

Chapter 500

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501 Assignment of Marks

501.01 Assignability of Marks in Applications and Registrations

Extract from 15 U.S.C. §1060(a):

(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.

(3) Assignments shall be by instruments in writing duly executed...

*Extract from 37 C.F.R. §3.1. *** Assignment means a transfer by a party of all or part of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.*

501.01(a) Assignability of Intent-to-Use Applications

Extract from 15 U.S.C. §1060(a)(1). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be

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assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

An applicant cannot assign an application that was filed under 15 U.S.C. §1051(b) before the applicant files an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), except 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. Section 10 of the Trademark Act, 15 U.S.C. §1060; 37 C.F.R. §3.16.

The primary purpose of this provision is to ensure that a mark may only be assigned along with some business or goodwill, and to prevent "trafficking" in marks.

As a general rule, the United States Patent and Trademark Office ("USPTO") does not investigate or evaluate the validity of assignments. Therefore, the examining attorney should issue an inquiry concerning the compliance of an assignment with the cited provisions of §10 only if:

- (1) The application itself includes a statement indicating that the assignee is not a successor to the original applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing; or
- (2) *All* of the following conditions are present:
 - (a) The assignment is executed before the filing of an acceptable amendment to allege use or statement of use;
 - (b) The applicant submits the assignment document for inclusion in the application record; *and*
 - (c) The assignment document fails to include the relevant language from §10 to the effect that the assignment includes the entire business of the applicant/assignor or the portion of the business to which the mark pertains.

The examining attorney should not require the submission of assignment documents to determine compliance.

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If the examining attorney issues an inquiry, the applicant's statement that the assignment was in compliance with the cited provision of §10 is sufficient to resolve the issue. This statement may be entered through an examiner's amendment.

The assignment of an intent-to-use application to someone who is not the successor to the applicant's business before filing an allegation of use renders the application and any resulting registration void. *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

501.01(b) Assignability of Extensions of Protection of International Registrations to the United States

Under §72 of the Trademark Act, 15 U.S.C. §1141*l*, an extension of protection to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is party to the Madrid Protocol (or in a country that is a member of an intergovernmental organization that is a party to the Madrid Protocol). See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection to the United States, and TMEP Chapter 1900 for further information about the Madrid Protocol.

501.02 Assignments Must Be in Writing

Extract from 15 U.S.C. §1060(a)(3). Assignments shall be by instruments in writing duly executed.

501.03 Effect of Failure to Record Assignment

Extract from 15 U.S.C. §1060(a).

*(3) * * * Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.*

(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

See TMEP §§503 *et seq.* regarding the recordation of assignments in the Assignment Services Division of the Office.

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501.04 Foreign Assignee May Designate Domestic Representative

15 U.S.C. §1060(b). An assignee not domiciled in the United States may designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the assignee does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served upon the Director.

37 C.F.R. §3.61. If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should 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.

An assignee not domiciled in the United States may designate, by a document filed in the USPTO, the name and address of a domestic representative. 15 U.S.C. §§1051(e), 1058(f), 1059(c) and 1060; 37 C.F.R. §3.61; TMEP §604. The USPTO encourages assignees who do not reside in the United States to designate domestic representatives.

When an assignee designates a domestic representative, the designation should be in a paper separate from the assignment document. One copy of the designation of domestic representative should be sent to the Assignment Services Division with the document to be recorded. In addition, the assignee should send a separate copy of the designation for each registration or application to which an assignment pertains to the Trademark Branch of the USPTO ("Trademark Operation"), so that a copy of the designation can be entered in each file that is identified in the assignment document. 37 C.F.R. §1.4(b).

501.05 Assignee Stands in Place of Applicant or Registrant

Extract from 15 U.S.C. §1127. The terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

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*Extract from 37 C.F.R. §3.71. *** 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.*

An assignee, like an applicant, must be a natural or juristic person. See 15 U.S.C. §1127 and TMEP §803.

501.06 Partial Assignments

A trademark may be owned by two or more persons (see TMEP §803.03(d)), and a co-owner may assign his or her interest in a mark. Also, a party who is the sole owner of a mark may transfer a portion (e.g., 50%) of his or her interest in the mark to another party.

A trademark owner may also assign a separate portion of a business, together with the good will and trademarks associated with that portion of the business, but retain rights in the mark for uses pertaining to another part of the business. See *VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982). A single trademark of a company can be validly assigned if the assignor transfers the good will associated with only some of the goods or services on which that mark appears. After a registration has been assigned with respect to only some of the goods or services, both owners must file the necessary renewal applications and affidavits of continued use or excusable nonuse under 15 U.S.C. §1058 or §1141k to maintain the registration. If only one party files, only those goods or services in the registration for which that party owns the mark are continued or renewed. See TMEP §§1604 *et seq.* and 1613 regarding affidavits of continued use or excusable nonuse, and TMEP §§1606 *et seq.* and 1614 regarding renewal.

A trademark owner may not use an assignment to impose geographic restrictions on a registration. This must be done by way of a concurrent use proceeding before the Trademark Trial and Appeal Board or pursuant to a final determination by a federal court. 15 U.S.C. §1052(d). See TMEP §§1207.04 *et seq.* and *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") Chapter 1100 regarding concurrent use registration. However, the Assignment Services Division of the USPTO will record an assignment purporting to transfer rights in an unrestricted registration for less than the entire United States, because it is a transfer that may affect title to the registration. As noted in TMEP §503.01, the Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording the document is not a determination of the validity or effect of the purported assignment and does not create a concurrent use registration.

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See TMEP §§1615 *et seq.* regarding a registrant's request to divide a registration in which ownership has changed with respect to some but not all of the goods/services, and TMEP §1110.08 regarding an applicant's request to divide a pending application in which ownership has changed with respect to some but not all of the goods/services.

501.07 Assignment of Extension of Protection of International Registration to the United States

15 U.S.C. §1141l. Assignment of an Extension of Protection:

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.

Under §72 of the Trademark Act, 15 U.S.C. §1141l, an extension of protection of an international registration to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is party to the Madrid Protocol (or in a country that is a member of an intergovernmental organization that is a party to the Madrid Protocol).

