

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 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 applica-

tion 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

§ 3.85

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) of this chapter.

[57 FR 29642, July 6, 1992, as amended at 60 FR 20229, Apr. 25, 1995]

§ 3.85 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.

PART 4 [RESERVED]

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

SECRECY ORDERS

Sec.

- 5.1 Defense inspection of certain applications.
- 5.2 Secrecy order.
- 5.3 Prosecution of application under secrecy orders; withholding patent.
- 5.4 Petition for rescission of secrecy order.
- 5.5 Permit to disclose or modification of secrecy order.
- 5.6 General and group permits.
- 5.7 Compensation.
- 5.8 Appeal to Secretary.

LICENSES FOR FOREIGN EXPORTING AND FILING

- 5.11 License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.

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- 5.12 Petition for license.
- 5.13 Petition for license; no corresponding application.
- 5.14 Petition for license; corresponding U.S. application.
- 5.15 Scope of license.
- 5.16 Effect of secrecy order.
- 5.17 Who may use license.
- 5.18 Arms, ammunition, and implements of war.
- 5.19 Export of technical data.
- 5.20 Export of technical data relating to sensitive nuclear technology.
- 5.25 Petition for retroactive license.

GENERAL

- 5.31 Effect of modification, rescission or license.
- 5.32 Papers in English language.
- 5.33 Correspondence.

AUTHORITY: 35 U.S.C. 6, 41, 181-188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100-418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*, the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*, and the Nuclear Non-Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*, and the delegations in the regulations under these acts to the Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

SOURCE: 24 FR 10381, Dec. 22, 1959, unless otherwise noted.

SECRECY ORDERS

§ 5.1 Defense inspection of certain applications.

(a) The provisions of this part shall apply to both national and international applications filed in the Patent and Trademark Office and, with respect to inventions made in the United States, to applications filed in any foreign country or any international authority other than the United States Receiving Office. The (1) filing of a national or an international application in a foreign country or with an international authority other than the United States Receiving Office, or (2) transmittal of an international application to a foreign agency or an international authority other than the United States Receiving Office is considered to be a foreign filing within the meaning of Chapter 17 of Title 35, United States Code.

(b) In accordance with the provisions of 35 U.S.C. 181, patent applications containing subject matter the disclosure of which might be detrimental to