

Electronically Recording a Patent Assignment in the USPTO

By Rick Neifeld, Neifeld IP Law, PC

I. Introduction

Generally speaking, patent assignments should be recorded in the USPTO's Assignment Recordation Branch (ARB). While no law requires patent assignments to be recorded, failure to record an assignment may have various adverse consequences. These consequences include loss of ownership; loss of entitlement to priority under the Paris convention; and inability to take action in the USPTO.

The Assignment Recordation Branch (ARB) can be contacted via telephone at: 571-272-3350 and responds to email inquiries sent to EPAS@uspto.gov. However, prior to contacting ARB, you should review their FAQs at:

<https://www.uspto.gov/learning-and-resources/transferring-ownership-assignments-faqs>.

Recording an assignment is relatively easy, but it helps to see in advance specifically how to do that. Therefore, this article provides step-by-step description along with a graphical display of the screens provided by the USPTO's assignment recordation request filing system.

II. Filing a Request to Record a Patent Assignment

1. The Electronic Patent Assignment System (EPAS), home page, is at: <https://epas.uspto.gov/>
However, you can skip to the Guidelines page, <https://epas.uspto.gov/epas/guidelines.jsp> to start data entry. Assuming you do not have a stored a EPAS template and that you are submitting only one assignment, click "Start":

Electronic Patent Assignment System
Patent Assignment Recordation Form
Navigation: - Guidelines

EPAS v.1.10
PTO-1595 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

Guidelines

To file electronically, complete the following steps:

- Fill out all required fields for each input screen.
- [Help Instructions](#) are available by clicking on the highlighted term. A new window will open whenever one of these links is clicked.
- When all required forms are completed and the appropriate supporting legal documentation files are attached, a validation screen will appear displaying the information provided. If the information displayed is correct, proceed with the submission. If the information is incorrect, return to the appropriate screen by using the on-screen navigation controls.
- Do not use your browser's 'back' and 'forward' buttons to navigate. Use only the navigation controls on the EPAS screens.
- Legal supporting documentation may now be of either a TIFF or a PDF file. Documents must be black and white. More than one file in more than one format may be attached.
- **Saved Submission**
When all assignment data screens are completed, prior to proceeding with the submission process, the current submission can be temporarily saved to a USPTO server. A URL link will be provided via a display on the screen and by email that identifies the link that permits access to the saved submission. To save a submission use the 'Advanced' button on the Validation screen and choose the 'Save Submission' button on the following screen. The URL link is valid for 4 days.
- **Create Template**
Data from a submission, namely: correspondence information, conveying party(s), receiving party(s) and property(s) can be downloaded to your workstation as a template to re-use in future submissions. To download a template use the 'Advanced' button on the Validation screen and choose the 'Customize Template' button on the following screen.
Using the template
To start a new assignment filing from the downloaded template, use the 'Start from Template' button shown below on this screen.
- **Resubmission**
Use the Resubmission button below only if you received a Notice of Non-Recordation from the Assignment Recordation Branch (Assignment Branch) in response to a previous submission and wish to correct the identified omissions. If you originally used the EPAS system to file your previous submission, after you enter your document number and access code, provided on the Notice of Non-Recordation, the resubmission form will prepopulate with the information you provided in your prior submission, namely: correspondence information, conveying party(s), receiving party(s) and property(s) for your convenience. However, please note that you will have to reattach the necessary supporting documentation and provide your electronic signature prior to submittal.
- A Confirmation of Receipt (an html attachment) with the EPAS tracking identification number acknowledging receipt of your submission will be displayed to the screen and transmitted via email upon completion of the submission process. Please mark the appropriate check box if you do not wish to receive this email with the attached html receipt. You may also print a copy of this screen for your records.
- Once submitted, the filing will not be cancelled unless the request fails to satisfy the minimum filing requirements.

2. Note the various types of conveyances that can be recorded. Specify the type of conveyance (here, assignment) and click "Next Screen".

