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# FINAL RULE ON PTO ASSIGNMENT PRACTICE

57 FR 29634

**DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

**37 CFR Parts 1, 2 and 3**

**[Docket No. 910246-2140]**

**RIN 0651-AA43**

**Changes in Patent and Trademark Assignment Practice**

**AGENCY:** Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The Patent and Trademark Office (Office) is amending the rules of practice regarding assignments in patent and trademark cases to improve and clarify the rules, to codify changes in practice and to consolidate the rules. The Office has combined the assignment



rules currently in parts 1 and 2 into a new part 3 directed to assignments.

**EFFECTIVE DATE:** September 4, 1992. These rules will be applicable to all documents filed with the Office on or after the effective date.

**FOR FURTHER INFORMATION CONTACT:** Trademark related matters: Lynne Beresford by telephone at (703) 305-9464 or by mail marked to her attention addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231. Patent related matters: Jeffrey V. Nase by telephone at (703) 305-9282 or by mail marked to his attention and addressed to Commissioner of Patents and Trademarks, Box DAC, Washington, DC 20231.

**SUPPLEMENTARY INFORMATION:** In a Notice of Proposed Rulemaking published in the **Federal Register** on May 10, 1991 at 56 FR 21641 and in the Patent and Trademark Office "Official Gazette" of June 4, 1991 at 1127 O.G. 8-16, the Office proposed to amend the rules of practice in patent and trademark cases to revise, simplify, remove, or clarify existing assignment rules or to codify certain practices currently in effect. Changes were proposed for rules relating to the documents that will be recorded, to the requirements for recording a document, to the effect of recording, to new cover sheet requirements, to the appointment of domestic representatives; and to prosecution by assignees and issuance to assignees. While the existing rules do not require a cover sheet to accompany each document submitted for recording, typically a cover letter is submitted to ensure proper processing of the document.

The Office has encouraged the public to use a cover letter containing specific information concerning the document being submitted with each document submitted for recording. See "Helpful Hints", 1114 Official Gazette 77 (May 29, 1990). The public has adopted the suggested procedure to such an extent that most documents now submitted for recordation are accompanied by a cover letter which contains the suggested data. Documents submitted with these cover letters have enabled the Office to greatly improve the quality and efficiency of the recording process. To better ensure that the correct data is captured in recordation and recorded promptly, the Office is making a cover sheet mandatory.

The cover sheet will contain all the information necessary for the Assignment Branch to properly and promptly process the document.

Written comments were submitted by 12 firms, 2 individuals, 4 corporations and 1 organization. No one testified at the oral hearing held on July 17, 1991.

The following includes a brief discussion of the rules being changed and the reasons for those changes, a detailed section-by-section analysis of the final rules, and an analysis of the comments received in response to the notice of proposed rulemaking.

## Specific Rules To Be Deleted or Added

The existing rules of practice in parts 1 and 2 of title 37 of the Code of Federal Regulations which are deleted are §§ 1.32, 1.331, 1.332, 1.333, 1.334, 2.185, 2.186 and 2.187. These rules are deleted in their entirety and rewritten and renumbered under a new part 3. Table 1 is provided to assist readers in correlating previous rules with the new rules.

Consideration was given to moving § 1.12 (Assignment records open to public inspection.) to part 3. However, since this section primarily relates to records maintained by the Office and procedures for accessing those records, and no comments were received regarding the placement of § 1.12, this section remains under the general heading "Records and Files" of the Patent and Trademark Office.

TABLE 1

| Old section | New section |
|---|---|
| 1.32 | 3.71 and 3.73. |
| 1.331(a) | 3.11. |
| 1.331(b) | 3.26. |
| 1.331(c) | 3.21. |
| 1.332 | 3.51. |
| 1.333 | 3.56. |
| 1.334 | 3.81. |
| 2.185(a) | 3.11. |
| 2.185(a)(1) | 3.31. |
| 2.185(a)(2) | 3.26. |
| 2.185(a)(3) | 3.41. |
| 2.185(a)(4) | 3.61. |
| 2.185(b) | 3.31(b). |
| 2.185(c) | 3.51. |
| 2.186 | 3.71 and 3.73. |
| 2.187 | 3.85. |

## Discussion of Specific Sections To Be Changed or Added

Section 1.12(a) is revised to reflect the fact that all assignment records related to pre-1955 trademark records and pre-1957 patent records were transferred to the National Archives and Records Administration (NARA) during 1990. All assignments recorded on or after January 1, 1955, for trademarks and May 1, 1957, for patents continue to be maintained by the Office. The pre-1955/1957 records have been transferred to NARA to allow for greater accessibility to the public, improvement of file integrity for the older records, and preservation of these materials. The pre-1955/1957 assignment cards, digest books, and libers were stored in four locations: The Assignment Search Room (ASR) at the Office, the Federal Records Center in Suitland, Maryland, the National Archives in downtown Washington, DC, and the National Archives location in Alexandria, Virginia. Storage of information in these various locations made searching of old assignment records difficult. The materials located at the Federal Records Center could be ordered from the ASR.



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However, many times it took months to receive the materials.

All assignment records from 1837 to December 31, 1954, for trademarks and 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. Assignments recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

All requests for abstracts of title continue to be provided by the Office upon request and payment of fees set forth in §§ 1.19 and 2.6. Requests for copies and certified copies of the pre-1955 records for trademarks and pre-1957 records for patents should be directed to NARA since those records are not maintained by the Office. Since these records are maintained by NARA, it is more expeditious to request copies directly from NARA, rather than 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.

Another change makes clear that separate assignment records are kept for patents and trademarks, and that an extra charge will be imposed by the Office on requests for copies of recorded assignments if the correct reel and frame number are not identified.

Sections 1.17 and 1.46 are amended to make reference to § 3.81, which replaces § 1.334, and delete reference to § 1.334. The amount of the fee for recording a document is not affected by this rule change.

Section 1.104(e) is amended to make reference to part 3, which replaces § 1.331, and delete reference to § 1.331.

Section 3.1 is added to set out definitions of terms used in part 3. Terms which are defined include "application," "assignment," "document," "Office" (meaning Patent and Trademark Office), "recorded document," and "registration."

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Definitions are provided to make clear the intended meanings of the terms used in part 3. These definitions are intended to be applicable only to part 3. For example, the term "application" is defined, for the purpose of part 3, to mean a national application for patent, an international application for patent that designates the United States of America, or an application to register a trademark, unless otherwise indicated.

Section 3.11 replaces and modifies the practice set forth in §§ 1.331(a) and 2.185(a), which specify the documents the Office will record. This section specifies that assignments of patents and registrations will be recorded, as well as other documents which affect title to applications, registrations and patents. Section 3.11 requires that a completed cover sheet as specified in §§ 3.28 and 3.31 be submitted with the document to be recorded.

