Issue Fee Transmittal Form PTOL-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 5* of PTOL-85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

309 Restrictions Upon Employees of Patent and Trademark Office

35 U.S.C. 4. Restrictions on officers and employees as to interests 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.

310 License Rights to Contractor-Owned Inventions Made Under Federally-Sponsored Research and Development

Where a Government contractor retains U.S. domestic patent rights, the contractor is required to include the following statement at the beginning of the application and any patents issued thereon:

"The U.S. Government has a paid-up license in this invention and the right in limited circumstances to require the patent owner to license others on reasonable terms as provided for by the terms of contract No. (or Grant No.) awarded by (Agency)."

If reference is made in the first sentence of the application to prior copending applications of the applicant, such prior applications must be referred to in the first sentence of the specification (37 CFR 1.78(a) and MPEP § 201.11), and in this case

the required "License Rights" statement should follow immediately as the second paragraph of the specification.

If there is no reference to an earlier application, the required "License Rights" statement should appear as the first paragraph of the specification.

311 Filing of Notice of Arbitration Awards

35 U.S.C. 294. Voluntary arbitration.

(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

(b) Arbitration of such disputes, awards by arbitrators and confirmation of awards shall be governed by title 9, United States Code, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court of competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Commissioner. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Commissioner. The Commissioner shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the Commissioner, any party to the proceeding may provide such notice to the Commissioner.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Commissioner.

37 CFR 1.335 Filing of notice of arbitration awards.

(a) Written notice of any award by an arbitrator pursuant to 35 U.S.C. 294 must be filed in the Patent and Trademark Office by the patentee, or the patentee's assignee or licensee. If the award involves more than one patent a separate notice must be filed for placement in the file of each patent. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the award.

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for

placement in the file of each patent to which the modification applies. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

(c) Any award by an arbitrator pursuant to 35 U.S.C. 294 shall be unenforceable until any notices required by paragraph (a) or (b) of this section are filed in the Patent and Trademark Office. If any required notice is not filed by the party designated in paragraph (a) or (b) of this section, any party to the arbitration proceeding may file such a notice.

The written notices required by this section should be directed to the attention of the Office of the Solicitor, which Office will be responsible for processing of such notices.

>313 Recording of Documents Other Than Assignments [R-11]

In addition to assignments, other instruments affecting title to a patent or application may be recorded in the Assignment Division of the Patent and Trademark Office at the discretion of the Commissioner, (37 CFR 1.331).

Thus, some instruments which relate to patents or applications may be recorded, although they do not constitute a transfer or change of title. Typical of these instruments which are accepted for recording are license agreements and agreements which convey a security interest. Such instruments are recorded in the public interest in order to give third parties notification of equitable interests or other matters relevant to the ownership of a patent or application.

Foreclosures which comply with all of the following four criteria will be deemed to be a recordable instrument in accordance with 37 CFR 1.331 and will be recorded.

(1) Submission of the foreclosure document with original endorsement by the secured party, or a verified copy thereof;

(2) Identification of the patent by patent number or the application number, or other acceptable identifier(s) as specified in 37 CFR 1.331(c), in the body of the foreclosure document itself or any addenda incorporated by reference;

(3) Reference to the security agreement recorded under 37 CFR 1.331; and

(4) Submission of a verified statement by a representative of the secured party stating that the patent or the patent application has been legally foreclosed on based upon the applicable state laws.

Documents which amount merely to ex parte assertions or claims, for example, affidavits of intention to assign or self-serving liens, as distinguished from agreements between parties, normally will be returned by the Assignment Division unrecorded.

Any document returned unrecorded, which the sender nevertheless believes represents an unusual case which justifies recordation, may be submitted to the Commissioner by way of a petition under 37 CFR 1.181 requesting recordation of the document.

The recordation of a document is not a determination of the effect of the document on the chain of title. The determination of what, if any, effect a document has on title will be made by the Office at such times as ownership must be established to

permit action to be taken by the Office in connection with a patent or an application.<

>314 Certificates of Change of Name or of Merger [R-11]

Certificates issued by appropriate authorities showing a change of name of a business or a merger of businesses are recordable. Although a mere change of name does not constitute a change in legal entity, it is properly a link in the chain of title. Documents of merger are also proper links in the chain of title. They may represent a change of entity as well as a change of name.<

>315 Indexing Against a Recorded Certificate [R-11]

A certificate of change of name or merger does not have to include in it the patent number(s) or application number(s) to which it pertains, but the patent number(s) or application number(s) must be furnished.