Because the extension of protection remains part of the international registration, assignments of extensions of protection to the United States must be recorded at the International Bureau of the World Intellectual Property Organization ("IB"). The IB will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register, and will automatically update the Trademark Reporting and Monitoring ("TRAM") System and the Trademark Applications and Registrations Retrieval ("TARR") database to reflect these changes.

See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of international registrations or extensions of protection to the United States. 37 C.F.R. §7.22(b).

See TMEP §§1110.08 and 1615.02 regarding division of an extension of protection to the United States after ownership of an international registration has changed with respect to some, but not all, of the goods/services.

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502 Establishing Ownership of Applications or Registrations

*Extract from 37 C.F.R. §3.73(a). * * * The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.*

Section 1 or §44 Applications. In an application or registration based on §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126, an assignee is not required to record the assignment in order to take an action with respect to an application or registration. 37 C.F.R. §3.73(b); TMEP §502.01. However, the assignee must record the assignment (or other document affecting title) with the Assignment Services Division of the USPTO to obtain a certificate of registration in the name of the assignee. 37 C.F.R. §3.85; TMEP §§502.02(a) and 502.03. Moreover, it is advisable for an applicant or registrant to record the assignment to ensure that it is valid under §10(a)(4) of the Trademark Act against subsequent purchasers for valuable consideration without notice. See TMEP §501.03.

Section 66(a) Applications. In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the assignment with the IB in order to take an action with respect to an application or registration, or to obtain a certificate of registration in the name of a new owner. TMEP §§502.01, 502.02(b) and 502.03. See TMEP §501.07 regarding the assignment of extensions of protection of international registrations, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

502.01 Establishing The Right to Take Action in Application or Registration

Extract from 37 C.F.R. §3.73(b).

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to §3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office

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(e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

Applications and Registrations Based on §§1 and 44 of the Trademark Act

In an application or registration based on §1 or §44 of the Trademark Act, when a party other than the owner of record attempts to take an action with respect to an application or registration (e.g., filing a response to an Office action, allegation of use under 15 U.S.C. §1051(c) or §1051(d), request for an extension of time to file a statement of use under 15 U.S.C. §1051(d)(2), or affidavit of continued use or excusable nonuse under 15 U.S.C. §1058), the party must establish ownership of the application or registration. To establish ownership, the new owner must either: (1) record the assignment (or other document affecting title) with the Assignment Services Division of the USPTO, and notify the Trademark Operation that the document has been recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1). The document(s) must show a clear chain of title from the original owner to the party who is taking the action.

See 37 C.F.R. §3.85 and TMEP §§502.02(a) and 502.03 regarding issuance of a certificate of registration in the name of a new owner. See also TMEP §§504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of a document affecting title.

Section 66(a) Applications and Registered Extensions of Protection

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the assignment with the IB in order to take an action with respect to an application or registration. The IB will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §501.07 for further information about assignment of extensions of protection of international registrations, and TMEP §§1906.01 and 1906.01(a) for

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information about recording changes of ownership of international registrations with the IB. The document(s) must show a clear chain of title from the original owner to the party who is taking the action.

In an application under §66(a) of the Trademark Act or a registered extension of protection, the new owner does not have the option of submitting documentary evidence of ownership, pursuant to 37 C.F.R. §3.73(b). Part 3 of 37 C.F.R. does not apply to §66(a) applications and registered extensions of protection. 37 C.F.R. §7.22.

502.02 Pending Applications - Issuance of Registration Certificate in Name of Assignee or in Applicant's New Name

502.02(a) Applications Under §1 and §44 of the Trademark Act

37 C.F.R. §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.

Document Must Be Recorded With Assignment Services Division. In an application under §1 or §44 of the Trademark Act, an assignee must record the assignment, change of name, or other document affecting title with the Assignment Services Division of the USPTO to obtain a certificate of registration in the name of the assignee. 37 C.F.R. §3.85. However, the registration will not issue in the name of the new owner unless the ownership field in the Trademark Database (*i.e.*, TRAM and TARR) is updated to reflect the recorded assignment prior to approval of the mark for publication (or registration on the Supplemental Register) in an application based on 1(a) or §44, or prior to acceptance of the statement of use in an intent-to-use application based on §1(b).

For some documents recorded on or after November 2, 2003, recording a document with the Assignment Services Division will automatically update ownership in TRAM, even if the new owner does not notify the Trademark Operation that the document has been recorded. See TMEP §§504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of a document affecting title. In all other cases, a written request for issuance in the new name is required.

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Under 37 C.F.R. §3.85, a new owner bears the burden of recording *and* notifying appropriate Office personnel of assignments or changes of name to ensure that the registration issues in the name of the new owner, as necessary. Thus, if the recorded document does not meet the criteria for automatic updating set forth in TMEP §§504 and 504.01, or if there is insufficient time for the Assignment Services Division to process a recently recorded document for automatic updating (see TMEP §504.02), the new owner must file a written request that the certificate issue in the name of the new owner. The new owner can search the Assignment Services Division's database on the USPTO website at <http://assignments.uspto.gov/assignments> to determine whether the assignment has been recorded, and can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated to reflect the change of ownership. The TARR database contains the same information as TRAM.

A request that a registration issue in a new name should be directed to the examining attorney, and should state that the appropriate document has been recorded (or filed for recordation) and that the applicant wants the registration to issue in the name of the assignee or the new name of the applicant. The request should specify the assignee's address, and set forth the assignee's citizenship or state (or country) of incorporation or organization. If the assignee is a partnership or joint venture, the request should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members. See TMEP §502.02(c) regarding an examining attorney's handling of an application in which the mark has been assigned.

If the applicant states that a request to record a change of ownership has been filed with the Assignment Services Division but is not yet recorded, and the application is in condition to be approved for publication or registration on the Supplemental Register, the examining attorney should suspend action pending recordation of the document and entry of the information into the Trademark Database. See TMEP §§716 *et seq.* regarding suspension.