Section 3.16 is added to incorporate the limitation set out in 15 U.S.C. 1060 proscribing the assignment of an intent-to-use trademark application prior to the filing of a statement of use, except as a part of the sale of an on-going business. Because the rules in part 3 are intended to address all rules relating to assignments, it is appropriate to refer to the statutory requirements of an assignment of an intent-to-use trademark application.

Section 3.21 replaces and modifies the practice of § 1.331(c). Section 3.21 sets forth requirements for the identification of patents or patent applications in documents submitted for recording. An assignment relating to a patent must identify the patent by number. The name of the inventor, the issue date, and title of the invention as stated in the patent may also be given in the assignment to provide additional information on the patent being assigned. An assignment relating to a national patent application must identify the national patent application by application number (consisting of the series code and the serial number, e.g., 07/123,456) or serial number and filing date. An assignment relating to an international patent application which designates the United States of America must identify the international application number (e.g., PCT/US90/01234). The name of the inventor, date of filing, and title of the invention as stated in the patent application may also be given in the assignment. If an assignment 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 its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. Assignments submitted for recording that do not identify the patent or patent application as required by this section will not be recorded, but will be returned to the correspondence address that is required to be provided on the cover sheet by § 3.31(e).

Section 3.24 is added to set out formal document requirements to facilitate and expedite the recording process. This section requires that documents, either the original or a true copy of the original, submitted for recording be legible, using only one side of each page. The paper used should be flexible, white, durable, and preferably no larger than 21.6 × 33.1 cm. (8½ × 14 inches), with a 2.5 cm. (one-inch) margin on all sides. Documents submitted in this form are camera-ready and can be recorded expeditiously with little additional handling required. Documents that fail to meet the legibility and single-sided paper requirements of this section will be returned as set forth in § 3.51.

Section 3.26 replaces and modifies the practice of §§ 1.331(b) and 2.185(a)(2). Section 3.26 provides that the Office will accept and record non-English documents provided they are accompanied by a verified English translation signed by the translator. Documents submitted that fail to meet the requirements of this section will be returned as set forth in § 3.51.

Section 3.27 is added to set out how documents submitted for recording should be addressed to the Office. To ensure prompt and proper processing, documents and their cover sheets should be addressed to the Commissioner of Patents and Trademarks, Box Assignments, Washington, DC 20231, unless they are filed together with new applications or with a petition under § 3.81(b). Petitions under § 3.81(b) should be addressed to the Commissioner of Patents and Trademarks, Box DAC, Washington, DC 20231. New applications and other petitions should be addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.

Section 3.28 is added to set out the requirement that all documents submitted to the Office for recording be accompanied by at least one cover sheet referring either to the patent applications and patents or to the trademark applications and registrations against which the document is to be recorded. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, separate patent and trademark cover sheets must be submitted. If a document to be recorded is not accompanied by a completed cover sheet, the document and any incomplete cover sheet will be returned to the correspondence address for proper completion of the cover sheet and resubmission of the cover sheet and document. While the previous rules did not require a cover sheet to accompany each document submitted for recording, typically a cover letter is submitted to

ensure proper processing of the document. The Office is making a cover sheet mandatory in order to better ensure prompt and proper processing of all documents submitted for recording. The cover sheet contains all the information necessary for the Office to process the document.

Section 3.31 is added to set out the formal requirements of the cover sheet. Section 3.31 requires that each patent or trademark cover sheet must contain (1) the name of the party conveying the interest; (2) the name and address of the party receiving the interest; (3) a brief description of the interest conveyed or transaction to be recorded (e.g., assignment, license, change of name, merger, security agreement, etc.); (4) each application number, patent number or registration number 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 document to be recorded should be mailed; (6) the number of applications, patents or registrations identified in the cover sheet and the total fee; (7) the date the document was executed; (8) an indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative; (9) a statement by the party submitting the document that to the best of the person's knowledge and belief, the information contained on the cover sheet is true and correct, and (10) the signature of the party submitting the document. The term "party" as used in this rule means the person whose name appears on the documents to be recorded, that person's attorney or registered agent, or a corporate officer where a corporation's name appears on the document. Sample cover sheets for patent documents and for trademark documents are shown in appendices A and B.

Section 3.34 is added to set out the procedure to correct obvious errors in a recorded cover sheet. This section requires that if a recorded cover sheet contains an error that is apparent when



the cover sheet is compared with the recorded document, the error will be corrected only if a corrected cover sheet is filed for recordation. The corrected cover sheet must be accompanied by the originally recorded document or a copy of the originally recorded document and by a new assignment recording fee in the appropriate amount.

Section 3.41 replaces and consolidates practice under §§ 1.331(a) and 2.185(a)(3) regarding recording fees. Section 3.41 requires that all requests to record documents be accompanied by the appropriate fee. A fee is charged for each application, patent and registration identified in the cover sheet. The recording fee for patents and patent applications is specified in § 1.21(h). The recording fee for trademark registrations and applications is specified in § 2.6(q).

Section 3.51 replaces and modifies the practice of §§ 1.332 and 2.185(c). Section 3.51 sets the date of recording of a document as 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. For documents not accepted for recording, parties can petition under 37 CFR §§ 1.181 and 2.148(a). Other documents not meeting the requirements for recording, for example, a document submitted without a completed cover sheet, without the required fee, or without any required translation, will be returned for correction to the sender when a return address is available. The returned papers, stamped with the official date of receipt in the Office, will be accompanied by a letter indicating 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 papers. Submitters can use the certificate procedure under either § 1.8 or § 1.10 for resubmissions of returned papers if they desire 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 papers. Extensions of time will not be available to extend the specified period to resubmit the returned papers.

Section 3.54 is added to set out the effect of recording a document. This section states that 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, a patent, or a registration. The Office will determine, when necessary, what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office. Examples of when the Office will need to determine whether a party has the authority to take an action in a matter pending before the Office include: (1) Prosecution by the assignee as in § 3.71; (2) consent of an assignee to the filing of a reissue application as provided in § 1.172; and (3) execution of a disclaimer under § 1.321 by an assignee.

Section 3.56 replaces and modifies the practice of § 1.333. Section 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 section 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.

Section 3.61 replaces and modifies the practice of § 2.185(a)(4). Section 3.61 sets forth that an assignee of a trademark application or registration not domiciled in the United States must designate a domestic representative in writing to the Office. Assignees of patent applications or patents may designate domestic representatives if the assignee is not residing in the United States. 35 U.S.C. 293. The designation is required to 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.

Section 3.71 replaces and modifies the practice of §§ 1.32 and 2.186. Section 3.71 sets forth that the assignee of record of the entire right, title and interest in an application for patent is entitled to conduct the prosecution of the patent application to the exclusion of the named inventor. Similarly, the assignee of an application for registration is entitled to conduct the prosecution of the trademark application to the exclusion of the applicant.

