

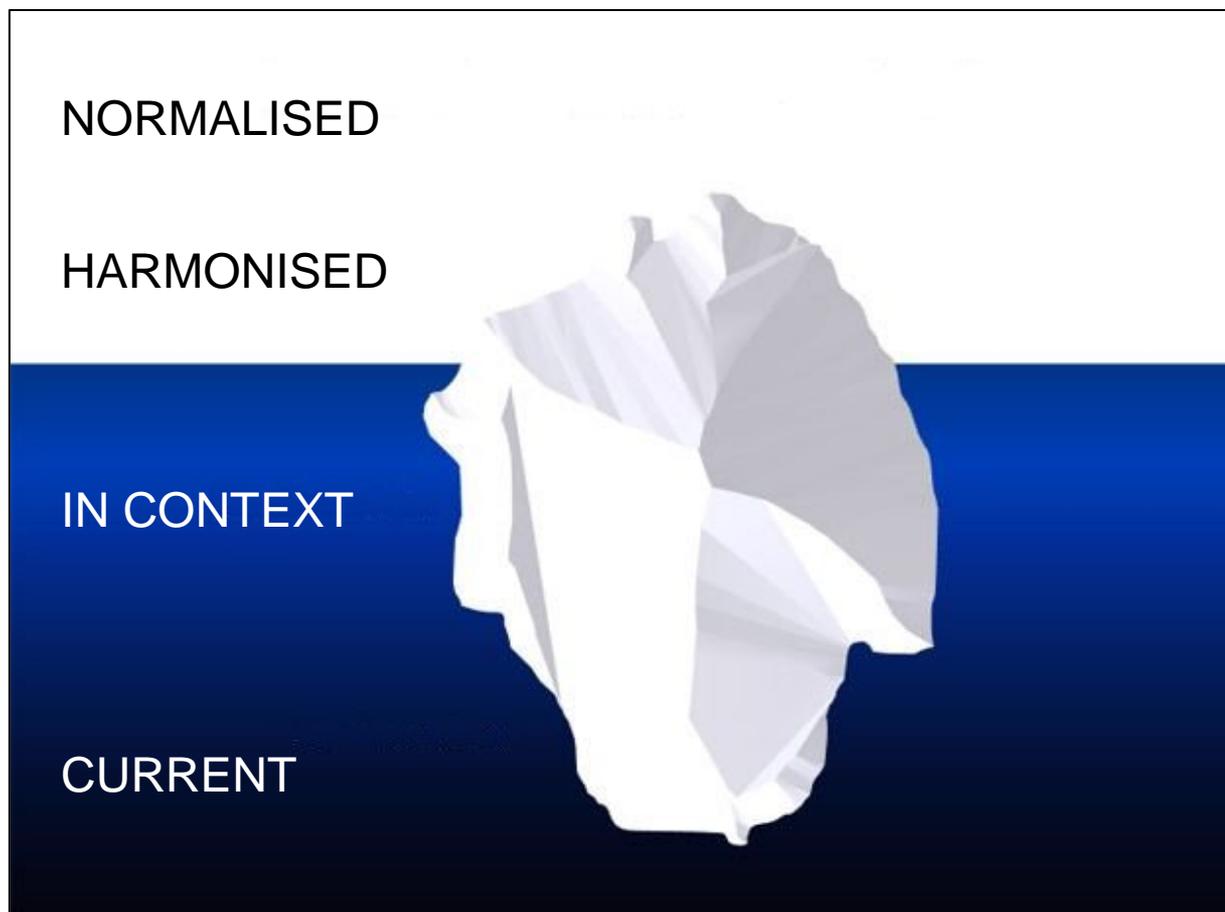


## **Origins of the problem – why is this happening?**

Stephen Adams,  
Vice-Chair, PIUG, Inc.



