

# Chapter 300 Ownership and Assignment

- 301 Ownership/Assignability of Patents and Applications**
    - 301.01 Accessibility of Assignment Records
  - 302 Recording of Assignment Documents**
    - 302.01 Assignment Document Must Be Copy for Recording
    - 302.02 Translation of Assignment Document
    - 302.03 Identifying Patent or Application
    - 302.04 Foreign Assignee May Designate Domestic Representative
    - 302.05 Address of Assignee
    - 302.06 Fee for Recording
    - 302.07 Assignment Document Must Be Accompanied by a Cover Sheet
    - 302.08 Mailing Address for Submitting Assignment Documents
    - 302.09 Facsimile Submission of Assignment Documents
    - 302.10 Electronic Submission of Assignment Documents
  - 303 Assignment Documents Not Endorsed on Pending Applications**
  - 306 Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to Parent Application**
    - 306.01 Assignment of an Application Claiming the Benefits of a Provisional Application
  - 307 Issue to Assignee**
  - 309 Restrictions Upon Employees of U.S. Patent and Trademark Office**
  - 310 Government License Rights to Contractor-Owned Inventions Made Under Federally Sponsored Research and Development**
  - 311 Filing of Notice of Arbitration Awards**
  - 313 Recording of Licenses, Security Interests, and Other Documents Other Than Assignments**
  - 314 Certificates of Change of Name or of Merger**
  - 315 Indexing Against a Recorded Certificate**
  - 317 Handling of Documents in the Assignment Division**
    - 317.01 Recording Date
    - 317.02 Correction of Unrecorded Returned Documents and Cover Sheets
    - 317.03 Effect of Recording
  - 318 Documents Not To Be Placed in Files**
  - 320 Title Reports**
  - 323 Procedures for Correcting Errors in Recorded Assignment Document**
    - 323.01 Correction of Error in Recorded Cover Sheet
    - 323.01(a) Typographical Errors in Cover Sheet
    - 323.01(b) Typographical Errors in Recorded Assignment Document
    - 323.01(c) Assignment or Change of Name Improperly Filed and Recorded by Another Person Against Owner's Application or Patent
    - 323.01(d) Expungement of Assignment Records
  - 324 Establishing Right of Assignee to Take Action**
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- 301 Ownership/Assignability of Patents and Applications [R-3]**
    - 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 patent application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

*Assignment* means a transfer by a party of all or part of its right, title and interest in a patent, patent application, 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 United States 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.<

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## I. < 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.

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## II. < 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.

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## III. < 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.

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## IV. < 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.

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## V. <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. >For a patent to issue to an assignee, the assignment must have been recorded or filed for recordation in accordance with 37 CFR 3.11. See 37 CFR 3.81(a).<

## 301.01 Accessibility of Assignment Records [R-8]

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), and published patent applications are open to public inspection at the United States Patent and Trademark Office, and copies of patent assignment records may be obtained upon request and payment of the fee set forth in § 1.19 of this chapter. See § 2.200 of this chapter regarding trademark assignment records.

(2) All records of assignments of patents recorded before May 1, 1957, 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 is open to the public pursuant to § 1.11 or for which copies or access may be supplied pursuant to § 1.14, are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of the applicant or applicant’s assignee or patent attorney or patent 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(g); 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. Records related to assignments of patents, and patent applications that have been published as patent application publications are available on the USPTO Internet \*>Web< site. To

view the recorded assignment document itself, members of the public must place an order pursuant to 37 CFR 1.12(d).

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 which are open to the public pursuant to 37 CFR 1.11 or for which copies or access may be supplied pursuant to 37 CFR 1.14 are available to the public. For pending or abandoned applications which are not open to the public pursuant to 37 CFR 1.11 or for which copies or access may not be supplied pursuant to 37 CFR 1.14, information related thereto is only 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, continuation, or continuation-in-part of an earlier application, the assignment records of that earlier application will be open to public inspection because copies or access may be supplied to the earlier application pursuant to 37 CFR 1.14.

