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301 Ownership/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, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.

37 CFR 3.1. *Definitions.*

For purposes of this part, the following definitions shall apply:

Application means a national application for patent, an international application that designates the United States of America, or an application to register a trademark unless otherwise indicated.

Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed.

Document means a document which a party requests to be recorded in the Office pursuant to § 3.11 and which affects some interest in an application, patent, or registration.

Office means the Patent and Trademark Office.

Recorded document means a document which has been recorded in the Office pursuant to § 3.11.

Registration means a trademark registration issued by the Office.

OWNERSHIP

Ownership of a patent gives the patent owner the right to exclude others from making, using, offering

for sale, selling, or importing into the United States the invention claimed in the patent. 35 U.S.C. 154(a)(1). Ownership of the patent does not furnish the owner with the **right** to make, use, offer for sale, sell, or import the claimed invention because there may be other legal considerations precluding same (e.g., existence of another patent owner with a dominant patent, failure to obtain FDA approval of the patented invention, an injunction by a court against making the product of the invention, or a national security related issue).

The ownership of the patent (or the application for the patent) initially vests in the named inventors of the invention of the patent. See *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26 USPQ2d 1572, 1582 (Fed. Cir. 1993). The patent (or patent application) is then assignable by an instrument in writing, and the assignment of the patent, or patent application, transfers to the assignee(s) an alienable (transferable) ownership interest in the patent or application. 35 U.S.C. 261.

ASSIGNMENT

“Assignment,” in general, is the act of transferring to another the ownership of one’s property, i.e., the interest and rights to the property. In 37 CFR 3.1, assignment of patent rights is defined as “a transfer by a party of all or part of its right, title and interest in a patent or patent application...” An assignment of a patent, or patent application, is the transfer to another of a party’s **entire** ownership interest or a percentage of that party’s ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application.

LICENSING

As compared to assignment of patent rights, the licensing of a patent transfers a bundle of rights which is less than the entire ownership interest, e.g., rights that may be limited as to time, geographical area, or field of use. A patent license is, in effect, a contractual agreement that the patent owner will not sue the licensee for patent infringement if the licensee makes, uses, offers for sale, sells, or imports the claimed

invention, as long as the licensee fulfills its obligations and operates within the bounds delineated by the license agreement.

An exclusive license may be granted by the patent owner to a licensee. The exclusive license prevents the patent owner (or any other party to whom the patent owner might wish to sell a license) from competing with the exclusive licensee, as to the geographic region, the length of time, and/or the field of use, set forth in the license agreement.

A license is not an assignment of the patent. Even if the license is an exclusive license, it is **not** an assignment of patent rights in the patent or application.

INDIVIDUAL AND JOINT OWNERSHIP

Individual ownership - An individual entity may own the entire right, title and interest of the patent property. This occurs where there is only one inventor, and the inventor has not assigned the patent property. Alternatively, it occurs where all parties having ownership interest (all inventors and assignees) assign the patent property to one party.

Joint ownership - Multiple parties may **together** own the entire right, title and interest of the patent property. This occurs when any of the following cases exist:

- (A) Multiple partial assignees of the patent property;
- (B) Multiple inventors who have not assigned their right, title and interest; or
- (C) A combination of partial assignee(s), and inventor(s) who have not assigned their right, title and interest.

Each individual inventor may only assign the interest he or she holds; thus, assignment by one joint inventor renders the assignee a partial assignee. A partial assignee likewise may only assign the interest it holds; thus, assignment by a partial assignee renders a subsequent assignee a partial assignee. All parties having any portion of the ownership in the patent property must act **together** as a composite entity in patent matters before the Office.

MAKING THE ASSIGNMENT OF RECORD

An assignment can be made of record in the United States Patent and Trademark Office (Office) in two

different ways, for two different purposes. The differences are important to note:

(A) An assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See 37 CFR 3.54 and MPEP § 317.03; and

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step is necessary to permit the assignee to “take action” in the application, patent, or other patent proceeding under the conditions set forth in 37 CFR 3.73 and MPEP § 324. Recordation of an assignment in the assignment records of the Office does **not**, by itself, permit the assignee to take action in the application, patent, or other patent proceeding.

301.01 Accessibility of Assignment Records

37 CFR 1.12. Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), published patent applications, and assignment records relating to pending or abandoned trademark applications and to trademark registrations (for assignments recorded on or after January 1, 1955), are open to public inspection at the United States Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 1.19 and § 2.6 of this chapter.

(2) All records of assignments of patents recorded before May 1, 1957, and all records of trademark assignments recorded before January 1, 1955, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application which has not been published under 35 U.S.C. 122(b) are not available to the public. Copies of any such assignment records and related information 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 in this part.

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

(1) Be in the form of a petition including the fee set forth in § 1.17 (h); 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 or attorney or agent of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in § 1.21(j) will be made for the time consumed in making a search for such assignment.

