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301 Assignability of Patents and Applications [R-1]

35 U.S.C. 261. Ownership; assignment.

Subject to the provisions of this title, patents shall have the attributes of personal property.

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

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, shall be prima facie evidence of the execution of an assignment, grant, or conveyance of a patent or application for patent.

An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

35 U.S.C. 262. Joint owners.

**> In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.<

37 CFR 3.1. Definitions.

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

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

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

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

Office means the Patent and Trademark Office.

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

Registration means a trademark registration issued by the Office.

301.01 Accessibility of Assignment Records [R-1]

37 CFR 1.12. Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the 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 assignment records relating to pending or abandoned trademark applications and to trademark registrations, for assignments recorded on or after January 1, 1955, are open to public inspection at the Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in §§ 1.19 and 2.6 of this chapter.

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

(b) Assignment records, digests, and indexes, relating to any pending or abandoned patent application are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

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

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i), 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, registrations of trademarks, and applications for registration of trademarks are open to public inspection.

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

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

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

Requests for abstracts of title for assignments of patents recorded after May 1, 1957, are provided by the Office 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 Re-

cords Administration (NARA). Since these records are maintained by NARA, it is more expeditious to request copies directly from NARA, rather than from the Office, which would then have to route the requests to NARA. Payment of the fees required by NARA should accompany all requests for copies.

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

302 Recording of Assignment Documents

37 CFR 3.11. Documents which will be recorded.

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

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

302.01 Assignment Document Must Be Original or True Copy for Recording

37 CFR 3.24. Formal requirements for documents and cover sheets.

The document and cover sheet must be legible. Either the original document or a true copy of the original document, may be submitted for recording. Only one side of each page shall be used. The paper used should be flexible, strong, white, non-shiny, durable, and preferably no larger than 21.6x33.1 cm. (8 1/2 x 14 inches) with a 2.5 cm. (one-inch) margin on all sides.

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

Certification shall be made by the person submitting a copy of an original document that the document sub-

mitted is a true copy of the original. The certification is not required to be in oath or declaration form.

302.02 Translation of Assignment Document

37 CFR 3.26. *English language requirement.*

The Office will accept and record non-English language documents only if accompanied by a verified 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 a verified English translation signed by the translator.

302.03 Identifying Patent or Application

[R-1]

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)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.<

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

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

"I hereby authorize and request my attorney, (Insert name), of (Insert address), to insert here in parentheses

(Application number , filed) the filing date and application number of said application when known."

302.04 Foreign Assignee May Designate Domestic Representative

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

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

37 CFR 3.61. *Domestic representative.*

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

An assignee not domiciled in the United States may, by written document signed by such assignee, designate a domestic representative. The designation of domestic representative should always be a paper separate from any assignment document, in order that the paper of designation can be retained in the appropriate application or patent file. Also, there should be a separate paper of designation of representative for each patent or application, so that a designation paper can be placed in each file. The designation of a domestic representative should be directed to the Office of the Solicitor for processing.

302.05 Address of Assignee

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

302.06 Fee for Recording

37 CFR 3.41. *Recording fees.*

All requests to record documents must be accompanied by the appropriate fee. 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(q) of this chapter for trademarks.

302.07

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.

302.07 Assignment Document Must Be Accompanied by a Cover Sheet

37 CFR 3.28. Requests for recording.

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

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) Each application number, patent number or registration number 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 number of applications, patents or registrations identified in the cover sheet and the total fee;
 - (7) The date the document was executed;
 - (6) The number of applications, patents or registrations identified in the cover sheet and the total fee;
 - (7) The date the document was executed;
 - (8) An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative (see § 3.61); and
 - (9) A statement by the party submitting the document that to the best of the person's knowledge and belief, the information contained on the cover sheet is true and correct and any copy submitted is a true copy of the original document; and
 - (10) The signature of the party submitting the document.
- (b) A cover sheet may not refer to both patents and trademarks.

Each assignment document submitted to the Office for recording must be accompanied by a cover sheet as required by 37 CFR 3.28. The patent cover sheet 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) 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;

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

(6) the number of patent applications and patents identified in the cover sheet and the total fee;

(7) the date the document was executed;

(8) a statement by the party submitting the document that to the best of the person's knowledge and belief, the information contained on the cover sheet is true and correct and any copy submitted is a true copy of the original document; and

(9) the signature of the party submitting the document.

The term "party" as used in 37 CFR 3.31 means the person whose name appears on the documents to be recorded, that person's attorney or registered agent, or an appropriate official where a corporation's or other organization's name appears on the document.

Examples of the type of descriptions of the interest conveyed or transaction to be recorded that can be identified are: (1) assignment, (2) security agreement, (3) merger, (4) change of name, (5) license, (6) foreclosure, (7) lien and (8) contract.