Clear Chain of Title Required. A new owner's request that a registration issue in a new name will not be granted unless documents recorded in the Assignment Services Division show a clear chain of title from the original applicant to the party requesting the change. The examining attorney should check the Assignment Services Division's Database ("Assignment Database") on the USPTO website at <http://assignments.uspto.gov/assignments> to ensure that there is a clear chain of title. If the Assignment Database shows a clear chain of title, the examining attorney should ensure that the TRAM database is updated, if necessary. If the Assignment Database does not show a clear chain of title, the examining attorney should issue an Office action advising applicant that it must record the necessary documents if it wants the

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registration to issue in the name of the new owner. If the applicant does not record the necessary documents, the registration will issue in the name of the party who has a clear chain of title according to the Assignment Database.

Time for Recordation and Filing of Request for Issuance in Name of New Owner. To ensure that the registration issues in the name of the new owner, the new owner should record the assignment before the mark is approved for publication (or registration on the Supplemental Register) in an application based on 15 U.S.C. §1051(a) or §1126, or prior to acceptance of a statement of use in an application based on 15 U.S.C. §1051(b). The USPTO cannot ensure that a request to issue the certificate in a new name filed after the mark has been approved for publication or registration will be processed in time for the registration to issue in the name of the new owner.

If, before a mark is approved for publication or registration, an applicant has filed a proper request that the certificate issue in the name of the new owner, but the registration does not issue in the name of the new owner, the USPTO will issue a certificate of correction. See 15 U.S.C. §1057(g), 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding the procedures for requesting correction of a USPTO error, and TMEP §502.03 regarding issuance of a new certificate of registration to the new owner of a registered mark.

502.02(b) Applications Under §66(a) of the Trademark Act

In an application under §66(a) of the Trademark Act, a new owner must record any assignment, change of name, or other document affecting title with the IB. The document(s) must show a clear chain of title from the original owner to the party who is taking the action. See TMEP §501.07 regarding assignment of §66(a) applications, and TMEP §§1906.01 and 1906.01(a) regarding requests to record changes with the IB. The IB will notify the USPTO when the change of ownership is recorded in the International Register. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register, and will automatically update the ownership field in the Trademark Database. A new owner can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated to reflect a change in ownership that has been recorded with the IB.

If the Trademark Database has not been updated, before the mark is approved for publication the new owner/assignee should file a written request that the registration issue in the name of the new owner/assignee. The request that a registration issue in a new name should be directed to the examining attorney, and should state that the appropriate document has been recorded (or filed for recordation) with the IB, and that the applicant wants the registration to issue in the name of the assignee or the new name of the applicant. The request should specify the assignee's address, and set forth the assignee's citizenship or state (or country) of incorporation or organization. If the

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assignee is a partnership or joint venture, the request should set forth the names, legal entities, and national citizenship (or state or country of organization) of all general partners or active members. See TMEP §502.02(c) regarding an examining attorney's handling of an application after a mark has been assigned.

If the applicant states that a request to record a change of ownership has been filed with the IB but is not yet recorded, and the application is in condition to be approved for publication, the examining attorney should suspend action pending recordation of the document and entry of the information into the Trademark Database. See TMEP §§716 *et seq.* regarding suspension.

If, before a mark is approved for publication, an applicant has filed a proper request that the certificate issue in the name of the new owner, but the registration does not issue in the name of the new owner, the USPTO will issue a certificate of correction. See 15 U.S.C. §1057(g), 37 C.F.R. §2.174, and TMEP §1609.10(a) regarding the procedures for requesting correction of a USPTO error.

502.02(c) Examining Attorney's Action Regarding Assignment

If, prior to approval for publication for opposition or registration on the Supplemental Register, or prior to acceptance of a statement of use in an application under 15 U.S.C. §1051(b), the applicant advises the examining attorney or the examining attorney learns through some other source that an assignment has been recorded, the examining attorney should check the Assignment Database at <http://assignments.uspto.gov/assignments> to ensure that there is a clear chain of title, and should ensure that the TRAM database is updated before approving the mark for publication or registration.

In general, the examining attorney should only issue an Office action questioning whether an assignment has occurred if an entity attempts to take action with respect to the application, and Office records show ownership in another party. In this situation, the assignee must establish entitlement to take the action, either by recordation of an assignment, or submission of proof of the assignment. 37 C.F.R. §3.73(b); TMEP §502.01.

During initial examination, the examining attorney should not suspend action or delay issuance of a final action to await recordation of a document. However, if the applicant submits a request indicating that the relevant document *has been submitted for recordation* and the application is in condition to be approved for publication for opposition or registration on the Supplemental Register, the examining attorney should withhold approval for publication or registration until the document has been recorded and the information regarding the assignment or the change of name has been entered

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into TRAM. Likewise, during examination of the statement of use in an application under 15 U.S.C. §1051(b), the examining attorney should withhold final approval for registration until the relevant document has been recorded and the information regarding the assignment or the applicant's new name has been entered in TRAM. If the application is in condition to be approved for publication or registration, the examining attorney should suspend action pending the recordation of the document and the entry of the information into the application record and in TRAM. See TMEP §§716 *et seq.* regarding suspension.

502.03 Issuance of New Certificate to Assignee of Registrant

Registrations Under §1 and §44 of the Trademark Act

In registrations that issued based on applications under §1 or §44 of the Trademark Act, the USPTO will issue a new certificate of registration of the mark for the unexpired part of the registration period in the name of the new owner, if the new owner: (1) records the appropriate document (*e.g.*, assignment document, change of name certificate) in the Assignment Services Division; (2) files a written request that a certificate of registration be issued in the new owner's name; *and* (3) pays the required fee (37 C.F.R. §§2.6(a)(8) and 3.41). The new owner must sign the request for a new certificate. 15 U.S.C. §1057(d); 37 C.F.R. §§2.171(a) and 3.85. The recorded document(s) must show a clear chain of title from the original registrant to the party requesting issuance of a new certificate.

Upon request and payment of the appropriate fee (see TMEP §111), the Certification Division of the USPTO will provide a certified copy of the registration that reflects ownership according to the records shown in the Assignment Database. The certified copy will not show any transfer of ownership that has not been recorded in the Assignment Services Division.

See TMEP §1604.07(c) regarding the issuance of a notification of acceptance of an affidavit or declaration under 15 U.S.C. §1058 in the name of the new owner of a registration.