Assignment documents relating to patents, published patent applications, registrations of trademarks, and applications for registration of trademarks are open to public inspection.

The Office will not open only certain parts 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 a document 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 published or patented. Documents relating only to one or more pending applications for patent which have not been published under 35 U.S.C. 122(b) will not be open to public inspection.

Copies of assignment records relating to pending or abandoned patent applications not published under 35 U.S.C. 122(b) and information related thereto are obtainable upon a showing of written authority from the applicant or applicant’s assignee or from the attorney or agent of either, or upon a showing that the person seeking such information is a *bona fide* prospective or actual purchaser, mortgagee, or licensee of such application.

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

on their individual merits upon petition to the Office of Petitions.

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

Requests for abstracts of title for assignments of patents recorded after May 1, 1957, are provided by the Certification Division upon request and payment of fee required in 37 CFR 1.19. Requests for copies of pre-1957 records for patents should be directed to the National Archives and Records Administration (NARA). Since these records are maintained by NARA, it is more expeditious to request copies directly from NARA, rather than from the Office, which would then have to route the requests to NARA. Payment of the fees required by NARA should accompany all requests for copies.

All assignment records from 1837 to April 30, 1957 for patents are now maintained and are open for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746. Assignment documents recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

302 Recording of Assignment Documents

37 CFR 3.11. Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Commissioner.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

37 CFR 3.58. Governmental registers.

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424. This Departmental Register will not be open to

public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in § 1.12.

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424. Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Commissioner of Patents and Trademarks. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.

Effective September 4, 1992, Part 3 has been added to 37 CFR to set forth Office rules on recording assignments and other documents and the rights of an assignee.

302.01 Assignment Document Must Be Original or True Copy for Recording

37 CFR 3.24. Requirements for documents and cover sheets relating to patents and patent applications.

The document and cover sheet must be legible. Either the original document or a true copy of the original document, may be submitted for recording. Only one side of each page shall be used. The paper used should be flexible, strong, white, non-shiny, durable, and preferably no larger than 21.6 x 33.1 cm. (8 1/2 x 14 inches) with a 2.5 cm. (one-inch) margin on all sides.

The United States Patent and Trademark Office will accept and record only an original, or a true copy of an original assignment or other document. See MPEP § 317.

Certification shall be made by the person submitting a copy of an original document that the document submitted is a true copy of the original. The certification is not required to be in oath or declaration form.

302.02 Translation of Assignment Document

37 CFR 3.26. English language requirement.

The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.

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

302.03 Identifying Patent or Application

37 CFR 3.21. Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (*e.g.*, PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

The patent or patent application to which an assignment relates must be identified by patent number or application number unless the assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed. Then, the application must be identified by the date of execution, the name(s) of the inventors, and the title of the invention. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name(s) of the inventors and the title of the invention.

The Office makes every effort to provide applicants with the application numbers for newly filed patent applications as soon as possible. It is suggested, however, that an assignment be written to allow entry of the identifying number after the execution of the assignment. An example of acceptable wording is:

“I hereby authorize and request my attorney, (Insert name), of (Insert address), to insert here in parentheses (Application number _____, filed _____) the filing date and application number of said application when known.”

302.04 Foreign Assignee May Designate Domestic Representative

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.

37 CFR 3.61. Domestic representative.

If the assignee of a trademark application or registration is not domiciled in the United States, the assignee must designate, in writing to the Office, a domestic representative. An assignee of a patent application or patent may designate a domestic representative if the assignee is not residing in the United States. The designation shall state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

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 any 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, so that a designation paper can be placed in each file. The designation of a domestic representative should be directed to the Office of Public Records for processing.

302.05 Address of Assignee

The address of the assignee may be recited in the assignment document and must be given in the required cover sheet. See MPEP § 302.07.

302.06 Fee for Recording

37 CFR 3.41. Recording fees.

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the

cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)); and

(2) The document and cover sheet are mailed to the Office in compliance with § 3.27(b).

The recording fee set forth in 37 CFR 1.21(h) is charged for each patent application and patent identified in the required cover sheet except as provided in 37 CFR 3.41(b).

302.07 Assignment Document Must Be Accompanied by a Cover Sheet

37 CFR 3.28. Requests for recording.

Each document submitted to the Office for recording must include at least one cover sheet as specified in § 3.31 referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, separate patent and trademark cover sheets should be submitted. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion. The document and a completed cover sheet should be resubmitted.