Section 3.73 is added to set out the procedure by which an assignee can establish the right to take action in an application, patent or registration. The inventor is presumed to be the original 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 original owner of a trademark application and any registration that may issue therefrom, unless there is an assignment. Any action before the Office with respect to an assigned patent application, patent, or reexamination may be taken by the assignee of the

entire right, title, and interest, provided ownership is established to the satisfaction of the Commissioner. The assignee may establish ownership by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g., reel and frame number, etc.) where such evidence is recorded in the Office. Additionally, when a patent assignee is not represented by an attorney or registered agent, a statement signed by the assignee must also be submitted stating the evidence has been reviewed and certifying that, to the best of the party's knowledge and belief, title is in the party seeking to take the action. Documents submitted to establish ownership may be required to be recorded in the Office as a condition to permitting the requesting party to take action in a matter pending before the Office. Any action before the Office with respect to an assigned trademark registration, application or post-registration matter, may be taken by the assignee provided ownership is established to the satisfaction of the Commissioner by recording an assignment to the assignee or by submitting other proof of the assignment.

Section 3.81 replaces and modifies the practice of § 1.334. Section 3.81 sets forth the procedure for issuance of a patent to an assignee. If an assignment of the entire right, title, and interest is recorded before the issue fee is paid for a patent application, the patent may issue in the name of the assignee. If the assignee holds an undivided part interest, the patent may issue jointly to the inventor and the assignee. At the time the issue fee is paid, the name of the assignee must be provided if the patent is to issue solely or jointly to that assignee. If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i)(1).

Section 3.85 replaces and modifies the practice of § 2.187. Section 3.85 sets forth the procedure for issuance of a registration to an assignee. The certificate of registration may be issued to the assignee of the applicant, or in a



new name of the applicant, provided that the party files a written request in the trademark application record by the time the application is being prepared for issuance of the certificate of registration, and an appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the trademark application file.

**Response to Comments on the Rules**

The comments received in response to the notice of proposed rulemaking have been given careful consideration and a number of the suggested modifications have been adopted. The comments and responses are discussed below.

In this discussion, "Patent and Trademark Office" is abbreviated as "Office" or "PTO."

*Comment:* Two comments were received addressed to the overall rule package. One comment expressed concern over the potential confusion of instituting a new part 3. It was suggested that parts 1 and 2 be amended to contain the necessary changes. Another comment was concerned that the rules and specifically the new cover sheet requirement would impede promptness and accuracy of the recordation process.

*Response:* The Office has determined that the new rules will result in greater efficiency and accuracy in the recordation process and improve the integrity of the records maintained by the PTO. Further, the PTO believes that a new part 3, containing all rules relating to assignments, will be beneficial to the majority of patent and trademark system users.

*Comment:* Section 3.1 was proposed to define "application" as an application for patent or an application to register a trademark. One comment questioned whether international applications filed under the Patent Cooperation Treaty were included in the definition of the word "application."

Two comments were received concerning the definition of "assignment." As proposed, § 3.1 defines "assignment" of a trademark in terms of a "trademark application" or "registration." The comments suggested that because Section 10 of the Trademark Act, 15 U.S.C. 1060, speaks in terms of a "registered mark" or a "mark for which application to register has been filed," which was reflected in previous trademark rule 2.186, the different terminology may be construed to permit assignment of a trademark without assignment of the underlying goodwill.

*Response:* The wording of § 3.1 has been changed to include both national applications for patent and international applications that designate the United States in the term "application."

Also to avoid any potential confusion over the definition of a trademark assignment, the Office adopted the suggestion to reflect Section 10 of the Trademark Act and to refer to a "registered mark" or a "mark for which application to register has been filed" in its definition of assignment.

*Comment:* As proposed, § 3.16 provides that an application to register a mark under 15 U.S.C. 1051(b) cannot be assigned before a statement of use is filed except to a successor to an ongoing business of the original applicant. One comment suggested § 3.16 be further amended to correct a legislative oversight and permit assignment of the application after an amendment of allege use is filed.

One other comment suggested the PTO define the statutory language "successor to the business of the applicant."

*Response:* As proposed, Rule 3.16 merely restates the statute. To permit the filing of an assignment to a successor to an on-going business before an amendment to allege use has been filed would make the rule inconsistent with the statute.

As to the definition of "successor to the business of the applicant," it has been determined that in the absence of any statutory definition, it is better left to case law to establish the meaning. A business, or portion thereof, can be transferred or assigned in a variety of ways, and the question of valid ownership might arise in a variety of circumstances. For the PTO to define what constitutes a successor may be unduly restrictive.

Accordingly, the suggested modifications have not been adopted.

*Comment:* Section 3.21, as proposed, provides that an assignment of a patent or patent application must be identified by number. One comment requested a further amendment to allow the filing of a patent assignment after filing an application for patent but before knowing the application number by allowing identification by the execution date, inventors and title of the invention instead of the application number.

Another comment suggested that assignments relating to trademark applications and registrations should also be required to have the identifying serial and registration numbers within the body of the assignment document.

One comment questioned whether the patent identification number was required in the document or whether the number could just appear on the cover sheet.

*Response:* Providing the identifying number in the assignment document

allows for greater efficiency and accuracy in recording assignments. However, unlike patents, trademarks can have an indefinite life. Assignments may be recorded years after an assignment has occurred to clear up the chain of title. It may not be possible to execute a new assignment to include identifying numbers in the document years later. Accordingly, it is preferable for the PTO to be more flexible in recording trademark assignments which may contain the identifying number in the cover sheet rather than in the document itself. Because of the nature of a patent, less flexibility is permitted. Patent rights, unlike trademark rights, do not exist apart from the issued patent. Accordingly, when an interest in a patent is transferred, the patent identifying number must be in the assignment document. This requirement only applies to assignments, not to documents other than assignments.

The PTO makes every effort to provide applicants with the application numbers for newly-filed patent applications as soon as possible. It is suggested, however, that assignment documents may 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."

Accordingly, the suggested modifications have not been adopted.

*Comment:* Section 3.24, as proposed, provides the formal requirements for the documents which are to be recorded and the cover sheet. Three comments stated that the one-side only requirement was unreasonable in light of PTO's issuance of two-sided patent and trademark copies and of the practices of other governments and corporations over which the submitter would have no control.

One comment requested clarification of "bond weight paper" and suggested the language used in the rules setting out drawing requirements be adopted.

One comment stated that the document size requirements should only pertain to documents prepared and



executed by parties who wish to convey title.

Two comments questioned whether the PTO would permit the filing of copies or true copies in lieu of the original documents for recording.