# 'Open' assignee data – but hidden dangers!





## What do we mean by “standardised information” ?

1. Normalised (error correction)
  - rationalising “trivial” spelling variations/contractions
2. Harmonised (authority lists)
  - designating a preferred form
3. In context (corporate structure)
  - locating each record within an agreed ontology
4. Current (accurate ownership record)
  - keeping dynamic information up-to-date



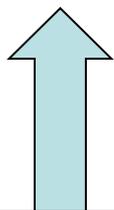
## Level 1 : Normalisation

- Most patent offices accept (and reproduce) an applicant or assignee name exactly as supplied.
- Mistakes or inconsistencies are not always corrected before publication.
  - Some applicants (particularly SMEs) are inconsistent in how they record their own name.
  - Patent offices may be reluctant to correct even 'obvious' mistakes.

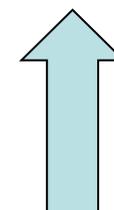


## A genuine example – UKIPO data

Patent application	Applicant name as filed	Variant number
IT 93 BO A 0254	G.D SpA	1
IT 93 BO A 0255	G.D. S.p.A.	2
IT 93 BO A 0256	G D Società per Azioni	3
IT 93 BO A 0257	G.D. S.p.A.	2
IT 93 BO A 0261	G.D Società per Azioni	4



5 sequentially numbered patent applications, all filed on the same day in the same office by the same applicant.



4 *different variations* on the same company name, producing *different index entries*.



## Does action by the patent office help? KIPO initiative Dec 2014

- From 23 Dec 2014, KIPRISPlus contains standardised English and Korean applicant names.
  - standardised Korean names were available from June 2013.
- Pre-2009, applicant names were not controlled at all prior to data entry
- The standardisation process has resulted in the elimination of c. 6% of the uncontrolled applicants list
  - down from 1.30 to 1.22 million names
  - personal and corporate names included
  - 980,000 available in both languages



## Level 2 : Harmonisation

- Current applicant data collection concentrates on the correct legal form of an applicant name
  - **BUT** the “well-known” form of a corporate name is not always the same as the legal form.
- Patent information should be accessible and useful to *all* user communities, not just the legal profession.
  - Therefore, applicant data should be collected and stored in alternative (“industry-preferred”) forms as well.
  - This can be achieved in the form of “authority lists” of corporate names.



# Why do we get the current ambiguity?

1. Some corporate entities choose to use different company forms in each jurisdiction, for legal reasons
  - Results in variation within and across patent families
2. The 'popular' name of a company may be far-removed from the formal 'legal' name;



**L'Air Liquide** used to be "*L'Air Liquide, Société Anonyme pour l'Etude et l'Exploitation des Procédés Georges Claude*"



**Agip**

- Most users know about **Agip** but not "*Azienda Generale Italiana Petroli*"

**3M**

- Very few everyday users refer to "*Minnesota Mining and Manufacturing*" rather than **3M**.



## Other factors can also affect the analysis of assignee names

(71) Applicants:

- **SANDOZ LTD.**  
4002 Basel (CH)  
Designated Contracting States:  
**BE CH DK ES FI FR GB GR IE IT LI LU NL PT SE**
- **SANDOZ-PATENT-GMBH**  
79539 Lörrach (DE)  
Designated Contracting States:  
**DE**
- **SANDOZ-ERFINDUNGEN**  
Verwaltungsgesellschaft m.b.H.  
1235 Wien (AT)  
Designated Contracting States:  
**AT**

a) Treatment of multiple applicants:  
One assignee – or three?

b) Treatment of individual name forms:  
Listed under 'D' in the name index!

(71) Applicant(s):  
**Dr.Ing. h.c.F. Porsche Aktiengesellschaft**  
**(Incorporated in the Federal Republic of Germany)**  
**Porscheplatz 1, 70435 Stuttgart, Germany**



# It is possible to control variation using “authority lists”

(12) UK Patent Application		
(21) Application No:	1420171.9	
(22) Date of Filing:	11.02.2013	
Date Lodged:	13.11.2014	
(30) Priority Data:		
(31) 1202622	(32) 15.02.2012	(33) GB
(86) International Application Data:	PCT/EP2013/052652 En 11.02.2013	
(87) International Publication Data:	WO2013/120795 En 22.08.2013	
(71) Applicant(s):	City University (Incorporated in the United Kingdom) Northampton Square, LONDON, EC1V 0HB, United Kingdom	

<b>Applicant / Proprietor</b>	CITY UNIVERSITY Incorporated in the United Kingdom Northampton Square LONDON EC1V 0HB United Kingdom [ADP Number 07140478001]
-------------------------------	---

UKIPO ADP identifiers:  
*not searchable.*

JPO applicant, agent and inventor  
identifiers: *not searchable.*

(71) 出願人	506122327 公立大学法人大阪市立大学 大阪府大阪市住吉区杉本3丁目3番138 号
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# Without any authority list, this is what happens....