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

302.08 Mailing Address for Submitting Assignment Documents

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

Documents and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignments, Washington, DC 20231, unless they are filed together with new applications or with a petition under § 3.81(b).

37 CFR 3.27 has been added to set out how documents submitted for recording should be addressed to the Office. To ensure prompt and proper processing, documents and their cover sheets should be addressed to the Commissioner of Patents and Trademarks, Box Assignments, Washington, DC 20231, unless they are filed together with new applications or with a petition under 37 CFR 3.81(b). Petitions under 37 CFR 3.81(b) should

be addressed to the Commissioner of Patents and Trademarks, Box DAC, Washington, DC 20231. New applications and other petitions should be addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.

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 determination of the assignment condition of an application is significant, as when applications of different inventors contain conflicting claims, it is necessary for the examining group to submit the application to the Assignment Search Branch for a title report. See MPEP § 319 and § 320.

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

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

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

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

>306.01 Assignment of an Application Claiming the Benefits of a Provisional Application [R-1]

An application claiming the priority benefits of a provisional application under 35 U.S.C. 119(e) should not be called a continuation, division, or continuation—in-part even though the claim for priority from a provisional application would make it appear to be one of these types of continuing applications. The benefit of an earlier filing date for continuations, divisions, and continuations—in-part may be claimed under the provisions of 35 U.S.C. 120 while the benefit of an earlier filing date of a provisional application may be claimed under the provisions of 35 U.S.C. 119(e).

As set forth in MPEP § 306, assignments recorded against an original application gives the assignee rights to the subject matter common to both applications. Therefore, a prior assignment in a parent application carries over into continuation and division applications since all subject matter contained in the continuation or division application was included in the parent. Continuations—in-part require new assignments due to the additional material included therein.

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

307 Issue to Assignee

35 U.S.C. 152. Issue of patent to assignee.

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

37 CFR 3.81. Issue of patent to assignee.

(a) For a patent application, if an assignment of the entire right, title and interest is recorded before the issue fee is paid, the patent may issue in the name of the assignee. If the assignee holds an undivided part interest, the patent may issue jointly to the inventor and the assignee. At

the time the issue fee is paid, the name of the assignee must be provided if the patent is to issue solely or jointly to that assignee.

(b) If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i)(1) of this chapter.

Normally, for the patent to issue to an assignee, the assignment must be recorded in the Patent and Trademark Office at a date not later than the day on which the issue fee is paid. If the assignment is submitted for recording after the day on which the issue fee is paid, the patent may issue to an assignee upon granting a petition filed under 37 CFR 3.81.

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

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 5 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for a certificate of correction under 37 CFR 1.323 (see MPEP § 1481 and § 1485) arising from incomplete or erroneous assignee's name furnished in item 5 of PTOL-85B will not be granted unless a petition under 37 CFR 1.183 has been granted. Any such petition under 37 CFR 1.183 should be directed to the Office of Petitions and should include: (1) the petition fee required by 37 CFR 1.17(h); (2) a request that 37 CFR 3.81(a) be waived to permit the correct name of the assignee to be provided after issuance of the patent; (3) a statement (verified if made by other than a registered attorney or agent) that the failure to include the correct assignee

name on the PTOL-85B was inadvertent; and (4) a copy of the Notice of Recordation of Assignment Document.

309 Restrictions Upon Employees of Patent and Trademark Office

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

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

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

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

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

If reference is made in the first sentence of the application to prior copending applications of the applicant, such prior applications must be referred to in the first sentence of the specification (37 CFR 1.78(a) and MPEP § 201.11), and in this case the required "Government License Rights" statement should follow immediately as the second paragraph of the specification.

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

311 Filing of Notice of Arbitration Awards

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

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

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

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

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

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

37 CFR 1.335. Filing of notice of arbitration awards.

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

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for placement in the file of each patent to which the modification applies. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

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

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

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

In addition to assignments, other documents affecting title to a patent or application will be recorded in the Assignment Division of the Patent and Trademark Office. Documents not affecting title may be recorded at the discretion of the Commissioner. (37 CFR 3.11).

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 in the Office of the Assistant Commissioner for Patents 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

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

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Other patent numbers or application numbers may be submitted later to be indexed against the recorded certificate of change of name or merger, which will be done for a fee for each additional patent or application identified on the coversheet. (This procedure of indexing does not apply to assignments since the applications and patents assigned must be identified in the assignment; 37 CFR 3.21).

317 Handling of Documents in the Assignment Division

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

Documents and cover sheets which are considered not to be recordable are returned to the sender by the Assignment Division with an explanation. If the sender disagrees or believes that the document represents an unusual case which justifies recordation, the sender may present the question to the Commissioner by way of petition under 37 CFR 1.181, filed with the Office of Petitions in the Office of the Assistant Commissioner for Patents.

