

SAMPLE AGREEMENT ANNOTATIONS

PATENT ASSIGNMENT

Assignment Provisions	Remarks
<p>Docket No.: _____</p> <p>Application No.: _____</p> <p>Filed Date: _____ [1]</p> <p style="text-align: center;">ASSIGNMENT [2]</p> <p>WHEREAS, I, _____ of _____ [3], have invented certain improvements in _____ [4] and described in a patent application filed on _____ [5], in The United States of America, being owner of and having the right to convey all rights, title, and interests in and to said application and in and to each invention described therein [6]; and</p> <p>WHEREAS, _____ of _____, [7] a _____ organized under the laws of the state of _____ [8] and having a mailing address of _____ (assignee) desires to acquire the entire right, title, and interest in and to said application [9] and said invention described therein and any and all patents to be obtained therefore, all as hereinafter set forth:</p> <p>NOW, THEREFORE, for good and valuable consideration received by the undersigned [10], the undersigned <u>hereby</u></p>	<p>[1] Include this information in the header: attorney docket number; application or patent number(s); filing date(s)</p> <p>[2] Could also say "Patent Assignment, "Provisional Patent Application Assignment," or "Non-Provisional Patent Application Assignment."</p> <p>[3] Name of inventor and home address, with country.</p> <p>[4] Typically use the title of the patent or application.</p> <p>[5] Filing date of application, whether provisional or non-provisional.</p> <p>[6] If multiple inventors, separate assignments will need to be prepared and executed. Note, it is important to determine inventorship prior to filing if possible. This can become an issue when filing a provisional, as inventorship is typically determined by claim contribution, and provisionals may not always include claims. It is better to clear inventorship at the beginning than attempt to clean it up later.</p> <p>[7] Name and place of business (or personal address if individual) of assignee.</p> <p>[8] Type of business (e.g., corporation, LLC, etc.) and state of organization.</p> <p>[9] Could also be patent. Also, can be restricted to a single application or patent or can be multiple enumerated documents. Consider if rights to "improvements" are to be conveyed as well. Bottom line is to be careful to define well what is the scope of "the invention" that is conveyed.</p> <p>[10] Some like to include value of consideration if purchased from assignor; however, becomes murky when employee has obligation to assign.</p>

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<p>[11] sells, assigns, transfers and sets over unto said assignee, its successors and assigns, the entire right, title and interest [12] in and to said invention or inventions, as described in said application, in all forms and embodiments thereof, and in and to the aforesaid application; and in and to any application filed in any foreign country based thereon, including the right to file said foreign applications under the International Convention [13]; also the entire right, title and interest in and to any and all patents or reissues or extensions thereof to be obtained in this or any foreign country upon said invention or inventions and any non-provisional, utility, design, divisional, continuation, continuation-in-part or substitute applications which may be filed upon said invention or inventions in this or any foreign country [14]; and the undersigned hereby authorizes and requests the issuing authority to issue any and all patents on said application or applications to said assignee or its successors and assigns.</p> <p>[15]</p> <p>The undersigned further agrees to execute and deliver all non-provisional, utility, design, divisional, continuing, substitute, improvement, extension, reissue and other patent applications in this or any foreign country relating to said application or invention and to sign all other lawful papers and to perform all other lawful acts without further consideration, subject to reimbursement of out-of-pocket expenses approved by assignee in advance in writing, which the assignee may deem necessary or desirable to make this Assignment fully effective, including by way of example, but not of limitation, the following acts: [16]</p>	<p>[11] Be sure the interest of the inventor is <u>presently</u> conveyed. "Agrees to assign..." or other language implying Assignment will occur in the future might require further action (e.g. completion of conception or any other condition set forth in the document) to complete the conveyance and so might not be effective. Also, if Assignment relates to an invention by a U.S. government contractor, keep Bayh-Dole statute (35 USC 202 et seq. - relating to default ownership by the U.S. government if the contractor declines to commercialize the invention) provisions in mind and take steps to get clear title (e.g. clear statement of waiver of rights by the government contractor and registration of ownership at the Edison clearinghouse to establish that U.S. government has also waived its rights). State contract law and "shop rights" might also be implicated by circumstances of making the invention. Also <u>remember to record the Assignment</u> to preclude a third party BFP from getting the rights. <i>See, Bd. of Trs. (of Stanford University) v. Roche Molecular Sys.</i>, 2007 U.S. Dist. LEXIS 16246 and appellate decisions for discussion of these issues.</p> <p>[12] ...sell, assign, transfer and set over to assignee, <u>its successors and assigns</u> – important to ensure entire interest is conveyed. Remember that we are assigning all interest the assignor has in the application, which means there may be others with interest, particularly if a security interest is taken.</p> <p>[13] Note that we are taking interest in any embodiment of the invention and other applications that are on this application in foreign countries.</p> <p>[14] Including interest in any future filed applications or other post-grant proceedings in the US and in foreign countries that may be filed using this application or patent as its parent.</p> <p>[15] Allows for assignee to claim ownership at the PTO.</p> <p>[16] Contractually obligates assignor to execute documents in the future that may help to secure rights of Assignee.</p>
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(1) Prompt execution of all lawful oaths, affidavits and/or supplemental oaths required or deemed advisable by the assignee to further the prosecution of any application or applications for letters patent relating to the subject matter of this Assignment **[17]**; and

(2) Cooperation to the best of my ability in the execution of all lawful documents, the production of evidence, and the giving of testimony in interference, opposition, nullification or infringement proceedings involving any of said invention or improvement, applications or patents. **[18]**

IN WITNESS WHEREOF, the undersigned has hereunto set
his/her hand and seal on the date set after his signature.

_____, _____, 2016

<NAME>

Date [19]

State of

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)SS:

County of

)

On this _____ day of _____, 2016, before me personally appeared _____, personally known, and known to me to be the person(s) who signed the foregoing assignment, and acknowledge the signing of same as his free act and deed.

Notary Public (Print Name)

[17] Often needed for continuation type application, disclaimers, other declarations, and other actions.

[18] Contractually obligates the Assignor to participate in proceedings, as needed; typically needed for post grant proceedings, either at the PTO or in other court actions.

[19] Include written name and signature of Assignor, and date of execution.

[20] Good idea to execute in the presence of a Notary Public. Although Notary not required in the U.S., if Assignment of an invention worldwide is contemplated, keep in mind that some countries require notarization or an apostille or the like.

Note: The USPTO provides a sample Patent Assignment agreement: Sample Form (former PTO/SB/41) (05-01) at <http://www.uspto.gov/web/forms/sb0041.pdf>

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<div style="border-bottom: 1px solid black; margin-bottom: 10px; width: 100%;"></div> <div style="display: flex; justify-content: space-between;"><div style="width: 60%;">Signature</div><div style="width: 40%;">Date [20]</div></div>	
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