

From: Anthony Venturino [email address redacted]
Sent: Tuesday, April 22, 2014 10:33 AM
To: AC90.comments
Subject: Proposed Changes To Require Identification of Attributable Owner

Sirs:

Speaking for myself as a patent practitioner member of the public, not for my firm or any of my clients, the costs and risks of making patent owners comply with these proposed rules outweigh any benefits. These requirements will create traps for patent owners. Patent Owners are still recovering from traps and unintended consequences of the AIA. For example, under the AIA foreign owned PCT international stage applications can no longer be prosecuted at the US Receiving Office even if they have US inventors. In some instances filing such a case in the US/RO could cause the applicant to lose its filing date. The US Patent Office did not do a good job of advertising this trap. Entering a trademark application into the US via the relatively recently adopted Madrid protocol caused traps for many foreign applicants. For example goods in some instances had to be dropped because US identification of goods requirements are inconsistent with those of other jurisdictions. I likewise foresee complications in the event of not accounted for ownership or transfer situations. Such situations could arise in the context of joint ownership, temporary ownership, inheritance, and foreign ownership, as well as situations involving wholly owned subsidiaries vs. partially owned subsidiaries vs. sister companies. Also, these rules will add to litigation expenses. Now the parties can fight over whether the patentee's title records are perfect.

Requiring updates on changes during prosecution within three months of any change in attributable owner is impractical and creates more traps for businesses big and small. After a patent is granted, many small clients go to an annuity service and have little further contact with their patent attorney or patent agent. The US Patent Office has asserted patent matters should be treated by lay people patent owners as they treat their most important business. However, as a practical matter laypeople often cannot keep up with changes to arcane Patent Office procedures. It is likely if a business is bought, sold, or otherwise changes IP ownership then the layperson owner will forget to register the change and be penalized in a draconian manner for a victimless crime. How many US patents were accidentally lost due to failure of a layperson to pay a maintenance fee?

Also, these rules interfere with corporate freedom. A company may have legitimate reasons to attribute ownership a particular part of the corporate organization which will be inconsistent with by these rules. Thus, driving corporate decisions by a need to comply with these rules rather than what makes business sense for the company.

If the public needs to know who is the attributable owner of the patent in a lawsuit then this should be handled by the US courts, not the US Patent Office. Ownership could be required to be part of the initial pleading or other disclosures early in the trial process. For the few instances where this ownership issue arises there is no need to burden holders of millions of patents.

Respectfully,
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