Assignment records relating to reissue applications are open to public inspection since reissue applications are open to public inspection pursuant to 37 CFR 1.11(b).

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 Civilian Records Division of the National Archives at College Park, 8601 Adelphi Road, College Park, MD 20740-6001.

## 302 Recording of Assignment Documents [R-5]

### 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 Director.

(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 Director 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.

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(c) A joint research agreement or an excerpt of a joint research agreement will also 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 Director. 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.

Effective December 10, 2004, as a result of the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), 37 CFR 3.11(c) has been added to provide that the Office will record a joint research agreement or an excerpt of a joint research agreement. \*\*

### **302.01 Assignment Document Must Be \*\* Copy for Recording [R-3]**

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

(a) *For electronic submissions:* Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one-inch) margin must be present on all sides.

(b) *For paper or facsimile submissions:* Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one-inch) margin must be present on all sides. For paper submissions, the paper used should be flexible, strong white, non-shiny, and durable. The Office will not return recorded documents, so original documents must not be submitted for recording.<

The United States Patent and Trademark Office will accept and record only \*\*>a< copy of an original assignment or other document. See MPEP § 317. >The document submitted for recordation will not be returned to the submitter. If the copy submitted for recordation is illegible, the recorded document will be illegible. Accordingly, applicants and patent owners

should ensure that only a legible copy is submitted for recordation.<

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### **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 [R-3]**

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*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 the name of each inventor and the 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 the name of each inventor and the 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 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 [R-3]**

*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.

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*37 CFR 3.61. Domestic representative.*

If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should 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 >of a patent or patent application who is< 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 [R-3]**

*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

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(2) The document and cover sheet are either: Faxed or electronically submitted as prescribed by the Director, or mailed to the Office in compliance with § 3.27.<

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 [R-8]**

*37 CFR 3.28. Requests for recording.*

Each document submitted to the Office for recording must include a single 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, then separate patent and trademark cover sheets, each accompanied by a copy of the document to be recorded, must be submitted. 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, in which case 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) The signature of the party submitting the document.

For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* /Thomas O'Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

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(8) For trademark assignments, the entity and citizenship of the party receiving the interest. In addition, if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.<

(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 relates to a Government interest; 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.

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(f) Each trademark cover sheet should include the citizenship of the party conveying the interest.<

(g) The cover sheet required by § 3.28 seeking to record a joint research agreement or an excerpt of a joint research agreement as provided by § 3.11(c) must:

(1) Identify the document as a “joint research agreement” (in the space provided for the description of the interest conveyed or transaction to be recorded if using an Office-provided form);

(2) Indicate the name of the owner of the application or patent (in the space provided for the name and address of the party receiving the interest if using an Office-provided form);

(3) Indicate the name of each other party to the joint research agreement party (in the space provided for the name of the party conveying the interest if using an Office-provided form); and

(4) Indicate the date the joint research agreement was executed.

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.

If the document submitted for recordation is a joint research agreement or an excerpt of a joint research agreement, the cover sheet must clearly identify the document as a “joint research agreement” (in the space provided for the description of the interest conveyed if using Form PTO-1595). The date the joint research agreement was executed must also be identified. The cover sheet must also identify the name(s) of the owner(s) of the application or patent (in the space provided for the name and address of the party receiving the interest if using Form PTO-1595). The name(s) of every other party(ies) to the joint research

agreement must also be identified (in the space provided for the name of the party conveying the interest if using Form PTO-1595).

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;
- (H) contract; and
- (I) joint research agreement.

Cover sheets required by 37 CFR 3.28 seeking to record a governmental interest must also (1) indicate that the document relates to a governmental interest 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.