*Response:* The formal requirements set out in § 3.24 are related to PTO's ability to capture on film papers filed with the PTO. The requirements are not related to the other printing or photocopying services PTO provides. Micrographics reproduction requires that only one side of each page be used for efficiency. If the original document is two-sided or the wrong size, the practitioner can comply with this requirement by providing a true copy of the original document using only one side of each page on the correct size paper. The language in § 3.24 has been changed to clarify that true copies or originals are acceptable. Further, the language describing the type of paper to be used has been changed to be consistent with the drawing requirement rules.

*Comment:* Section 3.28, as proposed, provides that all requests to record a document must be accompanied by the document to be recorded and at least one cover sheet. One comment expressed confusion over whether the document must be accompanied by a cover letter as well as a request for recording. One comment stated the requirement for a cover sheet did not help the PTO with the documents which are filed with applications and the commenter did not see the need for an additional paper included among the papers for a new application.

*Response:* The first sentence has been rewritten to clarify that only the document and a cover sheet(s) must be submitted. A separate request for recording is not required or needed. Because the cover sheet provides all pertinent information in one place, it will greatly assist the processing of assignments by the PTO. For those applications which are filed with an assignment, the additional cover sheet required for the assignment aids the processing of the assignment.

*Comment:* Numerous comments were received on the proposed cover sheet requirements of § 3.31. One comment questions whether the form or the contents of the form are being required and cautioned that the cover sheet should not become a technical obstacle to recordation.

Two comments claimed the cover sheet requirement would be burdensome and the documents recorded should speak for themselves.

Two comments objected to the requirement for the characterization of the interest being conveyed. One of the commentors indicated it was not the best evidence of what the interest is and may be misleading while the second commentor was concerned practitioners would be subject to malpractice claims and be made parties to litigation involving the transfer.

One comment stated that requiring the assignee's address was burdensome and excessive. Three comments questioned the lack of consistency between proposed subsections (a) and (b) of § 3.31 which requires only the name of the conveyor but both the name and address of the receiver.

Two comments stated that the language of the rule was unclear as to whether the list of properties within the assignment document should be retyped on the cover sheet, which would be burdensome and fraught with potential errors.

One comment was received suggesting that properties be identified with as much information as possible (i.e., serial number, patent number, filing date, inventors, etc.).

Four comments stated that the requirement for an execution date of the document is excessive and burdensome. One of the comments stated that the execution date may not be as important as the effective date of the document. One suggested the effective date would be more accurate and another suggested the document should speak for itself. One additional comment stated that a nunc pro tunc assignment of the substantive rights of an assignee or assignor may be unduly affected by the requirement for recitation of the execution date.

Nine comments were received objecting to the language of the proposed verification. Some comments recommended that the verification statement be deleted. Other comments recommended that the verification statement be based on "information and belief." The comments indicated (1) practitioners did not want to be held responsible for the information entered on the cover sheet, (2) there was no purpose served by signing the cover sheet because the documents should speak for themselves and (3) under 37 CFR 10.18, a registered practitioner's signature indicates that the filing is correct.

One comment suggested that proposed § 3.31(i) does not recognize the right of some non-lawyers to practice in trademark matters before the PTO.

Additionally, many comments and suggestions were received on the layout of the sample cover sheets.

*Response:* The proposed purpose of the cover sheet is to provide a synopsis of the vital information contained in a recorded document. The cover sheet form itself is not required, only the information outlined in § 3.31 is

required. Use of the sample cover sheet formats appearing as Appendices A and B to the rule package is encouraged. The Office will make paper copies of the sample cover sheets available for customer use. Persons wishing to obtain paper copies of the sample cover sheets should contact the Public Service Center at (703) 305–HELP. Questions regarding the sample cover sheets should be directed to the Assignment and Certification Services Division at (703) 308–9700.

As indicated in the proposed rule package, a majority of documents presently filed for recording are accompanied by a cover letter containing much of the information required in § 3.31. The PTO does not believe standardization of the information submitted is an undue burden. Standardization ensures easy reference to all critical information. Further, the parties or their representatives are in a better position to know or ascertain the nature of the interest involved than the PTO. The document will always speak for itself. However, a characterization assists in putting others on notice as to the nature of the transaction.

It was determined that a verification is not required. The language has been changed to a statement on the cover sheet based on "information and belief." Further, § 3.31(i) has been divided into two paragraphs, one for the statement that is required and one for the signature.

The address of the assignee or receiving party is vital information for maintaining complete assignment records. The original owner is the applicant, for which the Office has the address of record. Each subsequent assignee address is then obtained under this requirement and is of record if the PTO or public needs to contact the present assignee. The execution date is required to determine whether an assignment has been recorded within three months provided in 35 U.S.C. 261 and 15 U.S.C. 1060.

When there is a listing of properties contained within a document, any listing may be copied and attached to the cover sheet to reduce the amount of typing necessary. A notation of this attachment can be made in lieu of entering every property identification number on the cover sheet. Should submitters provide information in addition to that required by § 3.31, it is always welcome, but not required.

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The comments received on the layout of the sample cover sheets have all been considered and some modifications have been made. However, the sample cover sheet is not required and it is not part of the rules.

*Comment:* Section 3.34, as proposed, provides for correction of errors in a recorded cover sheet when the error is apparent by comparing the information on the cover sheet with the recorded document itself. One comment received expressed confusion regarding the correction procedure. Another comment suggested that corrections should not be limited to apparent errors.

*Response:* The PTO will not compare the cover sheet with the original documents during the recording process except to assure that application and patent numbers are present in patent assignments. Otherwise, it will only check to see that the cover sheet is complete. When a submitter discovers an obvious error on the recorded cover sheet, the PTO will consider a request to correct it when it receives: (1) the original recorded document (or a copy); (2) a corrected cover sheet; and (3) the appropriate fee for each property to be corrected. The PTO will then compare the cover sheet with the document to determine whether the error is apparent on its face. If the error is obvious, the corrected cover sheet will be recorded and the respective Office records corrected. If the error is not obvious, the procedure set forth in the Manual of Patent Examining Procedure, MPEP § 323 will govern for patents and the procedure set forth in *In re Abacab International Computers Ltd.* (Assignee of IHEC, Ltd.), 21 USPQ2d 1078 (Comm'r Pats. 1987), on reconsideration, 21 USPQ2d 1079 (Comm'r Pats. 1988) will govern for trademarks. Submitters may also petition under § 1.183 or § 2.146 for other corrections. Typographical errors made by the Office will be corrected without charge when brought to our attention.

Accordingly, the suggested modification has not been adopted. The rule has only been changed to correct a cross reference.

