

## 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.  
3.58 Governmental registers.

##### DOMESTIC REPRESENTATIVE

- 3.61 Domestic representative.

##### ACTION TAKEN BY ASSIGNEE

- 3.71 Prosecution by assignee.  
3.73 Establishing right of assignee to take action.

##### 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.

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 ap-

plication, 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 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). 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 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 an English trans-

lation 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 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 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;