37 CFR 3.31. Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

(1) The name of the party conveying the interest;
 (2) The name and address of the party receiving the interest;

(3) A description of the interest conveyed or transaction to be recorded;

(4) Identification of the interests involved:

(i) For trademark assignments and trademark name changes: Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) For any other document affecting title to a trademark or patent application, registration or patent: Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(6) The date the document was executed;

(7) An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative (see § 3.61); and

(8) The signature of the party submitting the document.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document is to be recorded on the Governmental Register, and, if applicable, that the document is to be recorded on the Secret Register (see § 3.58); and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

Each assignment document submitted to the Office for recording must be accompanied by a cover sheet as required by 37 CFR 3.28. The cover sheet for patents or patent applications must contain:

(A) The name of the party conveying the interest;
 (B) The name and address of the party receiving the interest;

(C) A description of the interest conveyed or transaction to be recorded;

(D) Each patent application number or patent number against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(E) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(F) The date the document was executed; and

(G) The signature of the party submitting the document.

Each patent cover sheet should contain the number of patent applications or patents identified in the cover sheet and the total fee.

Examples of the type of descriptions of the interest conveyed or transaction to be recorded that can be identified are:

- (A) assignment;
- (B) security agreement;
- (C) merger;
- (D) change of name;
- (E) license;
- (F) foreclosure;
- (G) lien; and
- (H) contract.

Cover sheets required by 37 CFR 3.28 seeking to record a governmental interest must also (1) indicate that the document is to be recorded on the Governmental Register, and, if applicable, that the document is to be recorded on the Secret Register (see 37 CFR 3.58); and (2) indicate, if applicable, that the document to be recorded is not a document affecting title.

A patent cover sheet may not refer to trademark applications or registrations.

Form PTO-1595, Recordation Form Cover Sheet, may be used as the cover sheet for recording documents relating to patent(s) and/or patent application(s) in the Office.

Form PTO-1595 (Rev. 03/01) OMB No. 0651-0027 (exp. 5/31/2002) Tab settings ⇌ ⇌ ⇌	RECORDATION FORM COVER SHEET PATENTS ONLY	U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office
To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.		
1. Name of conveying party(ies): Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No	2. Name and address of receiving party(ies) Name: _____ Internal Address: _____ _____ _____ Street Address: _____ _____ City: _____ State: _____ Zip: _____ Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No	
3. Nature of conveyance: <input type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____ Execution Date: _____		
4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date of the application is: _____ A. Patent Application No.(s) B. Patent No.(s) Additional numbers attached? <input type="checkbox"/> Yes <input type="checkbox"/> No		
5. Name and address of party to whom correspondence concerning document should be mailed: Name: _____ Internal Address: _____ _____ _____ Street Address: _____ _____ City: _____ State: _____ Zip: _____	6. Total number of applications and patents involved: <input type="text"/> 7. Total fee (37 CFR 3.41).....\$ _____ <input type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to be charged to deposit account 8. Deposit account number: _____ (Attach duplicate copy of this page if paying by deposit account)	
DO NOT USE THIS SPACE		
9. Statement and signature. <i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i> _____ Name of Person Signing Signature Date		
Total number of pages including cover sheet, attachments, and documents: <input type="text"/>		

Mail documents to be recorded with required cover sheet information to:
 Commissioner of Patents & Trademarks, Box Assignments
 Washington, D.C. 20231

Guidelines for Completing Patents Cover Sheets

Cover Sheet information must be submitted with each document to be recorded. If the document to be recorded concerns both patents and trademarks separate patent and trademark cover sheets, including any attached pages for continuing information, must accompany the document. All pages of the cover sheet should be numbered consecutively, for example, if both a patent and trademark cover sheet is used, and information is continued on one additional page for both patents and trademarks, the pages of the cover sheet would be numbered form 1 to 4.

Item 1. Name of Conveying Party(ies).

Enter the full name of the party(ies) conveying the interest. If there is insufficient space, enter a check mark in the "Yes" box to indicate that additional information is attached. The name of the additional conveying party(ies) should be placed on an attached page clearly identified as a continuation of the information Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page.

Item 2. Name and Address of Receiving Party(ies).

Enter the name and full address of the first party receiving the interest. If there is more than one party receiving the interest, enter a check mark in the "Yes" box to indicate that additional information is attached. Enter a check mark in the "No" box, if no information is contained on an attached page.

Item 3. Nature of Conveyance.

Place a check mark in the appropriate box describing the nature of the conveying document. If the "Other" box is checked, specify the nature of the conveyance. Enter the execution date of the document. It is preferable to use the name of the month, or an abbreviation of that name, in order that confusion over dates is minimized.

Item 4. Application Number(s) or Patent Number(s).

Indicate the application number(s), and/or patent number(s) against which the document is to be recorded. National application numbers must include both the series code and a six-digit number; and international application numbers must be complete, e.g., 07/123,456 for national application numbers, and PCTUS91/12345 for international application numbers. Enter a check mark in the appropriate box: "Yes" or "No" if additional numbers appear on attached pages. Be sure to identify numbers included on attached pages as the continuation of Item 4.

