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WRITER'S DIRECT LINE
202.295.4094
cbrinckerhoff@foley.com EMAIL

CLIENT/MATTER NUMBER
999120-0301

AC90.comments@uspto.gov

James Engel
Senior Legal Advisor,
Office of Patent Legal Administration,
Office of the Deputy Commissioner for Patent Examination Policy
United States Patent and Trademark Office

Re: Changes To Require Identification of Attributable Owner
78 Fed. Reg. 4105 (Jan. 24, 2014)

Dear Mr. Engel:

I am a partner of Foley & Lardner LLP, which is a national, full-service law firm with a vibrant intellectual property practice that includes over 200 intellectual property attorneys and professionals, and chair of the firm's IP Law and Practice committee. I participated in the January 2013 Real-Party-In-Interest Roundtable. These comments do not necessarily represent the views of other members of Foley & Lardner LLP or its clients.

As a federal agency subject to the Administrative Procedures Act, the USPTO must justify its needs for information required from the public. Although the Federal Register Notice sets forth specific reasons why the USPTO supposedly needs the information it proposes to require from patent applicants, the following comments explain why the stated reasons do not justify the heavy burdens the proposed rules would impose.

1. Verifying Power of Attorney

Information on Attributable Owner would not help the USPTO verify that power of attorney has been obtained from the appropriate entity.

The current USPTO rules on power of attorney for applications filed on or after September 16, 2012 are **inconsistent** with a goal of ensuring that power of attorney is consistent with ownership. The USPTO power of attorney rule, 37 CFR § 1.32(b)(4), requires that the power of attorney originate from the applicant(s). However, the USPTO rule that defines who may be named as the applicant, 37 CFR § 1.32(b)(4), permits inventors to be named as applicants even if they have assigned all of their rights in their applications. Thus, the USPTO

power of attorney rules in effect require power of attorney from people who no longer have any ownership rights whenever the inventors of an assigned application are named as the applicants.

When a Power of Attorney from a non-inventor applicant is submitted, the practitioner or applicant verifies that the Power of Attorney has been obtained from the appropriate entity (usually the titleholder) by submitting a statement under 37 CFR § 3.73. The USPTO does not, does not have the resources to, and does not need to, independently verify the statement.

Even if the USPTO did verify ownership, it is not likely that any “attributable owner” beyond the named titleholder (assignee) would have authority to file or prosecute a patent application, except possibly an exclusive licensee. However, not all exclusive license agreements give the exclusive licensee a right to prosecute. Thus, even knowing that a patent application has been exclusively licensed and to whom would not be sufficient to identify the party with the right to control prosecution.

Moreover, under 37 CFR § 1.34, a registered practitioner can prosecute a patent application without ever filing any formal power of attorney document. While a power of attorney is needed to support certain papers (such as an express abandonment or terminal disclaimer), most patent applications can be filed, prosecuted, allowed, and granted without a power of attorney document.

For at least these reasons, the USPTO does not need Attributable Owner information to verify that power of attorney has been obtained from the appropriate entity.

2. Avoiding Potential Conflicts Of Interest

The Federal Register Notice states that Attributable Owner information is required “to avoid potential conflicts of interest for Office personnel.” However, the USPTO has not shown that potential conflicts of interest cannot be identified from titleholder (assignee) information.

For proceedings before the PTAB, current rules already require identification of the real-party-in-interest. The USPTO has not explained why that requirement is not sufficient to permit Board members to identify when they may have “an investment in a company with a direct interest in a Board proceeding.”

Although the Federal Register Notice also expresses concerns regarding potential examiner conflicts of interest, it has not indicated that it currently takes into account available patent application ownership information when assigning applications to examiners. Rather, it is believed that the USPTO relies on individual examiners to identify potential conflicts of interest on a case-by-case basis. Before the USPTO requires additional information for this reason, it should explain how it would use that information to identify potential conflicts of interest.

