Chapter 300 Ownership and Assignment

301 Assignability of Patents and Applications

Extract from 35 U.S.C. 261. 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, shall be prima face evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

302 Effect of Recording

Extract from 35 U.S.C. 261. 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 Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

303 Endorsing Assignments on Pending Applications

The file jacket of an application ordinarily does *not* display the endorsement of an assignment during the period an application is before an Examiner.

The name of the assignee is endorsed on the file of an application only when it is submitted to the Assignment Branch for a title report. Therefore, the file jacket *cannot be relied upon* to accurately reflect the assignment status of an application while it is pending before an Examiner. Title searches are automatically made in all applications after the payment of the issue fee.

When the determination of the assignment condition of an application is significant, as in the factual situations represented by Sections 304 and 305, it is necessary to submit the application to the Assignment Branch for a title report.

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 to another.

305 Different Inventors, Common Ownership

Where there is a common assignee of two or more applications by different inventors, these applications are subject by reason of their common ownership to treatment in general the same as though they were all the applications of the same inventor that were voluntarily separately filed; see Chapter 800 and *In re* Stanley et al., 102 USPQ 234. Note, that in order to reject on the grounds of double patenting the cases must have the same inventive entity. See 804.

Where the applications disclose and claim patentably different inventions, there being no overlap of claims, or where the earlier filed application has issued as a patent and has become a statutory bar before filing of the other application, no problems arise.

305.01 Unclaimed Subject Matter in the Earlier Filed Application

If the second filed application claims subject matter disclosed but not claimed in the earlier filed application, 35 U.S.C. 102(e) applies and the earlier filed application is a reference (Section 706.02) unless it is removed (Section 715).

305.02 Claimed Subject Matter the Same or Not Patentably Different

Where the applications by different inventors but of common ownership claim the same subject matter or subject matter that is not patentably different, questions of interference therebetween and with third parties are handled as indicated in Section 1101.01(b).

305.02(a) Rejection of One Application on the Other

Where the examiner is of the opinion that the several applications are for the same subject matter or subject matter not patentably different:—

I. the claims in the later filed application should be rejected under 35 U.S.C. 102 or 103 on the claimed subject matter of the earlier filed still pending application;

II. where the senior application issues as a patent, the other should be rejected thereon under 35 U.S.C. 102 or 103.

In the event that a common assignee, after taking out a patent on one of two or more applications, for the first time presents claims in a pending application which are not patentably distinct from claims of the patent, the claims of the application should be rejected on the ground that the assignee, by taking out the patent at a time when the application was not claiming the patented invention, is estopped to contend that the patentee is not the prior inventor.

If a patent is inadvertently issued on one of two commonly owned applications by different inventive entities which at the time when the patent issued were claiming inventions which were not patentably distinct, the assignee should be called on to make a determination of priority as in the case of pending applications. If the determination indicates that the patent issued to the senior entity the rejection set forth above in II should be maintained. If no election is made and the patent has issued to the junior entity, an interference should be declared. An election of the applicant as the first inventor should not be accepted without a complete (not terminal) disclaimer of the conflicting claims in the patent. See 804.03.

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

After the payment of the issue fee, a divisional, continuation, or substitute application is sent to the Assignment Branch where the assignment of the original application is applied without charge to the later application, provided the date of the assignment of the original application was before the filing of the later application.

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. Continuation-in-part applications require separate assignments if they are to be issued to an assignee.

The Assignment Branch has discontinued mailing notification in cases where there is a conflict in assignment between an original application and its divisional, continuation, substitute, or continuation-in-part application. Where there are conflicting assignments, the patent will normally issue to the applicant.

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 issue fee (formerly termed "final fee") is paid; in the case of an application for a design patent filed before Oct. 25, 1965, 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

The Notice of Allowance no longer provides for including the name of the assignee.

309 Restrictions Upon Employees of Patent Office

35 U.S.C. 4. Restrictions on officers and employees as to interest in patents. Officers and employees of the Patent 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.