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - Conveyance Type

EPAS v.1.10
PTO-1595 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Conveyance Type

Select nature of conveyance

[Assignment](#)

[Nunc Pro Tunc Assignment](#)

[Merger](#)

[Merger and Change of Name](#)

[Change of Name](#)

[Court Order](#)

[Corrective Assignment](#)

You must attach a copy of the original coversheet for a corrective assignment

to correct the

Identify what parts of the assignment need to be corrected

previously recorded on Reel: and Frame:

Assignor(s) hereby confirms the

Identify conveyance text of the original assignment

[Security Interest](#)

[Release of Security Interest](#)

[Government Interest Agreement](#)

[Executive Order 9424, Confirmatory License](#)

[Mortgage](#)

[Lien](#)

[License](#)

[Option](#)

[Decree of Distribution](#)

[Letters Testamentary](#)

[Letters of Administration](#)

[Court Appointment of Trustee](#)

[Conditional Assignment](#)

[Other](#)

Enter other conveyance type text here
If the nature of conveyance is an "Assignment", "Merger", "Change of Name", or "Nunc Pro Tunc", you should check the appropriate box above.

Multiple assignments with the same execution date:
Are there any properties in your filing today that are the subject of multiple assignments with the same execution date that you will be filing today or that you have already filed?
 Yes No
If yes, in the sequence of transfers for that property, what number is this transaction i.e. first (1); second(2); third(3), etc.? (please just identify the numerical order in which this assignment should appear)

[http://www.epas/help.html#conveyance-type.Option](#)

3. Enter the Correspondence Information. This is your contact information for receiving communications from the ARB. (Upon filing the request for recording, you will promptly receive an email confirmation of filing. Expect to receive another email in no more than a few days containing the assignment recordation information.) Click "Next Screen".

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - [Conveyance Type](#) - Correspondence

EPAS v.1.10
PTO-1595 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Correspondence Information

Required input in the field named 'Address: Correspondent Name' is missing

Enter correspondence information
**** Verify pre-filled address for correctness**

Phone	<input type="text" value="7034150012"/>
Name *	<input type="text" value="NEIFELD IP LAW, PC"/>
Address	Street * <input type="text" value="5400 SHAWNEE ROAD"/>
	Internal <input type="text" value="SUITE 310"/>
	City * <input type="text" value="ALEXANDRIA"/>
	State * <input type="text" value="VIRGINIA"/>
	<input type="button" value="Switch to non US address"/>
Postal code *	<input type="text" value="22312"/>
E-mail Address *	<input type="text" value="general@neifeld.com"/> <small>Note: The confirmation receipt for this request and the Official Notice of Recordation/Non-Recordation will be sent via e-mail to the above-listed address.</small>
Fax number	<input type="text" value="7034150013"/> <small>Note: 10-digits, US or Canadian number, digits only. A fax number is recommended in the event there is a problem with the e-mail address provided above.</small>

4. Enter name and execution dates for the parties assigning the patent property (assignors). When you have entered the last of the entities, click "Add and Go To The Next Screen."

Conveying Party(ies)

Enter conveying party data

<input checked="" type="radio"/> Individual	Prefix	First Name *	Middle Name/Initial	Last Name *	Suffix
	<input type="text"/>	<input type="text" value="JOHN"/>	<input type="text"/>	<input type="text" value="DOE"/>	<input type="text"/>
<input type="radio"/> Company	Name *				
Date of Execution * <input type="text" value="12/06/2016"/> × Format: MM/DD/YYYY					

5. Enter name and execution dates for the parties receiving ownership of the patent property (assignees). When you have entered the data for the last of these entities, click "Add and Go To The Next Screen."

Electronic Patent Assignment System

Patent Assignment Recordation Form EPAS v.1.10
Navigation: [Guidelines](#) - [Upload](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) PTO-1595 (Rev. 08/12)
OMB No. 0851-0027 (Exp. 04/30/2018) PTO-1595 (Rev. 08/12)

Receiving Party(ies)

Enter receiving party data

<input type="radio"/> Individual	Prefix	First Name *	Middle Name/Initial	Last Name *	Suffix
<input checked="" type="radio"/> Company	Name * NEIFELD IP LAW, PC				
Address	Street *	5400 SHAWNEE ROAD			
	Internal	SUITE 310			
	City *	ALEXANDRIA			
	State *	VIRGINIA			
	Postal code *	22312			

6. Enter the identification of the patent property by application number, patent number, PCT number, or International registration number, and click "Add and Go to The Next Screen."