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Form PTO-1595 (Rev. 03-09)  
OMB No. 0651-0027 (exp. 03/31/2009)

U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

| <b>RECORDATION FORM COVER SHEET</b><br><b>PATENTS ONLY</b>  |   |
|---|---|
| To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.   |   |
| <b>1. Name of conveying party(ies)</b><br><br>Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No   | <b>2. Name and address of receiving party(ies)</b><br>Name: _____<br>Internal Address: _____<br>_____<br>Street Address: _____<br>_____<br>City: _____<br>State: _____<br>Country: _____ Zip: _____<br>Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No                      |
| <b>3. Nature of conveyance/Execution Date(s):</b><br>Execution Date(s) _____<br><input type="checkbox"/> Assignment <input type="checkbox"/> Merger<br><input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name<br><input type="checkbox"/> Joint Research Agreement<br><input type="checkbox"/> Government Interest Assignment<br><input type="checkbox"/> Executive Order 9424, Confirmatory License<br><input type="checkbox"/> Other _____ | <b>4. Application or patent number(s):</b> <input type="checkbox"/> This document is being filed together with a new application.<br>A. Patent Application No.(s) _____<br>B. Patent No.(s) _____<br><br>Additional numbers attached? <input type="checkbox"/> Yes <input type="checkbox"/> No                                  |
| <b>5. Name and address to whom correspondence concerning document should be mailed:</b><br>Name: _____<br>Internal Address: _____<br>_____<br>Street Address: _____<br>_____<br>City: _____<br>State: _____ Zip: _____<br>Phone Number: _____<br>Fax Number: _____<br>Email Address: _____  | <b>6. Total number of applications and patents involved:</b> _____<br><b>7. Total fee (37 CFR 1.21(h) &amp; 3.41) \$</b> _____<br><input type="checkbox"/> Authorized to be charged to deposit account<br><input type="checkbox"/> Enclosed<br><input type="checkbox"/> None required (government interest not affecting title) |
| <b>8. Payment Information</b><br><br>Deposit Account Number _____<br>Authorized User Name _____   |   |
| <b>9. Signature:</b><br><div style="display: flex; justify-content: space-between; margin-top: 20px;"> <span>_____ Signature</span> <span>_____ Date</span> </div> <div style="display: flex; justify-content: space-between; margin-top: 20px;"> <span>_____ Name of Person Signing</span> <span>Total number of pages including cover sheet, attachments, and documents: <input style="width: 50px;" type="text"/></span> </div>  |   |

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:  
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

## Guidelines for Completing Patents Cover Sheets (PTO-1595)

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 from 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. If the document to be recorded is a joint research agreement, enter the name(s) of the party(ies) other than the owner of the patent or patent application as the conveying party(ies).

### 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. If the document to be recorded is a joint research agreement, enter the name(s) of the patent or patent application owner(s) as the receiving party.

### Item 3. Nature of Conveyance/Execution Date(s).

Enter the execution date(s) 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. 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.

### 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 (e.g., 07/123,456), and international application numbers must be complete (e.g., PCT/US91/12345).

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. Also enter a check mark if this Assignment is being filed with a new application.

### 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. Payment Information.

Enter the deposit account number and authorized user name to authorize charges.

### Item 9. Signature.

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet. 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, USPTO, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Assignment Recordation Services, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.

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Privacy Act Statement for Patent Assignment Recordation Form Cover Sheet

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the above request for information. This collection of information is authorized by 35 U.S.C. 1, 2, 261 and E.O. 9424. This information will primarily be used by the USPTO for the recordation of assignments related to patents and patent applications. Submission of this information is voluntary but is required in order for the USPTO to record the requested assignment. If you do not provide the information required on the cover sheet, the assignment will not be recorded, and all documents will be returned to you.

After the information is recorded, the records and associated documents can be inspected by the public and are not confidential, except for documents that are sealed under secrecy orders or related to unpublished patent applications. Assignment records relating to unpublished patent applications are maintained in confidence in accordance with 35 U.S.C. 122. Records open to the public are searched by users for the purpose of determining ownership for other property rights with respect to patents and trademarks.