Other patent numbers or application numbers may be submitted later to be indexed against the recorded certificate of change of name or of merger, which will be done for a fee for each additional number. (The procedure of indexing does not apply to assignments.)<

>316 Character of Document for Recording [R-11]

To be recorded, other documents must conform to the requirements set out for assignments in MPEP §§ 302 - 302.06.<

>317 Handling of Documents of Title in the Assignment Division [R-11]

All documents submitted for recording are examined for form in the Assignment Division in order to separate documents which are recordable from those which are not recordable.

Documents which are considered not to be recordable are returned to the sender by the Assignment Division with an explanation. If the sender nevertheless believes that the document represents an unusual case which justifies recordation, the sender may present the question to the Commissioner by way of petition under 37 CFR 1.181.

In addition to assignments, other documents which convey or affect title to a patent application or patent may be recorded. MPEP § 313. Whether a document conveys or affects title is not determined by the heading or title of the document alone. It is desirable that documents have titles on them, but if there is any discrepancy between the title and the contents of the document, the contents are controlling. In identifying and digesting a document in assignment records, the Assignment Division will, if there is any doubt, use the language which appears in the body of the document rather than the title.<

>318 Documents Not to be Placed in Files [R-11]

Title documents must not be placed directly in application or patent files. It is highly desirable that the Assignment Division records be as complete and accurate as possible in order to provide a central location where chain of title to all applications and patents may be searched.<

>319 Examining Group May Request Report on Title [R-11]

If the Examining Group requires a title report, the group may forward the file to the Assignment Search Branch with a request that the Assignment Search Branch furnish a title report based upon the records of the Assignment Division. The Assignment Search Branch will furnish a report as to the owner of record relating to the particular file.<

>320 "Title Reports" [R-11]

The "title report" is a form which can be used under certain circumstances by the Assignment Search Branch to report to someone within the Office the name of the owner of an application or patent as shown by the Assignment Division records on the date the title report is made. Title reports are for internal Office use only, and are not available for order by applicants or attorneys except as provided by 37 CFR 1.171.

Note: The public can request a certified abstract of title. The fee for this service is set forth at 37 CFR 1.19(b)(6).

It is not normally necessary for title to be ascertained by an examiner by means of the "title report" form, since such information is not required to examine the application. However, a "title report" is required if the assignee intervenes in accordance with 37 CFR 1.32, a disclaimer under 37 CFR 1.321 is filed, or an applicant orders a title report in accordance with 37 CFR 1.171.

For applicants, the normal method of establishing title is to file in the Assignment Division of the Office all documents which convey title. After that is done, a person may verify or declare that he or she is the owner on the basis of the records of the Office. If the attorney or agent rather than the owner makes a statement as to ownership, the attorney or agent should cite the liber and page, or reel and frame, of the recordation of the title instrument in the Assignment Division.<

>321 Disposition of Documents Submitted for Recording [R-11]

After any document has been recorded, it will be returned to the sender.

If a document is considered not to be recordable, it will be returned to the sender without being recorded with a statement of the reason why the document is returned unrecorded. See MPEP § 313 as to petition to record such a document.<

>322 Recordation Date [R-11]

The date of recording is the date of receipt of the document at the Patent and Trademark Office in proper form and with the full fee for recording, 37 CFR 1.332.<

>323 Procedures for Correcting Errors in Recorded Document [R-11]

An error in a recorded document will be corrected by Assignment Division only when the following criteria is met:

A new document signed by the same party or parties is submitted for recording. The new document must;

- (a) acknowledge and correct the error in the original document,
- (b) confirm title in the proper assignee and
- (c) identify the incorrectly recorded document by reel and frame number.

A new recording fee is required (see MPEP § 302.06):

If the correction pertains to the name of a corporation or individual, a verified statement setting forth how the error occurred is required.

If a patent or application is incorrectly included in a merger or change of name, see MPEP § 314, it can be expunged by the assignor by lining out the incorrect patent or application number on the original recorded document and having the assignor initial and date the deletion. This document would then be recorded as a correction document and given a new reel and frame number and recording date. If the patent or application number is included in a list of properties which have been incorporated into the merger or change of name document and this appears on the official microfilm records of the Patent and Trademark Office, the assignor must then submit a verified statement attesting to the error, stating the reel and frame number where the error appeared and requesting that the incorrect number be deleted.<

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