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## **301 Ownership/Assignability of Patents and Applications [R-10.2019]**

### **35 U.S.C. 261 Ownership; assignment.**

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.

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 interest that constitutes 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, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.

#### 37 CFR 3.1 Definitions.

For purposes of this part, the following definitions shall apply:

*Application* means a national application for patent, an international patent application that designates the United States of America, an international design application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

*Assignment* means a transfer by a party of all or part of its right, title and interest in a patent, patent application, 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 United States 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.

## I. OWNERSHIP

Ownership of a patent gives the patent owner the right to exclude others from making, using, offering for sale, selling, or importing into the United States the invention claimed in the patent. [35 U.S.C. 154\(a\)\(1\)](#). Ownership of the patent does not furnish the owner with the **right** to make, use, offer for sale, sell, or import the claimed invention because there may be other legal considerations precluding same

(e.g., existence of another patent owner with a dominant patent, failure to obtain FDA approval of the patented invention, an injunction by a court against making the product of the invention, or a national security related issue).

For applications filed on or after September 16, 2012, the original applicant is presumed to be the owner of the application for an original patent. See [37 CFR 3.73\(a\)](#). For applications filed before September 16, 2012, the ownership of the patent (or the application for the patent) initially vests in the named inventors of the invention of the patent. See *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26 USPQ2d 1572, 1582 (Fed. Cir. 1993). A patent or patent application is assignable by an instrument in writing, and the assignment of the patent, or patent application, transfers to the assignee(s) an alienable (transferable) ownership interest in the patent or application. [35 U.S.C. 261](#).

## II. ASSIGNMENT

“Assignment,” in general, is the act of transferring to another the ownership of one’s property, i.e., the interest and rights to the property. The U.S. Patent and Trademark Office cannot explain or interpret laws that govern assignments and related documents, nor can it act as counselor for individuals. Assignments and other documents are contracts that are governed by the relevant state or jurisdictional law.

In [37 CFR 3.1](#), assignment of patent rights is defined as “a transfer by a party of all or part of its right, title and interest in a patent [or] patent application...” An assignment of a patent, or patent application, is the transfer to another of a party’s **entire** ownership interest or a percentage of that party’s ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application. [35 U.S.C. 261](#) requires transfer of ownership by an assignment to be in writing. See *Realvirt, LLC v. Lee*, 195 F.Supp.3d 847, 859 (E.D. Va. 2016).

### III. LICENSING

As compared to assignment of patent rights, the licensing of a patent transfers a bundle of rights which is less than the entire ownership interest, e.g., rights that may be limited as to time, geographical area, or field of use. A patent license is, in effect, a contractual agreement that the patent owner will not sue the licensee for patent infringement if the licensee makes, uses, offers for sale, sells, or imports the claimed invention, as long as the licensee fulfills its obligations and operates within the bounds delineated by the license agreement.

An exclusive license may be granted by the patent owner to a licensee. The exclusive license prevents the patent owner (or any other party to whom the patent owner might wish to sell a license) from competing with the exclusive licensee, as to the geographic region, the length of time, and/or the field of use, set forth in the license agreement.

A license is not an assignment of the patent. Even if the license is an exclusive license, it is **not** an assignment of patent rights in the patent or application.

### IV. INDIVIDUAL AND JOINT OWNERSHIP

**Individual ownership** - An individual entity may own the entire right, title and interest of the patent property. This occurs where there is only one inventor, and the inventor has not assigned the patent property. Alternatively, it occurs where all parties having ownership interest (all inventors and assignees) assign the patent property to one party.

**Joint ownership** - Multiple parties may **together** own the entire right, title and interest of the patent property. This occurs when any of the following cases exist:

- (A) Multiple partial assignees of the patent property;
- (B) Multiple inventors who have not assigned their right, title and interest; or
- (C) A combination of partial assignee(s), and inventor(s) who have not assigned their right, title and interest.

Each individual inventor may only assign the interest he or she holds; thus, assignment by one joint inventor renders the assignee a partial assignee. A partial assignee likewise may only assign the interest it holds; thus, assignment by a partial assignee renders a subsequent assignee a partial assignee. All parties having any portion of the ownership in the patent property must act **together** as a composite entity in patent matters before the Office.

### V. MAKING THE ASSIGNMENT OF RECORD

An assignment can be made of record in the United States Patent and Trademark Office (Office) in two different ways, for two different purposes. The differences are important to note:

(A) An assignment can be made of record in the assignment records of the Office as provided for in [37 CFR Part 3](#). Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document or the effect of the assignment document on the ownership of the patent property. See [37 CFR 3.54](#), [MPEP § 317.03](#), and *Realvirt, LLC v. Lee*, 195 F.Supp.3d 847, 862-3 (E.D. Va. 2016). For a patent to issue to an assignee, the assignment must have been recorded or filed for recordation in accordance with [37 CFR 3.11](#). See [37 CFR 3.81\(a\)](#).

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step may be necessary to permit the assignee to “take action” in the application, patent, or other patent proceeding under the conditions set forth in [37 CFR 1.46](#) and [37 CFR 3.81\(a\)](#) and [MPEP § 325](#) (for applications filed on or after September 16, 2012) or under the conditions set forth in [pre-AIA 37 CFR 3.73](#) and [MPEP § 324](#) (for applications filed before September 16, 2012). Recordation of an assignment in the assignment records of the Office does **not**, by itself, permit the assignee to take action in the application, patent, or other patent proceeding.

Additionally, for applications filed under [35 U.S.C. 111\(a\)](#), [363](#), or [385](#) on or after September 16, 2012, an assignment may contain the statements required to be made in an oath or declaration

(“assignment-statement”), and if the assignment is made of record in the assignment records of the Office, then the assignment may be utilized as the oath or declaration. See [35 U.S.C. 115\(e\)](#), [37 CFR 1.63\(e\)](#), and [MPEP §§ 302.07, 317](#), and [MPEP § 602.01\(a\)](#).

### 301.01 Accessibility of Assignment Records [R-10.2019]

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

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), and published patent applications are open to public inspection at the United States Patent and Trademark Office, and copies of patent assignment records may be obtained upon request and payment of the fee set forth in [§ 1.19](#) of this chapter. See [§ 2.200](#) of this chapter regarding trademark assignment records.

(2) All records of assignments of patents recorded before May 1, 1957, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application, which is open to the public pursuant to [§ 1.11](#) or for which copies or access may be supplied pursuant to [§ 1.14](#), are available to the public. Copies of any assignment records, digests, and indexes that are not available to the public shall be obtainable only upon written authority of an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record, 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 in this part.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under [§ 1.14](#), or any information with respect thereto, must:

(1) Be in the form of a petition including the fee set forth in [§ 1.17\(g\)](#); or

(2) Include written authority granting access to the member of the public to the particular assignment records from an inventor, the applicant, the assignee or an assignee of an undivided part interest, or a patent practitioner of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in [§ 1.21\(j\)](#) will be made for the time consumed in making a search for such assignment.

Assignment documents relating to patents, published patent applications, registrations of trademarks, and applications for registration of trademarks are open to public inspection. Records related to assignments of patents, and patent applications that have been published as patent application publications are available on the USPTO website. Images of assignment documents recorded June 1998 and later are also viewable on the Office website. To view images of earlier-recorded assignment documents, members of the public must place an order pursuant to [37 CFR 1.12\(d\)](#).

The Office will not open only certain parts 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 a document 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 published or patented. Documents relating only to one or more pending applications for patent which have not been published under [35 U.S.C. 122\(b\)](#) will not be open to public inspection.

Copies of assignment records relating to pending or abandoned patent applications which are open to the public pursuant to [37 CFR 1.11](#) or for which copies or access may be supplied pursuant to [37 CFR 1.14](#) are available to the public. For pending or abandoned applications which are not open to the public pursuant to [37 CFR 1.11](#) or for which copies or access may not be supplied pursuant to [37 CFR 1.14](#), information related thereto is only obtainable upon a proper showing of written authority. For applications filed on or after September 16, 2012, the written authority must be from (A) an inventor, (B) an applicant, (C) the assignee or an assignee of an undivided part interest, (D) a patent practitioner of record, or (E) a person with written authority from (A), (B), or (C) or (D). See [37 CFR 1.12](#). For applications filed prior to September 16, 2012, the written authority must be from the applicant or applicant’s assignee or from the attorney or agent of either, or upon a showing that the person seeking such information is a bona fide prospective or actual

purchaser, mortgagee, or licensee of such application. See [pre-AIA 37 CFR 1.12](#).

If the application on which a patent was granted is a division, continuation, or continuation-in-part of an earlier application, the assignment records of that earlier application will be open to public inspection because copies or access may be supplied to the earlier application pursuant to [37 CFR 1.14](#).

Assignment records relating to reissue applications are open to public inspection because reissue applications are open to public inspection pursuant to [37 CFR 1.11\(b\)](#).

Requests for abstracts of title for assignments of patents recorded after May 1, 1957, are provided by the Certification Division upon request and payment of fee required in [37 CFR 1.19](#). Requests for copies of pre-1957 records for patents should be directed to the National Archives and Records Administration (NARA). Since these records are maintained by NARA, it is more expeditious to request copies directly from NARA, rather than from the Office, which would then have to route the requests to NARA. Payment of the fees required by NARA should accompany all requests for copies.

All assignment records from 1837 to April 30, 1957 for patents are now maintained and are open for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746 and at the Civilian Records Division of the National Archives at College Park, 8601 Adelphi Road, College Park, MD 20740-6001. Assignment records from before 1837 are not available. Individuals should check the National Archives website, [www.archives.gov](http://www.archives.gov), for how to obtain information from these locations.

## 302 Recording of Assignment Documents [R-07.2015]

### *37 CFR 3.11 Documents which will be recorded.*

(a) Assignments of applications, patents, and registrations, and other documents relating to interests in patent applications and patents, 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 Director.

(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 Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

(c) A joint research agreement or an excerpt of a joint research agreement will also be recorded as provided in this part.

### *37 CFR 3.58 Governmental registers.*

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424. This Departmental Register will not be open to public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in [§ 1.12](#).

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424. Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Director. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.

[37 CFR Part 3](#) sets forth Office rules on recording assignments and other documents relating to interests in patent applications and patents and the rights of an assignee.

[37 CFR 3.11\(c\)](#) provides that the Office will record a joint research agreement or an excerpt of a joint research agreement.



### 302.01 Assignment Document Must Be Copy for Recording [R-08.2012]

#### *37 CFR 3.24 Requirements for documents and cover sheets relating to patents and patent applications.*

(a) *For electronic submissions:* Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one-inch) margin must be present on all sides.

(b) *For paper or facsimile submissions:* Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one-inch) margin must be present on all sides. For paper submissions, the paper used should be flexible, strong white, non-shiny, and durable. The Office will not return recorded documents, so original documents must not be submitted for recording.