Routine uses of the information you provide may also include disclosure to appropriate Federal, state, local, or foreign agencies in support of their enforcement duties and statutory or regulatory missions, including investigating potential violations of law or contract and awarding contracts or other benefits; to a court, magistrate, or administrative tribunal in the course of presenting evidence; to members of Congress responding to requests for assistance from their constituents; to the Office of Management and Budget in connection with the review of private relief legislation; to the Department of Justice in connection with a Freedom of Information Act request; to a contractor in the performance of their duties; to the Office of Personnel Management for personnel studies; and to the General Services Administration (GSA) as part of their records management responsibilities under the authority of 44 U.S.C. 2904 and 2906. Such disclosure to GSA shall not be used to make determinations about individuals.

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### 302.08 Mailing Address for Submitting Assignment Documents [R-3]

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

Documents and cover sheets submitted by mail for recordation should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications.<

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 \*\* >Mail Stop Assignment Recordation Services, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450<, unless they are filed together with new applications\*\*. Requests for recording documents which accompany new applications should be addressed to the \*\* >Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.<

### 302.09 Facsimile Submission of Assignment Documents [R-8]

Assignments and other documents affecting title may be submitted to the Office via facsimile (fax). See the USPTO Internet \* >Web< site or 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 for patent matters 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 credit card (use of the Credit Card form, PTO-2038 (see MPEP § 509), is required for the credit card information to be kept separate from the assignment records) or 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; and
- (E) 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.

### 302.10 Electronic Submission of Assignment Documents [R-8]

37 CFR 3.31. Cover sheet content.

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(a)(7) The signature of the party submitting the document. For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* /Thomas O' Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

\*\*\*\*\*

37 CFR 1.4. Nature of correspondence and signature requirements.

\*\*\*\*\*

(d)(2) *S-signature*. An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by a handwritten signature of § 1.4(d)(1). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.<

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *Forms*. The Office provides forms to the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (*e.g.*, oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.<

(4) *Certifications*. (i) *Section 11.18 certifications*: The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter. Violations of § 11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this subchapter. Any practitioner violating § 11.18(b) of this subchapter may also be subject to disciplinary action. *See* §§ 11.18(d) and 11.804(b)(9) of this subchapter.

(ii) *Certifications as to the signature*:

(A) *Of another*: A person submitting a document signed by another under paragraph (d)(2) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature.

(B) *Self certification*: The person inserting a signature under paragraph (d)(2) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

(C) *Sanctions*: Violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under § 11.18(c) and (d) of this chapter.<

\*\*\*\*\*

Assignments and other documents affecting title may be submitted to the Office via the Office's **Electronic Patent Assignment System (EPAS)**. See the USPTO Internet **Web** site **at** <http://epas.uspto.gov> for additional information regarding **EPAS**.

Any assignment related document submitted by **EPAS** must include:

(A) an identified application or patent number;

(B) one cover sheet to record a single transaction >which cover sheet is to be completed on-line<; and

(C) payment of the recordation fee by a credit card (use of the Credit Card form, PTO-2038 (see MPEP § 509), is required for the credit card information to be kept separate from the assignment records)>, electronic fund transfer (EFT)< or a USPTO Deposit Account.

For an assignment document filed electronically, >the signature of< the person who signs the cover sheet \*\* >must comply with 37 CFR 3.31(a)(7) or 37 CFR 1.4(d)(2)<.

The date of receipt accorded to an assignment document sent to the Office by \*\* EPAS is the date the complete transmission is received in the Office.

If a document submitted by \*\* EPAS 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, as amended, may then be resubmitted by mailing the corrected submission to the address set forth in 37 CFR 3.27. Timely submission 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 [R-3]**

In the case of a division or continuation application, a prior assignment recorded against the original application is applied >(effective)< 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. >Although the assignment recorded against an original application is applied to the division or continuation application, the Office’s assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed.<

In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied >(effective)< 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 >the recordation of< a new assignment if they are to be issued to an assignee. >See 37 CFR 3.81.<

\*\*

#### **306.01 Assignment of an Application - Claiming the Benefits of a Provisional Application [R-3]**

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 \*\*>recorded for< the \* application >claiming the benefit of the provisional 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 [R-8]

#### *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 of the assignee 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 must state that the document has been filed for recordation as set forth in § 3.11.

