

Attributable Ownership Public Hearing



March 26, 2014: San Francisco, CA

Welcome



John Cabeca
Director, Silicon Valley Office

Opening Remarks



Janet Gongola
Moderator



Agenda

Time	Topic
9:00 AM	Welcome and Opening Remarks
9:20 AM	Presentation of Proposed Rules <ul style="list-style-type: none">• Bob Bahr, Senior Legal Advisor, Office of the Deputy Commissioner for Patent Examination Policy
9:45 AM	Witness Testimony
10:30 AM	BREAK
10:45 AM	Witness Testimony (cont.)
11:55 PM	Closing Remarks



Attributable Owner Rulemaking

- Notice of Proposed Rulemaking:
 - Changes to Require Identification of Attributable Owner, 79 Fed. Reg. 4105 (Jan. 24, 2014); and
 - Notice of Public Hearings and Extension of Comment Period on the Proposed Changes to Require Identification of Attributable Owner, 79 Fed. Reg. 9677 (Feb. 20, 2014)



Public Hearings

- Alexandria, VA: March 13, 2014
- San Francisco, CA: March 26, 2014



Written Comments

- Due April 24, 2014
- Must be submitted by:

Method	Address
Email (preferred)	AC90.comments@uspto.gov
Postal Mail	Mail Stop Comments-Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA, 22313-1450
Federal eRulemaking Portal	http://www.regulations.gov

Proposed Rules: Overview and Goals



Drew Hirshfeld
Deputy Commissioner
for Patent Examination Policy

Proposed Rules: Changes to Require Identification of Attributable Owner



Robert W. Bahr

Senior Patent Counsel

Office of the Deputy Commissioner for Patent Examination Policy



Attributable Owner Notice of Proposed Rulemaking

- Topics addressed in proposed rules:
 - Who is the “attributable owner” (definition)?
 - When must the attributable owner be identified?

Attributable Owner Definition





Attributable Owner (proposed 37 CFR 1.271(a) and (b))

- Attributable owner includes:
 - Titleholders,
 - Enforcement entities, and
 - The ultimate parent entity as defined in 16 CFR 801.1(a)(3) of any titleholder or enforcement entity.
 - The ultimate parent entity is an entity which is not controlled by any other entity.



Attributable Owner (proposed 37 CFR 1.271(c))

- An entity cannot avoid being considered an attributable owner by creating or using any instrumentality with the purpose or effect of:
 - temporarily divesting itself of attributable ownership, or
 - preventing the vesting of such attributable ownership.



Attributable Owner (proposed 37 CFR 1.271(d) and (e))

- The definition of “entity” tracks the definition of entity in 16 CFR 801.1(a)(2).



Attributable Owner (proposed 37 CFR 1.271(d))

- The term “entity” includes:
 - Any natural person, corporation, company, partnership, joint venture, association, joint-stock company, trust, estate of a deceased natural person, foundation, fund, or institution,
 - whether incorporated, wherever located, and of whatever citizenship,
 - Any receiver, trustee in bankruptcy or similar official or any liquidating agent for any of these entities,
 - Any joint venture or other corporation which has not been formed but the acquisition of the voting securities or other interest in which, if already formed, would be an attributable owner, or
 - Any other organization or corporate form that holds an interest in an application or patent.



Attributable Owner (proposed 37 CFR 1.271(e))

- The term “entity” does not include:
 - any foreign state, foreign government, or agency thereof (other than a corporation or unincorporated entity engaged in commerce),
 - the United States, any of the States thereof, or any political subdivision or agency of either (other than a corporation or unincorporated entity engaged in commerce).



Identification of Attributable Owner (proposed 37 CFR 1.271(f))

- The attributable owner must be identified as:

Owner Type	Item of Information #1	Item of Information #2	Item of Information #3
Public Company	Name of company	Stock symbol	Stock exchange where the company is listed
Non-Public Company	Name of company	Place of incorporation	Address of principal place of business
Partnership	Name of partnership	Address of the principal place of business	
Natural Person	Full legal name	Residence	Correspondence Address
Other	Name	If organized under the laws of a state, the name of that state and legal form of organization	Address of the principal place of business



Identification of Attributable Owner (proposed 37 CFR 1.271(g))

- A shareholder or partner in a corporation, partnership, or other association must also be independently identified as an attributable owner if the shareholder or partner is an attributable owner,
 - even if the corporation, partnership or other association is separately identified as an attributable owner.
- Does not apply to shareholders of a public company.

Timing for Identification of Attributable Owner





Identification of Attributable Owner in Pending Applications

- The attributable owner must be identified in an application:
 - On filing (or in reply to a missing parts notice),
 - When there is a change in attributable owner, and
 - At allowance.



Identification of Attributable Owner on Filing (proposed 37 CFR 1.273)

- The attributable owner must be identified in each nonprovisional application, which includes:
 - reissue applications, and
 - international applications that commenced the national stage in the United States.
- The attributable owner need not be identified in provisional applications.