Registered Extensions of Protection of International Registration to the United States

In a registered extension of protection of an international registration to the United States, the new owner must record the assignment, change of name, or other document affecting title with the IB. See TMEP §501.07 regarding assignment of registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) regarding requests to record changes in the International Register. The IB will notify the USPTO when the change of ownership is recorded in the International Register, and the USPTO will record the change in the Assignment Database and update the ownership field in

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TRAM. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. The recorded document(s) must show a clear chain of title from the original owner to the party requesting issuance of a new certificate.

The USPTO will issue a new certificate of registration of the mark for the unexpired part of the registration period in the name of the new owner, if the new owner: (1) records the appropriate document (e.g., assignment document, change of name certificate) with the IB; (2) files a written request that a certificate of registration be issued in the new owner's name; and (3) pays the required fee (37 C.F.R. §2.6(a)(8)). The new owner must sign the request for a new certificate. 15 U.S.C. §1057(d); 37 C.F.R. §2.171(a).

Upon request and payment of the appropriate fee (see TMEP §111), the Certification Division of the USPTO will provide a certified copy of the registration that reflects ownership according to the records shown in the Assignment Database. The certified copy will not show any transfer of ownership that has not been recorded with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

503 Recording in Assignment Services Division

503.01 Effect of Recording a Document

37 C.F.R. §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.

Recording a document with the Assignment Services Division does not necessarily change the ownership of record shown in TRAM. See TMEP §504 and 504.01 regarding the circumstances in which the Trademark Database will be updated automatically upon recordation of an assignment, change of name, or other document transferring title. In all other cases, the new owner must notify the Trademark Operation of the recordation of a document, and request that the Trademark Database be updated manually. See TMEP §§502.02 *et seq.* and 502.03 regarding issuance of a certificate of registration in the name of a new owner.

The Assignment Services Division does not examine the substance of documents submitted for recording. The act of recording a document is a ministerial act, and not a determination of the document's validity or of its effect on title to an application or

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registration. The USPTO will determine the effect of a document only when an assignee attempts to take an action in connection with an application or registration (e.g., when an assignee files a statement of use under 15 U.S.C. §1051(d)(1) or an affidavit or declaration of use under 15 U.S.C. §1058). 37 C.F.R. §3.54.

Recording a document with the Assignment Services Division does *not* constitute a response to an Office action.

If an assignment is conditional on a given act or event at the time of its execution, the USPTO will view the submission of the assignment for recordation as an indication that the act or event has occurred. See 37 C.F.R. §3.56.

503.02 Documents That the Office Will Record

37 C.F.R. §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 Director.

(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 Director 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.

The USPTO records assignments of trademark applications and registrations, accompanied by completed cover sheets. The USPTO also records documents that affect title to a trademark application or registration, such as certificates issued by appropriate authorities showing a change of name of a business, or a merger of businesses. Although a mere change of name does not constitute a change of legal entity, it is a proper link in the chain of title. Documents of merger are also proper links in the chain of title.

Some instruments that relate to registered marks or to marks in pending applications may be recorded, even though they do not constitute a transfer or change of title to the mark or do not convey the entire title or interest in the business in which the mark is used. Typically, these instruments are license agreements, security agreements, and agreements between parties limiting future extension of use of a mark with regard to the

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goods or services or other circumstances of use. These instruments are recorded to give third parties notification of equitable interests or other matters relevant to the ownership of a mark.

The USPTO may also record a partial assignment of an interest in a mark. See TMEP §501.06.

In an application under §66 of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record any change of ownership with the IB, who will record the change in the International Register and notify the USPTO accordingly. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB. Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of §66(a) applications and registered extensions of protection. 37 C.F.R. §7.22. See TMEP §501.07.

503.03 Requirements for Recording

503.03(a) Formal Requirements for Documents

Applications and Registrations Based on §§1 and 44 of the Trademark Act

All documents submitted for recording must be accompanied by a cover sheet that meets the requirements of 37 C.F.R. §3.31. See TMEP §503.03(e).

To expedite recordation, new owners are encouraged to file requests for recordation electronically through the Electronic Trademark Assignment System (“ETAS”) on the USPTO website at <http://etas.uspto.gov>. Documents filed electronically are recorded much faster than paper documents. Using ETAS, a party can create and submit a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as an image in tagged image file format (“TIFF”) for submission via the Internet.

See TMEP §§503.03(b) *et seq.* regarding the requirements for recordation.

Section 66(a) Applications and Registered Extensions of Protection

In an application under §66 of the Trademark Act or a registered extension of protection of an international registration to the United States, the new owner must record the change of ownership with the IB, who will record the change in the International Register and notify the USPTO accordingly. See TMEP §501.07. The IB does not

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require supporting documents. See TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

503.03(b) Supporting Documents

To record a document affecting title to a trademark application or registration with the Assignment Services Division, a legible cover sheet and one of the following must be submitted:

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

37 C.F.R. §3.25(a).

To record a name change, only a legible cover sheet is required. 37 C.F.R. §3.25(b).

Documents filed through ETAS must be in TIFF format. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm (one-inch) margin must be present on all sides. 37 C.F.R. §3.25(c)(1).

All paper documents submitted for recordation must be submitted on white and non-shiny paper that is either 8½ by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) with a one-inch (2.5 cm) margin on all sides in either case. Only one side of each page may be used. Original documents should not be submitted, because the Office does not return recorded documents. 37 C.F.R. §3.25(c)(2).

Documents that do not meet these requirements will not be recorded. 37 C.F.R. §3.51. See TMEP §503.05.

503.03(c) English Language Requirement

The USPTO will not record a document that is not in the English language unless it is accompanied by an English translation that is signed by the translator. 37 C.F.R. §3.26.

503.03(d) Fee for Recording

All requests to record documents in the Assignment Services Division must be accompanied by the appropriate fee. A fee is required for *each* application and registration against which a document is recorded, as identified in the cover sheet. 37 C.F.R. §§2.6 and 3.41. The fee does not depend on the length of the document.

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If the Assignment Services Division determines that materials submitted for recording do not meet the recording requirements, the fee is not refunded.

503.03(e) Cover Sheet

Each document submitted for recording in the Assignment Services Division must be accompanied by a cover sheet that meets the requirements of 37 C.F.R. §3.31. Only one set of documents and cover sheets to be recorded should be filed. 37 C.F.R. §3.28.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>. Documents filed electronically are recorded much faster than paper documents. Using ETAS, a new owner can create a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as a TIFF image for submission via the Internet.

If the new owner decides to file the assignment or name change on paper, the cover sheet must be legible. 37 C.F.R. §3.25(a). The USPTO has a trademark cover sheet form that can be downloaded from the USPTO website at <http://www.uspto.gov/web/forms/pto1594.pdf>. Questions regarding cover sheets should be directed to the Assignment and Certification Services Division. Contact information is provided on the USPTO website at <http://etas.uspto.gov/>. See notice at 1140 TMOG 65, 69 (July 28, 1992). Use of the USPTO's form is preferred, but not mandatory.

Under 37 C.F.R. §3.31, a trademark cover sheet must contain the following:

- The name of the party conveying the interest;
- The name and address of the party receiving the interest;
- A description of the interest conveyed or transaction to be recorded (*e.g.*, assignment, license, change of name, merger, security agreement);
- Each application serial number or registration number against which the document is to be recorded, if known. If the application serial number is not known, the party seeking to record the document must submit a copy of the application and/or a reproduction of the mark and an estimate of the date that the USPTO received the application;
- The name and address of the party to whom correspondence concerning the request to record the document should be sent;

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- The date the document was executed; and
- The signature of the party submitting the document. For a document filed electronically, the person who signs the cover sheet must either: (1) place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.* “/Thomas O’Malley/”) in the signature block on the electronic submission; or (2) sign the cover sheet using some other form of electronic signature specified by the Director.

The cover sheet should also include:

- The entity of the conveying party, and the relevant entity information for the receiving party (*e.g.*, the citizenship of an individual, state or country of incorporation or organization of a corporation, or names and citizenship of the general partners of a partnership);
- The number of applications and/or registrations identified in the cover sheet;
- The total fee; and
- An identification or description of the mark.

In addition, if the receiving party has designated a domestic representative (see TMEP §§501.04 and 604), the cover sheet should include an indication to this effect.

Documents that are not accompanied by a completed cover sheet will not be recorded. 37 C.F.R. §3.51.

Separate patent and trademark cover sheets should be submitted for documents that include interests in, or transactions involving, both patents and trademarks. If a cover sheet contains both patent and trademark information, any information contained therein about pending patent applications will become public record upon recordation. 37 C.F.R. §§3.28 and 3.31(b).

503.04 Address for Submitting Documents for Recording

To expedite recordation, new owners are encouraged to file requests to record documents in the Assignment Services Division through the USPTO website, at <http://etas.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Services Division should be sent to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria VA 22313-1450. 37 C.F.R. §§2.190(c) and 3.27.

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503.05 Recording Procedure and Recordation Date

Applications and Registrations Under §1 and §44 of the Trademark Act

The recording of documents in the Assignment Services Division of the Office is governed by 37 C.F.R. Part 3.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>. Using ETAS, a new owner can create and submit a Trademark Assignment Recordation Coversheet by completing an online form, and attach the supporting legal documentation as a TIFF image for submission via the Internet. Documents filed electronically are recorded much faster than paper documents.

The date of recordation is the date that the USPTO receives a cover sheet that meets the requirements of 37 C.F.R. §3.31 and a document affecting title that meets the requirements of 37 C.F.R. §3.25. 37 C.F.R. §3.51.

The party recording the assignment (or other document affecting title) should carefully review the assignment or other document and cover sheet for accuracy and completeness. The Assignment Services Division does not examine the substance of documents submitted for recording or compare the cover sheet with the supporting documents. Rather, the USPTO merely examines the materials submitted for form, to determine whether the requirements for recording (*see* TMEP §§503.03 *et seq.*) have been met.

If the materials submitted meet the requirements for recordation, the Assignment Services Division will record the document and cover sheet. Only the data specified on the cover sheet will be entered in the Assignment Database. After recording the document and cover sheet, the USPTO will issue a notice of recordation that reflects the data as recorded in the Assignment Database. The party recording the document should carefully review the notice of recordation. *See* TMEP §§503.06 *et seq.* regarding correction of errors in a cover sheet or recorded document.

Under 37 C.F.R. §3.51, the USPTO will return papers that do not meet the requirements for recording (*e.g.*, documents submitted without a completed cover sheet, the appropriate fee, or an English translation, where applicable) to the sender for correction. The returned papers, stamped with the original date of receipt in the USPTO, will be accompanied by a letter indicating that, if the returned papers are corrected and resubmitted to the USPTO within a specified period of time, the USPTO will consider the original filing date of the papers as the recordation date of the document. The USPTO will not extend the time period specified in the letter. If the returned papers are corrected and resubmitted *after* the time specified in the letter, the recordation date is

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the date the USPTO receives corrected papers that meet the requirements for recording. The certificate of mailing procedure of 37 C.F.R. §2.197 and the “Express Mail” procedure of 37 C.F.R. §2.198 may be used for resubmitting the returned papers, to avoid lateness due to mail delay.

If papers submitted for recording are returned unrecorded by the Assignment Services Division, and the submitter believes that the papers were returned in error, he or she may file a petition under 37 C.F.R. §2.146. See TMEP §§1702 through 1708 regarding petitions.

Applicants and registrants can search the Assignment Services Division’s database on the USPTO website at <http://assignments.uspto.gov/assignments/> to determine whether an assignment has been recorded.

Section 66(a) Applications and Registered Extensions of Protection

In an application under §66(a) of the Trademark Act or a registered extension of protection, the IB will notify the USPTO of any changes in ownership recorded in the International Register, and of the date of recordation. The USPTO will record only those assignments (or other documents affecting title) that have been recorded in the International Register. See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

503.06 Correction of Errors in Cover Sheet or Recorded Document

37 C.F.R. §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 a copy of the document originally submitted for recording and by the recording fee as set forth in §3.41.

Once a document is recorded with the Assignment Services Division, the Assignment Services Division will not remove the papers from the record relating to that application or registration. See TMEP §503.06(e).

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During the recording process, the Assignment Services Division will check to see that a trademark cover sheet is complete and record the data exactly as it appears on the cover sheet. The Assignment Services Division does not compare the cover sheet with the assignment document (or other document affecting title). Once the document is recorded, the USPTO will issue a notice of recordation.