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 certification procedure under either § 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 where a correspondence address is available.

317.02 Correction of Returned Documents and Cover Sheets

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

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 which 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.

319 Examining Group May Request Report on Title

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

320 Title Reports

The "title report" is a form which can be used under certain circumstances by the Assignment Search Branch to report to someone within the Office the name of the owner of an application or patent as shown by the Assignment Division records on the date the title report is made. For example, a title report is requested by the Re-examination Preprocessing Unit when a request for re-examination is filed. Title reports are for internal Office use

only, and are not available for order by applicants or attorneys except as provided by 37 CFR 1.171.

Note: The public can request a certified abstract of title. The fee for this service is set forth at 37 CFR 1.19(b)(4). See MPEP § 301.01 for a discussion of which assignment records are publicly available.

It is not normally necessary for title to be ascertained by an examiner by means of the "title report" form, since such information is not required to examine the application. However, a title report is required if an applicant orders a title report in accordance with 37 CFR 1.171. See also MPEP § 303.

For applicants, the normal method of establishing title is to file in the Assignment Division of the Office all assignment documents which convey title. After that is done, a person may verify or declare that he or she is the owner on the basis of the records of the Office.

323 Procedures for Correcting Errors in Recorded Assignment Document

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

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

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

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

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

If a patent or patent application is incorrectly included in a merger or change of name (see MPEP § 314), it can be corrected by the party conveying the interest by lining out the incorrect patent or application number on the original recorded document and having the party conveying the interest initial and date the deletion. This document would then be recorded as a correction document and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is charged for each patent application and patent against which the cor-

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rected document is being recorded. If the patent or patent application number is included in a list of properties which have been incorporated into the merger or change of name document and this appears on the official microfilm records of the Patent and Trademark Office, the party conveying the interest must then submit a verified statement attesting to the error, stating the reel and frame number where the error appeared and requesting that the incorrect number be deleted.

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 USPQ 2d 1713 (Comm'r Pat. 1992).

323.01 Correction of Error in Recorded Cover Sheet

37 CFR 3.34. Correction of cover sheet errors.

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

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

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

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

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

324 Establishing Right of Assignee to Take Action

37 CFR 3.73. Establishing right of assignee to prosecute.

(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 unless there is an assignment.

(b) When the assignee of the entire right, title and interest seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g. reel and frame number, etc.) where such evidence is recorded in the Office. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. In addition, the assignee of a patent

application or patent must submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of assignee's knowledge and belief, title is in the assignee seeking to take the action.

When the assignee of the entire right, title, and interest first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee's ownership may be established either

(1) by submitting to the Office copies of the documentary evidence of a chain of title from the original inventor to the assignee, or

(2) by specifying, by reel and frame number, for example, where such documentary evidence is recorded in the Office.

In addition to the establishment of ownership, there is a further requirement that the assignee submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of the assignee's knowledge and belief, title is in the assignee seeking to take action. 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) statement each time, provided that ownership has not changed.

When an assignee files a continuation or divisional application (under 37 CFR 1.53, 1.60, or 1.62), reference may be made to a statement filed under 37 CFR 3.73(b) in the parent application or a copy of that statement may be filed. A newly executed statement under 37 CFR 3.73(b) must be filed when a continuation-in-part application is filed by an assignee.

The statement by the assignee must be signed by a person having authority to do so. For example, the statement under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following two manners if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.).

(1) The statement may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An 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 accept-

able, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to be an officer of the assignee or to have authority to sign the statement on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the statement on behalf of the assignee.

(2) The statement may be signed by any person, if the statement includes an averment that the person is empowered to sign the statement on behalf of the assignee. If not signed by a registered practitioner, the statement including the averment must be in oath or declaration form. Where a statement does not comply with (1) or (2) above, evidence of the person's authority to sign will be required.

Examples of situations where ownership must be established and the statement under 37 CFR 3.73(b) must be submitted are when the assignee: signs a request for status of an application or gives a power to inspect an ap-

plication (MPEP § 102); acquiesces to express abandonment of an application (MPEP § 711); appoints its own legal representative (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 1.475; signs an Issue Fee Transmittal (PTOL-85B) (MPEP § 1306); or signs a response to an Office action.

Examples of situations where ownership need not be established and a statement under 37 CFR 3.73(b) is not required to be submitted are when the assignee: signs a small entity statement (MPEP § 509.03); signs an affidavit or declaration of common ownership of two inventions (MPEP § 2188); 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).

Form PTO/SB/96 may be used for an acceptable certification under 37 CFR 3.73(b).

CERTIFICATE UNDER 37 CFR 3.73(b)

Applicant: _____

Application No.: _____ **Filed:** _____

Entitled: _____

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

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

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

OR

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

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

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

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

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

Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

 Date

 Signature

 Typed or printed name

 Title