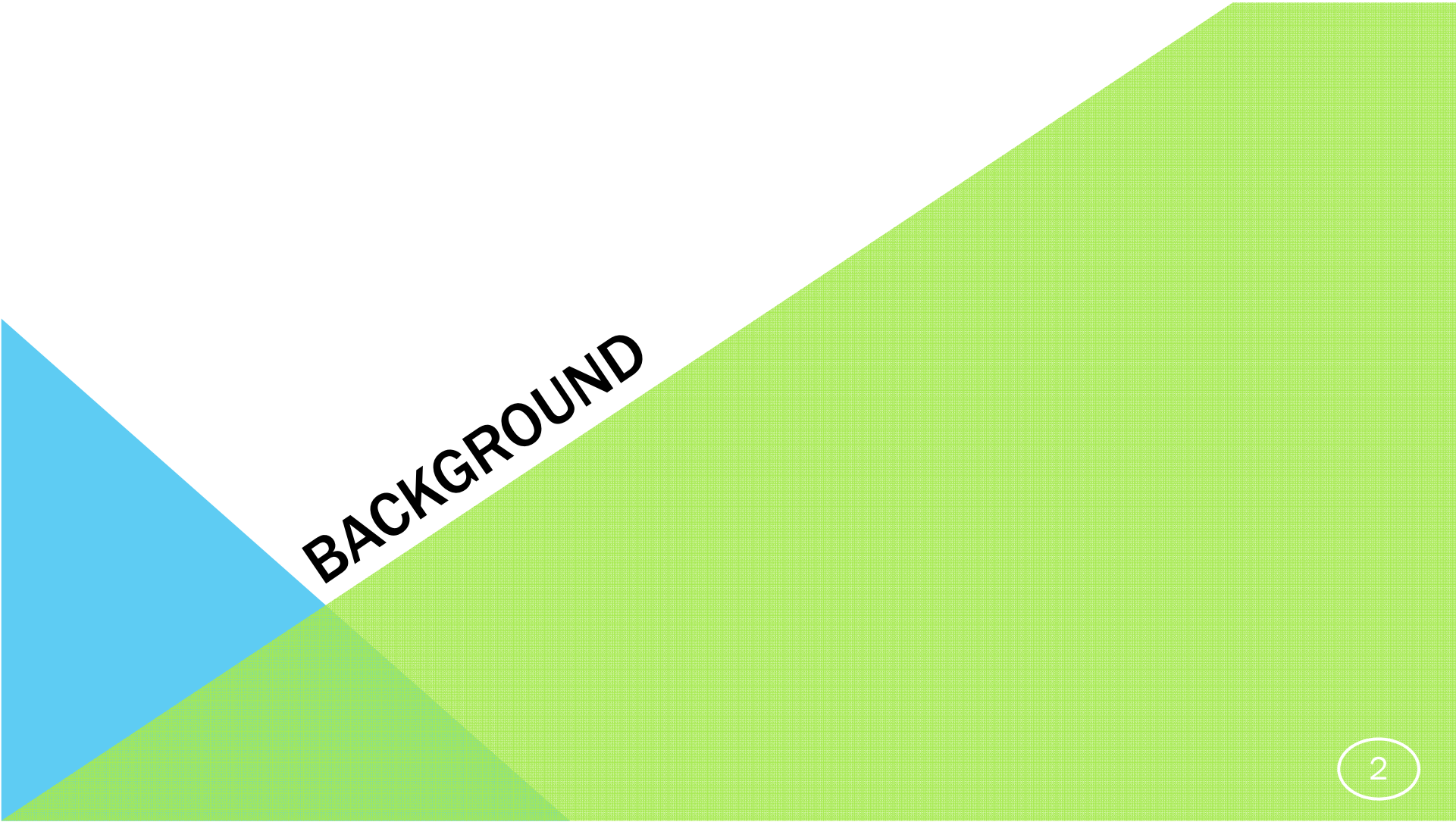




Intellectual[®]
Property
Owners
Association

SUMMIT OF THE GLOBAL NETWORK OF
NATIONAL IP PRACTITIONER
ASSOCIATIONS
14 SEPTEMBER 2022

GLOBAL ASSIGNMENT: AN OVERVIEW

The background features a white space with a blue triangle on the left side and a large green textured area on the right side. The green area has a fine, grid-like pattern. The word "BACKGROUND" is written in black, bold, uppercase letters, slanted upwards from left to right, positioned over the boundary between the blue triangle and the green area.

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:

- Use of resources for administrative tasks that could better be used to support innovation and related IP work
- Potentially prohibitive costs and complications for small- and medium-sized entities (SMEs)
- Less transparency for third parties and the public
- Documentation that is redundant
- Many opportunities for error
- Difficulties in locating inventors who depart before assignments occur, especially for priority filings

IP5 PROCESS

- IP5 Industry:
 - Conducted a landscape analysis of requirements in nearly twenty jurisdictions
 - Prepared draft global assignment forms and discussed potential processes for filing the forms
- Following information exchange between the IP5 Offices and IP5 Industry, the IP5 Offices accepted global assignment as a Patent Harmonization Expert Panel (PHEP) project



DETAILS OF GLOBAL ASSIGNMENT SYSTEM

DRAFT UNIVERSAL ASSIGNMENT FORM

- IP5 Industry developed two documents:
 - 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 the IP5 will begin with entity-to-entity assignments

LEGAL EFFECT- IP5 INDUSTRY ANALYSIS

Currently:

- Differing requirements in the jurisdictions reviewed include witness, signature, and recordal requirements

Proposal:

- Many of the different requirements are easily harmonized by allowing the filing of “one document in one place” with the same set of recordal requirements
- IP5 Industry anticipates that the few remaining differences can be resolved to provide the benefit of participating in the global assignment system

LEGAL EFFECT – INDUSTRY EXPECTATIONS

- **Filer Responsibility to Modify:** 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
- **Office Opinion on Substance of Form Not Necessary:** The Offices could accept the template proposed by IP5 Industry as procedurally acceptable for filing without providing an opinion on whether the template meets the substantive requirements of each designated jurisdiction

THE PROCESS FOR FILING THE FORM

- **Single Filing Worldwide:** The initiative would allow the filing of a global assignment in one location that would be recognized worldwide
- **Use of E-Signatures Envisioned:** E-signatures should be accepted to facilitate ease of filing
- **Optional Participation:** IP5 Industry proposes that participation by rights holders should be optional, but believes that that the benefits of the system would create great incentives for rights holders to use the system
- **Benefits:** A universal depository for recording would provide greater efficiency, cost management, accuracy, and transparency for IP owners, third parties, and the public

BENEFITS OF A UNIVERSAL DEPOSITORY

Having one depository recognized by multiple offices would result in:

- Allowing third parties, Offices, and the public to determine with ease who owns which patents in which jurisdictions
- Cost savings and cost management transparency
- Reduction of administrative burdens
- Capacity building for developing nations

POSSIBILITY OF RECORDING AT WIPO

- 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



CONCLUSION

SUMMARY AND NEXT STEPS

- The project is one with great potential benefits for users, the Offices, and the public
- The work with IP5 Industry has been very productive and Global assignment is now an IP5 PHEP project
 - Next report expected at IP5 Industry Consultation Group Meeting (March of 2023)
- IP5 Industry suggests that technical work on the global assignment database might continue in parallel (e.g., at WIPO)

FOR MORE INFORMATION:

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