*Comment:* As proposed, § 3.51 provides that the date of recording is the date all of the required information is filed in the Office. Incomplete documents will be returned. If the returned documents are resubmitted timely, the document will retain the date on which it was received as incomplete. Two comments were received regarding the time period to be set by the PTO. One comment indicated that any delay may affect the requirements of 15 U.S.C. 1060. It was therefore recommended that the PTO make some type of "conditional entry" in the records indicating an assignment has been submitted so interested members of the public could ascertain that there may be an effective recording date. The other comment suggested the time period for resubmission be long enough to allow communication with foreign parties, but it should be no longer than six months.

*Response:* After a review of the proposed rule, it was determined that the language of § 3.51 should be clarified to reflect that the originally-submitted papers with the official Office date stamp indicating the original receipt date in the Office must be returned in order to retain the original date. It is the intent of the PTO to set the time for response at one month from the date of mailing of the returned documents from the PTO. It is believed that most correctable errors will involve an incomplete cover sheet or the amount of the fee submitted, both of which can be corrected within one month.

Further, it is the policy of the PTO to make of record only those documents which meet the requirements for recording. It is not beneficial to cloud title to properties with potential transfers.

*Comment:* Section 3.56, as proposed, is a restatement of former § 1.333 and is made applicable to trademarks. It provides that an assignment which is made conditional upon a condition subsequent will be regarded by the Office as an absolute assignment. One comment was received inquiring as to whether § 3.56 applied to security interests, another was received requesting a reference in the rules to recording of security agreements.

*Response:* Section 3.56 is applicable only to assignments, as they are defined by § 3.1, that is, a transfer of right, title and interest in a patent or a trademark. A security interest or a security agreement is in the nature of a lien, not an assignment. Accordingly, § 3.56 would not apply to security interests or security agreements which are also recordable. It applies to conditional assignments because the Office has no way of determining whether and when conditions are satisfied and therefore must address this type of assignment in a uniform manner. The reference to the recordability of security agreements is referred to here in the final rule package.

*Comment:* The second sentence of § 3.71, as proposed, provides: "(t)he assignee of record of the entire right title and interest in a trademark application or registration is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee." One comment suggested, as had been recommended for the definitions in § 3.1,

that language be adopted consistent with section 10 of the Trademark Act, 15 U.S.C. 1060, so there be no confusion as to what can be assigned in the trademark area and further, that the language requiring "entire right, title and interest" be deleted.

*Response:* As was the case with the PTO's review of § 3.1, the language in § 3.71 has also been modified to eliminate any confusion. Accordingly, § 3.71 now provides for assignments of registered marks or a mark for which an application for registration has been filed, making it consistent with § 3.1. While this change cannot prevent assignments from being made without the underlying goodwill, it may eliminate some confusion.

*Comment:* Section 3.73, as proposed, provided that a full assignee could take any action before the Office with respect to the assigned application, patent, or registration provided ownership is established to the satisfaction of the Commissioner. The rule further provided that ownership could be established by providing documentary evidence of the chain of title to the assignee. The assignee was also required to submit a verified statement stating the evidence had been reviewed and certifying to the best of the party's belief, title is in the party seeking to take the action. The Office reserved the right to require recordation of any ownership documents. One comment suggested the procedure was too "elaborate" and "confusing" to permit the submitting party to act rapidly. Another comment suggested the Office use the language of former § 2.186 which only required "the assignment has been recorded or that proof of the assignment has been submitted" to enable action by the assignee.

Another comment suggested that a simple statement identifying the documents thought to place ownership in a party should be sufficient. It was believed that no additional benefit accrued by having the party state that they believed they were entitled to take the action because whether or not a party can act is a determination the PTO must make.

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Two comments suggested that a literal reading of the rule would require every paper filed on behalf of an assignee be accompanied by a proof of ownership. One comment suggested it was too harsh to preclude a party from taking action in a trademark matter until proof of ownership is established to the satisfaction of the Commissioner. Rather, it was suggested that a party be permitted to take action once documents establishing ownership are filed.

One comment received pointed to the proposed language of § 3.73 providing the statement must be signed by the party or its attorney or agent of record which was a greater requirement than § 1.34(a), if that was intended.

Another comment suggested that the proposed language be changed by deleting the provision that ownership must be established to the satisfaction of the Commissioner and substituting therefore "provided the assignee is owner of the entire right, title, and interest in the patent application, patent, registered mark or mark for which an application for registration has been filed."

One final comment suggested that § 3.73 be changed to specifically set forth that it applied to secure Office acceptance of a Section 8 or 15 affidavit or a section 9 application, 15 U.S.C. 1058, 1059, for trademark filings, and requested examples of the types of documents necessary to establish ownership.

*Response:* Ownership need only be established the first time the new party wants to act in patent and trademark cases, provided the appropriate documents are recorded. Section 3.73(b) is modified to provide that a statement of ownership need only be provided when a patent assignee wishes to act on a matter. For patents, the PTO believes it is appropriate for the patent assignee to review the documents it believes establishes its ownership prior to filing a paper signed by that assignee. Additionally, the statement will certify that to the best of the assignee's knowledge and belief, title is in that assignee. This will establish, to the satisfaction of the Commissioner, that the assignee knows of no other document establishing title in someone other than the assignee. The PTO will still make the determination of whether the assignee is entitled to take action after a review of the documents.

For trademarks the action sought to be taken can be submitted simultaneously by the party. The action will be examined as will the claim of ownership and the party will be notified whether it is satisfactory. As in the past, "any action" refers to post-registration documents as well.

**Other Considerations**

The rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Orders 12291 and 12612 and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*

The General Counsel of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these rule changes will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impact of these changes is to require that a cover sheet accompany each document submitted for recording. The rule change includes no additional or increased fees. Substantive rights to use trademarks and patents are not adversely affected.

The Office has determined that these rule changes are not a major rule under Executive Order 12291. The annual effect on the economy will be less than $100 million. Because most of the changes reduce procedural burdens, there will be no major increase in costs or prices for consumers; individual industries; Federal, State or local government agencies; or geographic regions. There will be no significant adverse effects on competition, employment, investment, productivity, or innovation, or on the ability of United States-based enterprises to compete with foreign-based enterprises in domestic or export markets.

These rule changes contain a collection-of-information requirement subject to the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* The rule changes add a requirement for a cover sheet to be submitted with each document to be recorded that will expedite the recording process and improve quality. This collection of information requirement is cleared under OMB Control No. 0651–0011. The public reporting burden for this requirement is estimated to be one-half hour per filing, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collections of information.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

**List of Subjects**

*37 CFR Part 1*

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents,

Reporting and recordkeeping requirements, Small businesses.

*37 CFR Part 2*

Administrative practice and procedure, Courts, Lawyers, Trademarks.

*37 CFR Part 3*

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Trademarks.

For the reasons set out in the preamble and pursuant to the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 6, parts 1, 2 and 3 of title 37 of the Code of Federal Regulations are amended as set forth below.

## PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 would continue to read as follows:

**Authority:** 35 U.S.C. 6, unless otherwise noted.

2. Section 1.12 paragraphs (a) and (d) are revised to read as follows:

**§ 1.12 Assignment records open to public inspection.**

(a) (1) Separate assignment records are maintained in the 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 assignment records relating to pending or abandoned trademark applications and to trademark registrations, for assignments recorded on or after January 1, 1955, are open to public inspection at the Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in §§ 1.19 and 2.6 of this chapter.

(2) All records of assignments of patents recorded before May 1, 1957, and all records of trademark assignments recorded before January 1, 1955, 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.

* * * * *



(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.

3. Section 1.17 is amended by revising paragraph (i)(1) to read as follows:

**§ 1.17 Patent application processing fees.**

* * * * *

(i) (1) For filing a petition to the Commissioner under a section of this part listed below which refers to this paragraph—$130.00.

§ 1.12—for access to an assignment record.
§ 1.14—for access to an application.
§ 1.53—to accord a filing date.
§ 1.55—for entry of late priority papers.
§ 1.60—to accord a filing date.
§ 1.62—to accord a filing date.
§ 1.103—to suspend action in application.
§ 1.177—for divisional reissues to issue separately.
§ 1.312—for amendment after payment of issue fee.
§ 1.313—to withdraw an application from issue.
§ 1.314—to defer issuance of a patent.
§ 1.666(b)—for access to interference settlement agreement.
§ 3.81—for patent to issue to assignee, assignment submitted after payment of the issue fee.

* * * * *

**§ 1.32 [Reserved]**

4. Section 1.32 is removed and reserved.

5. Section 1.46 is revised to read as follows:

**§ 1.46 Assigned inventions and patents.**

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

6. Section 1.104 is amended by revising paragraph (e) to read as follows:

**§ 1.104 Nature of examination; examiner's action.**

* * * * *

(e) Co-pending applications will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person if:

(1) The application files refer to assignments recorded in the Patent and Trademark Office in accordance with part 3 of this chapter which convey the entire rights in the applications to the same person or organization; or

(2) Copies of unrecorded assignments which convey the entire rights in the applications to the same person or organization are filed in each of the applications; or

(3) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership; or

(4) Other evidence is submitted which establishes common ownership of the applications.

In circumstances where the common owner is a corporation or other organization, an affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization.

7. The undesignated centerhead above § 1.331 is revised to read as follows:

Arbitration Awards

**1.331–1.334 [Reserved]**

8. Sections 1.331 through 1.334 are removed and reserved.

## PART 2—RULES OF PRACTICE IN TRADEMARK CASES

9. The authority citation for 37 CFR part 2 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 6, unless otherwise noted.

10. The undesignated centerhead above § 2.185 is removed.

**§ 2.185–2.187 [Reserved]**

11. Sections 2.185 through 2.187 are removed and reserved.

12. Part 3 is added to read as follows:

## PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

Sec.
3.1 Definitions.

**Documents Eligible for Recording**

3.11 Documents which will be recorded.
3.16 Assignability of trademarks prior to filing of use statements.

**Requirements for Recording**

3.21 Identification of patents and patent applications.
3.24 Formal requirements for documents and cover sheets.
3.26 English language requirement.
3.27 Mailing address for submitting documents to be recorded.
3.28 Requests for recording.

**Cover Sheet Requirements**

3.31 Cover sheet content.

3.34. Correction of cover sheet errors.

**Fees**

3.41 Recording fees.

**Date and Effect of Recording**

3.51 Recording date.
3.54 Effect of recording.
3.56 Conditional assignments.

**Domestic Representative**

3.61 Domestic representative.

**Prosecution by Assignee**

3.71 Prosecution by assignee.
3.73 Establishing right of assignee to prosecute.

**Issuance to Assignee**

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

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 6.

### § 3.1 Definitions.

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

*Application* means a national application for patent, an international application that designates the United States of America, or an application to register a trademark unless otherwise indicated;

*Assignment* means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed.

*Document* means a document which a party requests to be recorded in the Office pursuant to § 3.11 and which affects some interest in an application, patent, or registration;

*Office* means the Patent and Trademark Office.

*Recorded document* means a document which has been recorded in the Office pursuant to § 3.11.

*Registration* means a trademark registration issued by the Office.

## Documents Eligible for Recording

### § 3.11 Documents which will be recorded.

Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Commissioner.



### § 3.16 Assignability of trademarks prior to filing of use statements.

No application to register a mark under 15 U.S.C. 1051(b) is assignable prior to the filing of the verified statement of use under 15 U.S.C. 1051(d) except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

## Requirements for Recording

### § 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) or the serial number and filing date. 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/US90/01234). If an assignment 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 its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended.

### § 3.24 Formal requirements for documents and cover sheets.

The document and cover sheet must be legible. Either the original document or a true copy of the original document, may be submitted for recording. Only one side of each page shall be used. The paper used should be flexible, strong, white, non-shiny, durable, and preferably no larger than 21.6 x 33.1 cm. (8½ x 14 inches) with a 2.5 cm. (one-inch) margin on all sides.

### § 3.26 English language requirement.

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

### § 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignments, Washington, DC 20231, unless they are filed together with new applications or with a petition under § 3.81(b).

### § 3.28 Requests for recording.

Each document submitted to the Office for recording must be accompanied by at least one 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, separate patent and trademark cover sheets must be submitted. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded is not accompanied by a completed cover sheet, the document and any incomplete cover sheet will be returned pursuant to § 3.51 for proper completion of a cover sheet and resubmission of the document and a completed cover sheet.

## Cover Sheet Requirements

### § 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) Each application number, patent number or registration number 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 number of applications, patents or registrations identified in the cover sheet and the total fee;

(7) The date the document was executed;

(8) An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative (see § 3.61); and

(9) A statement by the party submitting the document that to the best of the person's knowledge and belief, the information contained on the cover sheet is true and correct and any copy submitted is a true copy of the original document; and

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

(b) A cover sheet may not refer to both patents and trademarks.

**§ 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 the originally recorded document or a copy of the originally recorded document and by the recording fee as set forth in § 3.41.

**Fees**

**§ 3.41 Recording fees.**

All requests to record documents must be accompanied by the appropriate fee. 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(q) of this chapter for trademarks.

*Date and Effect of Recording*

**§ 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 certification procedure under either § 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.

**§ 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

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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.

**§ 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 cancelled 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.

**Domestic Representative**

**§ 3.61 Domestic representative.**

If the assignee of a trademark application or registration is not domiciled in the United States, the assignee must designate, in writing to the Office, a domestic representative. An assignee of a patent application or patent may designate a domestic representative if the assignee is not residing in the United States. The designation shall 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.