APPARATUS FOR TRANSFERRING ELECTROMAGNETIC ENERGY				
Application No.	Publication No.	Applicant	Representative	IPC
EP14819858	WO2015000352	City University of Hong Kong	...	H02J17/00
COMPOSITION FOR PROMOTING COLLAGEN PRODUCTION, FOR PROMOTING ELASTIN PRODUCTION, AND/OR FOR PROMOTING KERATINOCYTE MIGRATION, AND USAGE THEREFOR				
Application No.	Publication No.	Applicant	Representative	IPC
EP14819528	WO2015001891	Public University Corporation Osaka City University	...	A61K8/49 A61K36/18 (+3)
APPARATUS FOR TRANSFERRING ELECTROMAGNETIC ENERGY				
Application No.	Publication No.	Applicant	Representative	IPC
EP14818282	WO2014208105	Osaka City University	...	G01R33/09 H01L43/00
CHANGE ANALYSIS SYSTEM&METHOD				
Application No.	Publication No.	Applicant	Representative	IPC
EP14761958	WO2014207161	The City University	...	A61B3/00
AN APERTURE ARRAY SUBSTRATE DEVICE, A DETECTION SYSTEM AND A METHOD FOR DETECTING ANALYTES IN A SAMPLE				
Application No.	Publication No.	Applicant	Representative	IPC
EP14733152	WO2014206968	Dublin City University	...	G01N21/25 G01N33/543

Authority lists can be prepared by a number of different bodies (patent offices, company registration authorities, commercial publishers) – but it is important that *one* takes responsibility.

City University of Hong Kong

The City University

Osaka City University

Dublin City University



## Level 3 : Information in context

- Corporate structures may change even during the life of a single patent, or small family.
- Mergers and acquisitions may involve some or all of the IP assets of a target entity.
- Potential purchasers or licensees need to be able to establish who has controlling interest in the assets
  - this may not be obvious from the original published proprietor name



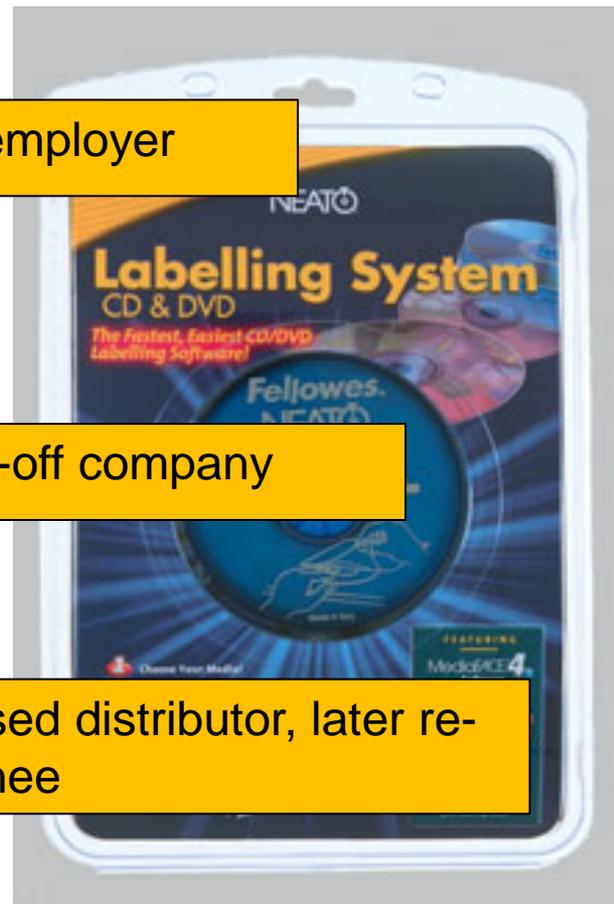
## Example 1 – an extended patent family from an SME invention

- US 5543001, granted 1996
  - Micropatent
- US 5902446, granted 1999
  - Neat-O LLC
- US 6196290, granted 2001
  - Neato LLC
- US 6321814, granted 2001
  - Neato LLC
- US 6431237, granted 2002
  - Fellowes Inc.
- US 6595258, granted 2003
  - Fellowes Inc.

Inventor's employer

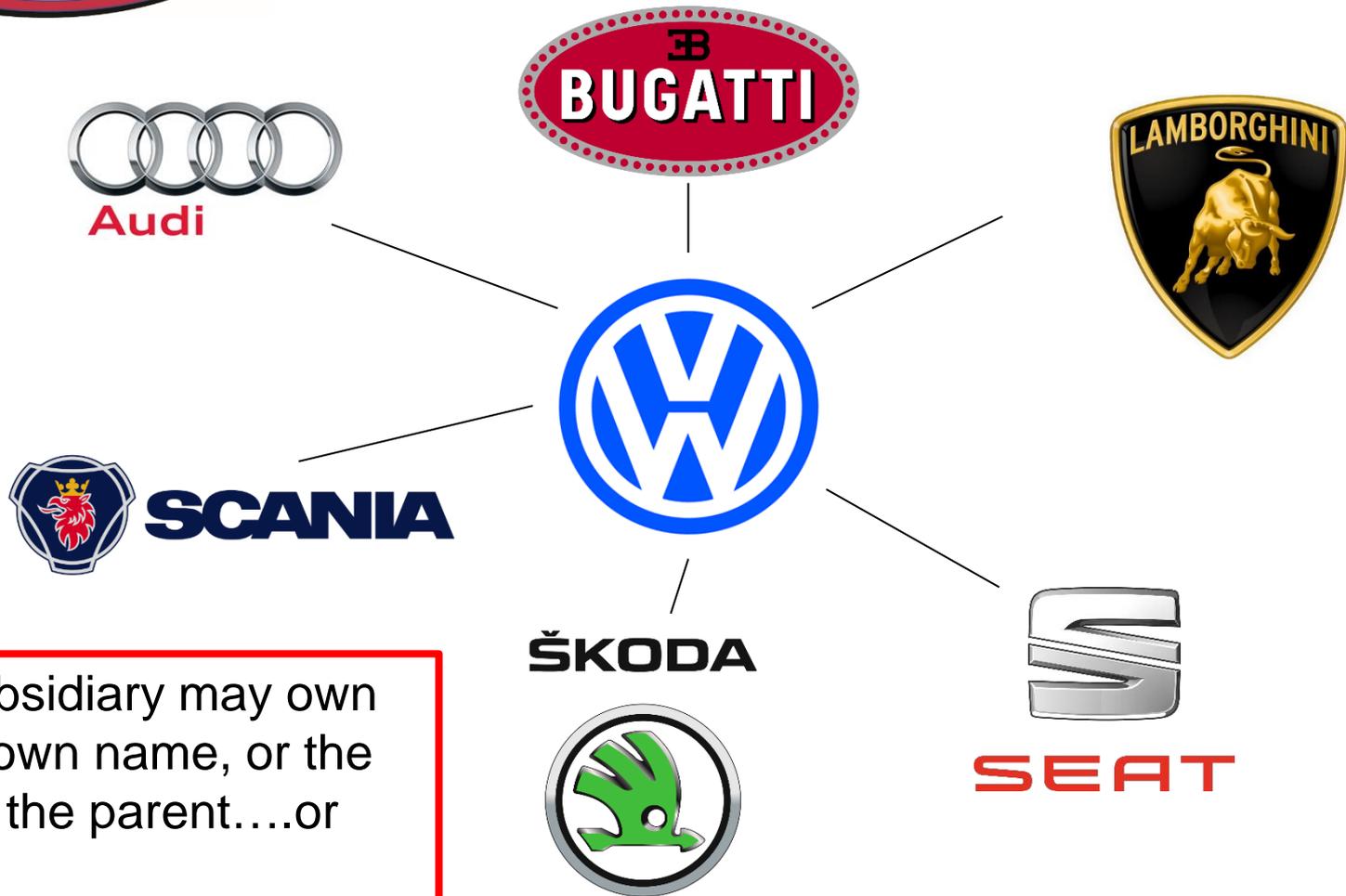
Spin-off company

Licensed distributor, later re-assignee





## Example 2: a large corporate group





# 1996: formation of Novartis

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UK ▾ / World ▾ / Business ▾ / People / Science / Environment ▾ / Media ▾ / Technology / Education ▾ / Images / Obit

News > Business

## Ciba-Geigy and Sandoz to merge into £40bn giant

Pharmaceutical fusion: Biggest merger in history will create `Novartis`, the world's second-largest drugs group, while bid spotlight turns on Zeneca

**MAGNUS GRIMOND** | Friday 08 March 1996

Source: www.independent.co.uk, 8 Mar 1996



# 2003: Sandoz re-born. Thanks, Novartis! ☹️

Novartis to Unite Its Generics Businesses Under One Single Global Brand: Sandoz

New Name to Strengthen Recognition as a World-Leading Generics Manufacturer

g+ 0 Like 0 Tweet 0 in Share 0 Email 0 Share 4

January 21, 2003 05:05 ET | Source: Novartis

BASEL, Switzerland and KUNDL, Austria, Jan. 21, 2002 (PRIMEZONE) -- Novartis (NYSE:NVS) today unveiled plans to unite its 14 Generics company brands under a single global umbrella name, "Sandoz," to strengthen recognition and leverage share of voice in the highly competitive marketplace for generics (off-patent medicines). The initiative capitalises on the strong reputation of the Sandoz name, which still commands a high level of awareness and trust among physicians, pharmacists and patients.

