

**From:** Dr. Michael Factor [mailto:michael@ipfactor.co.il]  
**Sent:** Wednesday, March 07, 2007 4:18 PM  
**To:** ethicsrules comments  
**Cc:** michael@ipfactor.co.il  
**Subject:** Assignments

I am a Licensed Israeli Patent Attorney, which is more or less the equivalent of a US Patent Agent. I do have a law degree, but have not, as yet, sat the Law Bar exams.

Frequently, I help my clients, who are mostly Israel based companies, to obtain patent protection in the US. As well as prior art searches, I draft the applications, and, via the services of US Attorneys or Patent Agents who represent them professionally in the States under my instructions, I help my clients prosecute the patent applications before the USPTO.

Now it frequently happens that although the client looks and feels like an Israeli firm having a C.E.O., R&D labs and head offices in Israel, the company may actually be an American Company incorporated in Delaware. The inventor(s) are typically Israeli citizens, but may also hold US citizenship. If holding American citizenship, like many US nationals living in Israel, they are frequently from the States of New York or New Jersey. They may be from California however.

Particularly when filing in the US under the Paris convention or through the PCT mechanism, one or more inventor may have moved on to another firm and may be living in California.

For cases where I expect that a face-to-face interview between counsel and the Examiner may be useful, I prefer to use a Washington IP Law firm to represent the client in the US.

Now, who needs to prepare the assignment? Who needs to file it? Until now, I got one of my paralegals to prepare the forms, e-mail out to associate for his approval and then filed via one of his staff, often a patent agent. They are typically bog-standard after all.

From the proposed amendments I can see a situation where I could need five different attorneys in five different jurisdictions to file a patent application and to assign to the company, whom, under Israeli law owns it anyway, and who, would be considered the applicant almost anywhere else in the world other than the US.

I can't imagine the professional representation required for changing a light bulb...

Dr. Michael Factor

[www.ipfactor.co.il](http://www.ipfactor.co.il)