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5.

OWNERSHIP AND ASSIGNMENT

5-1.

Assignability of Patents

Every patent or any interest therein is assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under the patent to the whole or any specified part of the United States. (from Sec. 4898 R.S.)

5-1-1.

In Whom May Be Vested

Interest in patents may be vested in assignees, in grantees of exclusive territorial rights, in mortgagees, and in licensees.

5-1-2.

Assignee

An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed and duly signed.

5-1-3.

Grantee

A grantee acquires by the grant, the exclusive right, under the patent, to make, use, and vend, and to grant to others the right to make, use, and vend, the thing patented within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed and be duly signed.

5-1-4.

Mortgagee

A mortgage must be written or printed and be duly signed.

5-1-5.

Licensee

A licensee takes an interest less than or different from either of the others. A license may be oral, written, or printed, and if written, or printed, must be duly signed.

5-2.

Acknowledgment

Act, Mar. 3, 1897: If any assignment, grant, or conveyance of any patent shall be acknowledged before any

notary public of the several States or Territories or the District of Columbia, or any Commissioner of any court of the United States for any District or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance.

5-3. Recording

No instrument will be recorded which is not in the English language and which does not, in the judgment of the Commissioner, 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. Such instrument should identify the patent by date and number; or, if the invention be unpatented, the name of the inventor, the serial number, and date of the application should be stated.

5-3-1. Receipt, Recording,
and Return of Assignments

The receipt of assignments is generally acknowledged by the office. They are recorded in regular order as promptly as possible, and then transmitted to the persons entitled to them. Sec. 2-1-4 for secret recording of Government-owned applications under Sec. 4894 R.S.

5-3-2. Date of Record

The date of the record is the date of the receipt of the assignment at the office in proper form and accompanied by the full legal fee for recording.

5-3-3. Effect of Recording

Sec. 4898 R.S.: An assignment, grant, or conveyance of a patent will be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice unless recorded in the Patent Office within three months from the date thereof or prior to such subsequent purchase or mortgage.

5-4. Conditional Assignment

Assignments which are made conditional on the performance of certain stipulations, as the payment of money, if recorded in the office are regarded as absolute assignments until canceled with the written consent of both parties or by the decree of a competent court.

The office has no means to determine whether such conditions have been fulfilled.

5-5. Details of Assignment Procedure

When an assignment is received in the Patent Office with the proper fee for recording, it goes to the Assignment Division, where it is indexed. A card index of assignees is kept and also a card index of inventors. The assignment is reproduced in record books, and the original is returned to the party filing it. A digest of the assignment is made indicating its purport and showing how it affects the title to the patent or application.

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

In the case of every application where the final fee has been paid, the file, before it goes to the Printing Office, is sent to the Assignment Division where a search is made to see that the proper assignee's name is endorsed on the file. The patent issues to the assignee whose name is indorsed on the file by the Assignment Division.

An exclusive license to make, use, and sell is treated as an assignment except that the patent does not issue to the licensee unless so requested in the license.

The records in the Assignment Division are open to the public for search and examination and copies of any assignment on record or of the abstracts of assignment may be obtained.

The assignment Division has a complete card index of all the inventors and registrants from deeds recorded from 1905 to date, for use in making title searches. It also has a card index since 1922 of inventors, assignors, and assignees in deeds received for record, from which searches can be completed from the book indexes prior to 1922 to ascertain what assignments have been received under the name of an assignor, assignee, or inventor.

5-5-1. Paper and Type to Be Used

The Patent Office records assignments by a photostat process, giving an accurate reproduction of the original document. It is, therefore, requested that all instruments presented for recording be typed on white paper in black ink, that when the papers are ribboned, the ribbons be arranged as not to obscure the typing and

that as far as possible the seal and any certificates be placed directly on the body of the assignment, after and below the signatures.

5-6.

Control By Assignee
of the Entire Interest

The assignee of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his own choice. Such intervention, however, does not exclude the inventor from access to the application to see that it is being properly prosecuted, unless the assignee makes specific requests to that effect. Despite such a request, the applicant may be permitted to inspect the case on sufficient showing why such inspection is necessary to conserve his rights.

5-7.

Conflicting Assignments

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to him unless there are conflicting assignments. Where there are two or more conflicting assignments of an application the assignee whose date of assignment is earliest may, if his assignment is recorded in the Patent Office, take over the prosecution of the case, and this irrespective of whether the date of recording in the Office is earlier or later than that of some other assignee. Although the Office practice permits this earliest assignee to prosecute the case, the patent issues to the inventor, leaving to the courts to decide the question of title as between the conflicting assignments.

5-8.

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 becomes reference against the second application for all common subject matter, irrespective of the dates of filing of the two applications, and also of any subsequent assignment of the second case. Sec. 10-8-23.

5-9.

Rejection Because of Common Ownership

Where there is a common assignee of two or more applications by different inventors these applications by reason of their common ownership are subject 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; or when one claiming that common subject matter is passed for issue it becomes as to such subject matter prior art against the other applications of that ownership.

5-10. Rights of Assignee of Part Interest

While it is only the assignee of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, as assignee of a part interest or a licensee of exclusive right is entitled to knowledge of the steps being taken in such prosecution.

5-11. Assignment of Division, Continuation, Substitution and Continuation-in-Part in Relation to Parent Case

Where there is filed a division, a continuation, or a substitute of a prior application which has been assigned, the assignment of the parent case applies to the later filed case. Where the later case is a continuation-in-part, the assignment does not carry over from the earlier case. For this reason the examiner does not endorse on the margin of the face of the file jacket of such case a notation as to its being a continuation-in-part, but does appropriately endorse a division, a continuation and a substitute. Such endorsement on the file wrapper should be made by the examiner at the time of his first action on the later case, and when preparing the case for issue the file should be sent to the Assignment Division for notation on the wrapper of the data pertaining to the assignment of the prior case.

Where the application is a continuation-in-part, the letters "C-1" are stamped at the bottom of the file jacket, and when the case is ready for allowance, it will be sent to the Assignment Division for title search.

5-12. Issue to Assignee

When the patent is normally issued to an assignee, the assignment must be recorded in the Patent Office at a date (C. 27) not later than the day on which the final fee is paid. In the case of an application for a design patent, the assignment must be recorded before the case is allowed.

5-12-1.

Notice of Allowance
Where Case 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.

Where an applicant carrying on the prosecution of an application after assignment dies, his administrator may carry on the prosecution on filing letters of administration unless and until the assignee intervenes.

5-12-2.

Issue of a Patent to
an Assignee of an Assignee

In view of the fact that an assignee takes title altogether by virtue of his grant and not at all through any request to the Commissioner of Patents, it is directed that hereafter whenever an assignee of the whole interest in an application assigns that application with request that the patent be granted to his assignee, the patent should issue as requested, even though the prior assignment or assignments contain no request as to whom the patent should be issued.