Electronic Patent Assignment System

Patent Assignment Recordation Form EPAS v.1.10
Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) - [Property](#) PTO-1595 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Property(ies)

Enter property number one at a time using patent number for an issued US patent, an application number for a pending US patent application, or a PCT number for an application filed under the Patent Cooperation Treaty agreement, or an international registration number.
If you would like to paste a list of properties to the form, [click here](#).

Application number	<input type="text"/>	<input type="button" value="Add"/>	<input type="button" value="Add and Go To The Next Screen"/>
Patent number	<input type="text" value="9000000"/>	<input type="button" value="Add"/>	<input type="button" value="Add and Go To The Next Screen"/>
PCT number	<input type="text"/>	<input type="button" value="Add"/>	<input type="button" value="Add and Go To The Next Screen"/>
International Registration number	DM <input type="text"/>	<input type="button" value="Add"/>	<input type="button" value="Add and Go To The Next Screen"/>

7. Attach an image copy of the assignment in TIFF or PDF format, 8.5 inch by 11 inch page size, portrait orientation, and black and white, with at dpi of at least 300, and click attach file.

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) - [Property](#) - [Attachments](#)

EPAS v.1.10
PTO-1595 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Image Attachments

Attach required legal documents
Document pages must be in TIFF or PDF format, letter size (8.5"x11"), 300 dpi, portrait orientation, black and white with black text on white background.
To ensure clarity of image please review each thumbnail.
If the file type attached is not of TIFF type, the attached document(s) will be converted to single page tiff files.
To attach a file click the 'Browse' button and select a file. (.pdf or .tif is permitted)
Then click the 'Attach' button to transmit the file to the server.
A thumbnail image will appear on the screen when the file is successfully attached.
Note: File types .pdf or multi-page tiff files will be converted to single page tiff files.

Y:\FirmForms\Firms_Patent\US\PatentAssignmentOf\

8. Review the images, and click "Next Screen."

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) - [Property Attachments](#)

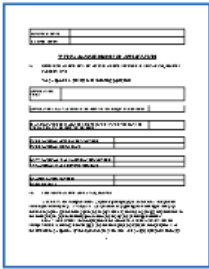
EPAS v.1.10
PTO-1595 (Rev. 06/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Image Attachments

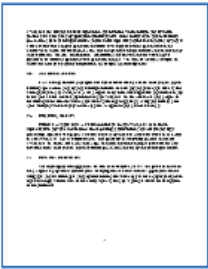
Attach required legal documents
Document pages must be in TIFF or PDF format, letter size (8.5"x11"), 300 dpi, portrait orientation, black and white with black text on white background.
To ensure clarity of image please review each thumbnail.
If the file type attached is not of TIFF type, the attached document(s) will be converted to single page tiff files.
To attach a file click the 'Browse' button and select a file. (.pdf or .tif is permitted)
Then click the 'Attach' button to transmit the file to the server.
A thumbnail image will appear on the screen when the file is successfully attached.
Note: File types .pdf or multi-page tiff files will be converted to single page tiff files.

Browse... Attach File

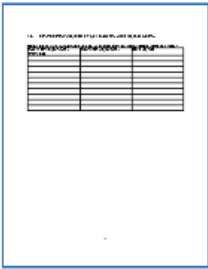
Attached images:




1. PatentAssignmentOfApplication#page1.tif



2. PatentAssignmentOfApplication#page2.tif



3. PatentAssignmentOfApplication#page3.tif



4. PatentAssignmentOfApplication#page4.tif

- Review your entered data, sign by typing your name between forward slashes ("/") in the "Signature" field and print your name in the "Name" field. If the assignment is combined with inventor oath or declaration, check the appropriate box, and click "Next Screen."

