

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

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AUTHORITY: 15 U.S.C. 1123; 35 U.S.C. 6.

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

### § 3.1 Definitions.

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

*Application* means a national application for patent, an international application that designates the United States of America, or an application to

register a trademark unless otherwise indicated.

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

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

*Office* means the Patent and Trademark Office.

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

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

##### DOCUMENTS ELIGIBLE FOR RECORDING

### § 3.11 Documents which will be recorded.

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

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

[62 FR 53202, Oct. 10, 1997]

**§ 3.16 Assignability of trademarks prior to filing of an allegation of use.**

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

[64 FR 48926, Sept. 8, 1999]

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). 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 of a patent application filed under § 1.53(b) 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. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

[62 FR 53202, Oct. 10, 1997]

**§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.**

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.

**§ 3.25 Recording requirements for trademark applications and registrations.**

(a) *Documents affecting title.* To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

- (1) The original document;
- (2) A copy of the document;
- (3) A copy of an extract from the document evidencing the effect on title; or
- (4) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes.* Only a legible cover sheet is required (See § 3.31).

(c) *All documents.* All documents submitted to the Office should be on white and non-shiny paper that is no larger than 8½ x 14 inches (21.6 x 33.1 cm.) with a one-inch (2.5 cm) margin on all sides. Only one side of each page should be used.

[64 FR 48927, Sept. 8, 1999]

**§ 3.26 English language requirement.**

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

[62 FR 53202, Oct. 10, 1997]

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

(a) Except as provided in paragraph (b) of this section, documents and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignment, Washington, DC 20231, unless they are filed together with new applications or with a petition under § 3.81(b).

(b) A document required by Executive Order 9424 to be filed which does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)) must be addressed and mailed to the Commissioner of Patents and Trademarks, Box

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Government Interest, Washington, DC 20231.

[62 FR 53202, Oct. 10, 1997]

#### § 3.28 Requests for recording.

Each document submitted to the Office for recording must include 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 should 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 the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion. The document and a completed cover sheet should be resubmitted.

[64 FR 48927, Sept. 8, 1999]

#### 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) Identification of the interests involved:

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

(ii) *For any other document affecting title to a trademark or patent application, registration or patent:* Each trademark or patent application number or each trademark registration number or pat-

ent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

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

(6) The date the document was executed;

(7) 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

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

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

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

(1) Indicate that the document is to be recorded on the Governmental Register, and, if applicable, that the document is to be recorded on the Secret Register (see § 3.58); and

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

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

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

[57 FR 29642, July 6, 1992, as amended at 62 FR 53202, Oct. 10, 1997; 64 FR 48927, Sept. 8, 1999]

**§ 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.**

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

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

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

(2) The document and cover sheet are mailed to the Office in compliance with § 3.27(b).

[63 FR 52159, Sept. 30, 1998]

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 procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

[62 FR 53203, Oct. 10, 1997]

**§ 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.

**§ 3.58 Governmental registers.**

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

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recorded on the Departmental Register will be available for public inspection as provided in §1.12.

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

[62 FR 53203, Oct. 10, 1997]

#### 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.

#### ACTION TAKEN 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 in-

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ventor 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 take action.

(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 an assignee 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, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. 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.

[57 FR 29642, July 6, 1992, as amended at 62 FR 53203, Oct. 10, 1997]

#### 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) 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—COMPLAINTS REGARDING INVENTION PROMOTERS**

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- 4.1 Complaints regarding invention promoters.
- 4.2 Definitions.
- 4.3 Submitting complaints.
- 4.4 Invention promoter reply.
- 4.5 Notice by publication.
- 4.6 Attorneys and agents.

AUTHORITY: 35 U.S.C. 6 and 297.

SOURCE: 65 FR 3129, Jan. 20, 2000, unless otherwise noted.

**§ 4.1 Complaints regarding invention promoters.**

These regulations govern the Patent and Trademark Office's (Office) responsibilities under the Inventors' Rights Act of 1999, which can be found in the U.S. Code at 35 U.S.C. 297. The Act requires the Office to provide a forum for the publication of complaints concerning invention promoters. The Office will not conduct any independent

investigation of the invention promoter. Although the Act provides additional civil remedies for persons injured by invention promoters, those remedies must be pursued by the injured party without the involvement of the Office.

**§ 4.2 Definitions.**

(a) *Invention Promoter* means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

(1) Any department or agency of the Federal Government or of a State or local government;

(2) Any nonprofit, charitable, scientific, or educational organization qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;

(3) Any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;

(4) Any party participating in a transaction involving the sale of the stock or assets of a business; or

(5) Any party who directly engages in the business of retail sales of products or the distribution of products.

(b) *Customer* means any individual who enters into a contract with an invention promoter for invention promotion services.

(c) *Contract for Invention Promotion Services* means a contract by which an invention promoter undertakes invention promotion services for a customer.

(d) *Invention Promotion Services* means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

**§ 4.3 Submitting complaints.**

(a) A person may submit a complaint concerning an invention promoter with