

trademark application, a signature may be applied to an Assignment document in one of the following ways:

(1) The applicant enters a "symbol" that the applicant has adopted as a signature on the electronic assignment document. The Office will accept any combination of letters, numbers, spaces and/or punctuation marks as a valid signature if it is placed between forward slash symbols (e.g., "/qwert!@#/'") and is in a signature block. The document is saved as a TIFF image; or

(2) The signatory signs paper copies of the assignment document in the traditional pen-and-ink manner. The attorney scans the document to create a TIFF image file for electronic submission of the document.

*See Trademark Manual of Examining Procedure (TMPEP) § 804.05, Signature of Electronically Transmitted Applications (May 2003).* Although when filing an assignment electronically, the cover sheet may be "signed" as explained in TMPEP § 804.05, the assignment document that is included therewith is an attached TIFF image.

The Office further proposes to revise paragraph (c)(1) of § 3.31 to simplify the requirements for the cover sheet to only require identification of whether the document to be recorded relates to a governmental interest.

The Office further proposes to add paragraph (f) of § 3.31, stating that a trademark cover sheet should include the citizenship of the parties conveying and receiving the interest, and that if the party receiving the interest is a partnership or joint venture, the cover sheet should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members. This information is required for purposes of examination of the application or registration file. Providing this information when the assignment is recorded may avoid a subsequent Office action by an examiner.

*Section 3.34:* The Office proposes to revise § 3.34(b) to delete "the originally recorded document or" to thereby provide that it is "a copy of the document originally submitted for recording" that must be submitted. As explained above, the Office is revising the procedure for handling assignment documents and will no longer be returning the document that is submitted for recording.

*Section 3.41:* The Office proposes to revise § 3.41(b)(2) to include electronic and facsimile submission as a means in which a statement of Government interest could be submitted for recordation without incurring a fee. Section 3.41(b)(2) is also proposed to be

revised to change the cross-reference to § 3.27 since § 3.27 was previously revised to delete § 3.27(b).

*Section 3.81:* The Office proposes to revise § 3.81(a) to change "name(s)" to "name" and "assignee(s)" to "assignee" because under rules of statutory and regulatory construction, the singular includes the plural unless the context indicates otherwise. Furthermore, the Office proposes to revise § 3.81(a) to change "should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b)" to "must state that the document has been filed for recordation as set forth in § 3.11." When an assignment document is submitted for recording, the preferred submission is by facsimile to (703) 306-5995, or through an electronic filing system (e.g., ETAS for trademark assignment documents or EFS for patent assignment documents), and not by mail. Accordingly, the Office proposes to revise the rules to enable patent applicants to state that the assignment documents have been filed for recordation, rather than including the assignment documents for recordation with the request.

Furthermore, the Office proposes to amend § 3.81(a) and (b) to delete the reference to a statement under § 3.73(b). If the application has been assigned, the assignment document should be submitted for recording as set forth in § 3.11 for the patent to issue showing the name of the assignee. Although during prosecution a statement under § 3.73(b) can be relied upon to establish that an assignee is of record, pursuant to § 3.73(b)(1)(i), "the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records as a condition to permitting the assignee to take action." By the time that a patent issues, any assignment should be submitted for recording, and reliance upon § 3.73(b) should not be necessary. Furthermore, although during prosecution of an application the Office will have an opportunity to require recordation, at issuance, prosecution has come to a close and there is no other practical opportunity for the Office to require recordation before the patent is issued.

The Office proposes to revise § 3.81(b) to read "[a]fter payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request that a patent be corrected to state the name of the assignee, must state that the assignment was submitted for

recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter." This would modify the practice relating to issuance of a patent to an assignee by requiring that after payment of an issue fee, a request for a certificate of correction must be filed in order to obtain issuance of the patent to an assignee. Thus, the patent document would not set forth such assignment information, but the assignment information would be set forth in a Certificate of Correction. Furthermore, this would discontinue the current practice of allowing a patent to issue to an assignee when an assignment has not been recorded but a § 3.73(b) statement has been filed. Instead of allowing submission of a § 3.73(b) statement, correction would be permitted via a certificate of correction where the assignment has been recorded, or submitted for recording before issuance of the patent. *See MPEP § 1481.*

Section 3.81(c)(1) is proposed to be amended to change "assignee(s)" to "assignee" and "inventor(s)" to "inventor" because under rules of statutory and regulatory construction, the singular includes the plural unless the context indicates otherwise.

#### Rule Making Considerations

*Administrative Procedure Act:* This notice proposes changes to the rules of practice to simplify the Office procedures involving power of attorney practice and recording assignment documents. The changes proposed in this notice are limited to the format for and the manner of submitting, establishing and changing the power of attorney, for submitting documents to be recorded in the assignment records, and the availability of assignment records to the public. Therefore, these changes involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (DC Cir. 2001). Therefore, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office is providing this opportunity for public comment on the changes proposed in this notice because the Office desires the benefit of public comment on these proposed changes.

*Regulatory Flexibility Act:* As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), an initial regulatory flexibility analysis under the