Electronic Patent Assignment System

Patent Assignment Recordation Form
 Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Consignor](#) - [Receiver](#) - [Property](#) - [Attachments](#) - [Sign](#)

SPAS v1.10
 PTO-1585 (Rev. 08/12)
 OIG No. 069-0027 (Sp. 06/05/16)

Signature

The request must be signed by the filer. The request will not be "signed" in the sense of a traditional paper document. To sign the request, the signer must enter any combination of printable characters that have been adopted to serve the function of a signature, preceded and followed by the forward slash(/) symbol. Acceptable "signatures" could include: (john doe), (j), and (/23-4567).

Sign the request by completing the following fields:

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT

CONVEYING PARTY DATA

Name	Execution Date
JOHN DOE	12/06/2016

RECEIVING PARTY DATA

Name:	NEIFELD IP LAW, PC
Street Address:	5400 SHAWNEE ROAD
Internal Address:	SUITE 310
City:	ALEXANDRIA
State/Country:	VIRGINIA
Postal Code:	22312

PROPERTY NUMBERS Total: 1

Property Type	Number
Patent Number:	9000000

CORRESPONDENCE DATA

File Number: 1000010-0010
 Phone: 7034120010
 Email: general@neifeld.com

Correspondence will be sent to the email address (only if email is announced); if it will be sent using a file number, if provided; if that is unsuccessful, it will be sent via US Mail.

Correspondent Name: NEIFELD IP LAW, PC
 Address Line 1: 5400 SHAWNEE ROAD
 Address Line 2: SUITE 310
 Address Line 3: ALEXANDRIA, VIRGINIA 22312

Total Attachments: 4
 source=PatentAssignmentOfApplication#page1.tif
 source=PatentAssignmentOfApplication#page2.tif
 source=PatentAssignmentOfApplication#page3.tif
 source=PatentAssignmentOfApplication#page4.tif

Signature: *

Name: *

Date: 12/06/2016

This document serves as an [Oath/Declaration \(37 CFR 1.63\)](#).

- Enter the attorney docket number, if one exists, check the "By checking this box...", and click "Submit."

Validate

All data entered on the previous screens are displayed below. Check the data carefully. If you find any errors, go back to the appropriate screen and correct. Otherwise, select the Submit button to proceed.

PATENT ASSIGNMENT COVER SHEET	
Electronic Version v1.1 Stylesheet Version v1.2	
SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT
CONVEYING PARTY DATA	
Name	Execution Date
JOHN DOE	12/06/2016
RECEIVING PARTY DATA	
Name:	NEIFELD IP LAW, PC
Street Address:	5400 SHAWNEE ROAD
Internal Address:	SUITE 310
City:	ALEXANDRIA
State/Country:	VIRGINIA
Postal Code:	22312
PROPERTY NUMBERS Total: 1	
Property Type	Number
Patent Number:	9000000
CORRESPONDENCE DATA	
Pat. Number:	1700110-0010
Phone:	703-610-0012
Email:	general@neifeld.com
Correspondence will be sent to the email address listed (if that is unacceptable, it will be sent using a fax number, if provided, if that is unacceptable, it will be sent via US Mail).	
Correspondent Name: NEIFELD IP LAW, PC	
Address Line 1:	5400 SHAWNEE ROAD
Address Line 2:	SUITE 310
Address Line 3:	ALEXANDRIA, VIRGINIA 22312
NAME OF SUBMITTER:	RICHARD NEIFELD
Signature:	/s/
Date:	12/06/2016
This document serves as an Oath Declaration (37 CFR 1.63).	
Total Attachments: 4 source=PatentAssignmentOfApplicationpage1.tif source=PatentAssignmentOfApplicationpage2.tif source=PatentAssignmentOfApplicationpage3.tif source=PatentAssignmentOfApplicationpage4.tif	

Attorney Docket Number:

This U.S. GOVERNMENT System is for recording documents with the U.S. Patent and Trademark Office.