**Prosecution by Assignee**

**§ 3.71 Prosecution by assignee.**

The assignee of record of the entire right, title and interest in an application for patent is entitled to conduct the prosecution of the patent application to the exclusion of the named inventor or previous assignee. The assignee of a registered trademark or a trademark for which an application to register has been filed is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee.

**§ 3.73 Establishing right of assignee to prosecute.**

(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 unless there is an assignment.

(b) When the assignee of the entire right, title and interest seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g. reel and frame number, etc.) where such evidence is recorded in the Office. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. In addition, the assignee of a patent application or patent must submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of assignee's knowledge and belief, title is in the assignee seeking to take the action.

**Issuance to Assignee**

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

(a) For a patent application, if an assignment of the entire right, title, and interest is recorded before the issue fee is paid, the patent may issue in the name of the assignee. If the assignee holds an undivided part interest, the patent may issue jointly to the inventor and the assignee. At the time the issue fee is paid, the name of the assignee must be provided if the patent is to issue solely or jointly to that assignee.

(b) If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i)(1) of this chapter.

**§ 3.88 Issue of registration to assignee.**

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

Dated: June 24, 1992.

**Douglas B. Comer,**

*Acting Assistant Secretary and Acting Commissioner of Patents and Trademarks*

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Note—The following appendix will not appear in the Code of Federal Regulations

Appendix A

FORM PTO-1594
1-31-92

RECORDATION FORM COVER SHEET
**TRADEMARKS ONLY**

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Tab settings ⇨ ⇨ ⇨ ▼ ▼ ▼ ▼ ▼ ▼ ▼ ▼

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

☐ Individual(s) ☐ Association
☐ General Partnership ☐ Limited Partnership
☐ Corporation-State
☐ Other _____

Additional name(s) of conveying party(ies) attached? ☐ Yes ☐ No

2. Name and address of receiving party(ies):

Name: _____

Internal Address: _____

Street Address: _____

City: _____ State: _____ ZIP: _____

☐ Individual(s) citizenship _____
☐ Association _____
☐ General Partnership _____
☐ Limited Partnership _____
☐ Corporation-State _____
☐ Other _____

If assignee is not domiciled in the United States, a domestic representative designation is attached: ☐ Yes ☐ No
(Designations must be a separate document from Assignment)
Additional name(s) & address(es) attached? ☐ Yes ☐ No

3. Nature of conveyance:

☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: _____

4. Application number(s) or registration number(s):

A. Trademark Application No.(s)

B. Trademark registration No.(s)

Additional numbers attached? ☐ Yes ☐ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: _____

Internal Address: _____

Street Address: _____

City: _____ State: _____ ZIP: _____

6. Total number of applications and registrations involved: _____

7. Total fee (37 CFR 3.41): ..... $ _____

☐ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

_____

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.
*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

_____ _____ _____
Name of Person Signing Signature Date

Total number of pages comprising cover sheet: _____

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

**Commissioner of Patents and Trademarks**
**Box Assignments**
**Washington, D.C. 20231**

Public burden reporting for this sample cover sheet is estimated to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed, and completing and reviewing the sample cover sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Office of information Systems, PK2-1000C, Washington, D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project (0651-0011), Washington, D.C. 20503.

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# Guidelines for Completing Trademarks Cover Sheets

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 more than one conveying party, enter a check mark in the "Yes" box to indicate that additional information is attached. The name of the second and any subsequent conveying party(ies) should be placed on an attached page clearly identified as a continuation of the information in Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page.

**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" to indicate that additional information is attached. An entity type must be indicated for each receiving party, and the citizenship of individuals must be indicated. If the receiving party is an assignee not domiciled in the United States, a designation of domestic representative is required. A designation of domestic representative must be contained in a document separate from the assignment document. Place a check mark in appropriate box to indicate whether or not a designation of domestic representative is attached. Enter a check mark in the "No" box, if no information is contained on an attached page.

**Item 3. Nature of Conveyance.**

Place a check mark in the appropriate box describing the nature of the conveying assignment document. If the "Other" box is checked, specify the nature of the conveyance. Enter the execution date 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.

**Item 4. Application Number(s) or Registration number(s).**

Indicate the application number(s) including series code and serial number, and/or registration number(s) against which the document is to be recorded. 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.

**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 Registration Involved.**

Enter the total number of applications and trademarks identified for recordation. Be sure to include all applications and registrations 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 registration against which the document is recorded.

**Item 8. Deposit Account Number.**

Enter the deposit account number to authorize charges. Attach a duplicate copy of cover sheet to be used for the deposit charge account transaction.

**Item 9. Statement and Signature.**

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet, confirming that to the best of the persons knowledge and belief, the information contained on the cover sheet is correct and that any copy of the document is a true copy of the original document. Enter the total number of pages contained in the cover sheet package, including any attached pages containing information continued from items on the cover sheet.

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Note--The following appendix will not appear in the Code of Federal Regulations

Appendix B

FORM PTO-1594
1-31-92

RECORDATION FORM COVER SHEET
**PATENTS ONLY**

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Tab settings ⇨ ⇨ ⇨ ▼ ▼ ▼ ▼ ▼ ▼ ▼ ▼

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Additional name(s) of conveying party(ies) attached? ☐ Yes ☐ No

3. Nature of conveyance:

☐ Assignment ☐ Merger

☐ Security Agreement ☐ Change of Name

☐ Other _____

Execution Date: _____

2. Name and address of receiving party(ies):

Name: _____

Internal Address: _____

Street Address: _____

City: _____ State: _____ ZIP: _____

Additional name(s) & address(es) attached? ☐ Yes ☐ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☐ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: _____

Internal Address: _____

Street Address: _____

City: _____ State: _____ ZIP: _____

6. Total number of applications and patents involved: ☐

7. Total fee (37 CFR 3.41):..... $ _____

☐ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

_____

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

Name of Person Signing | Signature | Date

Total number of pages comprising cover sheet: ☐

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

**Commissioner of Patents and Trademarks**
**Box Assignments**
**Washington, D.C. 20231**

Public burden reporting for this sample cover sheet is *estimated* to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed, and completing and reviewing the sample cover sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Office of Information Systems, PK2-1000C, Washington, D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project (0651-0011), Washington, D.C. 20503.

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# Guidelines for Completing Patents Cover Sheets

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 in Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page.

**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.

**Item 3. Nature of Conveyance.**

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. Enter the execution date 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.

**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 the serial number; and international application numbers must be complete, e.g., 07/123,456 for national application numbers, and PCT/US91/12345 for international application numbers. 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.

**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. Deposit Account Number.**

Enter the deposit account number to authorize charges. Attach a duplicate copy of cover sheet to be used for the deposit charge account transaction.

**Item 9. Statement and Signature.**

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet, confirming that to the best of the persons knowledge and belief, the information contained on the cover sheet is correct and that any copy of the document is a true copy of the original document. Enter the total number of pages contained in the cover sheet, including any attached pages containing information continued from items on the cover sheet.