The United States Patent and Trademark Office will accept and record only a copy of an original assignment or other document. See [MPEP § 317](#). The document submitted for recordation will not be returned to the submitter. If the copy submitted for recordation is illegible, the recorded document will be illegible. Accordingly, applicants and patent owners should ensure that only a legible copy is submitted for recordation.

### 302.02 Translation of Assignment Document [R-08.2012]

#### *37 CFR 3.26 English language requirement.*

The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.

The assignment document, if not in the English language, will not be recorded unless accompanied by an English translation signed by the translator.

### 302.03 Identifying Patent or Application [R-07.2015]

#### *37 CFR 3.21 Identification of patents and patent applications.*

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number; e.g., 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number; e.g., PCT/US2012/012345. An assignment relating to an international design application which designates the United States of America must identify the international design application by the international registration number or by the U.S. application number assigned to the international design application. If an assignment of a patent application filed under [§ 1.53\(b\)](#) of this chapter is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under [§ 1.53\(c\)](#) of this chapter is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

The patent or patent application to which an assignment relates must be identified by patent number or application number unless the assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed. Then, the application must be identified by the name(s) of the inventors, and the title of the invention. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name(s) of the inventors and the title of the invention.

The Office makes every effort to provide applicants with the application numbers for newly filed patent applications as soon as possible. It is suggested, however, that an assignment be written to allow entry of the identifying number after the execution of the assignment. An example of acceptable wording is:

“I hereby authorize and request my attorney, (Insert name), of (Insert address), to insert here in parentheses (Application number, filed ) the filing date and application number of said application when known.”

### 302.04 Foreign Assignee May Designate Domestic Representative [R-10.2019]

#### 35 U.S.C. 293 Nonresident patentee; service and notice.

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the Eastern District of Virginia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

#### 37 CFR 3.61 Domestic representative.

If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

An assignee of a patent or patent application who is not domiciled in the United States may, by written document signed by such assignee, designate a domestic representative. The designation of domestic representative should always be submitted to the Office as a paper separate from any assignment document. The designation of a domestic representative should be clearly labeled “Designation of Domestic Representative” and it will be entered into the record of the appropriate application or patent file. The designation must be signed in accordance with [37 CFR 1.33\(b\)](#).

### 302.05 Address of Assignee [R-08.2012]

The address of the assignee may be recited in the assignment document and must be given in the required cover sheet. See [MPEP § 302.07](#).

### 302.06 Fee for Recording [R-10.2019]

#### 37 CFR 3.41 Recording fees.

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of

this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)); and

(2) The document and cover sheet are either: Faxed or electronically submitted as prescribed by the Director, or mailed to the Office in compliance with § [3.27](#).

The recording fee set in [37 CFR 1.21\(h\)](#) is charged for each patent application and patent identified in the required cover sheet except as provided in [37 CFR 3.41\(b\)](#). If the request to record a document is submitted electronically, the fee is set forth in [37 CFR 1.21\(h\)\(1\)](#), currently at \$0. If the request to record a document is not submitted electronically (i.e., is submitted on paper or via facsimile), the applicable fee is set forth in [37 CFR 1.21\(h\)\(2\)](#). Customers should check the current fee schedule on the Office website before submitting documents for recordation. See [MPEP §§ 302.08 - 302.10](#) for additional information regarding the acceptable ways to submit documents for recordation.

### 302.07 Assignment Document Must Be Accompanied by a Cover Sheet [R-10.2019]

#### 37 CFR 3.28 Requests for recording.

Each document submitted to the Office for recording must include a single cover sheet (as specified in § [3.31](#)) referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, then separate patent and trademark cover sheets, each accompanied by a copy of the document to be recorded, must be submitted. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § [3.51](#) for proper completion, in which case the document and a completed cover sheet should be resubmitted.

#### 37 CFR 3.31 Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

- (1) The name of the party conveying the interest;
- (2) The name and address of the party receiving the interest;

(3) A description of the interest conveyed or transaction to be recorded;

(4) Identification of the interests involved:

(i) For trademark assignments and trademark name changes: Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) For any other document affecting title to a trademark or patent application, registration or patent: Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(6) The date the document was executed;

(7) The signature of the party submitting the document. For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* /Thomas O'Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

(8) For trademark assignments, the entity and citizenship of the party receiving the interest. In addition, if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document relates to a Government interest; and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

(f) Each trademark cover sheet should include the citizenship of the party conveying the interest.

(g) The cover sheet required by § 3.28 seeking to record a joint research agreement or an excerpt of a joint research agreement as provided by § 3.11(c) must:

(1) Identify the document as a “joint research agreement” (in the space provided for the description of the interest conveyed or transaction to be recorded if using an Office-provided form);

(2) Indicate the name of the owner of the application or patent (in the space provided for the name and address of the party receiving the interest if using an Office-provided form);

(3) Indicate the name of each other party to the joint research agreement party (in the space provided for the name of the party conveying the interest if using an Office-provided form); and

(4) Indicate the date the joint research agreement was executed.

(h) The assignment cover sheet required by § 3.28 for a patent application or patent will be satisfied by the Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, Patent Law Treaty Model International Request for Recordation of a License/ Cancellation of the Recordation of a License Form, Patent Law Treaty Model Certificate of Transfer Form or Patent Law Treaty Model International Request for Recordation of a Security Interest/ Cancellation of the Recordation of a Security Interest Form, as applicable, except where the assignment is also an oath or declaration under § 1.63 of this chapter. An assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as an oath or declaration under § 1.63 of this chapter.

Each assignment document submitted to the Office for recording must be accompanied by a cover sheet as required by 37 CFR 3.28. The cover sheet for patents or patent applications must contain:

(A) The name of the party conveying the interest;

(B) The name and address of the party receiving the interest;

(C) A description of the interest conveyed or transaction to be recorded;

(D) Each patent application number or patent number against which the document is to be recorded, or an indication that the document is filed together with a patent application;



(E) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(F) The date the document was executed; and

(G) The signature of the party submitting the document.

For applications filed on or after September 16, 2012, if the assignment document is also intended to serve as the required oath or declaration, the cover sheet must also contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under [37 CFR 1.63](#). See [37 CFR 3.31\(h\)](#).

If the document submitted for recordation is a joint research agreement or an excerpt of a joint research agreement, the cover sheet must clearly identify the document as a "joint research agreement" (in the space provided for the description of the interest conveyed if using Form PTO-1595). The date the joint research agreement was executed must also be identified. The cover sheet must also identify the name(s) of the owner(s) of the application or patent (in the space provided for the name and address of the party receiving the interest if using Form PTO-1595). The name(s) of every other party(ies) to the joint research agreement must also be identified (in the space provided for the name of the party conveying the interest if using Form PTO-1595).

Each patent cover sheet should contain the number of patent applications or patents identified in the cover sheet and the total fee.

Examples of the type of descriptions of the interest conveyed or transaction to be recorded that can be identified are:

- (A) assignment;
- (B) security agreement;
- (C) merger;
- (D) change of name;
- (E) license;
- (F) foreclosure;
- (G) lien;
- (H) contract; and
- (I) joint research agreement.

Cover sheets required by [37 CFR 3.28](#) seeking to record a governmental interest must also (1) indicate that the document relates to a governmental interest and (2) indicate, if applicable, that the document to be recorded is not a document affecting title.

A patent cover sheet may not refer to trademark applications or registrations.

Form PTO-1595, Recordation Form Cover Sheet, may be used as the cover sheet for recording documents relating to patent(s) and/or patent application(s) in the Office.

Form PTO-1595 (Rev. 6-12)  
OMB No. 0651-0027 (exp. 06/30/2021)

U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

<b>RECORDATION FORM COVER SHEET</b> <b>PATENTS ONLY</b>	
To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.	
<b>1. Name of conveying party(ies)</b>  Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No	<b>2. Name and address of receiving party(ies)</b> Name: _____ Internal Address: _____ _____ Street Address: _____ _____ City: _____ State: _____ Country: _____ Zip: _____ Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No
<b>3. Nature of conveyance/Execution Date(s):</b> Execution Date(s) _____ <input type="checkbox"/> Assignment <span style="margin-left: 100px;"><input type="checkbox"/> Merger</span> <input type="checkbox"/> Security Agreement <span style="margin-left: 100px;"><input type="checkbox"/> Change of Name</span> <input type="checkbox"/> Joint Research Agreement <input type="checkbox"/> Government Interest Assignment <input type="checkbox"/> Executive Order 9424, Confirmatory License <input type="checkbox"/> Other _____	<b>4. Application or patent number(s):</b> <input type="checkbox"/> This document serves as an Oath/Declaration (37 CFR 1.63). A. Patent Application No. (s) _____ B. Patent No. (s) _____  Additional numbers attached? <input type="checkbox"/> Yes <input type="checkbox"/> No
<b>5. Name and address to whom correspondence concerning document should be mailed:</b> Name: _____ Internal Address: _____ _____ Street Address: _____ _____ City: _____ State: _____ Zip: _____ Phone Number: _____ Docket Number: _____ Email Address: _____	<b>6. Total number of applications and patents involved:</b> _____ <b>7. Total fee (37 CFR 1.21(h) &amp; 3.41) \$</b> _____ <input type="checkbox"/> Authorized to be charged to deposit account <input type="checkbox"/> Enclosed <input type="checkbox"/> None required (government interest not affecting title)
<b>8. Payment Information</b>  Deposit Account Number _____ Authorized User Name _____	
<b>9. Signature:</b> _____ <div style="display: flex; justify-content: space-between; width: 80%; margin: 0 auto;"> <span>Signature</span> <span>Date</span> </div> _____ Name of Person Signing <span style="float: right;">Total number of pages including cover sheet, attachments, and documents: <input style="width: 40px; height: 20px;" type="text"/></span>	
<small>Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to: Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450</small>	

## Guidelines for Completing Patents Cover Sheets (PTO-1595)

Cover sheet information must be submitted with each document to be recorded. If the document to be recorded concerns both patents and trademarks separate patent and trademark cover sheets, including any attached pages for continuing information, must accompany the document. All pages of the cover sheet should be numbered consecutively, for example, if both a patent and trademark cover sheet is used, and information is continued on one additional page for both patents and trademarks, the pages of the cover sheet would be numbered from 1 to 4.

### Item 1. Name of Conveying Party(ies).

Enter the full name of the party(ies) conveying the interest. If there is insufficient space, enter a check mark in the "Yes" box to indicate that additional information is attached. The name of the additional conveying party(ies) should be placed on an attached page clearly identified as a continuation of the information Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page. If the document to be recorded is a joint research agreement, enter the name(s) of the party(ies) other than the owner of the patent or patent application as the conveying party(ies).

### Item 2. Name and Address of Receiving Party(ies).

Enter the name and full address of the first party receiving the interest. If there is more than one party receiving the interest, enter a check mark in the "Yes" box to indicate that additional information is attached. Enter a check mark in the "No" box, if no information is contained on an attached page. If the document to be recorded is a joint research agreement, enter the name(s) of the patent or patent application owner(s) as the receiving party.

### Item 3. Nature of Conveyance/Execution Date(s).

Enter the execution date(s) of the document. It is preferable to use the name of the month, or an abbreviation of that name, in order that confusion over dates is minimized. Place a check mark in the appropriate box describing the nature of the conveying document. If the "Other" box is checked, specify the nature of the conveyance.

### Item 4. Application Number(s) or Patent Number(s).

Indicate the application number(s), and/or patent number(s) against which the document is to be recorded. National application numbers must include both the series code and a six-digit number (e.g., 07/123,456), and international application numbers must be complete (e.g., PCT/US91/12345). An international design application for which a national application number has not been assigned may be indicated by the international registration number (e.g., DM/123456).

Enter a check mark in the appropriate box: "Yes" or "No" if additional numbers appear on attached pages. Be sure to identify numbers included on attached pages as the continuation of Item 4. Also enter a check mark if this Assignment is being filed as an Oath/Declaration (37 CFR 1.63).

**Item 5. Name and Address of Party to whom correspondence concerning the document should be mailed.** Enter the name and full address of the party to whom correspondence is to be mailed.

### Item 6. Total Applications and Patents involved.

Enter the total number of applications and patents identified for recordation. Be sure to include all applications and patents identified on the cover sheet and on additional pages.

### Block 7. Total Fee Enclosed.

Enter the total fee enclosed or authorized to be charged. A fee is required for each application and patent against which the document is recorded.

### Item 8. Payment Information.

Enter the deposit account number and authorized user name to authorize charges.

### Item 9. Signature.

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet. Enter the total number of pages including the cover sheet, attachments, and document.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number. This collection of information is required by 35 USC 261 and 262 and 15 USC 1057 and 1060. The information is used by the public to submit (and by the USPTO to process) patent and trademark assignment requests. After the USPTO records the information, the records for patent and trademarks, assignments, and other associated documents can be inspected by the public. To view documents recorded under secrecy orders or documents recorded due to the interest of the federal government, a written authorization must be submitted. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the form to the USPTO. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Manager of the Assignment Division, USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.  
DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Assignment Recordation Services, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.

### **Privacy Act Statement for Patent Assignment Recordation Form Cover Sheet**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the above request for information. This collection of information is authorized by 35 U.S.C. 1, 2, 261 and E.O. 9424. This information will primarily be used by the USPTO for the recordation of assignments related to patents and patent applications. Submission of this information is voluntary but is required in order for the USPTO to record the requested assignment. If you do not provide the information required on the cover sheet, the assignment will not be recorded, and all documents will be returned to you.

After the information is recorded, the records and associated documents can be inspected by the public and are not confidential, except for documents that are sealed under secrecy orders or related to unpublished patent applications. Assignment records relating to unpublished patent applications are maintained in confidence in accordance with 35 U.S.C. 122. Records open to the public are searched by users for the purpose of determining ownership for other property rights with respect to patents and trademarks.

Routine uses of the information you provide may also include disclosure to appropriate Federal, state, local, or foreign agencies in support of their enforcement duties and statutory or regulatory missions, including investigating potential violations of law or contract and awarding contracts or other benefits; to a court, magistrate, or administrative tribunal in the course of presenting evidence; to members of Congress responding to requests for assistance from their constituents; to the Office of Management and Budget in connection with the review of private relief legislation; to the Department of Justice in connection with a Freedom of Information Act request; to a contractor in the performance of their duties; to the Office of Personnel Management for personnel studies; and to the General Services Administration (GSA) as part of their records management responsibilities under the authority of 44 U.S.C. 2904 and 2906. Such disclosure to GSA shall not be used to make determinations about individuals.

### 302.08 Mailing Address for Submitting Assignment Documents [R-08.2012]

*37 CFR 3.27 Mailing address for submitting documents to be recorded.*

Documents and cover sheets submitted by mail for recordation should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications.

[37 CFR 3.27](#) sets out how documents submitted for recording should be addressed to the Office. In order to ensure prompt and proper processing, documents and their cover sheets should be addressed to the Mail Stop Assignment Recordation Services, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, unless they are filed together with new applications. Requests for recording documents which accompany new applications should be addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

### 302.09 Facsimile Submission of Assignment Documents [R-11.2013]

Assignments and other documents affecting title may be submitted to the Office via facsimile (fax). See the USPTO website or [MPEP § 1730](#) for the facsimile number. This process allows customers to submit their documents directly into the automated Patent and Trademark Assignment System and receive the resulting recordation notice at their fax machine. The customer's fax machine should be connected to a dedicated line because recordation notices will be returned automatically to the sending fax number through the Patent and Trademark Assignment System. If the Office system is unable to complete transmission of the recordation notice, the notice will be printed and mailed to the sender by U.S. Postal Service first class mail. Recorded documents will not be returned with the "Notice of Recordation."

Any assignment-related document for patent matters submitted by facsimile must include:

(A) an identified application or patent number;

(B) one cover sheet to record a single transaction; and

(C) payment of the recordation fee by a credit card (use of the Credit Card form, PTO-2038 (see [MPEP § 509](#)), is required for the credit card information to be kept separate from the assignment records) or a USPTO Deposit Account.

The following documents **cannot** be submitted via facsimile:

(A) Assignments submitted concurrently with newly filed patent applications;

(B) Documents with two or more cover sheets (e.g., a single document with one cover sheet to record an assignment, and a separate cover sheet to record separately a license relating to the same property); and

(C) Requests for "at cost" recordation services.

The date of receipt accorded to an assignment document sent to the Office by facsimile transmission is the date the complete transmission is received in the Office. See [MPEP § 502.01](#). The benefits of a certificate of transmission under [37 CFR 1.8](#) are available.

If a document submitted by fax is determined not to be recordable, the entire document, with its associated cover sheet, and the Office "Notice of Non-Recordation" will be transmitted via fax back to the sender. Once corrections are made, the initial submission, amended, may then be resubmitted by mailing the corrected submission to the address set forth in [37 CFR 3.27](#). Timely resubmission will provide the sender with the benefit of the initial receipt date as the recordation date in accordance with [37 CFR 3.51](#).

The Patent and Trademark Assignment System assigns reel and frame numbers and superimposes recordation stampings on the processed and stored electronic images. Accordingly, copies of all recorded documents will have the reel and frame numbers and recordation stampings.

### 302.10 Electronic Submission of Assignment Documents [R-10.2019]

*37 CFR 3.31 Cover sheet content.*

(a) \*\*\*\*\*



(7) The signature of the party submitting the document. For an assignment document or name change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* /Thomas O' Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

\*\*\*\*\*

**37 CFR 1.4 Nature of correspondence and signature requirements.**

\*\*\*\*\*

(d) \*\*\*\*\*

(2) *S-signature.* An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by paragraph (d)(1) of this section. An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature other than a handwritten signature as provided for in paragraph (d)(1) of this section. Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination or supplemental examination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *Electronically submitted correspondence.* Correspondence permitted via the Office electronic filing system may be signed by a graphic representation of a handwritten signature as provided for in paragraph (d)(1) of this section or a graphic representation of an S-signature as provided for in

paragraph (d)(2) of this section when it is submitted via the Office electronic filing system.

(4) *Certifications—*

(i) Certification as to the paper presented. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter. Violations of § 11.18(b)(2) of this subchapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this subchapter. Any practitioner violating § 11.18(b) of this subchapter may also be subject to disciplinary action. See § 11.18(d) of this subchapter.

(ii) *Certification as to the signature.* The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. A person submitting a document signed by another under paragraph (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. Violations of the certification as to the signature of another or a person's own signature as set forth in this paragraph may result in the imposition of sanctions under § 11.18(c) and (d) of this chapter.

(5) *Forms.* The Office provides forms for the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (*e.g.*, oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request forms) may be made. The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered other than permitted by EFS-Web customization.

\*\*\*\*\*

Assignments and other documents affecting title may be submitted to the Office via the Office's Electronic Patent Assignment System (EPAS). See the USPTO website at <http://epas.uspto.gov> for additional information regarding EPAS.

Any assignment related document submitted by EPAS must include:

(A) an identified application or patent number;  
and

(B) one cover sheet to record a single transaction which cover sheet is to be completed on-line.

The fee set in [37 CFR 1.21\(h\)\(1\)](#) for recording an electronically submitted document is currently \$0. Customers should check the current fee schedule on the Office website before submitting documents for recordation. If a recordation fee is required, see [MPEP § 509](#) for detailed information pertaining to the payment of fees.

For an assignment document filed electronically, the signature of the person who signs the cover sheet must comply with [37 CFR 3.31\(a\)\(7\)](#) or [37 CFR 1.4\(d\)\(2\)](#).

The date of receipt accorded to an assignment document sent to the Office by EPAS is the date the complete transmission is received in the Office.

If a document submitted by EPAS is determined not to be recordable, the entire document, with its associated cover sheet, and the Office "Notice of Non-Recordation" will be transmitted via fax back to the sender if possible. Once corrections are made, the initial submission, as amended, may then be resubmitted by mailing the corrected submission to the address set forth in [37 CFR 3.27](#). Timely submission will provide the sender with the benefit of the initial receipt date as the recordation date in accordance with [37 CFR 3.51](#).

The Patent and Trademark Assignment System assigns reel and frame numbers and superimposes recordation stampings on the processed and stored electronic images. Accordingly, copies of all recorded documents will have the reel and frame numbers and recordation stampings.

### **303 Assignment Documents Not Endorsed on Pending Applications [R-08.2012]**

Certified copies of patent applications as filed do not include an indication of assignment documents. Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by [37 CFR 1.19](#).

When the assignment condition of an application is significant, such as when applications of different inventors contain conflicting claims or there is a question as to who should direct prosecution, it is necessary for the examiner to obtain assignment information from PALM. See [MPEP § 320](#).

### **304-305 [Reserved]**

### **306 Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to Parent Application [R-07.2015]**

In the case of a division or continuation application, a prior assignment recorded against the original application is applied (effective) to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. Although the assignment recorded against an original application is applied to the division or continuation application, the Office's assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with [37 CFR 3.28](#), accompanied by the required fee ([37 CFR 3.41](#)), is filed.

In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied (effective) to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require the recordation of a new assignment if they are to be issued to an assignee, unless the substitute or continuation-in-part application is filed on or after September 16, 2012, and the assignee is the original applicant therein. See [37 CFR 3.81](#). See also [MPEP § 307](#) and [§ 308](#).

