

## **Global Assignment Project Gains Momentum**

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Introduction by Thomas Valente, IPO Senior Director for Global Affairs

### *Introduction*

Harmonization of patent procedures can have many benefits for IP owners and their attorneys, ranging from cost-savings to error avoidance. It can also result in the creation of multi-national platforms, such as Global Dossier, that result in more transparency in the IP system. Further, procedural harmonization should be easier to move forward on a more immediate timeline than projects that would require significant substantive changes to patent laws.

Enter the Global Assignment project. As described by Phil Soo below, filing patent assignments in a number of countries with different requirements creates unnecessary burdens for IP owners and their attorneys and creates barriers to transparency. As a result, the idea of a global patent assignment was raised by IPO and other members of IP5 Industry during meetings with the heads of the IP5 Offices (the patent offices of China, Europe, Japan, Korea, and the U.S.).

The IPO harmonization team, led by Daniel Staudt (Siemens Corp.), who currently serves as IPO's President, decided to make global assignment a priority. IPO formed a Global Assignment Subcommittee that has taken the lead on this issue by gathering information from our members and creating potential global assignment forms. Other IP5 Industry Groups and the IP5 Offices have provided helpful feedback to guide the efforts of IPO's Subcommittee. The project continues to see forward progress, which can be largely credited to the work of the Subcommittee's members.

### *The Issue*

IP owners currently record assignment documents in patent offices all over the world to secure IP ownership rights and preserve rights to license and enforce their IP. Yet different jurisdictions impose different formats and other requirements. This leads to increased costs for users, redundancy in documentation, opportunities for error, difficulties in locating inventors who depart before inventor assignments are executed, and lack of transparency to third parties. These problems are magnified when dealing with large patent portfolios that might be encountered in a merger, sale, or acquisition, or when there is a change of control or renaming of a company.

### *Global Assignment Forms*

Over the last year, IPO's Global Assignment Subcommittee has evaluated assignment requirements in a number of jurisdictions for both company-to-company and inventor-to-company assignments. It has identified common and differing national requirements for assignments. Based on this evaluation, the Subcommittee has created a global assignment form for each type of assignment based on the requirements of those jurisdictions and identified

differences in requirements between countries that would need to be resolved to achieve true harmonization.

### *A Universal Database*

A universal database of global assignments would provide great transparency for the benefit of not just IP owners, but for third parties. Inspiration can be drawn, for example, from WIPO's Digital Access Service (DAS) and Patent Information Initiative for Medicines (Pat-INFORMED), which facilitate access to priority documents and medicine patent information, respectively.

### *Current Status*

IP5 Industry is well situated to examine assignment requirements in major jurisdictions, because IP5 Industry members regularly record assignments for patent rights around the globe. IPO's Subcommittee has received helpful feedback from other IP5 Industry members to improve the assignment forms and their accompanying annotations. This feedback has been accounted for in the latest revisions to the forms, which are being circulated within IP5 Industry for additional feedback.

The IP5 Offices have provided helpful general feedback on the project, covering issues such as the expected timeframe for its completion, potential limitations, and suggested areas of cooperation. The Global Assignment project has gained traction and remains on the IP5 agenda.

### *Conclusion*

Benefits of a global assignment include greater legal certainty, improved efficiency, savings for users on ministerial tasks associated with assignment documents, which could be spent more productively on innovation and IP filings, and increased transparency of IP ownership globally. Having one portal recognized by all the major IP offices would result in significant cost savings, while eliminating administrative burdens from differing recordal requirements. The project continues to gain momentum, and IPO is hopeful that a Global Assignment will be implemented in the future.

IPO extends its appreciation to the many international IP owners and law firms participating in this effort, including 3M, ALG India Law Offices, Blakes Cassels & Graydon LLP, Daniel IP, ipan/Delegate Group, Ericsson, Fukami Patent Office, Google, Hewlett Packard Enterprise, Kasznar Leonardos, Lee International, Liu, Shen & Associates, Murgitroyd, Olivares, Schwegman Lundberg & Woessner, Shell, Simmons & Simmons, and Smart & Biggar.