There is no right to privacy in this system. Use of this system constitutes consent to have activities in association with the submission for recordation monitored, recorded, read, copied or captured by authorized personnel. Unauthorized use of this service, which includes providing false or spurious information such as false or improper assignment documents or security agreements, is a misrepresentation to the federal government. Unauthorized use of this system is prohibited and subject to criminal and civil penalties, including all penalties applicable to willful unauthorized access. See 37 CFR 1.4, 11.18 and 18 U.S.C. 1001.

The USPTO reserves the right, at its complete discretion, to change the terms, conditions, and use at any time by posting revised terms, conditions, and use restrictions for this system. It is the user's responsibility to check periodically for any changes USPTO may make to these terms, conditions, and use restrictions. Continued use of this system following the posting of changes to these terms, conditions, and use restrictions means you accept the changes.

By checking this box, you acknowledge your consent to the above statement.

Your IP address: 88.88.183.221

Save form for future access, or prepare a template

11. Step 10 effects filing your request to record the assignment and the assignment. However, if, you want to make an xml template storing some of your entered information, instead of clicking the "Submit" button, click "Advanced Options" and then click "Customize Template".

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) - [Property](#) - [Attachments](#) - [Sign](#) - [Validate](#) - [Advanced](#)

EPAS v. 1.10
PTO-1596 (Rev. 05/12)
OMB No. 0651-0027 (Exp. 04/30/2018)

Advanced Operations

Save Form

Selecting the 'Save Submission' button below saves the submission to a USPTO server for future access by filer. The URL link to access the submission will be displayed on the screen when the save submission button is selected and will also be sent in an email to the following e-mail address:
general@neifeld.com
(provided on the Correspondence Information Screen).

The saved submission will be maintained on the USPTO server for 4 days. The saved submission may be accessed (via the URL) and finalized from any computer. Once the Confirmation of Receipt is generated, the filing process is considered complete and the previously saved submission is no longer available.

Note: The operation 'Save Submission' does not finalize the assignment submission with the USPTO. To finalize the submission, use the 'Submit' button on the Validation screen.

Customize Template

Selecting the 'Customize Template' button allows the selection of screen data and the data content in the screen from the current submission to be reused in future submissions. Selection of data elements and data to be stored in the template will be presented on the screen after selecting the 'Customize Template' button.

12. Then select your template options and click "Download XML Template."

Electronic Patent Assignment System

Patent Assignment Recordation Form
Navigation: [Guidelines](#) - [Conveyance Type](#) - [Correspondence](#) - [Conveyor](#) - [Receiver](#) - [Property](#) - [Attachments](#) - [Sign](#) - [Validate](#) - [Advanced](#) - [Template](#)

EPAS v.1.10
PTO-1595 (Rev. 08/12)
OMB No. 0851-0027 (Exp. 04/30/2018)

Customize Template

Select the parts of the submission to include in the customized template and select the 'Download XML Template' button to download and save template file to your workstation. After saving and/or to return to the current submission you may select the 'Return to Validation Page' button. To use the template in a future submission, select the 'START FROM TEMPLATE' button shown on the guidelines page .

<input type="checkbox"/> Correspondence	general@neifeld.com NEIFELD IP LAW, PC 5400 SHAWNEE ROAD SUITE 310 ALEXANDRIA, VIRGINIA, 22312 general@neifeld.com Fax:(703)415-0013 Phone:7034150012
<input type="checkbox"/> Conveying party	JOHN DOE Individual Executed Date: 12/06/2016
<input type="checkbox"/> Receiving party	NEIFELD IP LAW, PC Company 5400 SHAWNEE ROAD SUITE 310 ALEXANDRIA, VIRGINIA, 22312
<input type="checkbox"/> Property	Patent #:9000000

You can then return to your assignment filing and click the "Submit" button.

ran

Y:\Library\LAW\FirmPublicationsAndPresentationsAndLectureMaterials\RickNeifeld\articles\Electronically Recording a Patent Assignment.wpd