Identification of Attributable Owner on Filing (proposed 37 CFR 1.273)

- If an application does not identify the attributable owner:
 - The applicant will be sent a notice to file missing parts giving the applicant two months (which may be extended to seven months) to identify the attributable owner.
 - Failure to identify the attributable owner in reply to this notice will result in abandonment.
 - The application may be revived under 37 CFR 1.137 if the delay in identifying the attributable owner was unintentional.



Identification of Attributable Owner When There is a Change in Attributable Owner (proposed 37 CFR 1.275)

- If there is a change to the attributable owner during the pendency of an application:
 - The applicant has three months to identify the new attributable owner.
 - This three-month period is not extendable.



Identification of Attributable Owner At Allowance (proposed 37 CFR 1.277)

- If a notice of allowance has been sent to the applicant,
 - The applicant has three months to identify the current attributable owner of the application.
 - If there has been no change to the attributable owner, the applicant may simply indicate that there has been no change to the attributable owner.
 - This three-month period is not extendable.
 - The failure to identify (or indicate no change) within three months would result in abandonment.
 - The application may be revived under 37 CFR 1.137 if the delay in identifying the attributable owner was unintentional.



Identification of Attributable Owner in Pending Applications

- Proposed Applicability Date:

Timing for Identification	Applicable to
On filing (proposed 37 CFR 1.273)	Applications filed on or after the final rule effective date
When there is a change in attributable owner (proposed 37 CFR 1.275)	Applications filed on or after the final rule effective date
At allowance (proposed 37 CFR 1.277)	Applications in which a notice of allowance is mailed on/after the final rule effective date



Identification of Attributable Owner in Patents

- The attributable owner must be identified in a patent:
 - At each maintenance fee payment,
 - In PTAB proceedings, and
 - In supplemental examination and reexamination proceedings.



Identification of Attributable Owner At Maintenance Fee Payment (proposed 37 CFR 1.381)

- The attributable owner must be identified within the maintenance fee payment windows (37 CFR 1.362(d) or (e)), but prior to the date the maintenance fee is paid.
- If there has been no change to the attributable owner, the patentee may simply indicate that there has been no change to the attributable owner.



Identification of Attributable Owner in Patents Involved in PTAB proceedings (proposed 37 CFR 1.383)

- The attributable owner must be identified in the mandatory notice filed by a patent owner as required by 37 CFR 42.8(a)(2).
- If there is a change to the attributable owner during the trial proceeding, the patent owner has twenty-one days to file a notice identifying the new attributable owner.
- This twenty-one-day period is not extendable.



Identification of Attributable Owner in Patents Involved in Supplemental Examination or Reexamination (proposed 37 CFR 1.385)

- The attributable owner must be identified in a request for supplemental examination under 37 CFR 1.610 for the request to be accorded a filing date.
- The attributable owner must be identified in a request for ex parte reexamination under 37 CFR 1.510 by the patent owner for the request to be accorded a filing date.



Identification of Attributable Owner in Patents Involved in Reexamination Proceedings (proposed 37 CFR 1.385)

- The attributable owner must be identified in papers filed by the patent owner in an ex parte reexamination proceeding, unless the current attributable owner was previously identified by the patent owner.
 - Otherwise, the paper would be considered incomplete.
- If there is a change to the attributable owner during the reexamination proceeding, the patent owner has three months to identify the new attributable owner.
 - This three-month period is not extendable.



Identification of Attributable Owner in Patents

- Proposed Applicability Date:

Timing for Identification	Applicable to
At each maintenance fee payment (proposed 37 CFR 1.381)	Patents with maintenance fees due on or after the final rule effective date
In PTAB proceedings (proposed 37 CFR 1.383)	Patents where petition is filed on or after the final rule effective date
In supplemental examination and reexamination proceedings (proposed 37 CFR 1.385)	Patents where the request is filed on/after the final rule effective date



Correction of Failures or Errors in Identifying the Attributable Owner (proposed 37 CFR 1.279 and 1.387)

- If the applicant or patent owner has failed to identify a change to the attributable owner, or has indicated an incorrect or an incomplete attributable owner, and
- If there was a good faith effort to identify the attributable owner or any changes to the attributable owner,
- The failure or error may be excused on petition accompanied by a showing of reason for the delay, error, or incompleteness (and the petition fee set forth in 37 CFR 1.17(g)).



Public Access to Attributable Owner Information

- The USPTO would make attributable owner information available to the public for:
 - published applications, and
 - patents.
- The USPTO is working on a database to provide electronic access to current and historical attributable owner information
 - such as via the public side of PAIR.



Thank You

Witness Testimony



R. Reams Goodloe Solo Practitioner



Brian Schar Practitioner



Daniel Nazer

Electronic Frontier Foundation



Julie Samuels

Engine Advocacy





Break

Mark Blafkin

Association for Competitive Technology



American Intellectual Property Law Association



Additional Witness Testimony



Closing





Written Comments

- Due April 24, 2014
- Must be submitted by:

Method	Address
Email (preferred)	AC90.comments@uspto.gov
Postal Mail	Mail Stop Comments-Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA, 22313-1450
Federal eRulemaking Portal	http://www.regulations.gov



Attributable Ownership Landing Page

- http://www.uspto.gov/patents/init_events/attributable_ownership.jsp

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Attributable Ownership

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ATTRIBUTABLE OWNERSHIP

In June 2013, the White House issued a series of [Executive Actions](#) concerning high-tech patent issues. To improve transparency in patent ownership, the USPTO has formulated a rule that will require patent applicants and owners to regularly update ownership information.