The party recording the document should carefully review the notice of recordation.

Typographical errors made by the USPTO will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other error, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error, using the procedures set forth in TMEP §§503.06(a) through 503.06(d).

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, any request to correct an error in a document recorded with the IB must be corrected at the IB. Such a request cannot be sent to the IB through the USPTO. See TMEP §§1906.01 *et seq.* for information about requests to record changes in the International Register.

503.06(a) Typographical Errors in Cover Sheet

A party who wishes to correct a typographical error on a recorded cover sheet must submit the following to the Assignment Services Division: (1) a copy of the originally recorded assignment document (or other document affecting title); (2) a corrected cover sheet; and (3) the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). 37 C.F.R. §3.34. The party requesting correction should also submit a copy of the original cover sheet, to facilitate comparison of this cover sheet with the originally recorded document.

The party filing the corrected cover sheet should check the box titled “Other” in the area of the sheet requesting “Nature of Conveyance,” and indicate that the submission is to correct an error in a cover sheet previously recorded. The party should also identify the reel and frame numbers (if known), and the nature of the correction (*e.g.*, “correction to the spelling of assignor’s name” or “correction of a serial number or registration number”).

The USPTO will then compare the corrected cover sheet with the original cover sheet and the originally recorded assignment document (or other document affecting title) to determine whether the correction is typographical in nature. If the error is typographical in nature, the Assignment Services Division will record the corrected cover sheet and correct the Assignment Database.

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503.06(a)(i) Typographical Errors in Cover Sheet That Do Not Affect Title to Application or Registration

If the original cover sheet contains a typographical error that does not affect title to the application or registration against which the original assignment or name change is recorded, the Assignment Services Division will correct the Assignment Database and permit the recording party to keep the original date of recordation.

503.06(a)(ii) Typographical Errors in Cover Sheet That Do Affect Title to Application or Registration

If the original cover sheet contains a typographical error that affects title to the application or registration against which the assignment or name change is recorded, the recording party will not be entitled to keep the original date of recordation. See TMEP §503.05. Rather, the Assignment Services Division will correct its automated records and change the date of recordation to the date on which the corrected cover sheet was received in the USPTO.

503.06(b) Typographical Errors in Recorded Assignment Document

If there is an error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for an erroneous document (e.g., the assignor) must either draft and record a new document or make corrections to the original document and re-record it. If an assignor is not available to correct an original document or execute a new one, the assignee may submit an affidavit in which the assignee identifies the error and requests correction. The affidavit must be accompanied by a copy of the originally recorded papers, a cover sheet (see TMEP §503.03(e)) and the required fee for each application or registration to be corrected (37 C.F.R. §§2.6 and 3.41). See *In re Abacab International Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pats. 1987).

In an application under §66(a) of the Trademark Act or a registered extension of protection of an international registration to the United States, any request to correct an error in a document recorded with the IB must be corrected at the IB. Such a request cannot be sent to the IB through the USPTO.

503.06(c) Assignment or Change of Name Improperly Filed and Recorded By Another Person Against Owner's Application or Registration

When the owner of an application or registration discovers that another party has improperly recorded an assignment or name change against the owner's application or

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registration, the owner must correct the error by having a corrected cover sheet filed with the Assignment Services Division.

The owner should contact the party who recorded the papers with the erroneous information and have that party record corrective papers. However, if the party cannot be located or is unwilling to file corrective papers, then the true owner must record the necessary papers with the Assignment Services Division to correct the error.

Specifically, the owner should submit the following to the Assignment Services Division: (1) a completed cover sheet identifying the application or registration against which the assignment or change of name was improperly recorded; (2) an affidavit or declaration identifying itself as the correct owner, stating that the previously recorded document was submitted with erroneous information, and providing the reel and frame number of the previously recorded document; and (3) the recording fee (37 C.F.R. §§2.6 and 3.41) for each application or registration to be corrected.

The affidavit or declaration should include a summary of the true chain of title to make it clear that the chain of title for the registration or application identified should not be considered altered by the incorrect assignment or name change, and a statement that the original registrant or last correct assignee has been and continues to be the owner of the application or registration at issue.

On the corrected cover sheet, the owner should check the box titled "Other" in the area of the cover sheet requesting the "Nature of Conveyance," and indicate that the submission is to correct an error made in a previously recorded document that erroneously affects the identified application(s) or registration(s). The party should also write the name of the correct owner in *both* the box requesting the name of the conveying party *and* the box requesting the name and address of the receiving party, to make it clear that ownership of the mark never changed and that any assignment or name change recorded against the application(s) or registration(s) was erroneous.

503.06(d) Owner Must Notify Trademark Operation of Correction

Recording a corrective document with the Assignment Services Division does not change the owner of record in the TRAM database maintained by the Trademark Operation. The owner must notify the Trademark Operation that the corrective document has been recorded.

See TMEP §504.03 regarding correction of the Trademark Database where it has been automatically updated to show ownership of an application or registration in a party who does not have a clear chain of title as evidenced by the Assignment Database.

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503.06(e) Recorded Documents Not Removed From Assignment Records

Once an assignment or other document is recorded against an application or registration, the Assignment Services Division will not remove the document from the records relating to that application or registration in the Assignment Database, even if the assignment or other document is subsequently found to be invalid.

The goal of the USPTO is to maintain a complete history of claimed interests in a mark. Since the act of recording a document is not a determination of the document's validity, maintaining a complete record of claimed interests does not preclude an owner from using a mark, or from establishing its ownership of the mark in a proper forum, such as a federal court. *In re Ratny*, 24 USPQ2d 1713 (Comm'r Pats. 1992).

503.06(f) Petitions to Correct or “Expunge” Assignment Records

To correct an error in a recorded document, the owner of an application or registration should record corrective papers with the Assignment Services Division, in accordance with the procedures outlined in TMEP §§503.06 through 503.06(d).

If the Assignment Services Division denies the request to correct the error, the owner may file a petition under 37 C.F.R. §2.146. See TMEP Chapter 1700 regarding petitions.

