

January 31, 2014

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via Email: saurabh.vishnubhakat@uspto.gov

RE: Response to “Request for Comments on Methods for Studying the Diversity of Patent Applicants” 78 Fed. Reg. 72064 (December 2, 2013)

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views with respect to the “Request for Comments on Methods for Studying the Diversity of Patent Applicants” as published in the December 2, 2013 issue of the Federal Register (the “Notice”). 78 Fed. Reg. 72064. The Notice seeks comments on how to study the diversity of patent applicants before the U.S. Patent and Trademark Office (USPTO) pursuant to the Leahy-Smith America Invents Act (AIA) Section 29.

AIPLA is a national bar association with approximately 15,000 members engaged in private and corporate practice, in government service, and in academia. AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent and trademark law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA welcomes this opportunity to comment on the USPTO’s request for comments concerning methods of studying the diversity of patent applicants.

INTRODUCTION

The Notice specifically states that the USPTO “is interested in gathering information on approaches for studying the diversity of patent applicants in accordance with research methodology developed as required by the [AIA]. To assist in gathering this information, the USPTO invites the public to provide comments on collecting information on the diversity of patent applicants consistent with the AIA.”

AIPLA recognizes the importance of diversity and, specifically, the importance of the USPTO's efforts to study the diversity of patent applicants. We hope that the collection and analysis of data on the diversity of patent applicants encourages the USPTO to develop outreach efforts that target specific groups of underrepresented patent applicants. While we understand the importance of this study, AIPLA believes that the collection of personal identifying information and demographic information directly from patent applicants should be collected on a voluntary basis, as discussed below.

Each of the questions raised in the USPTO's Request for Comment are addressed below.

ANALYSIS

1. How and by which methods should the USPTO effectively study patent applicant diversity in accordance with the expressed intent of Congress in Section 29 of the AIA?

Notwithstanding the method used to study patent applicant diversity, AIPLA believes that the collection of demographic information from patent applicants should be voluntary.

AIPLA believes that one of the most effective methods for the USPTO to study patent applicant diversity is to collect such data at the filing of patent applications. For example, the USPTO can amend the cover sheet filed with provisional and non-provisional patent applications to include a line item for the inventor to voluntarily list his or her gender, ethnic background (i.e., White/Caucasian, African American, Hispanic, Asian, Other, and Rather Not Say) or whether they are a military veteran or not. In particular, the USPTO can initially focus on capturing this information from the cover sheet filed with provisional patent applications. The advantage of focusing on the provisional patent application cover sheet is that the diversity of all patent applicants can be captured since many inventors, especially solo inventors, fail to convert provisional patent applications to non-provisional patent applications.

Another effective method for the USPTO to study patent application diversity is for the USPTO to amend the oath and declaration filed with a patent application to a line item for the inventor to voluntarily list his or her gender, ethnic background, or whether or not they are a military veteran.

2. Should the USPTO conduct surveys of patent applicants to obtain demographic data such as race, gender, age, and geography, of inventors as a group?

AIPLA believes that conducting surveys would be an effective way to obtain demographic data. Such surveys may be more effective if also administered at the time that a notice of allowance has issued. An inventor may be more forthcoming with diversity information after he or she believes that it is unlikely to affect issuance of the patent.

AIPLA also believes that any regulations should expressly state that any responses to survey questions will have no impact on the patentability or enforceability of the patent. AIPLA is

concerned that if the answers provided could potentially be the subject of discovery during subsequent litigations, on the belief that any perceived discrepancy in an answer will allow an attack on the validity or enforceability of any resulting patent, then applicants will be discouraged from voluntarily participating in the survey.

3. Aside from surveys, how can the USPTO effectively collect personal identifying information about U.S. and non-U.S. patent applicants in order to study applicant diversity through improved data matching, analytics, and studies?

(a) Should the USPTO collect certain personal identifying information about U.S. and non-U.S. patent applicants on a mandatory basis or on a voluntary basis? How would each of these approaches affect the accuracy of the information being provided?

As discussed above, AIPLA believes that personal identifying information about U.S. and non-U.S. patent applicants should be collected on a voluntary basis. While collecting personal identifying information on a mandatory basis may result in a larger collection of personal identifying information, AIPLA believes that the burden on the patent applicant and intrusion on the patent applicant's personal information outweighs the benefit of the USPTO collecting personal identifying information on a mandatory basis. In addition, AIPLA questions whether the mandatory collection of personal identifying information may violate federal and/or state laws.

(b) Can the USPTO effectively collect personal identifying information from other institutions or organizations about U.S. and non-U.S. patent applicants?

AIPLA believes that the USPTO can effectively collect personal identifying information from other institutions or organizations about U.S. and non-U.S. patent applicants. . For example, the USPTO may request corporations and companies applying for a patent to provide personal identifying information for inventors. However, there may be some limitations on the effectiveness of the data collected from international applications or from international patent offices. First, AIPLA does not know whether other patent offices request and collect personal identifying information. Second, some of the racial classifications applicable to the U.S. may not appropriately apply to data received from other countries. For example, a PCT national stage application under 371 that claims priority to a PCT application filed in an Asian country might classify the applicant as Asian even though the applicant is a Caucasian working in Asia. Notwithstanding, AIPLA believes that the USPTO should seek to avoid double counting of personal identifying information that may be provided to the USPTO or other institutions or organizations about patent applicants.

4. What particular personal identifying information should the USPTO seek (or not seek) in order to more effectively study applicant diversity? Why?

AIPLA believes that at a minimum it would be relevant to seek personal identifying information related to the applicant's gender and race and whether the applicant is a military veteran. AIPLA identifies these categories of personal identifying information since such categories are the only categories of personal identifying information specifically listed in Section 29 of the AIA. AIPLA also believes that it would be relevant to seek personal identifying information related to age, sexual orientation, geography, military status (for example veteran, active duty, reserve), and disability status. Since the stated goal of the Notice is to gather information about the diversity of patent applicants, there should not be any limits on the type of personal identifying information that the USPTO should seek to achieve its stated goal.

Again, all collection of any such data should be on a voluntary basis.

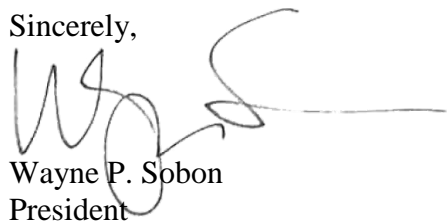
CONCLUSION

AIPLA believes that studying the diversity of patent applicants is important. Further, the collection of personal identifying information from patent applicants is critical to the development of this study. However, the collection of such data should be voluntary.

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Thank you for allowing AIPLA the opportunity to provide comments on this important initiative. AIPLA looks forward to further dialogues with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,



Wayne P. Sobon
President

American Intellectual Property Law Association