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## 301 Assignability of Patents and Applications

35 U.S.C. 261. *Ownership; assignment.* Subject to the provisions of this title, patents shall have the attributes of personal property.

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

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

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

35 U.S.C. 262. *Joint owners.* In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

37 CFR 1.331. *Recording of assignments.* (a) Assignments, including grants and conveyances, of patents, national applications, or international applications which designate the United States of America, will be recorded in the Patent and Trademark Office under 35 U.S.C. 261. Other instruments affecting title to a patent, a national application, or an international application which designates the United States of America, and licenses, even though the recording thereof may not serve as constructive notice under 35 U.S.C. 261, will be recorded as provided in this section or in the discretion of the Commissioner. Any instrument to be recorded, except those under Part 7 of this title, must be accompanied by the fee set forth in § 1.21(h).

(b) No instrument will be recorded which is not in the English language and which does not amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates, and which does not identify the patent or application to which it relates, except as ordered by the Commissioner.

(c) An instrument relating to a patent should identify the patent by number and date (the name of the inventor and title of the invention as stated in the patent should also be given); an instrument relating to a national application, or an international application which designates the United States of America should identify the application by serial number or international application number and date of filing (the name of the inventor and title of the invention as stated in the application should also be given) but if an assignment is executed concurrently with or subsequent to the execu-

tion of the application but before the application is filed or before its serial number or international application number and filing date are ascertained, it should adequately identify the application, as by its date of execution and name of the inventor and title of the invention; so that there can be no mistake as to the patent or application intended.

37 CFR 1.333. *Conditional Assignments.* Assignments which are made conditional on the performance of certain acts or events, as the payment of money or other condition subsequent, if recorded in the Office are regarded as absolute assignments for Office purposes until cancelled with the written consent of both parties or by the decree of a competent court. The Office has no means for determining whether such conditions have been fulfilled.

## 301.01 Accessibility of Assignment Records

37 CFR 1.12. *Assignment records open to public inspection.*

(a) The assignment records, relating to original or reissue patents, including digests and indexes, and assignment records relating to pending or abandoned trademark applications and to trademark registrations are open to public inspection and copies of any instrument recorded may be obtained upon request and payment of the fee set forth in § 1.19(a)(5).

(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 for attorney or agent of record.

(d) An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number or international application number of the application, an extra charge as set forth in § 1.21(f) will be made for the time consumed in making a search for such assignment.

Assignments relating to applications for registration of trademarks are open to public inspection.

The Office will not open certain parts only 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 an assignment 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. Assignments 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 case will be open to public inspection; similar situations involving continuation-in-

part applications will be considered on their individual merits.

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

### 302 Effect of Recording

*37 CFR 1.332. Receipt and recording.* Assignments are recorded in regular order as promptly as possible, and then transmitted with the date and identification of the record stamped thereon to the persons entitled to them. The date of record is the date of the receipt of the assignment at the Office in proper form and accompanied by the fee set forth in § 1.21(h).

The Patent and Trademark Office will accept and record legible certified copies of original assignments or other instruments.

The certified copy, if not in the English language, will not be recorded unless accompanied by a translation signed by the translator.

Certification shall be to the fact that the instrument submitted is a true copy of the original and shall be made by a notary public or, if in a foreign country, by a consular officer of the United States or an officer authorized to administer oaths and authenticated by a consular officer of the United States. Certification may also be made in the form of a declaration (*37 CFR 1.68*).

### 303 Endorsing Assignments on Pending Applications

Certified copies of patent applications as filed, do not include an indication of assignments. Applicants desiring an indication of assignments of record should request separately certified copies of assignment documents and submit the fees required by *37 CFR 1.19(b)(1)* and (2).

When the determination of the assignment condition of an application is significant, as in the factual situations represented by §§ 304 and 305, or when forwarding a form PTO-850 to the Board of Patent Interferences, it is necessary to submit the application to the Assignment Division 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 claimed therein, and assigns one of the applications in its entirety, which assignment is duly recorded in the Patent and Trademark 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 assignee.

Use Form Paragraph 3.01. in conflicting subject matter situations.

#### 3.01 Conflicting Subject Matter in two Applications of Same Inventor, one of Which Is Assigned

This application has overlapping subject matter with that of applicant's copending application serial number [1]. Since an assignment of the copending application has been recorded in the Patent and Trademark Office, applicant is advised that the copending application is considered a reference against the instant application for

all common subject matter disclosed, irrespective of the filing dates of these two applications, and also of any subsequent assignment of this application to another assignee. See MPEP 304.

#### Examiner Note:

This paragraph only applies when the instant application is not assigned, and thus knowledge thereof cannot be disclosed in the copending application. Thus, the presumption is made that the copending (assigned) application is prior art, placing the burden on applicant to overcome the presumption. If both are commonly assigned, this presumption is not made and a normal double patenting rejection is made.

### 305 Different Inventors, Common Ownership

Where there is a common assignee of two or more applications by different inventors involving conflicting subject matter see § 804.03. Note, that in order to reject on the grounds of double patenting the cases must have the same inventive entity. See § 804.

#### 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 §§ 804.03 and 1101.01(b).

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

In the case of a continuation-in-part, a prior assignment of the original application is not applied 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 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.

The Assignment Division 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

*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 1.334. Issue of patent to assignee.* (a) In case of an assignment of the entire interest in the invention and application, or of the entire interest in the patent to be granted, the patent will normally issue to the assignee. If the assignee should hold an undivided part interest, the patent will normally issue jointly to the inventor and the assignee. If it is desired that the patent so issue, the assignment in either case must first have been recorded, and at a day not later than the date payment is made of the issue fee.

(b) At the time of payment of the issue fee, a statement must be furnished indicating whether or not an assignment has been filed

with the Patent and Trademark Office. In the event an assignment has been filed, such statement must include the name and address of the assignee and indicate whether or not an acknowledgment of a recorded assignment has been received from the Patent and Trademark Office.

(c) If the assignment is recorded after the date of payment of the issue fee, the assignee may petition that the patent issue to the assignee as recorded. Any such petition must be accompanied by the fee set forth in § 1.17(i).

For the patent to normally 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.

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

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee payment form.

### 308 Notice of Allowance Where Application Is Assigned

The Issue Fee Transmittal Form portion (PTOL-85b) of the Notice of Allowance provides a space (item 2) for assignment data which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 2 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 correction of error arising from incomplete or erroneous information furnished in item 2 of PTOL-85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

### 309 Restrictions Upon Employees of Patent and Trademark Office

*35 U.S.C. 4. Restrictions on officers and employees as to interest 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 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 § 201.11), in this case the required "License Rights" statement should follow immediately as the second paragraph of the specification.

If there is no reference to an earlier application, the required "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 to competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the 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 of such notices.