However, petitions to correct, modify or “expunge” assignment records are rarely granted. Such petitions are granted only if the petitioner can prove that: (1) the normal corrective procedures outlined in TMEP §§503.06 through 503.06(d) will not provide the petitioner with adequate relief, and (2) the integrity of the assignment records will not be affected by granting the petition.

Even if a petition to “expunge” a document is granted with respect to a particular application or registration, the images of the recorded document remain in the records of the Assignment Services Division. The USPTO will delete the links to the application or registration that was the subject of the petition, so that no information about the recorded document will appear when someone searches for that application or registration number in the Assignment Database. However, the image of the document remains at the same reel and frame number, and it still will appear when someone views that reel and frame number.

503.07 “Indexing” Against Recorded Document Not Permitted

The USPTO does not process requests for “indexing” or “cross-referencing” additional trademark registration numbers or application serial numbers against a document previously recorded in the Assignment Services Division.

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Therefore, even when an assignment document (or other document affecting title) has already been recorded in the Assignment Services Division in connection with a trademark registration or application, a party who wants to record that document against additional applications or registrations must submit the following:

- (1) A copy of the originally recorded assignment document (or other document affecting title), a copy of an extract from the recorded document evidencing the effect on title, or a statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title (this may comprise a copy of the previously recorded papers on which the Assignment Services Division has stamped the reel and frame numbers at which they are recorded, or a copy of these papers);
- (2) A completed cover sheet (see TMEP §503.03(e)) that includes the number of each additional registration and/or application against which recordation of the assignment document (or other document affecting title) is requested; and
- (3) The appropriate recording fee (37 C.F.R. §§2.6 and 3.41).

The USPTO will assign a new date of recordation for the additional applications or registrations, update the Assignment Database, and create an electronic record of the cover sheet and assignment document (or other document affecting title), which will become part of the official record. See notice at 1157 TMOG 12 (Dec. 7, 1993).

503.08 Accessibility of Assignment Records

The public can search the trademark assignment records of the Assignment Services Division on the USPTO website at <http://assignments.uspto.gov/assignments>.

The Assignment Services Division of the USPTO maintains separate records for patents and trademarks. 15 U.S.C. §1060; 37 C.F.R. §2.200(a)(1).

Assignments of trademark applications and registrations are open to public inspection upon recordation in the Assignment Services Division. See 37 C.F.R. §3.31(b) and TMEP §503.03(e) regarding the submission of separate cover sheets for documents that include interests in, or transactions involving, both patents and trademarks.

Before 1955, documents were recorded in bound volumes. The location of documents in these volumes is designated by “liber and page,” that is, by the number of the book (liber) and the number of the page in the book. Since 1955, documents have been recorded on microfilm, and are available for immediate inspection in the Trademark Assignment Search Room. The location of these documents is designated by “reel and

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frame," that is, by the number of the reel on which they are microfilmed and the number of the frame on the reel.

All assignment records related to pre-1955 trademark records were transferred to the National Archives and Records Administration ("NARA") in 1990. The USPTO still maintains records of all trademark assignments recorded on or after January 1, 1955.

All trademark assignment records from 1837 to December 31, 1954 are maintained and available for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746. Assignments recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

Copies of assignment records recorded on or after January 1, 1955, may be ordered from the USPTO upon payment of the fee required by 37 C.F.R. §2.6. An order for a copy of an assignment record should identify the reel and frame at which it is recorded in the Assignment Services Division. If the correct reel and frame numbers are not identified (*e.g.*, the order identifies the document only by the name of the registrant and the number of the registration, or by the name of the applicant and the serial number of the application), the USPTO will charge an additional fee for the time spent searching for the document.

Requests for copies of pre-1955 trademark assignment records should be directed to NARA. Payment of the fees required by NARA should accompany all requests for copies. 37 C.F.R. §2.200(a)(2).

503.08(a) Abstracts of Title

Members of the public may obtain abstracts of title to particular registrations or applications from the Certification Division, Office of Public Records, upon payment of the fee required by 37 C.F.R. §2.6. See notices at 1140 TMOG 65, 66 (July 28, 1992) and 1165 TMOG 13 (Aug. 2, 1994).

504 Automatic Updating Ownership of Trademark Applications and Registrations in Trademark Databases

Prior to November 2, 2003, recording a document with the Assignment Services Division of the USPTO did not automatically change the ownership record in the Trademark Database. To change the ownership record in the Trademark Database, a new owner had to notify the Trademark Operation that ownership had changed. 37 C.F.R. §3.85. The Trademark Database includes the TRAM System and the TARR database.

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Effective November 2, 2003, except in the limited circumstances set forth in TMEP §504.01, the USPTO will automatically update the ownership information in the Trademark Database of registrations and pending applications when one of the following documents is recorded with the Assignment Services Division:

- Assignment of entire interest and goodwill
- Nunc Pro Tunc Assignment of entire interest and goodwill
- Merger
- Name Change

In these situations, it is unnecessary for the new owner to notify the Trademark Operation of the change of ownership, or to file a request in a pending application that the certificate of registration issue in the name of the new owner. In all other situations, the new owner must notify the Trademark Operation that ownership has changed in order to update the ownership information in TRAM and TARR.

To ensure that the Trademark Database is automatically updated, the party filing the assignment, merger or name change should identify the “Nature of the Conveyance” by checking the “Assignment,” “Merger” or “Name Change” box in the “Nature of Conveyance” field and should not check the “Other” box.

The Trademark Database will show only the last recorded owner, not the complete chain of title. The complete chain of title can be obtained from the Assignment Services Division’s database on the USPTO website at <http://assignments.uspto.gov/assignments>. The ownership field in the Trademark Database will be automatically updated regardless of whether the records of the Assignment Services Division show a clear chain of title transferring ownership to the last recorded owner. The Trademark Database will include the reel and frame number and execution date of the recorded document, as well as a notation to “Check Assignments.” Both examining attorneys and trademark owners should check assignment records to ensure that the owner of record in the Trademark Database has a clear chain of title.

Trademark owners can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated.