[FR Doc. 92-15378 Filed 7-2-92; 8:45 am]
BILLING CODE 3510-16-C

# PROPOSED NEW RULES ON OATH AND FEES FOR CONTINUING PATENT APPLICATIONS

57 FR 31344

**DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

**37 CFR Part 1**

**[Docket No. 920666-2166]**

**RIN 0651-AA59**

## Changes in Practice Relating To Filing Patent Applications

**AGENCY:** Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The Patent and Trademark Office (Office) is proposing to amend the rules of practice in patent cases to provide a uniform practice with respect to an oath or declaration and filing fees in continuing applications.

**DATES:** Written comments must be received on or before August 14, 1992, to ensure consideration. An oral hearing will not be conducted.

**ADDRESSES:** Address written comments to Office of the Assistant Commissioner for Patents, Box DAC, Washington, DC 20231, marked to the attention of Jeffrey V. Nase. Correspondence may be sent to FAX to the attention of Jeffrey V. Nase at (703) 305-8825.

**FOR FURTHER INFORMATION CONTACT:** Jeffrey V. Nase, by telephone at (703) 305-9282 or by mail marked to his attention and addressed to Office of the Assistant Commissioner for Patents, Box DAC, Washington, DC 20231

**SUPPLEMENTARY INFORMATION:** A continuing application (i.e., a continuation or divisional application) filed under § 1.60 does not receive a filing date until a complete copy of the prior application is filed, including a true copy of the oath or declaration. Since the Office is in possession of the prior application's oath or declaration, it is proposed that § 1.60 be modified to be consistent with §§ 1.53 and 1.62 by permitting filing of a true copy of the oath or declaration within a time specified in a notice of missing parts mailed by the Office.

The specific revisions proposed are discussed below.

### (1) Correction Inventorship (Section 1.48)

Section 1.48(a) is proposed to be amended to replace the designation by letter of various requirements therein with numbered designations so as to avoid confusion when making reference to this section.

### (2) Procedures for Completing Applications Filed Under Section 1.60

Section 1.60 outlines one of the procedures that may be followed by applicants to file a continuation or divisional application. One of the requirements under this section is that applicants file a true copy of the complete parent application as filed, including the oath or declaration. Paragraph (c) of this section specifies that a filing date will not be granted if applicant fails to file a complete application under this section. A filing date would be granted as of the date of receipt of the missing item. It is proposed that this practice be modified to be similar to the procedures for filing continuing applications under § 1.53(d) and continuation-in-part applications under § 1.62. More specifically, a new paragraph (d) is proposed to be added in § 1.60 to indicate that if an application filed pursuant to § 1.60(b) is otherwise complete, but does not include the appropriate filing fee or a true copy of the oath or declaration from the prior application, a filing date will be granted. The true copy of the oath or declaration, as well as payment of the appropriate filing fee must be submitted within a time period specified in a notice of missing parts mailed by the Office. In a manner similar to the practice under §§ 1.53(d) and 1.62(d), the appropriate oath or declaration and/or filing fee as



well as the surcharge set forth in § 1.16(e) must be filed within the time period specified in the notice of missing parts in order to avoid abandonment of the application. Paragraphs (b) and (c) of this section are proposed to be amended to make reference to the exception specified in proposed paragraph (d) discussed above.

### Other Considerations

The proposed rule change is in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 et seq.), Executive Orders 12291 and 12612 and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq.

The General Counsel of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these proposed rule changes will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impact of these proposed changes is to accord a filing date to certain continuing applications which, through oversight, fail to include certain papers which can be submitted after the filing date.

The Office has determined that this proposed rule change is not a major rule under Executive Order 12291. The annual effect on the economy will be less than $100 million. There will be no major increase in costs or prices for consumers, individuals, industries, Federal, state or local government agencies, or geographic regions because most of the proposed changes reduce procedural burdens. There will be no significant adverse effects on competition, employment, investment, productivity, innovation, or on the ability of United States based enterprises to compete with foreign-based enterprises in domestic or export markets.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

The rule change will not impose a burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq., since no recordkeeping or reporting requirements within the coverage of the Act are placed upon the public.

### List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements.

For the reasons set out in the preamble, and pursuant to the authority contained in 35 U.S.C. 6, the Office proposes to amend 37 CFR part 1 as follows, wherein deletions are indicated by brackets ([]) and additions by arrows (> <):

## PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 would continue to read as follows:

**Authority:** 35 U.S.C. 6, unless otherwise noted.

2. Section 1.48, paragraph (a) is proposed to be revised to read as follows:

**§ 1.48 Correction of inventorship.**

(a) If the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by [(a)] >:

(1)< A petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; [(b)]

>(2)< An oath or declaration by each actual inventor or inventors as required by § 1.63; [(c)]

>(3)< The fee set forth in § 1.17(h); and [(d)]

>(4)< The written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

* * * * *

3. In section 1.60, paragraph (b) and (c) are proposed to be revised and paragraph (d) is proposed to be added to read as follows:

**§ 1.60 Continuation or divisional application for invention disclosed in a prior application.**

* * * * *

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) if:

(1) The prior application was a complete application as set forth in § 1.51(a),

(2) Applicant indicates that the application is being filed pursuant to this section and files a true copy of the prior complete application as filed including the specification ([including] >with< claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application,

(3) The inventors named in the continuation or divisional application are the same or less than all the inventors named in the prior application, and

(4) The application is filed before the patenting or abandonment of or termination of proceedings on the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date. If the continuation or divisional application is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. [If] >Except as provided in paragraph (d) of this section, if< a true copy of the prior application as filed is not filed with the application or if the statement that the application papers are a true copy is omitted, the application will not be given a filing date earlier than the date upon which the copy and statement are filed, unless a petition with the fee set forth in § 1.17(i)(1) is filed which satisfactorily explains the delay in filing these items.

(c) If an application filed pursuant to paragraph (b) of this section is incomplete >for reasons other than those specified in paragraph (d) of this section<, applicant will be notified and given a time period within which to complete the application in order to obtain a filing date as of the date of filing the omitted item provided the omitted item is filed before the patenting or abandonment of or termination of proceedings on the prior application. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n).

>(d) If an application filed pursuant to paragraph (b) of this section is otherwise complete, but does not include the appropriate filing fee or a true copy of the oath or declaration from the prior application, showing the signature or an indication it was signed, a filing date will be granted and applicant will be so notified and given a period of time within which to file the fee, or the true copy of the oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section.<

Dated: July 8, 1992.

**Douglas B. Comer,**

*Acting Assistant Secretary and Acting Commissioner of Patents and Trademarks.*

[FR Doc. 92-16494 Filed 7-14-92; 8:45 am]