### 306.01 Assignment of an Application Claiming the Benefits of a Provisional Application [R-07.2015]

If an application which claims the benefit of the earlier filing date of a provisional application under [35 U.S.C. 119\(e\)](#) includes only subject matter which formed a part of the provisional application, an assignment recorded against the provisional application will be effective in the later application, similar to the practice with respect to continuations and divisions filed under [35 U.S.C. 120](#). See [MPEP § 306](#). If an application claiming the benefit of the earlier filing date of a provisional application includes subject matter that is not common with subject matter of the provisional application, new assignment papers must be recorded for the application claiming the benefit of the provisional application, unless the later application is filed on or after September 16, 2012 and the assignee is the original applicant therein. This is similar to the practice with respect to continuations-in-part filed under [35 U.S.C. 120](#). See [MPEP § 306](#), [§ 307](#), and [§ 308](#).

### 307 Issue to Non-Applicant Assignee [R-11.2013]

#### 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 3.81 Issue of patent to assignee.*

(a) *With payment of the issue fee:* An application may issue in the name of the assignee consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request must state that the document has been filed for recordation as set forth in [§ 3.11](#).

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in [§ 3.11](#) before issuance of the patent, and must include a request for a certificate of correction under [§ 1.323](#) of this chapter (accompanied by the fee set forth in [§ 1.20\(a\)](#)) and the processing fee set forth in [§ 1.17](#) (i) of this chapter.

(c) *Partial assignees.*

(1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

Normally, for a patent to issue to an assignee (other than an assignee who is the applicant in an application filed on or after September 16, 2012), a request for issuance of the application in the name of the assignee must be filed in the United States Patent and Trademark Office (Office) at a date not later than the day on which the issue fee is paid. Such a request must indicate that the assignment has been previously recorded in the Office. If the assignment has not been previously recorded in the Office, the request must state that the document has been filed for recordation as set forth in [37 CFR 3.11](#). See [37 CFR 3.81\(a\)](#). See [MPEP § 308](#) for information regarding issuance of a patent to an assignee who is the applicant in an application filed on or after September 16, 2012.

If a request for issuance to an assignee pursuant to [37 CFR 3.81\(b\)](#) is submitted after the day on which the issue fee is paid, the request under [37 CFR 3.81\(b\)](#) must include a request for a certificate of correction under [37 CFR 1.323](#) (accompanied by the fee set forth in [37 CFR 1.20\(a\)](#)) and the processing fee set forth in [37 CFR 1.17\(i\)](#). The request under [37 CFR 3.81\(b\)](#) must state that the assignment was submitted for recordation as set forth in [37 CFR 3.11](#) before issuance of the patent. The Office will issue a certificate of correction to reflect that the patent issued to the assignee provided the requirements of [37 CFR 3.81\(b\)](#) and [37 CFR 1.323](#) are complied with.

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 Fee(s) 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.”

Unless an assignee’s name and address are identified in item 3 of the Fee(s) 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. Assignment information printed on a patent is not updated after a patent is issued, and may not be reflective of the assignment recorded in the Office subsequent to the issuance of the patent. Detailed assignment information can be found by performing an assignment search on the USPTO website and by inspecting the recorded assignment documents.

A request for a certificate of correction under [37 CFR 1.323](#) (see [MPEP §§ 1481](#) and [1485](#)) arising from incomplete or erroneous assignee’s name furnished, or a missing assignee’s name, in item 3 of PTOL-85B will not be granted unless a request under [37 CFR 3.81\(b\)](#) has been granted and the assignment was submitted for recordation as set forth in [37 CFR 3.11](#) before the patent issued. Any such request under [37 CFR 3.81\(b\)](#) should be directed to the Office of Petitions and should include:

- (A) the processing fee required by [37 CFR 1.17\(i\)](#);
- (B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;
- (C) a statement that the assignment was submitted for recordation as set forth in [37 CFR 3.11](#) before the issuance of the patent; and
- (D) a request for a certificate of correction under [37 CFR 1.323](#) accompanied by the fee set forth in [37 CFR 1.20\(a\)](#).

### 308 Issue to Applicant [R-10.2019]

*[Editor Note: This MPEP section is **only applicable** to applications filed on or after September 16, 2012.]*

### 35 U.S.C. 118 Filing by other than inventor.

*[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See [pre-AIA 35 U.S.C. 118](#) for the law otherwise applicable.]*

A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

#### **37 CFR 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.**

*[Editor Note: Applicable only to patent applications filed under [35 U.S.C. 111\(a\)](#), [363](#), or [385](#) on or after September 16, 2012. See [pre-Hague 37 CFR 1.46](#) or [pre-AIA 37 CFR 1.46](#) for the rule otherwise applicable.]*

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(b) If an application under [35 U.S.C. 111](#) is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § [1.76](#) specifying in the applicant information section (§ [1.76\(b\)\(7\)](#)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under [35 U.S.C. 371](#), or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (*e.g.*, assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

- (i) The fee set forth in § [1.17\(g\)](#);
- (ii) A showing that such person has sufficient proprietary interest in the matter; and



(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

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(e) If a patent is granted on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest. Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81. Where a real party in interest has filed an application under § 1.46, the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest.

[35 U.S.C. 118](#) and [37 CFR 1.46\(e\)](#) provide that where the Director grants a patent on an application filed under [35 U.S.C. 118](#) by a person other than the inventor, the Office must grant the patent to the real party in interest. Therefore, the Office is requiring applicants other than the inventor to notify the Office of any change in the real party in interest in a reply to a notice of allowance. Absent any such notification, the Office will presume no change has occurred and will grant the patent to the real party in interest of record.

Applicants other than the inventor can notify the Office of a change in the real party in interest by providing the real party in interest in Box 3 of the PTOL-85B. See [MPEP § 307](#). The real party in interest will be listed in the assignee section of the patent. This does not change the applicant designated in the application or on any patent that is granted. Any desired change to the designated applicant must be made in accordance with [37 CFR 1.46](#) no later than issue fee payment. Note: requests to change the recorded applicant cannot be filed after patent grant.

Applicants other than the inventor should record the documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) before payment of the issue fee.

### **309 Restrictions Upon Employees of U.S. Patent and Trademark Office [R-07.2015]**

#### **35 U.S.C. 4 Restrictions on officers and employees as to interests 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.

See [MPEP § 1701](#) for additional restrictions on Office employees.

### **310 Government License Rights to Contractor-Owned Inventions Made Under Federally Sponsored Research and Development [R-10.2019]**

Where a Government contractor retains U.S. domestic patent rights, the contractor is under an obligation by virtue of [35 U.S.C. 202\(c\)\(6\)](#) to include the following statement at the beginning of the application and any patents issued thereon:

“This invention was made with government support under (identify the contract) awarded by (identify the Federal agency). The government has certain rights in the invention.”

If reference is made in the first sentence(s) of the specification following the title to related applications, the above “Government License Rights” statement should follow immediately as the second paragraph of the specification. If there is no such reference to related applications, the “Government License Rights” statement should appear as the first paragraph of the specification. See [37 CFR 1.77\(b\)\(1\)-\(3\)](#).

Providing information concerning government support on a provisional application cover sheet does not satisfy the requirement of [35 U.S.C. 202\(c\)\(6\)](#) which requires that the a statement be included within the specification of such application and any patent issuing thereon specifying that the invention



was made with Government support and that the Government has certain rights in the invention.

### **311 Filing of Notice of Arbitration Awards [R-11.2013]**

#### **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, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under [section 282](#) 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 of 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 Director. 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 Director. The Director 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 Director, any party to the proceeding may provide such notice to the Director.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Director.

#### **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. The Office of the Solicitor will be responsible for processing such notices.

### **312 [Reserved]**

### **313 Recording of Licenses, Security Interests, and Documents Other Than Assignments [R-07.2015]**

In addition to assignments and documents required to be recorded by Executive Order 9424, upon request, assignments of applications, patents, and registrations, and other documents relating to interests in patent applications and patents will be recorded in the Office. See [35 U.S.C. 261](#) and [37 CFR 3.11](#). Other documents affecting title to applications, patents, and registrations will be recorded as provided in [37 CFR Part 3](#) or at the discretion of the Director. [37 CFR 3.11\(a\)](#).

In addition to documents that constitute a transfer or change of title, other documents relating to interests in patents or applications will generally be recorded. Typical of these documents which are accepted for recording are license agreements and agreements which convey a security interest. Such documents are recorded in the public interest in order to give third parties notification of equitable interests or other matters relevant to the ownership of a patent or application. Documents that are not accepted for

recording include attorney's liens against patents or patent applications. See *In re Refusal of Assignment Branch to Record Attorney's Lien*, 8 USPQ2d 1446 (Comm'r Pat. 1988).

Any document returned unrecorded, which the sender nevertheless believes represents an unusual case which justifies recordation, may be submitted to the Office of Petitions with a petition under [37 CFR 1.181](#) requesting recordation of the document.

The recordation of a document is not a determination of the effect of the document on the chain of title. The determination of what, if any, effect a document has on title will be made by the Office at such times as ownership must be established to permit action to be taken by the purported assignee in connection with a patent or an application. See [MPEP § 324](#) and [§ 325](#).

### **314 Certificates of Change of Name or of Merger [R-08.2012]**

Certificates issued by appropriate authorities showing a change of name of a business or a merger of businesses are recordable. Although a mere change of name does not constitute a change in legal entity, it is properly a link in the chain of title. Documents of merger are also proper links in the chain of title. They may represent a change of entity as well as a change of name.

### **315 Indexing Against a Recorded Certificate [R-11.2013]**

The Office does not process requests for “indexing” or “cross-referencing” additional patent numbers or application numbers against a document, other than an assignment, previously recorded in the Assignment Division. Such requests do not comply with [37 CFR 3.11](#), [3.28](#), and [3.31](#), which require that each request for recordation include the document to be recorded and a cover sheet.

Therefore, even where a document has already been recorded in the Assignment Division in connection with a patent or patent application, a party that wishes recordation of that document with respect to

additional patents and/or patent applications must submit the following to the Assignment Division:

(A) a copy of the original document (which may consist of the previously recorded papers on which the Assignment Division has stamped the reel and frame numbers at which they are recorded, or a copy of such papers);

(B) a completed cover sheet (see [37 CFR 3.31](#) and [MPEP § 302.07](#)); and

(C) the appropriate recording fee (see [37 CFR 1.21\(h\)](#) and [3.41](#)).

The Office will assign a new recording date to that submission, update the assignment database, and include the cover sheet and document as part of the official record.

### **316 [Reserved]**

### **317 Handling of Documents in the Assignment Division [R-11.2013]**

All documents and cover sheets submitted for recording are examined for formal requirements in the Assignment Division in order to separate documents which are recordable from those which are not recordable.

Documents and cover sheets that are considered not to be recordable are returned to the sender by the Assignment Division with an explanation. If the sender disagrees or believes that the document represents an unusual case which justifies recordation, the sender may present the question to the Director by way of petition under [37 CFR 1.181](#), filed with the Office of Petitions.

After an assignment and cover sheet have been recorded, notification will be sent to the name and address indicated on the cover sheet to receive correspondence, showing the reel and frame number.