504.01 Circumstances in Which Trademark Database Will Not be Automatically Updated

In the circumstances discussed below, the USPTO will not automatically update the Trademark Database to show the change in ownership, even if the appropriate

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document is recorded in the Assignment Services Division on or after November 2, 2003. In these situations, the applicant must notify the Trademark Operation that the assignment or other title document has been recorded and request that the Trademark Database be updated to show title in the new owner. 37 C.F.R. §3.85; TMEP §§502.02 *et seq.* and 502.03.

- (1) *Execution Date Conflicts With Previously Recorded Document.* If a previously recorded assignment, merger or change of name document for the same application or registration has an execution date that is the same as or later than the execution date of the subsequently recorded document, the Trademark Database will not be automatically updated. Office personnel will have to review the assignment records and update the database manually.
- (2) *Blackout Period: Ownership of Pending Applications Cannot be Updated During Certain Time Periods.* The Trademark Database will not be automatically updated to show a change of ownership during the following stages of the registration process:
 - (a) For §1(a) and §44 applications:
 - Between approval for publication and issuance of registration
 - (b) For §1(b) applications:
 - Between approval for publication and issuance of notice of allowance;
and
 - Between approval for registration and issuance of registration
- (3) *Maximum Number of Ownership Changes.* The Trademark Database will not be automatically updated if the maximum number of ownership changes permitted for the following time periods has been reached:
 - *Prior to publication* - up to nine changes of ownership
 - *Between publication and registration* - up to nine additional changes of ownership

504.02 Processing Time for Automatic Updating

The process for automatically updating the Trademark Database requires that the Assignment Services Division: (1) record the document transferring title in the Assignment Database; and (2) extract the trademark assignment information from the Assignment Database and send it electronically to the Trademark Operation for

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automatic updating. The Assignment Services Division will extract trademark assignment information from the Assignment Database and transmit it to the Trademark Operation once a week.

To expedite recordation, new owners are encouraged to file requests for recordation through the USPTO website, at <http://etas.uspto.gov>.

If a trademark owner wants the Trademark Database updated within a certain timeframe, and there is insufficient time for the Assignment Services Division to process a recently recorded title document for automatic updating, the owner should notify the Trademark Operation of the change of ownership. 37 C.F.R. §3.85; TMEP §§502.02 *et seq.* and 502.03. Trademark owners can search the Assignment Services Division's database on the USPTO website at <http://assignments.uspto.gov/assignments> to determine whether an assignment has been recorded, and can check the TARR database at <http://tarr.uspto.gov> to determine whether the Trademark Database has been updated.

504.03 Correction to Automatic Update - Last Recorded Owner Does Not Have Clear Chain of Title

In the situations set forth in TMEP §504, the Trademark Database will be automatically updated to show the last recorded owner regardless of whether the Assignment Database shows that the last recorded owner has a clear chain of title. If the Trademark Database is automatically updated to show ownership of an application or registration in a party who does not have a clear chain of title as evidenced by the Assignment Database, the true owner of the application or registration may file a written request to have the ownership field in the Trademark Database corrected. The USPTO will grant a request for correction of the ownership field if:

- (1) The Trademark Database was automatically updated to show ownership in a party who does not have a clear chain of title according to the Assignment Database; *and*
- (2) The Assignment Database shows a clear chain of title in the party requesting correction of the ownership field in the Trademark Database.

The correction of the Trademark Database will not be automatically reflected in the Assignment Database. To correct the assignment records, a party must follow the procedures set forth in TMEP §§503.06 *et seq.* for correcting errors in the Assignment Database.

Example: ABC Corporation owns Application No. 1. An assignment of the entire interest and goodwill is filed transferring ownership of Application 1 from ZED Corporation to XYZ Corporation. The

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Assignment Services Division records the assignment and transmits the trademark assignment information to the Trademark Operation. The Trademark Database is automatically updated to show XYZ Corporation as the new owner of Application 1. The Trademark Operation will correct its database, upon ABC Corporation's request, because the Assignment Database does not show a clear chain of title from ABC Corporation to XYZ Corporation, and the Assignment Database shows a clear chain of title in ABC Corporation.

In all other situations, a party requesting correction of the ownership records of the Trademark Operation must follow the procedures for correcting errors in recorded documents or cover sheets, as set forth in TMEP §§503.06 *et seq.* That is, the party must file corrective documents with the Assignment Services Division and pay the recordal fees necessary to correct the error, then notify the Trademark Operation that the corrective documents have been recorded.

Prior to registration, a request for correction of the ownership field in the Trademark Database should be made in an amendment directed to the examining attorney. If such a request is filed after publication, it will be handled in accordance with standard procedures for processing amendments after publication, as set forth in TMEP §§1505.02 *et seq.* In a §1(b) application, if a request for correction of the ownership field is filed between the issuance of the notice of allowance and the submission of a statement of use, the USPTO will place the request in the file for consideration at the time of examination of the statement of use. 37 C.F.R. §2.77; TMEP §1107.

After registration, a request for correction of the ownership field should be made in the form of a request for correction under §7(g) of the Trademark Act and 37 C.F.R. §2.174.

504.04 Automatic Updating Does Not Apply to Requests for Recordation Filed Before November 2, 2003

The automatic updating procedures discussed in §§504.01 through 504.03 apply to all assignments, mergers, and name changes recorded in the Assignment Services Division on or after November 2, 2003, even if the request for recordation was filed before November 2, 2003.

These procedures do not apply to assignments, mergers, or name changes that were recorded in the Assignment Services Division prior to November 2, 2003. For documents recorded prior to November 2, 2003, the new owner must notify the Trademark Operation of the change of ownership, and request that the Trademark Database be updated. 37 C.F.R. §3.85.

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504.05 Automatic Updating Does Not Apply to International Applications and Registrations Under the Madrid Protocol

The procedures discussed in §§504.01 *et seq.* do not apply to §66(a) applications and registered extensions of protection of international registrations to the United States. Changes of ownership of international registrations and requests for extensions of protection of international registrations to the United States must be recorded with the IB. The USPTO will record only those assignments (or other documents of title) that have been recorded in the International Register. The Trademark Databases will be automatically updated to reflect any change of ownership that is recorded in the International Register. See TMEP §501.07 for further information about assignment of §66(a) applications and registered extensions of protection, and TMEP §§1906.01 and 1906.01(a) for information about recording changes of ownership of international registrations with the IB.