

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Recording Assignments
OMB CONTROL NUMBER 0651-0027
(August 2012)

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to update information collection 0651-0027, "Recording Assignments." The USPTO is making revisions to two existing approved forms in this collection related to the inventor's oath or declaration: Patent Recordation Form Cover Sheet (PTO-1595) and Electronic Patent Assignment System (EPAS).

Section 4 of the Leahy-Smith America Invents Act (AIA) amends 35 U.S.C. § 115 to streamline the requirements for the inventor's oath or declaration. For example, amended 35 U.S.C. § 115(e) provides for making the statements required under 35 U.S.C. § 115(b) and (c) in an assignment of record and specifically permits an individual who is under an obligation of assignment of an application to include the required statements in the assignment executed by the individual, in lieu of filing the statements separately. The changes to 35 U.S.C. § 115 in the AIA are effective on September 16, 2012, but apply only to patent applications filed on or after September 16, 2012.

37 CFR 1.63(e) implements the provisions of 35 U.S.C. § 115(e). Section 1.63(e)(1) provides that an assignment may also serve as an oath or declaration required by § 1.63 if the assignment: (1) includes the information and statements required under § 1.63(a) and (b); and (2) a copy of the assignment is recorded as provided for in 37 CFR part 3. The assignment, including the information and statements required under § 1.63(a) and (b), must be executed by the individual who is under the obligation of assignment. Section 1.63(e)(2) provides that any reference to an oath or declaration under § 1.63 includes an assignment as provided for in § 1.63(e).

37 CFR 3.31 now requires a conspicuous indication, such as by use of a check-box on the assignment cover sheet, to alert the USPTO that an assignment submitted with an application is submitted for a dual purpose: recording in the assignment database, such as to support a power of attorney, and for use in the application as the oath or declaration. Assignments cannot be recorded unless an application number is provided against which the assignment is to be recorded. When an assignment is submitted for recording along with a paper application, the assignment is separated from the paper application and forwarded to the Assignment Recordation Branch for recording in its database at the time where the application is assigned an application number. The assignment does not become part of the application file. If the applicant indicates that an assignment-statement is also an oath or declaration, the USPTO will scan the assignment into the Image File Wrapper (IFW) file for the application before forwarding

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(continued)**

it to the Assignment Recordation Branch. Failure to utilize the check-box will result in a Notice to File Missing Parts of Nonprovisional Application requiring an inventor's oath or declaration as the assignment will not be made part of the application file nor will the USPTO recognize that the § 1.63 oath or declaration requirement has been satisfied. A copy of the assignment would need to be submitted in reply to the Notice along with the surcharge for the late submission of the inventor's oath or declaration.

For EFS-Web filing of application papers, EFS-Web does not accept assignments for recording purposes when filing an application. See Legal Framework for Electronic Filing System – Web (EFS-Web), 74 Fed. Reg. 55200, 55202 (Oct. 27, 2009). Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment System), notwithstanding the existence of a link from EFS-Web to EPAS that can be utilized to file an assignment after the application is filed. Accordingly, for EFS-Web submissions, all assignments submitted on filing of the application or later submitted will be made of record in the application (entered into the IFW), and will not be forwarded to the Assignment Recordation Branch for recordation by the Office. Thus, an assignment must be submitted to the Assignment Recordation Branch in order to comply with § 1.63(e)(1)(ii). If an applicant files the assignment-statement for recording via EPAS and utilizes the check-box, the Office will place a copy of the assignment-statement in the related application file.

Summary of Changes

In order to accommodate the revised procedure, the USPTO is revising Form PTO-1595 and EPAS to allow the public to indicate that the assignment document serves as an oath or declaration under 37 CFR 1.63.

Changes in Burden

The proposed revisions of these forms will not result in a substantive change in the burden for this collection. The changes will have no effect on the estimated annual responses or estimated time per response for the revised forms.