

Chapter 300 Ownership and Assignment

in re Shohamy 1941 CB

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305 Rejection Because of Common Ownership *(Ellis)* *29 JPOS460-1*

Where there is a common assignee of two or more applications by different inventors these applications by reason of their common ownership are subject in general to the same treatment as to overlapping claimed subject matter as though they were all the applications of one and the same inventor. That is, when the question of interference involving this common subject matter arises, the owner of the applications must, in the absence of any good reason to the contrary, elect which one shall be placed in interference. Claims in a later filed application should be rejected if they conflict with claimed subject matter in an earlier filed case of common ownership. See Rule 78 (b), 706.03 (k), 1101.01 (b) and 822 to 822.03.

301 Assignability of Patents and Applications

Extract from Section 4898 R. S., 35 U. S. C. 47. Every application for patent or patent or any interest therein shall be assignable in law by an instrument in writing, and the applicant or patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent or patent to the whole or any specified part of the United States.

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

When a divisional, continuation, or substitute application is ready for allowance, it is sent to the Assignment Branch where the assignment of the original application is applied to the later application, provided the date of the assignment of the original application was before the filing of the later application.

302 Effect of Recording

Extract from Section 4898 R. S., 35 U. S. C. 47. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice unless it is recorded in the Patent Office within three months from the date thereof or prior to such subsequent purchase or mortgage.

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

303 Endorsing Assignments on Pending Applications

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

307 Issue to Assignee

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

304 Conflicting Subject Matter in Two Applications of Same Inventor, One of Which Is Assigned

Where applicant has pending two applications with overlapping subject matter therein, and assigns one of the applications in its entirety, which assignment is duly recorded in the Patent Office, the assigned application at once may become a reference against the second application for all common subject matter disclosed, irrespective of the dates of filing of the two applications, and also of any subsequent assignment of the second case.

application for reissue, the assignment must be recorded before the case is allowed; in the case of an application for a design patent, the assignment must be recorded at least ten days before the case is allowed.

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to him unless there are conflicting assignments.

308 Notice of Allowance Where Application Is Assigned

In writing the notice of allowance of an application in which there is an assignment of record,

after the name of the applicant, a comma followed by the expression "Assor, etc." should be written. This will serve to notify the addressee that the patent will issue to the assignee.

309 Restrictions Upon Employees of Patent Office

35 U. S. C. 4; R. S. 480. Restrictions on officers and employees of Patent Office as to interest in patents. All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the office.