Vishnubhakat, Saurabh

From: John Slaughter <e-mail address redacted>
Sent: Tuesday, January 24, 2012 1:22 PM
To: Vishnubhakat, Saurabh
Subject: Eliciting More Complete Patent Assignment Information

Dear Saurabh,

The following should be considered by the USPTO to obtain more timely and accurate patent assignment information:

1. An assignee should not be listed on a published patent application or issued patent until a patent assignment has been recorded with the assignment division. Many people, including corporate and IP attorneys, are under the misimpression that an assignee listed in those locations demonstrates that a patent assignment has been recorded, and therefore assignments do not get recorded. Please see U.S. Patent Appl. No. 12632485 (Publ. No. 20100145813) for a particularly egregious example, where the front page of the published application should the assignee as Advanced Programs Group, LLC, while the patent assignment database shows a recorded patent assignment from the inventor to Trusted.com, LLC.

2. MPEP 306 should be eliminated. While at first blush, it appears that patent assignments sensically should be applied to divisionals or continuations, there are a number of problems that arise. One problem is that patent assignments then do not get filed and do not show up in the patent assignment database for those divisionals and continuations. Another problem is that contract law dictates whether the divisionals and continuations are assigned, so unless the recorded assignment includes an assignment of divisionals and continuations, then there is no such assignment and MPEP 306 just creates confusion because people still think the assignment applies. A further problem is that someimes multiple inventions end up in a patent application, and once divided, one could be assigned to another party; if the primary application is assigned but the divisional is retained, when the assignment is recorded against the primary application, MPEP 306 makes it appear as if the divisional was also assigned. Because of these and other numerous problems, MPEP 306 should be eliminated.

3. The USPTO could have better accuracy if the patent assignments were reviewed by the assignment branch prior to recordation and only allowed to record if consistent with being an assignment from the prior listed owner. However, the CIPO has done this in the past, and it has caused many difficulties, e.g., for lien holders to get their liens filed while the owners are still processing updates to reflect proper ownership of patents. So the USPTO should not implement a prior review for consistency.

Please let me know of any questions.

Regards,

John

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