

Vishnubhakat, Saurabh

From: Paul Morgan ~~Paul Morgan <Paul.Morgan@USPTO>~~
Sent: Tuesday, November 29, 2011 2:36 PM
To: Vishnubhakat, Saurabh
Subject: "Eliciting More Complete Patent Assignment Information"

In response to your 11/23/11 FR request "Eliciting More Complete Patent Assignment Information," this is to support your proposed efforts in that regard.

A particular problem is being caused by patent trolls who engage in assignment transfers of patent ownership, often between plural "shell" corporations, and may even file patent suits without a recorded assignment of the patents in suit to the named plaintiff. Anything the PTO can do in that regard would be desirable. It is appreciated that the PTO may be limited, as to issued patents, to situations in which other papers are being filed in the PTO by a patent owner, since the PTO recording of assignments is not mandatory. Apparently neither is it mandatory to even maintain a current address in any PTO records for the service of reexamination-initiations or other papers on the current attorneys or current owners of issued patents still in force - a related issue and problem.

Re the specific PTO 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?"

The answer is yes, there are some companies which consider that not disclosing the ownership of their patent applications, especially after they are published or laid open, provides a commercial "lead time" advantage, in that it makes it more difficult for their competitors to determine, in advance of product launches, what new products they are developing and/or which avenues of R&D they are currently engaged in. Whether that is of more public benefit than *identified* ownership of patent applications is a public policy and economics issue which may be beyond the appropriate scope of this study?

Paul F. Morgan
[Retired patent attorney, *pro bono*]