

AIPPI • JAPAN



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International Association for the Protection of Intellectual Property of Japan

April 24, 2014

Ms. Michelle K. Lee  
Deputy Under Secretary of Commerce  
for Intellectual Property and Deputy Director of  
the United States Patent and Trademark Office

Attention to: Mr. James Engel  
Senior Legal Advisor, Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy

Re: Comments on the “proposed rules for changes to require identification of  
attributable owner”

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the “proposed rules for changes to require identification of attributable owner”

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

Our comments are as follows.

## **AIPPI Japan's Comments regarding the USPTO's proposed rules for changes to require identification of attributable owner**

AIPPI Japan understands the importance to ensure timely updating of patent ownership information and enhance the transparency of such information for the benefit not only patent examiners and patent judges but also third parties. However, in view of possible undue burdens on ordinary patent applicants and patent owners, we have the following comments and wish a reconsideration of the proposed rules in question.

1. The proposed rules uniformly require a patent applicant and patent owner (hereinafter collectively referred to as the "patent owner") to record attributable owner information at each step during the prosecution process; upon filing, when replying to an Office action, upon patent registration, upon payment of a maintenance fee, upon filing a petition for post-grant proceedings, and during post-grant proceedings. This requirement is not advisable because it would complicate procedures and place an undue burden on the financial and human resources of patent owners.

1-1. We therefore respectfully propose that the proposed rules be revised to provide that a new attributable owner should be recorded within a predetermined period (e.g., three months) from the date of a change during the period from the filing of the application to the expiration of the patent term with regard to the attributable owner information recorded at the time of the filing.

The revised rule which we propose in the preceding paragraph should also apply to post-grant proceedings (e.g., *inter partes* review (IPR), covered business method review (CBM), and post-grant review (PGR)), because a rule exists requiring a patent owner to file notice confirming who has standing to enforce the patent immediately after the petition to institute proceedings is filed. Therefore, recording of attributable owner information should be required within the predetermined period after filing the petition "only where there is a change" in the attributable owner.

1-2. If our proposal mentioned in item 1-1 above is unacceptable to the USPTO, we alternatively propose that the proposed rules be revised as follows:

In order to mitigate the burdens (for example, required time and cost) on patent owners and their attorneys, a simple procedure should be considered to enable them to report no change in the attributable owner each time reporting is required. Such consideration may include, for example, providing a check box or sample statement in an application data sheet (ADS) or any other form to be submitted.

2. Upon filing and while a patent application is pending

The information required to be reported upon filing and while a patent application is pending must be limited to the minimum necessary for a patent examination. Recording of attributable owner information should be required only where there is a change in the attributable owner recorded at the time of the filing, who was the "same person" within the meaning used in the provisions of AIA-35 U.S.C.102(b)(2)(C); "the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person."

3. The definition of an "attributable owner," which must be recorded under the proposed rules, is complicated. We therefore request that the USPTO includes brief examples to enable users to ascertain what parties would be regarded as attributable owners without consulting experts in corporate law because there may be some differences between the corporate law of the United States and that of other countries. To be specific, we believe undisclosed shareholder information and licensee information should be excluded from the scope of attributable owner information.

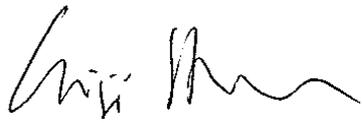
4. Penalty for failure to comply with the requirement

According to the proposed rules, a patent owner who failed to comply with the requirement to record attributable owner information shall be subject to severe penalties, i.e. abandonment of the application or loss of the right to enforce the patent. We believe remedies for failure to meet the time limit without malicious intent or due to *force majeure* as well as conditions for enjoying such remedies should be established, while ensuring consistency with the Patent Law Treaty (PLT).

5. Procedure for reporting after the patent grant

After the patent is granted, requiring the recording of attributable owner information only at the time of a maintenance fee payment is insufficient to ensure timely updating of information (because of the possibility of a considerable time lag between the change and the recording). Therefore, recording of attributable owner information should be required within the predetermined period (e.g. three months) for any change in the attributable owner occurring after the patent grant, instead of only at the time of the first to third fee payments.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Eiji Katayama', with a stylized, flowing script.

Eiji Katayama  
President  
The Japanese Group of AIPPI