#### **317.01 Recording Date [R-08.2012]**

##### *37 CFR 3.51 Recording date.*

The date of recording of a document is the date the document meeting the requirements for recording set forth in this part is

filed in the Office. A document which does not comply with the identification requirements of § 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

The date of recording of a document is the date the document meeting the requirements for recording set forth in the regulations is filed in the Office. A document which does not comply with the identification requirements of [37 CFR 3.21](#) will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender when a correspondence address is available.

### **317.02 Correction of Unrecorded Returned Documents and Cover Sheets [R-07.2015]**

Assignment documents and cover sheets, or copies of the same, which are returned by Assignment Division will be stamped with the original date of receipt by the Office and will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of receipt of the papers as the date of recording of the document. See [37 CFR 3.51](#). The certification procedure under [37 CFR 1.8](#) (see [MPEP § 512](#)) or the “Priority Mail Express<sup>®</sup>” procedure under [37 CFR 1.10](#) (see [MPEP § 513](#)) may be used for resubmissions of returned papers to obtain the benefit of the date of deposit in the United States Postal Service to establish that the papers were returned within the time period specified. If the returned papers are not corrected

and resubmitted within the specified period, the date of receipt of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

### **317.03 Effect of Recording [R-10.2019]**

#### *37 CFR 3.54 Effect of recording.*

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

#### *37 CFR 3.56 Conditional assignments.*

Assignments which are made conditional on the performance of certain acts or events, such as the payment of money or other condition subsequent, if recorded in the Office, are regarded as absolute assignments for Office purposes until canceled with the written consent of all parties or by the decree of a court of competent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

The recording of a document is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent. See *Realvirt, LLC v. Lee*, 195 F.Supp.3d 847, 862-3 (E.D. Va. 2016). When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office. See [MPEP §§ 324](#) and [325](#).

[37 CFR 3.56](#) provides that an assignment, which at the time of its execution is conditional on a given act or event, will be treated by the Office as an absolute assignment. This rule serves as notification as to how a conditional assignment will be treated by the Office in any proceeding requiring a determination of the owner of an application, patent, or registration. Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred. A security agreement that does not convey the right, title, and interest of a patent property is not a conditional assignment.

In accordance with the subsequent purchaser provision in [35 U.S.C. 261](#), if an assignment is not timely recorded at the USPTO, the unrecorded assignment will not be superior to the rights acquired by a third party, i.e. a bona fide purchaser, for valuable consideration if that third party did not have knowledge of the unrecorded assignment. See *CMS Industries, Inc. v. L.P.S. International, Ltd.*, 643 F.2d 289 (5th Cir. 1981).

### **318 Documents Not to be Placed in Files [R-08.2012]**

Assignment documents submitted for recording should not be placed directly in application or patent files, but should be forwarded to Assignment Division for recording.

### **319 [Reserved]**

### **320 Title Reports [R-08.2012]**

The “title report” is a form which can be used under certain circumstances by the Assignment Division to report to someone within the Office the name of the owner of an application or patent as shown by the Assignment Division records on the date the title report is made. For example, a title report is requested by the Reexamination Preprocessing Staff when a request for reexamination is filed. Title reports may not be ordered by applicants or attorneys.

Information as to the title is not normally required by the examiner to examine an application. It is only in limited circumstances when the ownership becomes an issue and an examiner needs a title report. See [MPEP § 303](#). Examiners may obtain a title report using the PALM Intranet (select “General Information,” insert the appropriate application number, select “Search,” select “Assignments”). The screen resulting from the search may be printed to yield the copy of the title report.

**NOTE:** The public can request a certified abstract of title. The fee for this service is set forth at [37 CFR 1.19\(b\)\(4\)](#). See [MPEP § 301.01](#) for a discussion of which assignment records are publicly available.

### **321-322 [Reserved]**

### **323 Procedures for Correcting Errors in Recorded Assignment Document [R-08.2012]**

An error in a recorded assignment document will be corrected by Assignment Division provided a “corrective document” is submitted. The “corrective document” must include the following:

(A) A copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and

(B) A new Recordation Form Cover Sheet (form PTO-1595) (See [MPEP § 302.07](#)).

The new recordation form cover sheet must identify the submission as a “corrective document” submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in [37 CFR 1.21\(h\)](#) is required for each patent application and patent against which the corrective document is being recorded. See [MPEP § 302.06](#).

Corrections may be made on the original assignment document, for example, by lining out an incorrect patent or application number in a merger or change of name (see [MPEP § 314](#)).

Office policy regarding recordation of assignment documents is directed toward maintaining a complete history of claimed interests in property and, therefore, recorded assignment documents will not be expunged even if subsequently found to be invalid. See *In re Ratny*, 24 USPQ2d 1713 (Comm’r Pat. 1992). Once a document is recorded with the Assignment Services Division, the Assignment Services Division will not remove the papers from the record relating to that application or patent. See [MPEP § 323.01\(d\)](#).



### **323.01 Correction of Error in Recorded Cover Sheet [R-08.2012]**

#### *37 CFR 3.34 Correction of cover sheet errors.*

- (a) An error in a cover sheet recorded pursuant to § [3.11](#) will be corrected only if:
- (1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains and
  - (2) A corrected cover sheet is filed for recordation.
- (b) The corrected cover sheet must be accompanied by a copy of the document originally submitted for recording and by the recording fee as set forth in § [3.41](#).

Any alleged error in a recorded cover sheet will only be corrected if the error is apparent from a comparison with the recorded assignment document. The corrected cover sheet should be directed to Assignment Division.

During the recording process, the Assignment Services Division will check to see that a cover sheet is complete and record the data exactly as it appears on the cover sheet. The Assignment Services Division does not compare the cover sheet with the assignment document (or other document affecting title). Once the document is recorded, the Office will issue a notice of recordation.

The party recording the document should carefully review the notice of recordation.

Typographical errors made by the Office will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other error, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error, using the procedures set forth in [MPEP §§ 323.01\(a\)](#) through [323.01\(c\)](#).

#### **323.01(a) Typographical Errors in Cover Sheet [R-08.2012]**

A party who wishes to correct a typographical error on a recorded cover sheet must submit the following to the Assignment Services Division:

- (A) a copy of the originally recorded assignment document (or other document affecting title);

(B) a corrected cover sheet; and

(C) the required fee for each application or patent to be corrected ([37 CFR 3.41](#)).

See [37 CFR 3.34](#). The party requesting correction should also submit a copy of the original cover sheet, to facilitate comparison of the corrected cover sheet with the originally recorded document.

The party filing the corrected cover sheet should check the box titled “Other” in the area of the sheet requesting “Nature of Conveyance,” and indicate that the submission is to correct an error in a cover sheet previously recorded. The party should also identify the reel and frame numbers (if known), and the nature of the correction (e.g., “correction to the spelling of assignor’s name” or “correction of application number or patent number”). The Office will then compare the corrected cover sheet with the original cover sheet and the originally recorded assignment document (or other document affecting title) to determine whether the correction is typographical in nature. If the error is typographical in nature, the Assignment Services Division will record the corrected cover sheet and correct the Assignment Historical Database.

#### **I. TYPOGRAPHICAL ERRORS IN COVER SHEET THAT DO NOT AFFECT TITLE TO APPLICATION OR PATENT**

If the original cover sheet contains a typographical error that does not affect title to the application or patent against which the original assignment or name change is recorded, the Assignment Services Division will correct the Assignment Historical Database and permit the recording party to keep the original date of recordation.

#### **II. TYPOGRAPHICAL ERRORS IN COVER SHEET THAT DO AFFECT TITLE TO APPLICATION OR PATENT**

If the original cover sheet contains a typographical error that affects title to the application or patent against which the assignment or name change is recorded, the recording party will not be entitled to keep the original date of recordation. Rather, the Assignment Services Division will correct its automated records and change the date of recordation



to the date the corrected cover sheet was received in the Office.

### **323.01(b) Typographical Errors in Recorded Assignment Document [R-08.2012]**

If there is an error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for an erroneous document (e.g., the assignor) must either create and record a new document or make corrections to the original document and re-record it. If an assignor is not available to correct an original document or execute a new one, the assignee may submit an affidavit or declaration in which the assignee identifies the error and requests correction. The affidavit or declaration must be accompanied by a copy of the originally recorded papers, a cover sheet, and the required fee for each application or patent to be corrected ([37 CFR 3.41](#)). See *In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pat. 1987).

### **323.01(c) Assignment or Change of Name Improperly Filed and Recorded by Another Person Against Owner's Application or Patent [R-07.2015]**

When the owner of an application or registration discovers that another party has improperly recorded an assignment or name change against the owner's application or patent, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

The owner should contact the party who recorded the papers with the erroneous information and request that such party record corrective papers. However, if the party cannot be located or is unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.

Specifically, the owner should submit the following to the Assignment Services Division:

(A) a completed cover sheet identifying the application or patent against which the assignment was improperly recorded;

(B) an affidavit or declaration (1) identifying itself as the correct owner, (2) stating that the previously recorded document was submitted with erroneous information, and (3) providing the reel and frame number of the previously recorded document; and

(C) the required fee ([37 CFR 3.41](#)) for each application or patent to be corrected.

The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the application or patent identified should not be considered altered by the incorrect assignment or name change, and a statement that the original applicant or patentee or last correct assignee has been, and continues to be, the owner of the application, or patent at issue.

On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s), or patent(s). The party should also write the name of the correct owner in both the box requesting the name of the conveying party and the box requesting the name and address of the receiving party; this is to make it clear that ownership never changed and that any assignment or name change recorded against the application(s) or patent(s) was erroneous.

### **323.01(d) Expungement of Assignment Records [R-07.2015]**

Petitions to correct, modify or "expunge" assignment records are rarely granted and will not result in the removal of a document from the assignment records. Such petitions are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in [MPEP § 323.01\(a\)](#) through [§ 323.01\(c\)](#) will not provide the petitioner with adequate relief; and

(B) the integrity of the assignment records will not be affected by granting the petition.

Assignment records are recognized as distinct from application file records. Even if a petition to "expunge" a document is granted with respect to a

particular application or patent, the image of the recorded document will remain in the records of the Assignment Services Division at the same reel and frame number, and the image will appear when someone views that reel and frame number. The Office will, however, delete the links to the application or patent that was the subject of the petition, so that no information about the recorded document will appear when someone searches for that application or patent number in the Assignment Historical Database. A redacted version of the "expunged" document must be recorded and will appear in the assignment records instead of the "expunged" document upon the granting of the petition. An additional assignment of the "correct" document may be recorded in addition to the redacted version where the redacted version is incomplete or the original document was not correct.

### 324 Establishing Right of Assignee To Take Action in Application Filed Before September 16, 2012 [R-10.2019]

[Editor Note: See [MPEP § 325](#) for establishing the right of assignee to take action in an application filed on or after September 16, 2012.]