- [Announcements](#)
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Announcements

- The USPTO is extending the period for public comment on the proposed rule until **April 24, 2014**.
- [Public Meetings on Notice of Public Rulemaking "Changes to Require Identification of Attributable Owner":](#) < View for details and agendas
 - March 13, 2014, from 1 p.m. (ET) until 4 p.m. (ET)
USPTO Madison Auditorium North, Concourse Level
Madison Building
600 Dulany Street
Alexandria, VA 22314
 - March 26, 2014, from 9 a.m. (PT) until noon (PT)
U.C. Hastings College of the Law
Louis B. Mayer Lounge
198 McAllister Street
San Francisco, CA 94102

>> [Instructions for WebEx access and agenda information](#)

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Resources

- [Notice of Public Hearings and Extension of Comment Period on the Proposed Changes To Require Identification of Attributable Owner](#) (February 2014) [PDF]

The USPTO has extended the period for public comment on the proposed rule until **April 24, 2014** and has announced [two public hearings](#).



Patent Litigation Online Tool Kit

- <http://www.uspto.gov/patents/litigation/index.jsp>

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Beta

Been Sued or Gotten a Demand Letter? **Answers To Common Questions About Abusive Patent Litigation**

Received a letter about or been sued over a patent? You're in the right place. See below for answers to common questions:

See the topics below for answers to common questions:

-  I'VE BEEN SUED...
-  I GOT A LETTER...
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-  ABOUT PATENT INFRINGEMENT
-  ABOUT PATENTS
-  RESOURCES and GLOSSARY

In June 2013, President Obama ordered the creation of this website to empower those who have received a demand letter or may be threatened with a patent lawsuit with information about their options. In response, the USPTO has created this site.

The information presented on this site does not constitute legal advice. It should not be considered to replace advice from an attorney. Reference to any specific organizations, attorneys, law firms, corporations, or websites does not constitute endorsement, recommendation, or favoring by the USPTO.

We welcome your comments and suggestions in the box below.

Related Links:

- [Glossary of Patent Terms](#)
- [White House Fact Sheet](#)
- [National Economic Council and the Council of Economic Advisers report "PATENT ASSERTION AND U.S. INNOVATION"](#)



Inventors Resources

- <http://www.uspto.gov/inventors/index.jsp>

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The USPTO assists independent inventors, small business concerns and university affiliated inventors through its Office of Innovation Development. The office also works closely with other officials and agencies throughout the government in support of the administration's efforts to promote small business, entrepreneurship, and job creation. The Office of Innovation Development designs and implements outreach programs intended to reach a wide range of groups, including independent inventors, women, small business concerns, minorities, and other underserved communities.

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Pro Bono Assistance

- <http://www.uspto.gov/inventors/proseprobono/index.jsp>



The screenshot shows the USPTO website's Pro Bono page. At the top, the USPTO logo is displayed with the text "uspto.GOV" and "The United States Patent and Trademark Office an agency of the Department of Commerce". A search bar is located in the top right corner. Below the header, a navigation menu lists various categories: PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US. The main content area is titled "Pro Bono" and includes a quote from the America Invents Act (AIA) and a section for "Nationwide Pro Bono Program Information". A video player is embedded, showing a cartoon illustration of a storefront with a sign that says "PRO BONO". The video player controls show a play button and a progress bar at 0:00 / 4:24. Below the video, there is a list of states where pro bono programs are available: Alaska, Arizona, California, Colorado, Delaware, District of Columbia, Hawaii, Idaho, Louisiana, Maryland, Massachusetts, Minnesota, Nevada, New York, Ohio, Oregon, Pennsylvania, Texas, Virginia, Washington, and Wyoming.

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Pro Bono

The America Invents Act (AIA) encourages the United States Patent and Trademark Office (USPTO) to "work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses."

Nationwide Pro Bono Program Information

PLEASE VIEW THE FOLLOWING VIDEO AND READ THE INFORMATION BELOW BEFORE REQUESTING PRO BONO ASSISTANCE

Legal Assistance Programs for Independent Inven...

You can download the video [here](#). The transcript is available [here](#).

Currently, at least part or all of 20 states have pro bono programs offering assistance, with more slated to begin operation in 2014 and 2015. The current pro bono programs is limited to residents of:

**Alaska Arizona California Colorado Delaware District of Columbia
Hawaii Idaho Louisiana Maryland Massachusetts Minnesota Nevada New York
Ohio Oregon Pennsylvania Texas Virginia Washington Wyoming**

If your state is listed above, Pro-bono assistance is available, to be considered and apply go to the Federal Circuit Bar Association National Clearing House



Thank You