

§ 1.991

in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the Commissioner may suspend the *inter partes* reexamination or the interference. The Commissioner will not consider a request to suspend an interference unless a motion under § 1.635 to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an admin-

37 CFR Ch. I (7-1-02 Edition)

istrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

§ 1.995 Third party requester's participation rights preserved in merged proceeding.

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester's right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

§ 1.997 Issuance of *inter partes* reexamination certificate.

(a) Upon the conclusion of an *inter partes* reexamination proceeding, the Commissioner will issue a certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

U.S. Patent and Trademark Office, Commerce

§ 3.11

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

EDITORIAL NOTE: Part 2 is placed in the separate grouping of parts pertaining to trademarks regulations. It appears on page 263 of this volume.

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

Sec.

3.1 Definitions.

DOCUMENTS ELIGIBLE FOR RECORDING

- 3.11 Documents which will be recorded.
- 3.16 Assignability of trademarks prior to filing of an allegation of use.

REQUIREMENTS FOR RECORDING

- 3.21 Identification of patents and patent applications.
- 3.24 Requirements for documents and cover sheets relating to patents and patent applications.
- 3.25 Recording requirements for trademark applications and registrations.
- 3.26 English language requirement.
- 3.27 Mailing address for submitting documents to be recorded.
- 3.28 Requests for recording.

COVER SHEET REQUIREMENTS

- 3.31 Cover sheet content.
- 3.34 Correction of cover sheet errors.

FEEES

- 3.41 Recording fees.

DATE AND EFFECT OF RECORDING

- 3.51 Recording date.
- 3.54 Effect of recording.
- 3.56 Conditional assignments.
- 3.58 Governmental registers.

DOMESTIC REPRESENTATIVE

- 3.61 Domestic representative.

ACTION TAKEN BY ASSIGNEE

- 3.71 Prosecution by assignee.
- 3.73 Establishing right of assignee to take action.

ISSUANCE TO ASSIGNEE

- 3.81 Issue of patent to assignee.
- 3.85 Issue of registration to assignee.

AUTHORITY: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

SOURCE: 57 FR 29642, July 6, 1992, unless otherwise noted.

§ 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.

DOCUMENTS ELIGIBLE FOR RECORDING

§ 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 Commissioner.

(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 Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting