

Vishnubhakat, Saurabh

From: Robert Lelkes Ø! a Uj` UXXfygg`fYXUMWXQ
Sent: Monday, January 23, 2012 8:27 PM
To: Vishnubhakat, Saurabh
Subject: 76FR226: Eliciting more complete assignment information

To whom it may concern,

I am responding as a US patent attorney to the request for comments issued in 76 Federal Register 226. My comments are inserted below each question:

(1) Is there any reason that the mandatory disclosure of any assignee or assignees should not take place at the time of application filing?

Practitioners are often faced with last minute requests to file a patent application or enter the US national phase based on a PCT application. There is often not much time to confirm special requirements at that time.

Formalities such as assignments are not required by statute to be filed or identified at the time of filing in the US. Processing time and complexity could be reduced by specifying a later point in time for satisfying formalities such as recordation of assignments.

(2) Would it be in the public interest for the USPTO to obtain from applicants updated identification of the assignee at the time of allowance, e.g. in response to the Notice of Allowance? Are there limitations on the USPTO's rights and powers to require the reporting of such information?

Requiring updated identification or confirmation of ownership at the time of allowance appears to be in the public interest for the purpose of identifying the patent owner for challenges to patent validity post-grant. However, it is not clear on what statutory basis such a rule could be enforced for all applicants uniformly.

Applicant reliance on 35 USC §118 appears to be voluntary. However, once an applicant relies on a recordation of an assignment to take action before the USPTO, it seems to be a legitimate exercise of authority to request confirmation that ownership has remained with the assignee.

(3) Would it be in the public interest for the USPTO to obtain from applicants updated identification of the assignee during prosecution of the application? Are there limitations on the USPTO's rights and powers to require the reporting of such information? Should the USPTO consider requiring the identification of assignment changes after filing date for inclusion on the patent application publication (PGPub)? At what time should changes be recorded relative to the assignment, and what are the appropriate consequences of non-compliance?

Since ownership can play a role in the availability of prior art, it may be in the public interest for the USPTO to receive updated identification of the assignee during prosecution of the application. However, the applicant and patent practitioner seem to have a self-interest in updating ownership information to ensure that they comply with their duty of candor to the USPTO under 37 CFR §1.56 and to protect the assignee from a loss of rights to a subsequent bona fide purchaser for interest. A reminder to the applicant and its patent counsel would seem to be sufficient to effectuate this goal.

(4) Would it be in the public interest for the USPTO to obtain from applicants updated identification of the assignee after issue of the patent? Are there limitations on the USPTO's rights and powers to require the reporting of such information? At what time should such identification be made to the Office relative to a change? Should the USPTO consider requiring the identification of assignment changes during the maintenance period of the patent right, *i.e.*, after grant, but prior to patent expiration? What are the appropriate consequences of non-compliance?

Requiring updated identification or confirmation of ownership post-allowance appears to be in the public interest for the purpose of identifying the patent owner for challenges to patent validity post-grant. However, it is not clear on what statutory basis such a rule could be enforced.

In general, it seems to be in the patentee's interest to keep identifying information up-to-date to prevent entry of default judgment for failure to respond to a challenge to the patent and to prevent a potential loss of rights to a subsequent bona fide purchaser for interest.

(5) To accomplish adequate and timely recording, are changes to Agency regulations necessary? What are the most effective and appropriate means for the USPTO to provide the public with a timely and accurate record of the assignment of patent rights and the assignee?

Recordation is often simply overlooked. Regular reminders to update ownership followed by posting of “orphaned” patents on a public website if unanswered may be an appropriate means.

(6) Would it help the USPTO’s goal of collecting more updated assignment information if 37 CFR 1.27(g)(2) were amended to require identification of any new ownership rights that caused the application or issued patent to lose entitlement to small entity status?

This proposal addresses only a small percentage of pending patent applications and issued patents, leaving the vast majority of applications and patents untouched. The benefit would appear to be negligible compared with the effort required to implement this rule.

(7) Given the passage of the America Invents Act, is it proper for the Office to provide for financial incentives for disclosure of assignment information by way of discounts in fee payments? For example, would it be more likely for patentees to update assignment information and record assignment documents on in-force patents if a maintenance-fee discount were available in return? What are the appropriate consequences for failure to provide accurate information when accepting such a discount?

I doubt that a maintenance fee discount would provide sufficient motivation to update assignment information. If the potential for loss of rights due to failure to record an assignment is not enough motivation, then a maintenance fee discount will not likely cause a change in behavior.

Recordation is often simply overlooked. Regular reminders to update ownership followed by posting of “orphaned” patents on a public website if unanswered may be an appropriate means.

(8) In order to provide a more complete record for transactional purposes, what changes do you recommend that USPTO make in its requirements or incentives relating to the disclosure of assignment information during the patent application process and for issued in- force patents?

It has been said that the USPTO will record practically anything the applicant or owner submits without checking whether the underlying documentation actually completes a chain of title. The assignment records could be made more reliable by actually checking whether this formality is met as is currently the practice by the EPO.

Respectfully submitted,

Robert Lelkes
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