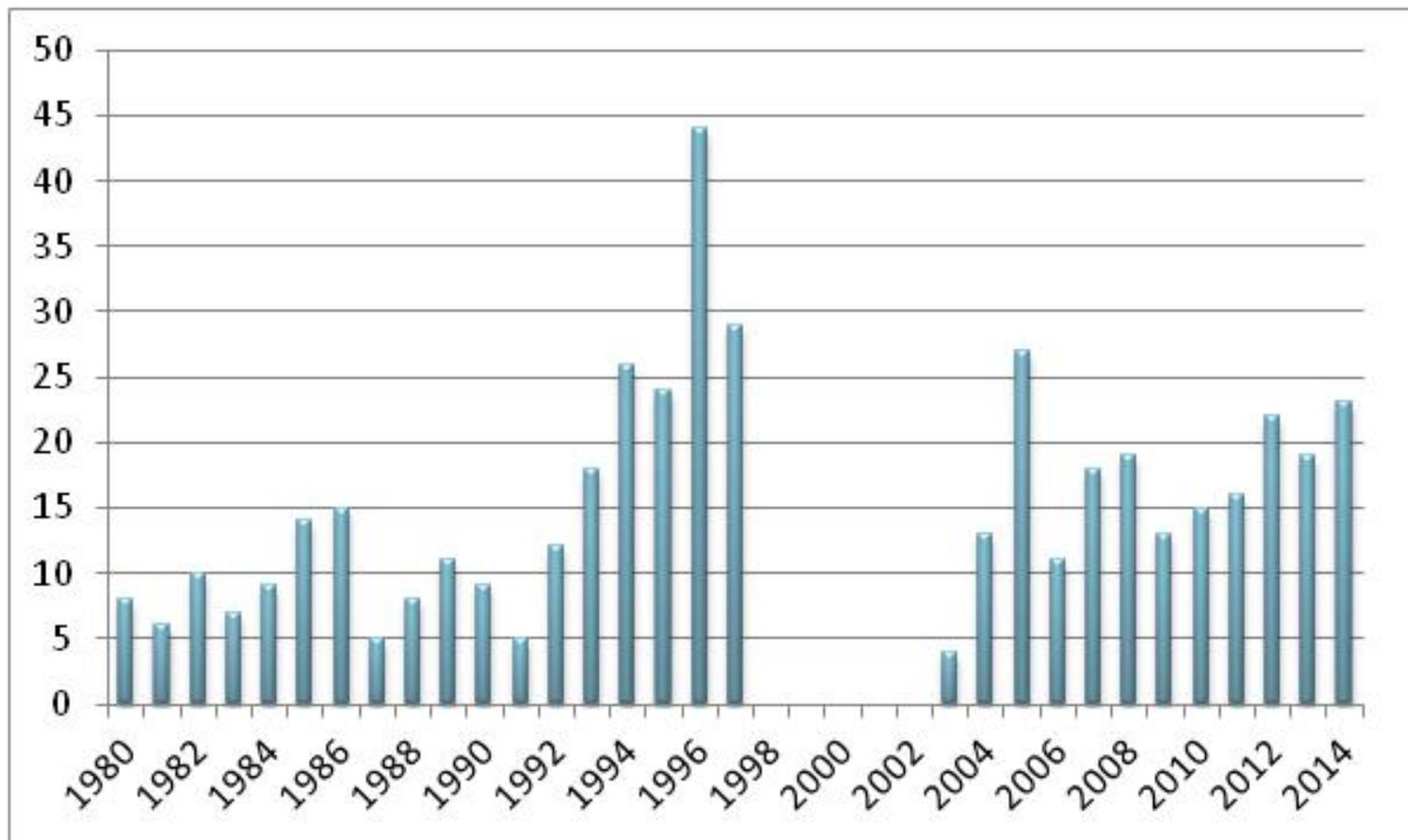
PROFILE  
Novartis

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Source: www.globenewswire.com, 21 Jan 2003



## Published PCT applications in the name of 'Sandoz' as corporate applicant; 1980-2014





## **Level 4 : Keeping it current.**

**Legal identity -v- published identity**

- Bibliographic patent databases typically only show the assignee *at the time of publication*.
- Databases which contain more than one family member / publication stage may *appear* to show a change in ownership
  - it is *always* necessary to check the status of each family member in order to verify this – other factors may be at work....



# The problems of maintaining currency

- Without authority files, IP rights may appear to belong to companies with similar, identical or re-used names.
- The same IP right may belong to a different entity at different stages in its life, including during pendency.
- Most patent offices do not require timely reporting (or any reporting) of changes of ownership.
- Patent owners complain about the administrative burden of recording changes in large portfolios.