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17 (i) of this chapter.

(c) *Partial assignees.* (1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(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 of the assignee 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. Such a request must indicate that the assignment has been previously recorded in the Office. If the assignment has not been previously recorded in the Office, the request must state that the document has been filed for recordation as set forth in 37 CFR 3.11. See 37 CFR 3.81(a).

If a request for issuance to an assignee pursuant to 37 CFR 3.81(b) is submitted after the day on which the issue fee is paid, the request under 37 CFR 3.81(b) must include a request for a certificate of correction under 37 CFR 1.323 (accompanied by the fee set forth in 37 CFR 1.20(a)) and the processing fee set forth in 37 CFR 1.17(i). The request under 37 CFR 3.81(b) must state that the assignment was submitted for

recordation as set forth in 37 CFR 3.11 before issuance of the patent. The Office will issue a certificate of correction to reflect that the patent issued to the assignee provided the requirements of 37 CFR 3.81(b) and 37 CFR 1.323 are complied with.

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 Fee(s) 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 Fee(s) Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 3 of the Fee(s) 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. Assignment information printed on a patent is not updated after a patent is issued, and may not be reflective of the assignment recorded in the Office subsequent to the issuance of the patent. Detailed assignment information can be found by performing an assignment search on the USPTO Internet [\\*Web site](#) and by inspecting the recorded assignment documents.

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, or a missing assignee's name, in item 3 of PTOL-85B will not be granted unless a request under 37 CFR 3.81(b) has been granted and the assignment was submitted for recordation as set forth in 37 CFR 3.11 before the patent issued. Any such request under 37 CFR 3.81(b) should be directed to the Office of Petitions and should include:

(A) the processing fee required by 37 CFR 1.17(i);

(B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;

(C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before the issuance of the patent; and

(D) a request for a certificate of correction under 37 CFR 1.323 accompanied by the fee set forth in 37 CFR 1.20(a).

### **309 Restrictions Upon Employees of >U.S.< Patent and Trademark Office [R-3]**

*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 [R-8]**

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:

“\*\*>This invention was made with government support under (identify the contract) awarded by (identify the Federal agency). The government has certain rights in the invention.<”

If reference is made in the first sentence(s) of the specification following the title to prior copending applications of the applicant (37 CFR 1.78(a) and MPEP § 201.11), 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 [R-3]**

*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, 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 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 [R-3]**

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 \*>Director<. 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 [R-3]**

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) \*\* a \* 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 [R-3]

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 \*>Director< 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 considered 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 Unrecorded Returned Documents and Cover Sheets [R-8]

Assignment documents and cover sheets, or copies of the same, 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 to establish that the papers were returned within the time period specified. \*\* 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 competent 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 [R-5]

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 >(select “General Information,” insert the appropriate application number, select “Search,” select “Assignments”)<. 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)(4). See MPEP § 301.01 for a discussion of which assignment records are publicly available.

## 323 Procedures for Correcting Errors in Recorded Assignment Document [R-8]

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) A copy of 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-1595) (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 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). Once a document is recorded with the Assignment Services Division, the Assignment Services Division will not remove the papers from the record relating to that application or patent. See MPEP § 323.01(d).

### 323.01 Correction of Error in Recorded Cover Sheet [R-3]

\*\*>

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 a copy of the document originally submitted for recording 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.

>During the recording process, the Assignment Services Division will check to see that a cover sheet is complete and record the data exactly as it appears on the cover sheet. The Assignment Services Division does not compare the cover sheet with the assignment document (or other document affecting title). Once the document is recorded, the Office will issue a notice of recordation.