#### 37 CFR 3.71 (pre-AIA) Prosecution by assignee.

[Editor Note: **Not applicable** to applications filed under [35 U.S.C. 111\(a\)](#), [363](#) or [385](#) on or after September 16, 2012. See [37 CFR 3.71](#) for the rule otherwise applicable.]

(a) *Patents — conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents — assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).*

All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents — Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with [§ 3.73\(b\)](#) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with [§ 3.73\(b\)](#).

#### 37 CFR 3.73 (pre-AIA) Establishing right of assignee to take action.

[Editor Note: **Not applicable** to applications filed under [35 U.S.C. 111\(a\)](#), [363](#), or [385](#) on or after September 16, 2012. See [37 CFR 3.73](#) for the rule otherwise applicable.]

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to [§ 3.11](#) in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to [§ 3.11](#); or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

The owner or assignee (other than a juristic entity) of a patent property based on an application filed before September 16, 2012, can take action in a patent application or patent proceeding in numerous instances. The owner or assignee can sign a reply to an Office action ([pre-AIA 37 CFR 1.33\(b\)\(3\)](#) and [\(4\)](#)), a request for a continued prosecution application under [37 CFR 1.53\(d\)](#) ([MPEP § 201.06\(d\)](#)), a terminal disclaimer ([MPEP § 1490](#)), Fee(s) Transmittal (PTOL-85B) ([MPEP § 1306](#)), or a request for status of an application ([MPEP § 102](#)). The owner or assignee can file an application under [pre-AIA 37 CFR 1.47\(b\)](#) ([MPEP § 409.03\(b\)](#)), appoint its own registered patent practitioner to prosecute an application ([pre-AIA 37 CFR 1.32](#) and [MPEP § 402.07](#)), and grant a power to inspect an application ([MPEP § 104](#)). The owner or assignee consents to the filing of a reissue application ([MPEP § 1410.01](#)), and to the correction of inventorship ([MPEP § 602.01\(c\)](#) or [MPEP § 1481](#)).

Effective September 16, 2012, an owner or assignee who is a juristic entity must be represented by a patent practitioner. See [37 CFR 1.31](#). Juristic entities may sign small entity assertions under [37 CFR 1.27](#) ([MPEP § 509.03](#)), disclaimers under [37 CFR 1.321](#) ([MPEP § 1490](#)), submissions under [37 CFR 3.73](#) to establish ownership, powers of attorney under [37 CFR 1.32](#) ([MPEP § 402](#)) and powers to inspect under [37 CFR 1.14](#) ([MPEP § 104](#)). However, any other paper submitted on behalf of a juristic entity on or after September 16, 2012, must be signed by a patent practitioner.

See subsection VI below for a discussion of when ownership must be established to take action in a patent matter, and subsection VII below for a discussion of when ownership need not be established to sign certain papers.

## I. THE ASSIGNEE/OWNER THAT CAN TAKE ACTION IN PATENT MATTERS

The provisions of [pre-AIA 37 CFR 3.71\(b\)\(1\)](#) and [\(2\)](#) identify the owner or assignee that can take action in patent matters, e.g., the assignee which may conduct the prosecution of a U.S. national application for a patent ([35 U.S.C. 111\(a\)](#)), or any other patent proceeding (e.g., a reexamination proceeding, an interference proceeding). A national patent application is owned by one of the following individual or composite entities:

- (A) the inventor(s);
- (B) an assignee or multiple assignees of the inventor(s); or
- (C) some combination of the assignee(s), and inventor(s) who have not assigned away their right, title and interest in the application.

Pursuant to [pre-AIA 37 CFR 3.73\(b\)](#), a party must be established as the assignee by satisfying the requirements of that subsection, in order to be recognized as an owner or part owner, for purposes of taking action in patent matters before the Office.

As discussed in subsection II below, all parties having any portion of the ownership must join in “taking action” (i.e., act together as a composite entity) in order to be entitled to conduct the prosecution in patent matters.

### A. *Individual and Partial Assignees*

If there is a single assignee of the **entire** right, title and interest in the patent application, [pre-AIA 37 CFR 3.71\(b\)\(1\)](#) provides that the single assignee (i.e., individual assignee) may act alone to conduct the prosecution of an application or other patent proceeding (upon complying with [pre-AIA 37 CFR 3.73\(b\)](#)).

If there is no assignee of the **entire** right, title and interest of the patent application, then two possibilities exist:

- (A) The application has not been assigned, and ownership resides solely in the inventor(s) (i.e., the applicant(s)). In this situation, [pre-AIA 37 CFR 3.71](#) does not apply, since there is no assignee, and the

combination of all inventors is needed to conduct the prosecution of an application.

(B) The application has been assigned by at least one of the inventors, and there is thus at least one “partial assignee.” As defined in [pre-AIA 37 CFR 3.71\(b\)\(2\)](#), a partial assignee is any assignee of record who has less than the entire right, title and interest in the application. The application is owned by the combination of all partial assignees and all inventors who have not assigned away their right, title and interest in the application.

Where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application, unless one or more inventors have refused to join in the filing of the application and a petition under [pre-AIA 37 CFR 1.47](#) has been granted. If a petition under [pre-AIA 37 CFR 1.47](#) has been granted, then the assignee need only be the assignee of the entire interest of the [pre-AIA 37 CFR 1.47](#) applicant to sign a power of attorney. See [pre-AIA 37 CFR 1.32\(b\)\(4\)](#). Where an applicant retains an ownership interest, the combination of all partial assignees and the applicant with the ownership interest is needed to conduct the prosecution of an application.

Where a reissue application is filed to correct inventorship in the patent by the deletion of the name of inventor X and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the filing of the reissue application, even though inventor X is being deleted and need not sign the reissue oath or declaration. If inventor X has assigned his/her rights to the patent, then inventor X’s assignee must consent to the filing of the reissue application.

### ***B. Example***

Inventors A and B invent a process and file their application, signing the declaration for the patent application. Inventors A and B together may conduct prosecution of the application. Inventor A then assigns all his/her rights in the application to Corporation X. As soon as Corporation X (now a partial assignee as per [pre-AIA 37 CFR 3.71\(b\)\(2\)](#)) is made of record in the application as a partial

assignee (by filing a statement pursuant to [pre-AIA 37 CFR 3.73\(b\)](#)) stating Corporation X is an assignee of an undivided interest in the entirety of the application), Corporation X and Inventor B together may conduct prosecution of the application. Corporation X and Inventor B then both assign their rights in the application to Corporation Y. As soon as Corporation Y (now an assignee of the entire right, title and interest) is made of record in the application as the assignee (by filing a statement pursuant to [pre-AIA 37 CFR 3.73\(b\)](#)) stating it is assignee of the entire right, title and interest), Corporation Y is then the sole (one hundred percent) owner and thus may, by itself, conduct prosecution of the application.

## **II. ESTABLISHING OWNERSHIP**

When an assignee first seeks to take action in a matter before the Office with respect to a patent application filed before September 16, 2012, or a with respect to a patent or a reexamination proceeding relating to a patent that issued from an application that was filed before September 16, 2012, the assignee must establish its ownership of the property to the satisfaction of the Director. [Pre-AIA 37 CFR 3.73\(b\)](#). The assignee’s ownership may be established under [pre-AIA 37 CFR 3.73\(b\)](#) by submitting to the Office, in the Office file related to the matter in which action is sought to be taken:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is, submitted for recordation pursuant to [37 CFR 3.11](#); or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

Documents submitted to establish ownership are required to be recorded, or submitted for recordation pursuant to [37 CFR 3.11](#), as a condition to permitting the assignee to take action in a matter pending before the Office. [35 U.S.C. 261](#) requires transfer of ownership by an assignment to be in writing. See *Realvirt, LLC v. Lee*, 195 F.Supp.3d 847, 859 (E.D. Va. 2016).



The action taken by the assignee, and the [pre-AIA 37 CFR 3.73\(b\)](#) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. [Pre-AIA 37 CFR 3.73\(c\)](#). If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or the date of the assignee's action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. See discussion below. Once [pre-AIA 37 CFR 3.73\(b\)](#) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a [pre-AIA 37 CFR 3.73\(b\)](#) submission each time, provided that ownership has not changed.

The submission establishing ownership by the assignee pursuant to [pre-AIA 37 CFR 3.73\(b\)](#) is generally referred to as the “statement under [37 CFR 3.73\(b\)](#)” or the “[37 CFR 3.73\(b\)](#) statement.” A duplicate copy of the [pre-AIA 37 CFR 3.73\(b\)](#) statement is not required and should not be submitted. See [37 CFR 1.4\(b\)](#) and [MPEP § 502.04](#).

### III. CONTINUING APPLICATIONS

When an assignee files a continuation or divisional application under [37 CFR 1.53\(b\)](#) before September 16, 2012, the application papers must:

(A) contain a copy of a statement filed under [pre-AIA 37 CFR 3.73\(b\)](#) in the parent application; or

(B) contain a newly executed statement under [pre-AIA 37 CFR 3.73\(b\)](#).

When a continuation-in-part application is filed before September 16, 2012 by an assignee, a newly executed statement under [pre-AIA 37 CFR 3.73\(b\)](#) must be filed. When in a design application, a continued prosecution application (CPA) under

[37 CFR 1.53\(d\)](#) is filed, the statement filed under [37 CFR 3.73\(b\)](#) in the parent application will serve as the statement for the CPA.

### IV. REQUESTS FOR CONTINUED EXAMINATION

Where a Request for Continued Examination of an application is filed under [37 CFR 1.114](#), the application is not considered to be abandoned; rather the finality of the Office action is withdrawn and the prosecution continues. Thus, the statement under [pre-AIA 37 CFR 3.73\(b\)](#) in the application will continue to serve as the statement establishing ownership.

### V. PARTY WHO MUST SIGN

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under [pre-AIA 37 CFR 3.73\(b\)](#) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. [Pre-AIA 37 CFR 3.73\(b\)\(2\)\(ii\)](#). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title “Manager” or “Director” is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. The Office recommends that when a person with such a title is authorized to act on behalf of the assignee, the submission should clearly indicate that person's authority (see paragraph (B), below). A power of attorney ([pre-AIA 37 CFR 1.32\(b\)\(4\)](#)) to a patent practitioner to prosecute a patent application executed by the applicant or the



assignee of the entire interest does not make that practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. [Pre-AIA 37 CFR 3.73\(b\)\(2\)\(i\)](#).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

## VI. WHEN OWNERSHIP MUST BE ESTABLISHED

Examples of situations where ownership must be established under [pre-AIA 37 CFR 3.73\(b\)](#) are when the assignee: signs a request for status of an application or gives a power to inspect an application ([MPEP §§ 102 and 104](#)); appoints its own registered attorney or agent to prosecute an application ([pre-AIA 37 CFR 3.71](#) and [MPEP § 402.07](#)); signs a disclaimer under [37 CFR 1.321](#) ([MPEP § 1490](#)); consents to the filing of a reissue application ([MPEP § 1410.01](#)); consents to the correction of inventorship in a patent ([MPEP § 1481](#)); or signs a Fee(s) Transmittal (PTOL-85B) ([MPEP § 1306](#)). Effective September 16, 2012, a juristic entity (e.g., organizational assignee) must be represented by a patent practitioner. See [37 CFR 1.31](#).

