

Mail Stop—External Affairs
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Saurabh Vishnubhakat, Attorney Advisor, Office of Chief Economist, United States Patent and Trademark Office

VIA EMAIL ONLY
saurabh.vishnubhakat@uspto.gov

Dear Mr. Vishnubhakat,

In response to the request for comments regarding the proposed rulemaking published on November 23, 2011 in the Federal Register (76 FR 72,372) applying to 37 CFR Part 3 “Request for Comments on Eliciting More Complete Patent Assignment Information,” the Washington State Patent Law Association (“WSPLA”) desires to provide the following comments. WSPLA generally opposes the proposed changes to provisions of 37 CFR that would require any change in the identity of the assignee(s) be made known to the U.S.P.T.O. by the representative of the applicant at the time of application filing, at the time of payment of the issue fee, for inclusion on the patent application publication and any time the assignment causes the patent to gain or lose entitlement to small entity status. It is the opinion of WSPLA that compliance with the proposed rules as detailed in the Federal Register would be unduly burdensome for practitioners, applicants and patentees. The costs associated with obtaining and maintaining patent rights are already quite high and significant additional administrative requirements posed by the proposed rules would only increase costs for applicants and patentees further, requiring expenditure of limited resources that could otherwise be used to support new companies and innovations. Further, the proposed rules would likely result in increased administrative costs for the U.S.P.T.O. The additional administrative burden and costs seem to be out of proportion with the benefits of improving “market efficiency” and supporting “markets of innovation” cited as justifications eliciting more complete assignment information.

Moreover, the proposals outlined in the Federal Register do not adequately outline the procedures for complying with the proposed rules and the consequences for non-compliance. For example, it is unclear whether the representative of the applicant would be obligated to provide executed assignment documents establishing a complete chain of title. It is also unclear whether the disclosure of updated assignment information would be an absolute

requirement, leading to abandonment of an application or invalidation of a patent if the requirements are not met, or if the penalties for noncompliance would consist of additional fees and/or lost incentives. Without knowledge of the details of implementation, the potential effects of the proposed requirements for disclosing assignment information cannot be fully evaluated.

Comments have been solicited for the question: “Is there any reason that the mandatory disclosure of any assignee or assignees should not take place at the time of application filing?” WSPLA submits that there are legitimate business reasons for not disclosing assignment information at the time of filing. For example, disclosure of assignment information may cause businesses to lose a competitive advantage when developing new technology or when entering a new market.

Finally with regard to the proposal for amending 37 CFR to provide for discounted maintenance fees in return for verification or update of assignee information either when a maintenance fee is paid or within a limited time period from the date of maintenance fee payment, WSPLA does not oppose the provision of incentives for disclosing updated assignee information. In general, incentives, such as the proposed reduction in maintenance fees, are much preferred over requirements that carry punitive fees or other costs (e.g., abandonment of an application or expiration of a patent) for noncompliance. Such incentives seem better calibrated to achieve the stated goal of eliciting more complete patent assignment information without placing an undue burden on practitioners, applicants and patentees.

Thank you,

/Peter J. Knudsen/

Peter J. Knudsen

Reg. No. 40682

President, WSPLA