The party recording the document should carefully review the notice of recordation.

Typographical errors made by the Office will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other error, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error, using the procedures set forth in MPEP § 323.01(a) through § 323.01(c).<

>

### **323.01(a) Typographical Errors in Cover Sheet [R-3]**

A party who wishes to correct a typographical error on a recorded cover sheet must submit the following to the Assignment Services Division:

(A) a copy of the originally recorded assignment document (or other document affecting title);

(B) a corrected cover sheet; and

(C) the required fee for each application or patent to be corrected (37 CFR 3.41).

See 37 CFR 3.34. The party requesting correction should also submit a copy of the original cover sheet, to facilitate comparison of the corrected cover sheet with the originally recorded document.

The party filing the corrected cover sheet should check the box titled “Other” in the area of the sheet requesting “Nature of Conveyance,” and indicate that

the submission is to correct an error in a cover sheet previously recorded. The party should also identify the reel and frame numbers (if known), and the nature of the correction (e.g., “correction to the spelling of assignor’s name” or “correction of application number or patent number”). The Office will then compare the corrected cover sheet with the original cover sheet and the originally recorded assignment document (or other document affecting title) to determine whether the correction is typographical in nature. If the error is typographical in nature, the Assignment Services Division will record the corrected cover sheet and correct the Assignment Historical Database.

#### **I. TYPOGRAPHICAL ERRORS IN COVER SHEET THAT DO NOT AFFECT TITLE TO APPLICATION OR PATENT**

If the original cover sheet contains a typographical error that does not affect title to the application or patent against which the original assignment or name change is recorded, the Assignment Services Division will correct the Assignment Historical Database and permit the recording party to keep the original date of recordation.

#### **II. TYPOGRAPHICAL ERRORS IN COVER SHEET THAT DO AFFECT TITLE TO APPLICATION OR PATENT**

If the original cover sheet contains a typographical error that affects title to the application or patent against which the assignment or name change is recorded, the recording party will not be entitled to keep the original date of recordation. Rather, the Assignment Services Division will correct its automated records and change the date of recordation to the date the corrected cover sheet was received in the Office.

### **323.01(b) Typographical Errors in Recorded Assignment Document [R-3]**

If there is an error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for an erroneous document (e.g., the assignor) must either create and record a new document or make corrections to the original document and re-record it. If an assignor is

not available to correct an original document or execute a new one, the assignee may submit an affidavit or declaration in which the assignee identifies the error and requests correction. The affidavit or declaration must be accompanied by a copy of the originally recorded papers, a cover sheet, and the required fee for each application or patent to be corrected (37 CFR 3.41). See *In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pat. 1987).

### **323.01(c) Assignment or Change of Name Improperly Filed and Recorded by Another Person Against Owner's Application or Patent [R-3]**

When the owner of an application or registration discovers that due to a typographical error, another party has improperly recorded an assignment or name change against the owner's application or patent, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

The owner should contact the party who recorded the papers with the erroneous information and request that such party record corrective papers. However, if the party cannot be located or is unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.

Specifically, the owner should submit the following to the Assignment Services Division:

(A) a completed cover sheet identifying the application or patent against which the assignment was improperly recorded;

(B) an affidavit or declaration (1) identifying itself as the correct owner, (2) stating that the previously recorded document was submitted with erroneous information, and (3) providing the reel and frame number of the previously recorded document; and

(C) the required fee (37 CFR 3.41) for each application or patent to be corrected.

The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the application or patent identified should not be considered altered by the incorrect assignment or name change, and a statement that the

original applicant or patentee or last correct assignee has been, and continues to be, the owner of the application, or patent at issue.

On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s), or patent(s). The party should also write the name of the correct owner in both the box requesting the name of the conveying party and the box requesting the name and address of the receiving party; this is to make it clear that ownership never changed and that any assignment or name change recorded against the application(s) or patent(s) was erroneous.

