

April 24, 2014

VIA E-MAIL ONLY

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United States Patent and Trademark Office
Mail Stop Comments-Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: James Engel, Senior Legal Advisor
Office of Patent Legal Administration

Re: Oracle's Comments on Proposed Changes to Require Identification of Attributable Owner ("Proposed Rule"), Fed. Reg. Vol. 79, No. 16, Jan. 24, 2014, pp. 4105-4121

Dear Mr. Engel:

Oracle supports the United States Patent and Trademark Office's efforts to adopt procedures designed to increase patent ownership transparency. We are in favor of enhanced ownership disclosure rules that will apply to both patent applications and issued patents, and we commend the PTO's Proposed Rule as a significant step in the right direction. Oracle agrees with written comments submitted by the Coalition for Patent Fairness (of which Oracle is a member), and submits this brief additional comment to underscore our view that the disclosure requirements for issued patents outlined in the Proposed Rule should go further by requiring patent owners to file updated attributable ownership information at more frequent intervals.

In its current form, the Proposed Rule requires filing updated post-issuance patent ownership information only when patent annuities are paid and when a patent has already become involved in a post-grant proceeding. Under current regulations, three different maintenance fee payments are due during the lifetime of a patent. The first, second, and third maintenance fees are payable without a surcharge within six-month window periods ending 3.5, 7.5, and 11.5 years, respectively, after a patent issues. These fees can be paid with a surcharge within six-month window periods ending 4, 8, and 12 years after a patent issues. 37 C.F.R. §1.362(d)-(e). Consequently, four years separate the due dates between any two consecutive maintenance fees. The actual period between two consecutive maintenance fee payments for a patent could be as long as five years if the first payment is made at the start of the six-month (no surcharge) window and the next payment is made at the end of the six-month (surcharge) window. Similarly, because a patent generally is in force for a period of 20 years from its application priority date, a very long period can separate the payment date of the third maintenance fee and the patent's expiration date. For example, if a patent issues three years after



its application filing date, a period of five to six years will separate the patent's third maintenance fee payment and the patent's expiration.

These very long intervals between required filings of updated ownership information create significant gaps in the disclosure process that could be exploited by patent owners. Attributable ownership information could change, potentially many times, during the multi-year periods between required updates. For instance, under the Proposed Rule, a patent owner could wait until the third maintenance fee has been paid, and then transfer ownership of the patent to a shell company controlled by a different entity. The PTO and the public could be denied accurate attributable ownership information for the patent for years, unless and until the patent has become involved in a post-grant proceeding. Such long disclosure gaps undermine the very important transparency objectives that the Proposed Rule seeks to advance.

In order to avoid this potential for abuse, in addition to obligations to file updated ownership information when patent annuities are paid and when a patent becomes involved in a post-issuance proceeding, we respectfully suggest modification of the Proposed Rule to require reporting any change of attributable ownership within three months of such a change during the enforceable lifetime of an issued patent. This modification would bring the post-issuance reporting obligation in line with the reporting obligation that the Proposed Rule would apply during the pendency of a patent application and would avoid the long disclosure gaps discussed above.

Respectfully submitted,

/s/ Matthew Sarboraria
Matthew Sarboraria
Associate General Counsel