Moreover, the USPTO has not shown that titleholder (assignee) information would not be sufficient to identify conflicts of interest. Indeed, most of the Attributable Owner information that goes beyond titleholder (assignee) information likely would not be relevant to identifying conflicts of interest, particularly in view of the exemptions from financial conflicts pertaining to investments in diversified mutual funds and publicly traded stocks and bonds. *See* <http://www.uspto.gov/web/offices/com/advisory/acrobat/pto2000e.pdf>.

3. Identifying Commonly Owned Prior Art and Double Patenting

The most substantive justification for the proposed Attributable Owner rules relates to the relevance of patent ownership to the prior art exception of 35 U.S.C. § 102(b)(2)(C) and double patenting. However, the Federal Register Notice does not explain how the onerous attributable ownership information is required to implement § 102(b)(2)(C) or identify double patenting issues.

Under the USPTO's rules implementing the AIA version of § 102, the applicant will bear the burden of establishing the applicability of 35 U.S.C. § 102(b)(2)(C). That is, under 37 § CFR 1.131, an examiner will cite prior art without regard to the exception, and the **applicant** will have to establish that the common ownership exception applies. Thus, requiring all applicants to provide ownership information at the outset is not necessary for implementation of § 102(b)(2)(C).

For double patenting, most double patenting issues arise between related applications/patents or applications/patents with overlapping inventorship, where ownership information may not be necessary to support double patenting. Moreover, an applicant already has a duty to disclose ownership information and/or commonly owned applications/patents if material to patentability, under 37 CFR § 1.56.

For at least these reasons, the USPTO does not need Attributable Owner information to implement the AIA version of § 102 or identify double patenting issues.

4. Parties Requesting Post-Issuance Proceedings

The Federal Register Notices states that Attributable Owner information is required to verify that the party making a request for a post-issuance proceeding is a proper party for the proceeding; however, existing rules already require the necessary information.

The Inter Partes Review and Post Grant Review statutes already require the **petitioners** to identify the real-party-in-interest (35 USC §§ 312(a)(2), 322(a)(2)).

Since these are proceedings **against** a patent, it is not clear how requiring more information on patent ownership would help “verify that the party making a **request** for a post-issuance proceeding is a proper party for the proceeding,” as stated in the Federal Register Notice.

The Supplemental Examination statute permits a “patent owner” to request Supplemental Examination, and 37 CFR § 1.601(a) already provides that “[a] request for supplemental examination of a patent must be filed by the owner(s) of the entire right, title, and interest in the patent.” The USPTO does not need information beyond the titleholder information already required in order to administer Supplemental Examination proceedings.

For at least these reasons, the USPTO does not need Attributable Owner information to implement the new AIA post-issuance proceedings.

5. Improving The Accuracy Of Public Information

The Federal Register Notice states that Attributable Ownership information is needed to help “ensure that the information the Office provides to the public concerning published applications and issued patents is accurate and not misleading.” This justification might be more credible if it were not so difficult for the public to obtain the ownership information that the USPTO already has.

The current USPTO searchable database of patent assignment information is maintained separately from both the electronic file wrapper system and the published application/patent databases, and information from the patent assignment database is not accessible through the other portals. Patent assignment information can be searched by patent number or publication number, but not application number.

An assignment is indexed in accordance with the information provided at the time of recordation. The USPTO does not verify that information, and generally will not correct improperly recorded assignments (e.g., assignments recorded under the wrong application or patent due to a clerical error), but rather relies on the submitting party to make corrections. An assignment that by its own terms applies to continuation and divisional applications will not be indexed to those applications (or resulting patents) unless the assignment is re-recorded under those application/patent numbers.

On the other hand, the USPTO publishes applications and patents with ownership information provided by the applicant on the Application Data Sheet or Issue Fee Transmittal, regardless of whether that information is consistent with any recorded ownership information.

Before the USPTO demands more onerous ownership information, it should make it easier for the public to obtain the most current ownership information that the USPTO already has.

I appreciate the Patent Office's careful consideration of these comments.

Sincerely,

/Courtenay C. Brinckerhoff/

Courtenay C. Brinckerhoff
Chair, IP Law & Practice
Foley &Lardner LLP