

Supplement to Prior Submissions on Recordation of Real Party in Interest (RPI) Information

Arti K. Rai, Elvin R. Latty Professor, Duke Law School

Docket NO. PTO-P-2012-0047

These comments supplement prior submissions I have made on the question of recordation of real-party-in-interest (RPI) information. I submitted a set of comments on the question in 2012 and also gave oral testimony at a January 11, 2013 USPTO hearing.

My prior submissions discussed the issue of whether, as a matter of administrative law, the USPTO has the authority to promulgate rules that require periodic submission of RPI information. The prior submissions did not address the relevance for purposes of USPTO power of two patent statute sections that mention assignment.

Section 261 of the patent statute states that “[a]pplications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing.” The section also provides that “[a]n assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.”

The America Invents Act (AIA) of 2011 also includes a provision that addresses the issue of assignment. Specifically, under Section 115(e) of the patent statute, individuals who are under an obligation of assignment may include, within the filing of assignment information, statements regarding the inventor’s oath.

Neither of these provisions should be construed as preventing the PTO from requiring additional information about assignment. Section 261, which has been in the patent statutes since 1870, merely provides a floor of protection against unfair surprise for subsequent purchasers or mortgagees. The provision simply does not address the question of what information the PTO can request. Thus the maxim of *expressio unius est exclusio alterius* -- that is, when a statute limits a thing to be done in a particular mode, it includes a negative of any other mode, *see* *Raleigh & Gaston R. Co. v. Reid*, 13 Wall. 269, 270 (1872) – is inapplicable. What the PTO is seeking to do is largely orthogonal to the 19th century goal of protecting subsequent purchasers. *Cf.* *Christensen v. Harris County*, 529 U.S. 576, 583-584 (2000) (holding that, in context of overall statute, provision that addressed compensatory time was properly read as providing a minimum guarantee that an employee would be able to use the time as opposed to the exclusive method by which compensatory time could be used).

Similarly, section 115 (e) of the AIA is intended to provide an efficient mechanism for assignees to include inventor’s oath information. The goal of this provision is very different from that which the PTO aims to achieve. Hence the maximum of *expression unius* is inapplicable.