## VII. WHEN OWNERSHIP NEED NOT BE ESTABLISHED

Examples of situations where ownership need not be established under [pre-AIA 37 CFR 3.73\(b\)](#) are when the assignee: signs a small entity statement ([MPEP § 509.03](#)); signs a statement of common ownership of two inventions ([MPEP § 2146.02](#)); signs a NASA or DOE property rights statement ([MPEP § 151](#)); signs an affidavit under [37 CFR 1.131\(a\)](#) where the inventor is unavailable ([MPEP](#)

[§ 715.04](#)); signs a certificate under [37 CFR 1.8](#) ([MPEP § 512](#)); or files a request for reexamination of a patent under [37 CFR 1.510](#) ([MPEP § 2210](#)).

## VIII. MULTIPLE ASSIGNEES

When an assignee seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding and the right, title, and interest therein is held by more than one assignee, each partial assignee must provide a submission under [pre-AIA 37 CFR 3.73\(b\)](#). In each submission, the extent of each assignee's interest must be set forth so that the Office can determine whether it has obtained action by the entirety of the right, title and interest holders (owners). [Pre-AIA 37 CFR 3.73\(c\)\(2\)](#). If the extent of the partial assignee's ownership interest is not set forth in the submission under [pre-AIA 37 CFR 3.73\(b\)](#), the Office may refuse to accept the submission as an establishment of ownership interest.

## IX. CONFLICTING PRE-AIA 37 CFR 3.73(b) STATEMENTS

Where there are two or more conflicting [pre-AIA 37 CFR 3.73\(b\)](#) statements in an application or other Office proceeding, the statement with the latest date of submission to the Office will normally control as to establishment of the assignee. If, however, the ownership established as controlling is contested on the record by another party who has submitted a conflicting [pre-AIA 37 CFR 3.73\(b\)](#) statement, then the application or other proceeding shall be forwarded by the Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolving any procedural issues. Generally, where there are two or more conflicting [pre-AIA 37 CFR 3.73\(b\)](#) statements in an application, the ownership entity that filed that application will be permitted to conduct the prosecution, and the other party that submitted a [pre-AIA 37 CFR 3.73\(b\)](#) statement to establish its ownership may wish to consider filing its own application.

## X. FORMS

Form PTO/SB/96 may be used to establish ownership under [pre-AIA 37 CFR 3.73\(b\)](#).

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: \_\_\_\_\_  
 Application No./Patent No.: \_\_\_\_\_ Filed/Issue Date: \_\_\_\_\_  
 Titled: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_  
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- 1.  the assignee of the entire right, title, and interest in;
  - 2.  an assignee of less than the entire right, title, and interest in  
 (The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
  - 3.  the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)
- the patent application/patent identified above, by virtue of either:

A.  An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy\* is attached.

OR

B.  A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

- 1. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy\* is attached.
- 2. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy\* is attached.
- 3. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the United States Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy\* is attached.

Additional documents in the chain of title are listed on a supplemental sheet(s).

\*As required by 37 CFR 3.73(b)(1)(i), if a copy/copies is/are attached, the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

\_\_\_\_\_  
 Signature Date

\_\_\_\_\_  
 Printed or Typed Name Title or Registration Number

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## 325 Establishing Right of Assignee To Take Action in Application Filed On or After September 16, 2012 [R-10.2019]

[Editor Note: See [MPEP § 324](#) for establishing the right of assignee to take action in an application filed before September 16, 2012.]

### 37 CFR 3.71 Prosecution by assignee.

[Editor Note: Applicable to patent applications under [35 U.S.C. 111\(a\)](#), [363](#), or [385](#) on or after September 16, 2012. See [pre-AIA 37 CFR 3.71](#) for the rule otherwise applicable.]

(a) *Patents—conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may conduct prosecution of a national patent application as the applicant under § 1.46 of this title, or conduct prosecution of a supplemental examination or reexamination proceeding, to the exclusion of the inventor or previous applicant or patent owner. Conflicts between purported assignees are handled in accordance with § 3.73(c)(3).

(b) *Patents—assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent as the applicant under § 1.46 of this title or a supplemental examination or reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent, who together own the entire right, title and interest in the application or patent. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent. The word "assignee" as used in this chapter means with respect to patent matters the single assignee of the entire right, title and interest in the application or patent if there is such a single assignee, or all of the partial assignees, or all of the partial assignee and inventors who have not assigned their interest in the application or patent, who together own the entire right, title and interest in the application or patent.

(c) *Patents—Becoming of record.* An assignee becomes of record as the applicant in a national patent application under § 1.46 of this title, and in a supplemental examination or reexamination proceeding, by filing a statement in compliance with § 3.73(c) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § [3.73\(b\)](#).

### 37 CFR 3.73 Establishing right of assignee to take action.

[Editor Note: Applicable to patent applications filed under [35 U.S.C. 111\(a\)](#), [363](#) or [385](#) on or after September 16, 2012. See [pre-AIA 37 CFR 3.73](#) for the rule otherwise applicable.]

(a) The original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b) In order to request or take action in a trademark matter, the assignee must establish its ownership of the trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(1) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(2) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(c)(1) In order to request or take action in a patent matter, an assignee who is not the original applicant must establish its ownership of the patent property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) If the submission is by an assignee of less than the entire right, title and interest (*e.g.*, more than one assignee exists) the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title and interest and stating that all the identified parties own the entire right, title and interest.

(3) If two or more purported assignees file conflicting statements under paragraph (c)(1) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

(d) The submission establishing ownership under paragraph (b) or (c) of this section must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

- (1) Including a statement that the person signing the submission is authorized to act on behalf of the assignee;
- (2) Being signed by a person having apparent authority to sign on behalf of the assignee; or
- (3) For patent matters only, being signed by a practitioner of record.

The owner or assignee of a patent property can take action in a patent application as the applicant. However, an owner or assignee that is a juristic entity must be represented by a patent practitioner. See [37 CFR 1.31](#) and [1.33\(b\)\(3\)](#).

An assignee who is not the original applicant must become the applicant under [37 CFR 1.46\(a\)](#) in order to request or take action in a patent application. A request to change the applicant under [37 CFR 1.46\(c\)\(2\)](#) must be filed and must be accompanied by an application data sheet under [37 CFR 1.76](#) specifying the applicant in the applicant information section and comply with [37 CFR 3.71](#) and [37 CFR 3.73](#).

As the applicant, the owner or assignee that is not a juristic entity can sign a reply to an Office action ([37 CFR 1.33\(b\)\(3\)](#)), a request for a continued prosecution application under [37 CFR 1.53\(d\)](#) ([MPEP § 201.06\(d\)](#)), a disclaimer under [37 CFR 1.321](#) ([MPEP § 1490](#)), Fee(s) Transmittal (PTOL-85B) ([MPEP § 1306](#)), or a request for status of an application ([MPEP § 102](#)). The owner or assignee can file an application under [37 CFR 1.46](#), appoint its own registered patent practitioner to prosecute an application ([37 CFR 1.32](#)), and grant a power to inspect an application ([MPEP § 104](#)). The owner or assignee can consent to the filing of a reissue application ([MPEP § 1410.01](#)), and to the correction of inventorship ([MPEP § 602.01\(c\)](#) or [MPEP § 1481](#)).

Effective September 16, 2012, juristic entities may sign small entity assertions under [37 CFR 1.27](#) ([MPEP § 509.03](#)), disclaimers under [37 CFR 1.321](#)

([MPEP § 1490](#)), submissions under [37 CFR 3.73](#) to establish ownership, powers of attorney under [37 CFR 1.32](#) ([MPEP § 402](#)) and powers to inspect under [37 CFR 1.14](#) ([MPEP § 104](#)). However, any other paper submitted on behalf of a juristic entity on or after September 16, 2012, must be signed by a patent practitioner.

See subsection VI below for a discussion of when ownership must be established to take action in a patent matter, and subsection VII below for a discussion of when ownership need not be established to sign certain papers.

## I. THE ASSIGNEE/OWNER THAT CAN TAKE ACTION IN PATENT MATTERS

The original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, unless there is an assignment. [37 CFR 3.73\(a\)](#).

The provisions of [37 CFR 3.71\(b\)](#) provide that the assignee(s) who may conduct either the prosecution of a national application for patent as the applicant under [37 CFR 1.46](#) or a supplemental examination or reexamination proceeding are:

- (1) a single assignee who is the assignee of the entire right, title and interest in the application or patent, or
- (2) all partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent, who together own the entire right, title and interest in the application or patent.

As discussed in subsection II below, all parties having any portion of the ownership must join in “taking action” (i.e., act together as a composite entity) in order to be entitled to conduct the prosecution in patent matters. For a discussion of the applicant for patent, see [MPEP § 409](#) et seq. and [§ 605](#) et seq.

### A. Individual and Partial Assignees

If there is a single assignee of the entire right, title and interest in the patent application, [37 CFR 3.71\(b\)\(1\)](#) provides that the single assignee (i.e.,



individual assignee) may act alone to conduct the prosecution of an application or other patent proceeding. If the assignee is not already the applicant under [37 CFR 1.46](#) in the patent application, then the assignee must file a request to change the applicant under [37 CFR 1.46\(c\)\(2\)](#).

If there is no assignee of the entire right, title and interest of the patent application, then either:

(1) The application has not been assigned, [37 CFR 3.71](#) is not applicable, and the prosecution must be conducted by the applicant. The word "applicant" refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in [37 CFR 1.43](#), [1.45](#), or [1.46](#). See [MPEP § 409](#) et seq. and [§ 605](#) et seq.

(2) The application has been assigned by at least one of the inventors, and there is thus at least one "partial assignee." As defined in [37 CFR 3.71\(b\)\(2\)](#), a partial assignee is any assignee of record who has less than the entire right, title and interest in the application. The application is owned by the combination of all partial assignees and all inventors who have not assigned away their right, title and interest in the application.

Where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application, unless one or more inventors have refused to join in the filing of the application and a petition under [37 CFR 1.46\(b\)\(2\)](#) has been granted.

Where a reissue application is filed to correct inventorship in the patent by the deletion of the name of inventor X and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the filing of the reissue application, even though inventor X is being deleted; however, inventor X need not sign the reissue oath or declaration. If inventor X has assigned his/her rights to the patent, then inventor X's assignee must consent to the filing of the reissue application.