Item 5. Name and Address of Party to whom correspondence concerning the document should be mailed.

Enter the name and full address of the party to whom correspondence is to be mailed.

Item 6. Total Applications and Patents involved.

Enter the total number of applications and patents identified for recordation. Be sure to include all applications and patents identified on the cover sheet and on additional pages.

Block 7. Total Fee Enclosed.

Enter the total fee enclosed or authorized to be charged. A fee is required for each application and patent against which the document is recorded.

Item 8. Deposit Account Number.

Enter the deposit account number to authorize charges. Attach a duplicate copy of cover sheet to be used for the deposit charge account transaction.

Item 9. Statement and Signature.

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet, confirming that to the best of the persons knowledge and belief, the information contained on the cover sheet is correct and that any copy of the document is a true copy of the original document. Enter the total number of pages including the cover sheet, attachments, and document.

This collection of information is required by 35 USC 261 and 262 and 15 USC 1057 and 1060. The information is used by the public to submit (and by the USPTO to process) patent and trademark assignment requests. After the USPTO records the information, the records for patent and trademarks, assignments, and other associated documents can be inspected by the public. To view documents recorded under secrecy orders or documents recorded due to the interest of the federal government, a written authorization must be submitted. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the form to the USPTO. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Manager of the Assignment Division, Crystal Gateway 4, Room 310, 1213 Jefferson Davis Highway, Arlington, Va. 22202. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C., 20231.

302.08 Mailing Address for Submitting Assignment Documents

37 CFR 3.27. Mailing address for submitting documents to be recorded.

Documents and cover sheets to be recorded should be addressed to the Commissioner, United States Patent and Trademark Office, Box Assignment, Washington, D.C. 20231, unless they are filed together with new applications or with a request under § 3.81.

37 CFR 3.27 sets out how documents submitted for recording should be addressed to the Office. In order to ensure prompt and proper processing, documents and their cover sheets should be addressed to the Commissioner, United States Patent and Trademark Office, Box Assignment, Washington, D.C. 20231, unless they are filed together with new applications or with a request under 37 CFR 3.81. Requests for recording documents which accompany new applications should be addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231. Requests under 37 CFR 3.81 will be processed by the Office of Patent Publications. Therefore, such requests should be marked to the attention of the Office of Patent Publications and addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

302.09 Facsimile Submission of Assignment Documents

Assignments and other documents affecting title may be submitted to the Office via facsimile (fax). See MPEP § 1730 for the facsimile number. This process allows customers to submit their documents directly into the automated Patent and Trademark Assignment System and receive the resulting recordation notice at their fax machine. The customer's fax machine must be connected to a dedicated line because recordation notices will be returned automatically to the sending fax number through the Patent and Trademark Assignment System. If the Office system is unable to complete transmission of the recordation notice, the notice will be printed and mailed to the sender by U.S. Postal Service first class mail. Recorded documents will not be returned with the "Notice of Recordation."

Any assignment-related document submitted by facsimile must include:

- (A) an identified application or patent number;
- (B) one cover sheet to record a single transaction; and
- (C) payment of the recordation fee by a USPTO Deposit Account.

The following documents **cannot** be submitted via facsimile:

- (A) Assignments submitted concurrently with newly filed patent applications;
- (B) Documents with two or more cover sheets (e.g., a single document with one cover sheet to record an assignment, and a separate cover sheet to record separately a license relating to the same property);
- (C) Requests for corrections to documents recorded previously;
- (D) Requests for "at cost" recordation services;
- (E) Documents with payment of the recordation fee by credit card; and
- (F) Resubmission of a non-recorded assignment.

The date of receipt accorded to an assignment document sent to the Office by facsimile transmission is the date the complete transmission is received in the Office. See MPEP § 502.01. The benefits of a certificate of transmission under 37 CFR 1.8 are available.

If a document submitted by fax is determined not to be recordable, the entire document, with its associated cover sheet, and the Office "Notice of Non-Recordation" will be transmitted via fax back to the sender. Once corrections are made, the initial submission, amended, may then be resubmitted by mailing the corrected submission to the address set forth in 37 CFR 3.27. Timely resubmission will provide the sender with the benefit of the initial receipt date as the recordation date in accordance with 37 CFR 3.51.

The Patent and Trademark Assignment System assigns reel and frame numbers and superimposes recordation stampings on the processed and stored electronic images. Accordingly, copies of all recorded documents will have the reel and frame numbers and recordation stampings.

303 Assignment Documents Not Endorsed on Pending Applications

Certified copies of patent applications as filed do not include an indication of assignment documents.

Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by 37 CFR 1.19.

When the assignment condition of an application is significant, such as when applications of different inventors contain conflicting claims or there is a question as to who should direct prosecution, it is necessary for the examiner to obtain assignment information from PALM. See MPEP § 320.