- Rights may be recorded as re-assigned for other purposes (e.g. tax benefits) whilst the original owner is still the principal beneficiary.



# Variation in legal identity of assignees? – or not? (I)

⑨ Europäisches Patentamt  
European Patent Office  
Office européen des brevets

⑪ Publication number: **0 219 348 A2**

⑬ **EUROPEAN PATENT APPLICATION**

⑰ Application number: 86307955.4      ⑲ Int. Cl.4: **G 06 F 15/20**

⑳ Date of filing: 14.10.86

---

㉓ Priority: 16.10.85 US 787893

④③ Date of publication of application: 22.04.87 Bulletin 87/17

⑦① Applicant: **SPERRY CORPORATION**  
1290 Avenue of the Americas  
New York, NY 10104 (US)

⑨ Europäisches Patentamt  
European Patent Office  
Office européen des brevets

⑪ Publication number: **0 219 348 A3**

⑬ **EUROPEAN PATENT APPLICATION**

⑰ Application number: 86307955.4      ⑲ Int. Cl.4: **G06F 15/20**

⑳ Date of filing: 14.10.86

---

㉓ Priority: 16.10.85 US 787893

④③ Date of publication of application: 22.04.87 Bulletin 87/17

⑥⑧ Designated Contracting States: **DE FR GB IT**

⑥⑧ Date of deferred publication of the search report: 01.02.89 Bulletin 89/05

⑦① Applicant: **HONEYWELL INC.**  
Honeywell Plaza  
Minneapolis Minnesota 55408(US)

