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

<table>
<thead>
<tr>
<th>Patent application</th>
<th>Applicant name as filed</th>
<th>Variant number</th>
</tr>
</thead>
<tbody>
<tr>
<td>IT 93 BO A 0254</td>
<td>G.D SpA</td>
<td>1</td>
</tr>
<tr>
<td>IT 93 BO A 0255</td>
<td>G.D. S.p.A.</td>
<td>2</td>
</tr>
<tr>
<td>IT 93 BO A 0256</td>
<td>G D Società per Azioni</td>
<td>3</td>
</tr>
<tr>
<td>IT 93 BO A 0257</td>
<td>G.D. S.p.A.</td>
<td>2</td>
</tr>
<tr>
<td>IT 93 BO A 0261</td>
<td>G.D Società per Azioni</td>
<td>4</td>
</tr>
</tbody>
</table>

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”
   • Most users know about Agip but not “Azienda Generale Italiana Petroli”
   • Very few everyday users refer to “Minnesota Mining and Manufacturing” rather than 3M.
Other factors can also affect the analysis of assignee names

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”

UKIPO ADP identifiers: not searchable.

JPO applicant, agent and inventor identifiers: not searchable.
Without any authority list, this is what happens....

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.
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

Each subsidiary may own IP in its own name, or the name of the parent….or both!
1996: formation of Novartis

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

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

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.

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.
On 10 Mar 1988, the EPO received a request to re-assign 48 pending applications from Sperry Corp. to Honeywell Inc.
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.
Patent offices currently have very limited powers to help

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...

Drug Patents Held Overseas Can Pare Makers’ Tax Bills

By ANDREW FOLLACK
SEPTEMBER 29, 2014

As the Obama administration moves 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.
### Who can contribute to standardisation?

<table>
<thead>
<tr>
<th>Level of standardisation</th>
<th>Applicant</th>
<th>Patent Office</th>
<th>Third party (*)</th>
<th>Proprietor(s)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Normalised</td>
<td>+</td>
<td>+</td>
<td>+</td>
<td>+</td>
</tr>
<tr>
<td>Harmonised</td>
<td></td>
<td>+</td>
<td>+</td>
<td>+</td>
</tr>
<tr>
<td>In context</td>
<td>+</td>
<td></td>
<td>+</td>
<td></td>
</tr>
<tr>
<td>Current</td>
<td></td>
<td>+</td>
<td></td>
<td>+</td>
</tr>
</tbody>
</table>

(*) 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!

Non-identical ‘unique’ identifiers…. 