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

In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against 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 application, a prior assignment of the original application is not applied to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require a new assignment 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.

306.01 Assignment of an Application Claiming the Benefits of a Provisional Application

If an application which claims the earlier filing date of a provisional application under 35 U.S.C. 119(e) includes only subject matter which formed a part of the provisional application, an assignment recorded against the provisional application will be effective in the later application, similar to the practice with

respect to continuations and divisions filed under 35 U.S.C. 120. See MPEP § 306. If an application claiming the earlier filing date of a provisional application includes subject matter that is not common with subject matter of the provisional application, new assignment papers must be submitted in the later application, similar to the practice with respect to continuations-in-part filed under 35 U.S.C. 120. See MPEP § 306.

307 Issue to Assignee

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 3.81. Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(b) *After payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee set forth in § 1.17(i) of this chapter is submitted after the date of payment of the issue fee, but prior to issuance of the patent, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(c) *Partial assignees.*

(1) If one or more assignee(s) together with one or more inventor(s) hold the entire right, title, and interest in the application, the patent may issue in the names of the assignee(s) and the inventor(s).

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

Normally, for a patent to issue to an assignee, a request for issuance of the application in the name(s) of the assignee(s) must be filed in the United States Patent and Trademark Office (Office) at a date not later than the day on which the issue fee is paid. If the request for such issuance is submitted after the day on which the issue fee is paid, the patent may issue to an assignee upon submission of a request under 37 CFR 3.81(b) along with the processing fee set forth in

37 CFR 1.17(i). The extent to which the Office can comply with such a request will depend upon when the request is filed, the time it takes to match the request with the file, and whether there is sufficient time for the appropriate Office official to act on the request before the date of issue.

37 CFR 3.81 permits proof of the application's assignment to be submitted so that a patent may issue in the name(s) of the assignee(s) consistent with the application's assignment. The prior requirement for submitting a copy of an actual assignment for recording (in the assignment records of the Office) has been replaced with a requirement that proof of the assignment be submitted pursuant to 37 CFR 3.73(b) (which may include a copy of the assignment, or alternatively, may make reference to a reel and frame number if the assignment is recorded in the Office assignment records). Recording of the assignment is not required; only proof of its existence is required. Reliance may be had on a 37 CFR 3.73(b) statement already of record in the application, if the statement is still accurate at the time the request for issue of the application in the name(s) of the assignee(s) is submitted.

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. Unless an assignee's name and address are identified in item 3 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 a certificate of correction under 37 CFR 1.323 (see MPEP § 1481 and § 1485) arising from incomplete or erroneous assignee's name furnished in item 3 of PTOL-85B will not be granted unless a petition under 37 CFR 1.183 has been granted. Any such petition under 37 CFR 1.183 should be directed to the Office of Petitions and should include:

- (A) the petition fee required by 37 CFR 1.17(h);
- (B) a request that 37 CFR 3.81(a) be waived to permit the correct name of the assignee to be provided after issuance of the patent;
- (C) a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- (D) a copy of the Notice of Recordation of Assignment Document.

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 Government 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 under an obligation by virtue of 35 U.S.C. 202(c)(6) 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 above “Government License Rights” statement should follow immediately as the second paragraph of the specification.

If there is no reference to an earlier application, the “Government License Rights” statement should appear as the first paragraph of the specification. See 37 CFR 1.77.

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 to 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 Director. 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 Director. The Director 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 Director, any party to the proceeding may provide such notice to the Director.

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

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. The Office of the Solicitor will be responsible for processing such notices.

313 Recording of Licenses, Security Interests, and Other Documents Other Than Assignments

In addition to assignments and documents required to be recorded by Executive Order 9424, documents affecting title to a patent or application will be recorded in the Assignment Division of the United States Patent and Trademark Office (Office). Other documents not affecting title may be recorded at the discretion of the Commissioner. 37 CFR 3.11(a).

Thus, some documents which relate to patents or applications will be recorded, although they do not constitute a transfer or change of title. Typical of these documents which are accepted for recording are license agreements and agreements which convey a security interest. Such documents 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.

Any document returned unrecorded, which the sender nevertheless believes represents an unusual case which justifies recordation, may be submitted to

the Office of Petitions with 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. See MPEP § 324.

314 Certificates of Change of Name or of Merger

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

Prior to amendment of the Rules of Practice to add Part 3 to 37 CFR, it had been the practice of the United States Patent and Trademark Office (Office) to process requests for “indexing” or “cross-referencing” additional patent numbers or application numbers against a document, other than an assignment, previously recorded in the Assignment Division, upon submission of a transmittal letter and recording fee. The Office no longer processes such indexing requests. Such requests do not comply with 37 CFR 3.11, 3.28, and 3.31, which require that each request for recordation include the document to be recorded and a cover sheet.

