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Property
Owners
Association

2019 IP5 HEADS OF OFFICE
MEETING WITH IP5 INDUSTRY

12 JUNE 2019
INCHEON, KOREA

PATENT HARMONIZATION EXPERT PANEL (PHEP)
NEW TOPIC:
GLOBAL PATENT ASSIGNMENT

WHY A GLOBAL ASSIGNMENT IS NEEDED

- Users are currently required to file assignment documents with each Patent Office, with differing formats and requirements
- This creates:
 - Increased costs for users
 - Documentation that is redundant, but that requires excess work
 - Opportunities for inadvertent errors
 - Timing problems if inventors have left companies before the filings occur
 - Less transparency for third parties than a universal database would provide

WHY A GLOBAL ASSIGNMENT IS NEEDED

The aforementioned problems increase substantially when:

- An applicant/owner has a name change due to
 - Merger or acquisition
 - Change of control or
 - Other business reasons such as the renaming of a company
- Sale of a global portfolio or a company spin-off occurs
- For example:
 - One invention filed in five countries
 - A portfolio of 500 patent families
 - Requires 2,500 assignment changes

CREATION OF A UNIVERSAL FORM

- IP5 Industry is in an excellent position to examine assignment requirements in major jurisdictions, because IP5 Industry members regularly file patent assignments around the globe
- IPO's Global Patent Assignment Subcommittee has evaluated assignment requirements in a number of jurisdictions for both company-to-company and inventor-to-company assignments
- The subcommittee is in the final stages of creating a draft global patent assignment form for each type of assignment based on the content required by those jurisdictions

CREATION OF A UNIVERSAL FORM

- The IPO Subcommittee has also identified differences in requirements between countries that would need to be resolved for true harmonization to occur
- Examples of such differences were also identified in the IP5 responses to the IP5 Offices survey on New PHEP topics

CREATION OF A UNIVERSAL FORM

- Differing requirements include, but are not limited, to:
 - Witness requirements
 - Signature requirements
 - Recordal requirements
- IPO is investigating these requirements further
- To the extent that differing requirements can be harmonized, that will lead to a more uniform form

CREATION OF A UNIVERSAL FORM

- IPO will present its draft forms and findings to the other IP5 industry groups for further feedback on national requirements
- IP5 Industry can then provide its recommendations to the IP5 Offices

CREATION OF A UNIVERSAL DATABASE

- A universal database of global patent assignments would provide great transparency for the benefit of not just patent owners, but for third parties
- Inspiration can be drawn from WIPO's Patent Information Initiative for Medicines (Pat-INFORMED), which facilitates easy access to medicine patent information

CREATION OF A UNIVERSAL DATABASE

- One perspective among IP5 Industry is that a common depository is not necessary if the status in different jurisdictions is accessible via one dossier
- Another perspective is that having one depository recognized by all of the offices would result in cost savings and eliminate administrative burdens and differing recordal requirements
- IP5 Industry would appreciate feedback from the IP5 Offices and WIPO on these issues

SUMMARY

Benefits of a global patent assignment would include:

- Greater legal certainty
- Improved efficiency
- Savings for users on this ministerial task, which could be spent more productively on innovation and patent applications
- Increased transparency of IP ownership

SUMMARY

- Industry has the knowledge to create the form based on content requirements
- Feedback will be needed from the offices on:
 - The forms ultimately prepared
 - Creation of a universal database, and
 - Whether differing requirements can ultimately be harmonized

FOR MORE INFORMATION:

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