⑦② Inventor: Zweifel, Terry L.  
7250 North 30th Drive  
Phoenix Arizona 85021(US)

⑦④ Representative: Singleton, Jeffrey et al  
ERIC POTTER & CLARKSON 27 South Street  
Reading Berkshire, RG1 4QU(GB)

④③ Date of publication of application:  
22.04.87 Bulletin 87/17

⑥⑧ Date of deferred publication of the search report:  
01.02.89 Bulletin 89/05

On 10 Mar 1988, the EPO received a request to re-assign 48 pending applications from Sperry Corp. to Honeywell Inc.



# Variation in legal identity of assignees? – or not? (II)

Europäisches Patentamt  
European Patent Office  
Office européen des brevets

Publication number: **0 405 782 A1**

EUROPEAN PATENT APPLICATION

Application number: 90306326.1  
Date of filing: 11.06.90  
Int. Cl.<sup>5</sup>: C07D 251/30, C07D 253/07, A01N 43/66, A01N 43/707

Priority: 28.06.89 GB 8914797  
13.11.89 GB 8925612

Date of publication of application: **02.01.91 Bulletin 91/01**

Designated Contracting States:  
AT BE CH DE DK ES FR GB GR IT LI LU NL SE

Applicant: **IMPERIAL CHEMICAL INDUSTRIES PLC**  
Imperial Chemical House, Millbank  
London SW1P 3JF(GB)

Inventor: Clough, John Martin  
7 Gypsy Lane  
Marlow, Buckinghamshire(GB)  
Inventor: Streeting, Ian Thomas

Europäisches Patentamt  
European Patent Office  
Office européen des brevets

Publication number: **0 405 782 B1**

EUROPEAN PATENT SPECIFICATION

Date of publication of patent specification : **13.04.94 Bulletin 94/15**  
Int. Cl.<sup>5</sup> : **C07D 251/30, C07D 253/07, A01N 43/66, A01N 43/707**

In June 1993, Zeneca Limited was formed as a spin-out from ICI plc. Only part of the IP was re-assigned; the ICI Group continued to exist.

**43** Date of publication of application:  
**02.01.91 Bulletin 91/01**

**45** Publication of the grant of the patent :  
**13.04.94 Bulletin 94/15**

Fungicides.

Priority : 28.06.89 GB 8914797  
13.11.89 GB 8925612

Date of publication of application :  
02.01.91 Bulletin 91/01

Publication of the grant of the patent :  
**13.04.94 Bulletin 94/15**

Proprietor: **ZENECA LIMITED**  
Imperial Chemical House, 9 Millbank  
London SW1P 3JF (GB)

Inventor: Clough, John Martin  
7 Gypsy Lane  
Marlow, Buckinghamshire (GB)  
Inventor: Streeting, Ian Thomas  
36 Valley Crescent  
Wokingham, Berkshire (GB)



# Patent offices currently have very limited powers to help

PATENT BLOG JOBS PATENTLYO ETHICS JOURNALS

America's leading patent law source

## Whither the USPTO's Authority to Require Ownership Recordation

February 10, 2014 • Dennis Crouch

By Dennis Crouch

The USPTO has proposed a new set of **proposed rules** that would require recordation of patent ownership rights, including the ultimate parent entity of any patent owner. Some question whether the USPTO actually have the authority to make these rules. The basics of federal agency authority begins at zero. That is, an agency has no authority to act until given authority by Congress. Because the longstanding nature of Patent Office activities, some of these authorities may flow from explicit statutory authority while others may flow from very longstanding practice.

The USPTO has long-maintained a registry of patent ownership, although the Patent Act only implicitly suggests as much. 35 U.S.C. § 261 provides that an assignment of patent rights (or other conveyance) "shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months." Section 161 suggests that the USPTO must have authority to create and organize its system of recordation. However, there are no statutory provisions that particularly provide that authority.

35 USC §261: An assignment .... shall be void as against any subsequent purchaser .... unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase...

