

# Global and National Identifiers Applicant/IP Owner Perspective

*WIPO Standards Workshop*

*Geneva, Switzerland*

*May 2-3, 2019*

*Jonathan P. Osha*

*Managing Partner, Osha Liang LLP*

# AIPLA

Serving the

**Creative** and **Legal** Communities

### Topics for Discussion

- Summary of Industry IP5 feedback to Global Dossier Task Force
- What are possible concerns with using national or global identifiers?
  - Stakeholder concerns expressed during Global Dossier Task Force discussions

### IP5 with Industry IP5

- IP5 (since 2007):  
EPO, JPO, KIPO, CNIPA, USPTO  
WIPO participates as an observer
- Industry IP5 (since 2012):  
AIPLA, BusinessEurope, IPO, JIPA, KINPA, PPAC

*“Patent harmonization of practices and procedures, enhanced work-sharing, high-quality and timely search and examination results, and seamless access to patent information to promote an efficient, cost-effective and user-friendly international patent landscape.”*

- GDTF:  
Development of Global Dossier focused on the needs of the user community

More information:

<https://www.fiveipoffices.org/industry-consultation/GDTF>

### Background

#### Vision

- **Harmonize** applicant names across IP5 patent document collections

#### Objectives

- **Unifying** multiple versions of an applicant name into a single, standardized name to eliminate the confusion caused by inconsistency

ABC Co. Ltd.
ABC Co Ltd
ABC Corp.
A BEE CEE Co. Ltd



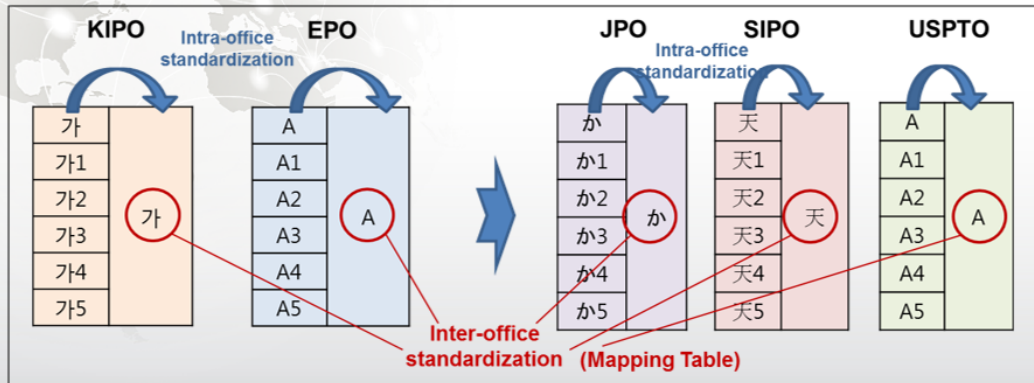
ABC Co. Ltd.

## Stakeholder reactions 2016-2019

Premise does not apply to all Applicants

### Background

- **Step 1. Intra-office standardization**
  - KIPO's and EPO's standardized names can be used as a basis for intra-office standardization of JPO, SIPO and USPTO within family applications
    - Premise: Applicants are same among family patents
    - KIPO has standardized applicant name by 'Customer No.' (former 'Applicant Code')
- **Step 2. Inter-office standardization**
  - Standardized applicant names in IP5 Offices are grouped in the mapping table



## Example:

- US: Schlumberger Technology Corporation
- CA: Schlumberger Canada Limited
- FR: Services Petroliers Schlumberger
- All others: GeoQuest Systems B.V.
- Post-uses of office data by third parties are the work scope and responsibility of those third parties
- Industry believes IP Offices should not, as part of the official record, attempt to combine or conflate distinct legal entities based on a common name or identifier



## Stakeholder reactions 2016-2019 (continued)

- Different applicant names may be used for a patent application within the same patent family due to, for example:
  - Contractual agreements among affiliate companies
  - Tax or other legal considerations
  - Mergers, acquisitions, divestitures, licenses
- An official “grouping” of distinct legal entities under a common name or identifier as part of a legal record may have unforeseen tax or other legal implications
- As a practical matter, Applicant name may not be under sole control of IP department in a large company
  - Consultation with corporate legal, tax, and other departments may be required

## Stakeholder reactions 2016-2019

- Where there is an obvious error or misspelling, there is less concern about a correction being made by the Office
- However, what is considered “obvious” may not be uniform and might encompass intentional name variations that reflect separate legal entities
  - Acme Inc. vs. Acme Company Ltd. vs. Acme LLC
    - *In the United States, differences depend on State law*
- Therefore, Applicant should have an opportunity to confirm a correction by the Office before it is made
  - If not before the change is made, at least afterwards so that the error is not repeated in the future



## Stakeholder reactions 2016-2019 (continued)

- Customer Number / Applicant Code, if used, should remain a separate number for each legal entity
- For example, in Germany, for Siemens there are 36 different registration numbers (depends on contracting party)
  - there are tax and legal implications to any changes.

## Stakeholder reactions 2016-2019 (continued)

- "Industry requests that the Patent Office consult with the Applicant before changing the applicant's name in an application or patent for standardized applicant name."
- "Industry requests that the Patent Offices not assign Applicant registration numbers without consulting with the Applicant, as there are potential legal and tax implications."

## Additional observations

- Any method of correcting or verifying name/identifier errors must maintain confidentiality of all applicants pre-publication
  - “Drop down” option suggestion
    - *If an option is NOT part of the corporate family, this is a clue as to another party’s confidential filing*
  - Auto-correcting apparent mistakes
    - *Filing receipt for Samsung’s patent application is sent to Samsung?*
  - Applicant contact to verify
    - *A pre-publication contact to ask if Applicant X is really intended to be Applicant X’ risks disclosing another party’s confidential filing if they are not the same party*

## Additional observations

- Geotagging
  - *Multiple different legal entities, sometimes sharing common parts of the name, may reside at the same address*
    - Legal certainty requires that offices not assume these to be the same applicant
    - In the case of tech centers and incubators, there may be completely unrelated entities working in the same technical area at the same address
  - *Inventor address is usually c/o the corporate address*
  - *Corporate address is often the corporate seat, regardless of actual physical location*

### Legal certainty should be the primary consideration

- The desire to have clean applicant data for statistical analysis purposes is understood and agreed, but cannot be at the expense of accurate record of legal ownership
- The legal record at the Offices, and efforts to correct typos and minor variants, should remain separate from post-filing data analysis
- Offices should not engage in determining ultimate ownership, corporate structure, etc.
- Offices should confirm with Applicant before Applicant Name is presumed to be the same for patent applications in a patent family
- Identifiers should be voluntary and under control of the Applicant so that proper differentiation between legal entities can be maintained
- In the event a typographical name error or name variant is identified by an Office, Applicant should be consulted prior to change
  - If Applicant is not consulted prior to change, Applicant should be advised after the change, so that future errors can be avoided

The purpose of this presentation is to provide educational and informational content and is not intended to provide legal services or advice. The opinions, views and other statements expressed by the presenter are solely those of the presenter and do not necessarily represent those of AIPLA.