### *B. Example*

Inventors A and B invent a process and file a patent application as the applicant, naming both inventors. Inventors A and B together may conduct prosecution of the application.

Inventor A then assigns all his/her rights in the application to Corporation X. Corporation X and Inventor B together may conduct prosecution of the application only if Corporation X (now a partial assignee as per [37 CFR 3.71\(b\)\(2\)](#)) is made of record in the application as a partial assignee and the applicant is changed under [37 CFR 1.46\(c\)\(2\)](#) to Corporation X and Inventor B. Pursuant to [37 CFR 1.46\(c\)\(2\)](#), an application data sheet must be filed specifying the applicant (i.e., Corporation X and Inventor B) in the applicant information section, and a statement pursuant to [37 CFR 3.73\(c\)](#) must be filed establishing that Corporation X is an assignee of an undivided interest in the entirety of the application.

Corporation X and Inventor B then both assign their rights in the application to Corporation Y. Corporation Y is then the sole (one hundred percent) owner and may, by itself, conduct prosecution of the application after Corporation Y (now an assignee of the entire right, title and interest) is made of record in the application as the applicant (by filing a request to change the applicant under [37 CFR 1.46\(c\)\(2\)](#), an application data sheet pursuant to [37 CFR 1.76](#) specifying the applicant as Corporation Y, and a statement pursuant to [37 CFR 3.73\(c\)](#) establishing that Corporation Y is assignee of the entire right, title and interest).

## II. ESTABLISHING OWNERSHIP

An assignee who is not the original applicant must become the applicant under [37 CFR 1.46](#) in order to request or take action in a patent application. When an assignee who is not the original applicant first seeks to take action in a matter before the Office with respect to a patent application filed on or after September 16, 2012, the assignee must establish its ownership of the property to the satisfaction of the Director. [37 CFR 3.73\(c\)](#). The assignee must also file a request to change the applicant under [37 CFR 1.46\(c\)\(2\)](#) and an application data sheet under [37 CFR 1.76](#) specifying the applicant in the application

information section. When an assignee who was not the original applicant or patent owner first seeks to take action in a matter before the Office with respect to a reissue patent application, patent, reexamination proceeding or supplemental examination proceeding for a patent that issued from an application filed on or after September 16, 2012, the assignee must establish its ownership of the property to the satisfaction of the Director. [37 CFR 3.73\(c\)](#).

The statement establishing assignee's ownership under [37 CFR 3.73\(c\)](#) must be filed in the Office file related to the matter in which action is sought to be taken, and must contain:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is, submitted for recordation pursuant to [37 CFR 3.11](#); or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

Documents submitted to establish ownership are required to be recorded, or submitted for recordation pursuant to [37 CFR 3.11](#), as a condition to permitting the assignee to take action in a matter pending before the Office. [35 U.S.C. 261](#) requires transfer of ownership by an assignment to be in writing. See *Realvirt, LLC v. Lee*, 195 F.Supp.3d 847, 859 (E.D. Va. 2016).

The action taken by the assignee, and the [37 CFR 3.73\(c\)](#) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The establishment of ownership by the assignee (and the request for change of applicant under [37 CFR 1.46\(c\)\(2\)](#)) must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. [37 CFR 3.73\(c\)](#). If the submission establishing ownership and the request for change of applicant are not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date,

that date will be the date of the request for action or the date of the assignee's action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee or a patent practitioner of record. See discussion below. Once [37 CFR 3.73\(c\)](#) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a [37 CFR 3.73\(c\)](#) submission each time, provided that ownership has not changed.

Where there is more than one assignee (i.e., partial assignees) or a combination of partial assignees and inventors who have not assigned away their right, title and interest in the application, each owner must submit a statement under [37 CFR 3.73\(c\)](#) that either:

(A) Specifies (by percentage) the extent of its ownership interest, so as to account for the entire right, title and interest in the application or patent by all parties. [37 CFR 3.73\(c\)\(2\)\(i\)](#); or

(B) Identifies the parties including inventors who together own the entire right, title and interest and state that all the identified parties own the entire right, title and interest. [37 CFR 3.73\(c\)\(2\)\(ii\)](#).

The submission establishing ownership by the assignee pursuant to [37 CFR 3.73\(c\)](#) is generally referred to as the "statement under 37 CFR 3.73(c)" or the "37 CFR 3.73(c) statement." A duplicate copy of the [37 CFR 3.73\(c\)](#) statement is not required and should not be submitted. See [37 CFR 1.4\(b\)](#) and [MPEP § 502.04](#).

### III. CONTINUING APPLICATIONS

When an assignee files a continuing application under [37 CFR 1.53\(b\)](#), the application papers must:

(A) contain a copy of a statement filed under [pre-AIA 37 CFR 3.73\(b\)](#) or under [37 CFR 3.73\(c\)](#) in the parent application; or

(B) contain a newly executed statement under [37 CFR 3.73\(c\)](#).

When a CPA under [37 CFR 1.53\(d\)](#) is filed in a design application, the statement filed under [pre-AIA 37 CFR 3.73\(b\)](#) or under [37 CFR 3.73\(c\)](#) in the

parent application will serve as the statement for the CPA.

#### IV. REQUESTS FOR CONTINUED EXAMINATION

Where a Request for Continued Examination (RCE) of an application is filed under [37 CFR 1.114](#), the application is not considered to be abandoned; rather the finality of the Office action is withdrawn and the prosecution continues. Thus, the statement under [pre-AIA 37 CFR 3.73\(b\)](#) or under [37 CFR 3.73\(c\)](#) in the application will continue to serve as the statement establishing ownership.

#### V. PARTY WHO MUST SIGN

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under [37 CFR 3.73\(c\)](#) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. [37 CFR 3.73\(d\)\(2\)](#). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title “Manager” or “Director” is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. In this situation the Office recommends that when such person is authorized to act on behalf of the assignee, the submission clearly indicate the authority (see paragraph (B), below). A power of attorney ([37 CFR 1.32\(b\)\(4\)](#)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that practitioner an official

of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. [37 CFR 3.73\(d\)\(1\)](#).

(C) The submission may be signed by a patent practitioner of record. [37 CFR 3.73\(d\)\(3\)](#). A patent practitioner will be considered “of record” where the patent practitioner was appointed in a power of attorney already of record, or where the [37 CFR 3.73\(c\)](#) statement is accompanied by a power of attorney that appoints the patent practitioner who signed the statement.

(D) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), (C) or (D) above, evidence of the person’s authority to sign will be required.

#### VI. WHEN OWNERSHIP MUST BE ESTABLISHED

Examples of situations where ownership must be established under [37 CFR 3.73\(c\)](#) are when the assignee who is not the applicant: signs a request for status of an application or gives a power to inspect an application ([MPEP § 102](#) and [§ 104](#)); appoints its own registered attorney or agent to prosecute an application ([37 CFR 3.71](#) and [MPEP § 402.07](#)); signs a disclaimer under [37 CFR 1.321](#) ([MPEP § 1490](#)); consents to the filing of a reissue application ([MPEP § 1410.01](#)); or signs a Fee Transmittal (PTOL-85B) ([MPEP § 1306](#)). Effective September 16, 2012, a juristic entity (e.g., organizational assignee) must be represented by a patent practitioner.

#### VII. WHEN OWNERSHIP NEED NOT BE ESTABLISHED

Examples of situations where ownership need not be established under [37 CFR 3.73\(c\)](#) are when the assignee: signs a small entity statement under [37 CFR 1.27](#) ([MPEP § 509.03](#)); signs a statement of

common ownership of two inventions ([MPEP § 2146.02](#)); signs a NASA or DOE property rights statement ([MPEP § 151](#)); signs an affidavit under [37 CFR 1.131\(a\)](#) where the inventor is unavailable ([MPEP § 715.04](#)); signs a certificate under [37 CFR 1.8](#) ([MPEP § 512](#)); or files a request for reexamination of a patent under [37 CFR 1.510](#) ([MPEP § 2210](#)).

#### VIII. MULTIPLE ASSIGNEES

When an assignee seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding and the right, title, and interest therein is held by more than one assignee, each partial assignee must provide a submission under [37 CFR 3.73\(c\)](#). In each submission, the extent of each assignee's interest must be set forth so that the Office can determine whether it has obtained action by the entirety of the right, title and interest holders (owners). [37 CFR 3.73\(c\)\(2\)\(i\)](#). Where there are unspecified percentages of ownership, each partial assignee must submit a statement identifying the parties including inventors who together own the entire right, title and interest and state that all the identified parties own the entire right, title and interest. [37 CFR 3.73\(c\)\(2\)\(ii\)](#). If the extent of the partial assignee's ownership interest is not set forth in the submission under [37 CFR 3.73\(c\)](#), the Office may refuse to

accept the submission as an establishment of ownership interest.

#### IX. CONFLICTING 37 CFR 3.73(c) STATEMENTS

Where two or more purported assignees file conflicting [37 CFR 3.73\(c\)](#) statements in an application or other Office proceeding, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application. [37 CFR 3.73\(c\)\(3\)](#). Additionally, if the ownership established as controlling is contested on the record by another party who has submitted a conflicting [37 CFR 3.73\(c\)](#) statement, then the application or other proceeding shall be forwarded by the Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolving any procedural issues. Generally, where there are two or more conflicting [37 CFR 3.73\(c\)](#) statements in an application, the applicant will be permitted to conduct the prosecution, and the other party that submitted a [37 CFR 3.73\(c\)](#) statement to establish its ownership may wish to consider filing its own application.

#### X. FORMS

Form PTO/AIA/96 may be used to establish ownership under [37 CFR 3.73\(c\)](#).

**STATEMENT UNDER 37 CFR 3.73(c)**

Applicant/Patent Owner: \_\_\_\_\_

Application No./Patent No.: \_\_\_\_\_ Filed/Issue Date: \_\_\_\_\_

Titled: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_

(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that, for the patent application/patent identified above, it is (choose **one** of options 1, 2, 3 or 4 below):

- 1.  The assignee of the entire right, title, and interest.
- 2.  An assignee of less than the entire right, title, and interest (check applicable box):
  - The extent (by percentage) of its ownership interest is \_\_\_\_\_%. Additional Statement(s) by the owners holding the balance of the interest must be submitted to account for 100% of the ownership interest.
  - There are unspecified percentages of ownership. The other parties, including inventors, who together own the entire right, title and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

- 3.  The assignee of an undivided interest in the entirety (a complete assignment from one of the joint inventors was made). The other parties, including inventors, who together own the entire right, title, and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

- 4.  The recipient, via a court proceeding or the like (e.g., bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose **one** of options A or B below):

- A.  An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
- B.  A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

[Page 1 of 2]

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



PTO/AIA/96 (08-12)

Approved for use through 01/31/2013. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(c)**

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

4. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

5. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

6. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet(s).

As required by 37 CFR 3.73(c)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Printed or Typed Name

\_\_\_\_\_  
Title or Registration Number

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.