



Intellectual<sup>®</sup>  
Property  
Owners  
Association

25-26 FEBRUARY 2020  
IP5 ICG MEETING

# **GLOBAL ASSIGNMENT: RESPONSE TO INFORMATION REQUEST BY IP5 OFFICES**

**BACKGROUND**

# THE CURRENT SYSTEM

- IP owners currently record assignment documents with various patent offices to secure IP ownership rights and preserve rights to license and enforce such IP
- Yet, different jurisdictions impose different formats and requirements

# WHY A GLOBAL ASSIGNMENT IS NEEDED

The current system leads to:

- High costs for users
- Documentation that is redundant, requiring excess work
- Many opportunities for error
- Difficulties in locating inventors who depart before assignments occur
- Potentially prohibitive costs and complications for small- and medium-sized entities (SMEs)
- Less transparency for third parties

# IP5 INDUSTRY PROCESS

- Conducted a landscape analysis of requirements in nearly twenty jurisdictions
- Draft forms were discussed among IP5 industry groups and revised
- Potential processes for filing the forms were also discussed
- The IP5 Offices provided constructive input on the topic, which IP5 Industry has taken into account

# RESPONSE TO INFORMATION REQUEST

# DRAFT UNIVERSAL ASSIGNMENT FORM

IP5 Industry has developed two documents which are still under discussion, but which we plan to finalize for the Offices' review in the near future:

- A very simple basic application for global assignment of IP rights that would facilitate data sharing between the Offices
- A more detailed document for entity-to-entity assignments, which would be a template filed with the simple basic application and modified by applicants if necessary
- There is also value in having a recordable inventor-to-entity assignment document, but IP5 Industry agrees that entity-to-entity assignments are the best place to begin

# LEGAL EFFECT- IP5 INDUSTRY ANALYSIS

- Differing requirements in the jurisdictions reviewed include witness, signature, and recordal requirements
- Many of these requirements are easily harmonized in a document
- Other requirements could be easily harmonized by recording in one place, with the same set of recordal requirements
- IP5 Industry hopes the few remaining differences would eventually be set aside by countries imposing them in order to participate in the global assignment system

# LEGAL EFFECT – INDUSTRY EXPECTATIONS

- Although IP5 Industry believes the template for entity-to-entity assignments generally meets the requirements of the IP5 and other major jurisdictions, each filer would be responsible to modify the template if a designated jurisdiction has additional requirements
- The IP5 Offices could recognize the documents proposed by IP5 Industry and the process for filing them without providing an opinion on whether the form meets the substantive requirements of each designated jurisdiction

# THE PROCESS FOR FILING THE FORM

- Once a form is agreed upon, the initiative could allow the filing of a global assignment in one location that would be recognized worldwide
- A universal depository for recording may also provide the maximum benefit for IP owners, third parties, and the public

# CREATING A UNIVERSAL DEPOSITORY

- Having one depository recognized by multiple offices would result in:
  - Cost savings
  - Reduction of administrative burdens
  - Allowing third parties, Offices, and the public to determine with ease who owns which patents in which jurisdictions
  - Capacity building for developing nations

# LEGAL REQUIREMENTS FOR RECORDING

- Having one universal depository should not create an issue with fulfilling local legal requirements for recording
- Recordal requirements would be set by the universal depository
- The IP5 Offices should be able to meet their statutory obligations as well
  - For example, because the documents could be securely exchanged among the Offices, the USPTO system could automatically record the document when received from the universal depository to meet statutory requirements

# POSSIBILITY OF RECORDING AT WIPO

- As discussed at the 2019 IP5 Heads of Office Meeting with Industry, WIPO could potentially provide a universal depository for global assignment recordal
- WIPO's Digital Access Service could be looked at as a starting point, as it already allows priority documents and similar documents to be securely exchanged between participating intellectual property offices

# ALTERNATIVE TO GLOBAL DEPOSITORY WITH AN ACTIVE COMPONENT?

- The global assignment application and template could be filed in one Office at the choice of the rights owner
- The receiving Office could then share the document electronically with the other designated Offices
- This would have some, but not all, of the benefits of recording in a universal depository

# ADDITIONAL ISSUES

- IP5 Industry believes participation by rights holders should be optional, but that the form and its filing should be recognized globally
- IP5 Industry also believes, however, that the benefits of the global assignment system would create great incentives for rights holders to use the system
- This would create efficiencies for the users and the Offices, and increased transparency in the system
- Due to the COVID-19 pandemic, the need for universal acceptance of electronic signatures for assignments is now clearer than ever before, and these should be accepted in the context of a global assignment

**CONCLUSION**

# SUMMARY

- The process to date has been very productive
- IP5 Industry is hopeful that the Offices will agree to global assignment as a new PHEP project
- The project is one with great potential benefits for both users, the Offices, and the public, and is achievable within the envisioned timeframe
- We look forward to working with the Offices to make this vision become a reality

**FOR MORE INFORMATION:**

**Intellectual Property Owners Association  
(IPO)**

1501 M Street, NW

Suite 1150

Washington, DC 20005

Phone: 202-507-4500 Fax: 202-507-4501

Web: [www.ipo.org](http://www.ipo.org)