### **323.01(d) Expungement of Assignment Records [R-3]**

Petitions to correct, modify or "expunge" assignment records are rarely granted. Such petitions are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through § 323.01(c) will not provide the petitioner with adequate relief; and

(B) the integrity of the assignment records will not be affected by granting the petition.

Even if a petition to "expunge" a document is granted with respect to a particular application or patent, the image of the recorded document will remain in the records of the Assignment Services Division at the same reel and frame number, and the image will appear when someone views that reel and frame number. The Office will, however, delete the links to the application or patent that was the subject of the petition, so that no information about the recorded document will appear when someone searches for that application or patent number in the Assignment Historical Database.<

## **324 Establishing Right of Assignee To Take Action [R-8]**

*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 reexamina-

tion 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 Director. 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). For trademark matters only, 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. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; 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), Fee(s) 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)), appoint its own registered patent practitioner to prosecute an application (37 CFR 1.32 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.

#### A. *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, unless one or more inventors have refused to join in the filing of the application and a petition under 37 CFR 1.47 has been granted. If a petition under 37 CFR 1.47 has been

granted, then the assignee need only be the assignee of the entire interest of the 37 CFR 1.47 applicant to sign a power of attorney. See 37 CFR 1.32(b)(4). Where an applicant retains an ownership interest, the combination of all partial assignees and the applicant with the ownership interest is needed to conduct the prosecution of an application.

Where a reissue application is filed to correct inventorship in the patent by the deletion of the name of inventor X and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the filing of the reissue application, even though inventor X is being deleted and need not sign the reissue oath or declaration. If inventor X has assigned his/her rights to the patent, then inventor X’s assignee must consent to the filing of the reissue application.

#### B. *Example*

Inventors A and B invent a process and file their application, signing the declaration for the patent application. Inventors A and B together may conduct prosecution >of the application<. Inventor A then assigns all his/her rights in the application to Corporation X. As soon as Corporation X (now a partial assignee >as per 37 CFR 3.71(b)(2)<) is made of record in the application as a partial assignee (by filing a statement pursuant to 37 CFR 3.73(b) stating **\*\*>Corporation X is an assignee of an undivided interest in the entirety of the application<**), Corporation X and Inventor B together may conduct prosecution >of the application<. 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 **\*\*>it is assignee of the entire right, title and interest<**), Corporation Y >is then the sole (one hundred percent) owner and thus< may, by itself, conduct prosecution >of the application<.

## 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 Director. 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) and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is, submitted for recordation pursuant to 37 CFR 3.11; or

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

Documents submitted to establish ownership are required to be recorded, or submitted for recordation pursuant to 37 CFR 3.11, 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.

### III. 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.

### IV. 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.

### V. 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. In foreign countries, a person who holds the title “Manager” or “Director” is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (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 1.32(b)(4)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that 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.

## **VI. 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 a Fee(s) Transmittal (PTOL-85B) (MPEP § 1306); or signs a reply to an Office action.

## **VII. 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).

## **VIII. 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.

## **IX. 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 owner-

ship 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 \*\*>resolving any procedural issues<. Generally, where there are two or more conflicting 37 CFR 3.73(b) statements in an application, the ownership entity that filed that application will be permitted to

conduct the prosecution, and the other party that submitted a 37 CFR 3.73(b) statement to establish its ownership may wish to consider filing an application under 37 CFR 1.47.

#### **X. FORMS**

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

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PTO/SB/96 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: \_\_\_\_\_

Application No./Patent No.: \_\_\_\_\_ Filed/Issue Date: \_\_\_\_\_

Titled: \_\_\_\_\_

\_\_\_\_\_, 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 in;
- 2.  an assignee of less than the entire right, title, and interest in (The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
- 3.  the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

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 therefore is attached.

**OR**

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

- 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(s).

As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment 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.

\_\_\_\_\_  
 Signature Date  
 \_\_\_\_\_  
 Printed or Typed Name Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. 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 Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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