

From: CBrinckerhoff@foley.com [mailto:CBrinckerhoff@foley.com]
Sent: Monday, April 28, 2014 5:45 PM
To: AC90.comments
Subject: Supplemental Comments On Proposed Attributable Owner Rules

Dear Mr. Engel,

I previously submitted the attached comments on the proposed Changes To Require Identification of Attributable Owner, 78 Fed. Reg. 4105 (Jan. 24, 2014). (I am reattaching them in case you did not receive them as they are not yet posted on the Attributable Owner webpage.) I ask that the USPTO consider these supplemental comments, which are based on a provision of the MPEP that was just brought to my attention (MPEP 1130), even though I am submitting them a few days after the comment period has closed. As with my previously submitted comments, these comments may not reflect the views of other members of Foley & Lardner LLP or its clients.

The Federal Register Notice states that one goal of the proposed rules is to “ensure that the information the Office provides to the public concerning published applications and issued patents is accurate and not misleading.” However, current USPTO procedures **actively discourage** applicants from ensuring that accurate ownership information is made available to the public. In particular, MPEP 1130 governs when the USPTO will republish an application at no charge to the applicant due to a “material mistake,” and provides that any error or omission relating to assignee information is **not** a material mistake. MPEP 1130 also provides that if an applicant seeks republication of an application to correct an error in the assignee information as a material mistake (i.e., without paying a second publication fee), the application may be subject to a patent term adjustment (PTA) reduction. This PTA penalty may be imposed even if the error sought to be corrected was made by the USPTO. By disseminating this guidance and **penalizing** applicants who attempt to have their applications republished with correct assignee information, the USPTO discourages applicants who have no interest whatsoever in hiding their identity from ensuring that the public is informed of the correct ownership information.

This MPEP guidance reveals just how far current USPTO policies, procedures and guidance are from “ensuring that the information the Office provides to the public ... is accurate.” Before the USPTO imposes new, onerous burdens on applicants, the USPTO should adopt new policies, procedures and guidance that encourage and facilitate **voluntary** disclosure and correction of patent ownership information, and should make all voluntarily disclosed ownership information readily available to the public. For example, the USPTO should treat errors in published applications relating to assignee information as “material errors” under MPEP 1130, and should republish applications **without charge** to correct patent ownership information. The USPTO also should republish applications **without charge** to update patent ownership information whenever an assignment is recorded.

Thank you for considering these supplemental comments.

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From: Brinckerhoff, Courtenay C.
Sent: Thursday, April 24, 2014 3:58 PM
To: 'AC90.comments@uspto.gov'
Subject: Comments On Proposed Attributable Owner Rules

Please see the attached comments responsive to the proposed Changes To Require Identification of Attributable Owner, 78 Fed. Reg. 4105 (Jan. 24, 2014).

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