79 FR 4105 (2014): Notice of Proposed Rulemaking, "Changes To Require Identification of Attributable Owner": The Office is ... proposing that the attributable owner be identified on

- filing of an application ...
- when there is a change in ... owner during pendency...
- at the time of issue fee and maintenance fee payments, and
- when a patent is involved in supplemental examination, ex parte reexamination, or a trial proceeding before the ... PTAB.

Source: <http://patentlyo.com>



## Post-grant reassignments can happen for a variety of reasons...

The New York Times

Business Day

SEPTEMBER 29, 2014

### Drug Patents Held Overseas Can Pare Makers' Tax Bills

By ANDREW POLLACK

As the O, the patent rights have been transferred to an Irish subsidiary. moving their headquarters overseas, the makers of some of the world's most lucrative and expensive medicines are using another tactic to reduce their payments to the government.

Take the case of Gilead Sciences, which has come under severe criticism for the high cost of its in-demand new hepatitis C drug, Sovaldi, which sells for \$1,000 a pill, or \$84,000 for a typical course of treatment.

Although Gilead, the developer of Sovaldi, is an American company based in Foster City, Calif, the patent rights have been transferred to an Irish subsidiary. So Gilead's profits from the booming sales of Sovaldi are taxed at Ireland's rate, which is well below the American one.

Source: New York Times 29 Sep 2014



# Who can contribute to standardisation?

Level of standardisation	Applicant	Patent Office	Third party (*)	Proprietor(s)
Normalised	+	+	+	+
Harmonised		+	+	
In context	+		+	
Current		+		+

(\*) e.g. commercial database producers, national government agencies



# Solutions to the problems?

- Level 1:
  - Empower patent offices to maintain authority files; insist upon the use of unique identifiers at the point of application.
- Level 2:
  - Patent offices and third parties should work together to develop existing national identifiers into an international thesaurus of harmonised corporate names, applied across worldwide data.
- Level 3:
  - Applicants should be encouraged to disclose ultimate parent / beneficiary as well as legal applicant.
  - Third parties should work with government agencies to create and maintain accurate corporate trees, *including* proper archiving policies.
- Level 4:
  - Patent offices should be given powers to require timely, frequent and complete reporting of changes in legal ownership and ultimate beneficiary.



# Do not underestimate the issues; good databases require investment!

**Tregothnan** [+ info](#)

**eSearch Plus**  
No preview

**Trade mark information**

Trade mark number	<b>004713178</b>
Type	<b>Word</b>
Filing date	<b>27/10/2005</b>
Registration date	<b>26/09/2006</b>
Nice Classification	<b>3, 30, 31</b>
Trade mark status	<b>Registered</b>
Basis	<b>EUTM</b>
Reference	<b>LHM/T0193001</b>

**Owner information**

Owner ID number	<b>239434</b>
Owner name	<b>Evelyn Arthur Hugh Boscawen</b>

**Representative information**

Representative ID num...	<b>48602</b>
Representative name	<b>STEPHENS SCOWN LLP</b>

**Last publication**

02/04/2014	<b>C.2.2</b>
------------	--------------

Owner ID number	<b>239434</b>
Owner name	<b>Evelyn Arthur Hugh Boscawen</b>

Non-identical 'unique' identifiers....

**TREGOTHNAN** [+ info](#)

**eSearch Plus**  
No preview

**Trade mark information**

Trade mark number	<b>013778394</b>
Type	<b>Word</b>
Filing date	<b>26/02/2015</b>
Registration date	<b>29/06/2015</b>
Nice Classification	<b>30, 35, 43</b>
Trade mark status	<b>Registered</b>
Basis	<b>EUTM</b>
Reference	<b>BOSC-11-10</b>

**Owner information**

Owner ID number	<b>681969</b>
Owner name	<b>Evelyn Arthur Hugh Boscawen</b>

**Representative information**

Representative ID num...	<b>48602</b>
Representative name	<b>STEPHENS SCOWN LLP</b>

**Last publication**

01/07/2015	<b>B.1</b>
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Owner ID number	<b>681969</b>
Owner name	<b>Evelyn Arthur Hugh Boscawen</b>