Therefore, even where a document has already been recorded in the Assignment Division in connection with a patent or patent application, a party that wishes recordation of that document with respect to additional patents and/or patent applications must submit the following to the Assignment Division:

(A) the original document, or a true copy of the original document (which may consist of the previously recorded papers on which the Assignment Division has stamped the reel and frame numbers at which they are recorded, or a copy of such papers);

(B) a completed cover sheet (see 37 CFR 3.31 and MPEP § 302.07); and

(C) the appropriate recording fee (see 37 CFR 1.21(h) and 3.41).

The Office will assign a new recording date to that submission, update the assignment database, and microfilm the cover sheet and document, which shall become part of the official record.

317 Handling of Documents in the Assignment Division

All documents and cover sheets submitted for recording are examined for formal requirements in the Assignment Division in order to separate documents which are recordable from those which are not recordable.

Documents and cover sheets that are considered not to be recordable are returned to the sender by the Assignment Division with an explanation. If the sender disagrees or 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, filed with the Office of Petitions.

After an assignment and cover sheet have been recorded, they will be returned to the name and address indicated on the cover sheet to receive correspondence, showing the reel and frame number.

317.01 Recording Date

37 CFR 3.51. Recording date.

The date of recording of a document is the date the document meeting the requirements for recording set forth in this part is filed in the Office. A document which does not comply with the identification requirements of § 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be con-

sidered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

The date of recording of a document is the date the document meeting the requirements for recording set forth in the regulations is filed in the Office. A document which does not comply with the identification requirements of 37 CFR 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender when a correspondence address is available.

317.02 Correction of Returned Documents and Cover Sheets

Assignment documents and cover sheets which are returned by Assignment Division will be stamped with the original date of receipt by the Office and will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of receipt of the papers as the date of recording of the document. See 37 CFR 3.51. The certification procedure under 37 CFR 1.8 or the "Express Mail" procedure under 37 CFR 1.10 may be used for resubmissions of returned papers to obtain the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of receipt of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

317.03 Effect of Recording

37 CFR 3.54. Effect of recording.

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

37 CFR 3.56. Conditional assignments.

Assignments which are made conditional on the performance of certain acts or events, such as the payment of money or other condition subsequent, if recorded in the Office, are regarded as absolute assignments for Office purposes until canceled with the written consent of all parties or by the decree of a court of compe-

tent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

The recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office. See MPEP § 324.

37 CFR 3.56 provides that an assignment, which at the time of its execution is conditional on a given act or event, will be treated by the Office as an absolute assignment. This rule serves as notification as to how a conditional assignment will be treated by the Office in any proceeding requiring a determination of the owner of an application, patent, or registration. Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred. A security agreement that does not convey the right, title, and interest of a patent property is not a conditional assignment.

318 Documents Not to be Placed in Files

Assignment documents submitted for recording should not be placed directly in application or patent files, but should be forwarded to Assignment Division for recording.

320 Title Reports

The "title report" is a form which can be used under certain circumstances by the Assignment Division 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. For example, a title report is requested by the Reexamination Preprocessing Staff when a request for reexamination is filed. Title reports may not be ordered by applicants or attorneys.

Information as to the title is not normally required by the examiner to examine an application. It is only in limited circumstances when the ownership becomes an issue and an examiner needs a title report. See MPEP § 303. Examiners may obtain a title report using the PALM Intranet, Patent Assignment Information (either link to the Assignments home page from the OASIS home page or go to [HTTP://A16/ASGN/OBJECT/ASNINFO](http://A16/ASGN/OBJECT/ASNINFO)). The screen resulting from the

search may be printed to yield the copy of the title report.

NOTE: The public can request a certified abstract of title. The fee for this service is set forth at 37 CFR 1.19(b)(5). See MPEP § 301.01 for a discussion of which assignment records are publicly available.

323 Procedures for Correcting Errors in Recorded Assignment Document

An error in a recorded assignment document will be corrected by Assignment Division provided a “corrective document” is submitted. The “corrective document” must include the following:

(A) The original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and

(B) A new Recordation Form Cover Sheet (form PTO-1619) (See MPEP § 302.07).

The new recordation form cover sheet must identify the submission as a “corrective document” submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06.

Corrections may be made on the original assignment document, for example, by lining out an incorrect patent or application number in a merger or change of name (see MPEP § 314).

Office policy regarding recordation of assignment documents is directed toward maintaining a complete history of claimed interests in property and, therefore, recorded assignment documents will not be expunged even if subsequently found to be invalid. See *In re Ratny*, 24 USPQ2d 1713 (Comm’r Pat. 1992).

323.01 Correction of Error in Recorded Cover Sheet

37 CFR 3.34. *Correction of cover sheet errors.*

(a) An error in a cover sheet recorded pursuant to § 3.11 will be corrected only if:

(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains and

(2) A corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by the originally recorded document or a copy of the originally recorded document and by the recording fee as set forth in § 3.41.

Any alleged error in a recorded cover sheet will only be corrected if the error is apparent from a comparison with the recorded assignment document. The corrected cover sheet should be directed to Assignment Division.

324 Establishing Right of Assignee To Take Action

37 CFR 3.71. *Prosecution by assignee.*

(a) Patents — conducting of prosecution. One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) Patents — assignee(s) who can prosecute. The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) A single assignee. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) Partial assignee(s) together or with inventor(s). All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) Patents — Becoming of record. An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

(d) Trademarks. The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee’s trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

37 CFR 3.73. Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

The owner or assignee of a patent property can take action in a patent application or patent proceeding in numerous instances. The owner or assignee can sign a reply to an Office action (37 CFR 1.33(b)(3) and (4)), a request for a continued prosecution application under 37 CFR 1.53(d) (MPEP § 201.06(d)), a terminal disclaimer (MPEP § 1490), an Issue Fee Transmittal (PTOL-85B) (MPEP § 1306), or a request for status of an application (MPEP § 102). The owner or assignee can file an application under 37 CFR 1.47(b) (MPEP § 409.03(b)) or 37 CFR 1.425, appoint its own registered attorney or agent to prosecute an application (37 CFR 3.71 and MPEP

§ 402.07), grant a power to inspect an application (MPEP § 104), and acquiesce to express abandonment of an application (MPEP § 711.01). The owner or assignee consents to the filing of a reissue application (MPEP § 1410.01), and to the correction of inventorship (MPEP § 201.03 or § 1481).

I. THE ASSIGNEE/OWNER THAT CAN TAKE ACTION IN PATENT MATTERS

The provisions of 37 CFR 3.71(b)(1) and (2) identify the owner or assignee that can take action in patent matters, *e.g.*, the assignee which may conduct the prosecution of a U.S. national application for a patent (35 U.S.C. 111(a)), or any other patent proceeding (*e.g.*, a reexamination proceeding, an interference proceeding). A national patent application is owned by one of the following individual or composite entities:

(A) the inventor(s);

(B) an assignee or multiple assignees of the inventor(s); or

(C) some combination of the assignee(s), and inventor(s) who have not assigned away their right, title and interest in the application.

Pursuant to 37 CFR 3.73(b), a party must be established as the assignee by satisfying the requirements of that subsection, in order to be recognized as an owner or part owner, for purposes of taking action in patent matters before the Office.

As discussed in subsection II below, all parties having any portion of the ownership must join in “taking action” (*i.e.*, act together as a composite entity) in order to be entitled to conduct the prosecution in patent matters.

Individual and Partial Assignees

If there is a single assignee of the **entire** right, title and interest in the patent application, 37 CFR 3.71(b)(1) provides that the single assignee (*i.e.*, individual assignee) may act alone to conduct the prosecution of an application or other patent proceeding (upon complying with 37 CFR 3.73(b)).

If there is no assignee of the **entire** right, title and interest of the patent application, then two possibilities exist:

(A) The application has not been assigned, and ownership resides solely in the inventor(s) (i.e., the applicant(s)). In this situation, 37 CFR 3.71 does not apply, since there is no assignee, and the combination of all inventors is needed to conduct the prosecution of an application.

(B) The application has been assigned by at least one of the inventors, and there is thus at least one “partial assignee.” As defined in 37 CFR 3.71(b)(2), a partial assignee is any assignee of record who has less than the entire right, title and interest in the application. The application is owned by the combination of all partial assignees and all inventors who have not assigned away their right, title and interest in the application.

Where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application. Where no inventor retains an ownership interest, the combination of all partial assignees is needed to conduct the prosecution of an application.

Example

Inventors A and B invent a process and file their application. Inventors A and B together may conduct prosecution. Inventor A then assigns all his/her rights in the application to Corporation X. As soon as Corporation X (now a partial assignee) is made of record in the application as a partial assignee (by filing a statement pursuant to 37 CFR 3.73(b) stating fifty percent ownership), Corporation X and Inventor B together may conduct prosecution. Corporation X and Inventor B then both assign their rights in the application to Corporation Y. As soon as Corporation Y (now an assignee of the entire right, title and interest) is made of record in the application as the assignee (by filing a statement pursuant to 37 CFR 3.73(b) stating one-hundred percent ownership), Corporation Y may, by itself, conduct prosecution.

II. ESTABLISHING OWNERSHIP

When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property

to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee’s ownership may be established under 37 CFR 3.73(b) by submitting to the Office, in the Office file related to the matter in which action is sought to be taken:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording); or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

The action taken by the assignee, and the 37 CFR 3.73(b) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. 37 CFR 3.73(c). If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or the date of the assignee’s action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. See discussion below. Once 37 CFR 3.73(b) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a 37 CFR 3.73(b) submission each time, provided that ownership has not changed.

The submission establishing ownership by the assignee pursuant to 37 CFR 3.73(b) is generally referred to as the “statement under 37 CFR 3.73(b)” or the “37 CFR 3.73(b) statement.” A duplicate copy of the 37 CFR 3.73(b) statement is not required and should not be submitted. See 37 CFR 1.4(b) and MPEP § 502.04.

CONTINUING APPLICATIONS

When an assignee files a continuation or divisional application under 37 CFR 1.53, other than a continued

prosecution application (CPA) under 37 CFR 1.53(d), the application papers must:

(A) refer to a statement filed under 37 CFR 3.73(b) in the parent application;

(B) contain a copy of a statement filed under 37 CFR 3.73(b) in the parent application; or

(C) contain a newly executed statement under 37 CFR 3.73(b).

When a continuation-in-part application is filed by an assignee, a newly executed statement under 37 CFR 3.73(b) must be filed. When a CPA under 37 CFR 1.53(d) is filed, the statement filed under 37 CFR 3.73(b) in the parent application will serve as the statement for the CPA.

REQUESTS FOR CONTINUED EXAMINATION

Where a Request for Continued Examination of an application is filed under 37 CFR 1.114 (which can be filed on or after May 29, 2000 for an application filed on or after June 8, 1995), the application is not considered to be abandoned; rather the finality of the Office action is withdrawn and the prosecution continues. Thus, the statement under 37 CFR 3.73(b) in the application will continue to serve as the statement establishing ownership.

PARTY WHO MUST SIGN

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the

board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney (37 CFR 1.34(b)) from the inventors or the assignee to a patent practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

WHEN OWNERSHIP MUST BE ESTABLISHED

Examples of situations where ownership must be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), unless papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d)); signs a request for status of an application or gives a power to inspect an application (MPEP § 102 and § 104); acquiesces to express abandonment of an application (MPEP § 711.01); appoints its own registered attorney or agent to prosecute an application (37 CFR 3.71 and MPEP § 402.07); signs a terminal disclaimer (MPEP § 1490); consents to the filing of a reissue application (MPEP § 1410.01); consents to the correction of inventorship (MPEP § 201.03 or § 1481); files an application under 37 CFR 1.47(b) (MPEP § 409.03(b)) or 37 CFR 1.425; signs an Issue Fee Transmittal (PTOL-85B) (MPEP § 1306); or signs a reply to an Office action.

WHEN OWNERSHIP NEED NOT BE ESTABLISHED

Examples of situations where ownership need not be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), where papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d)); signs a small entity statement (MPEP § 509.03); signs a statement of common ownership of two inventions (MPEP § 706.02(1)(2)); signs a NASA or DOE property rights statement (MPEP § 151); signs an affidavit under 37 CFR 1.131 where the inventor is unavailable (MPEP § 715.04); signs a certificate under 37 CFR 1.8 (MPEP § 512); or files a request for reexamination of a patent under 37 CFR 1.510 (MPEP § 2210).

MULTIPLE ASSIGNEES

When an assignee seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding and the right, title, and interest therein is held by more than one assignee, each partial assignee must provide a submission under 37 CFR 3.73(b). In each submission, the extent of each assignee's interest must be set forth so

that the Office can determine whether it has obtained action by the entirety of the right, title and interest holders (owners). 37 CFR 3.73(c)(2). If the extent of the partial assignee's ownership interest is not set forth in the submission under 37 CFR 3.73(b), the Office may refuse to accept the submission as an establishment of ownership interest.

CONFLICTING 37 CFR 3.73(b) STATEMENTS

Where there are two or more conflicting 37 CFR 3.73(b) statements in an application or other Office proceeding, the statement with the latest date of submission to the Office will normally control as to establishment of the assignee. If, however, the ownership established as controlling is contested on the record by another party who has submitted a conflicting 37 CFR 3.73(b) statement, then the application or other proceeding shall be forwarded by the Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolution of the ownership question.

FORMS

Form PTO/SB/96 may be used to establish ownership under 37 CFR 3.73(b).

PTO/SB/96 (08-00)
 Approved for use through 10/31/2002. OMB 0651-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

Application No./Patent No.: _____ Filed/Issue Date: _____

Entitled: _____

_____, a _____,
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- 1. the assignee of the entire right, title, and interest; or
- 2. an assignee of less than the entire right, title and interest.
 The extent (by, percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

A. An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.
 [NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

_____ Date

_____ Typed or printed name

_____ Signature

_____ Title

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

MANUAL OF PATENT EXAMINING PROCEDURE