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OFFICE OF PETITIONS

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WASHINGTON, DC 20005-3096

In re Application of :
Sang Bong Lee et al. :
Application No. 10/962,357 : DECISION ON PETITIONS
Filed: October 8, 2004 :

This is a decision on the petition, filed April 6, 2009 and supplemented May 12, 2009 under 37 C.F.R. 1.181(a)(3) requesting that the Director exercise his supervisory authority and designate the March 5, 2009 petition decision a final agency decision for the purposes of judicial review and reverse the conclusion in the March 5, 2009 decision regarding ownership of the above-referenced application.

The petition is **DENIED**¹.

BACKGROUND

On January 24, 2005, a signed declaration was filed in the present application identifying Sang Bong Lee (Lee) and Yong Jin Yang (Yang) as the first and second inventors, respectively. Also, on August 23, 2005, an assignment of rights from Lee and Yang to Komipharm International Co., Ltd. (Komipharm) was recorded at reel 016661 and frame 0653, but incorrectly identified the application to which it applies as 10/962,257 rather than the present application, 10/962,357.

A petition filed on April 28, 2008 by McDermott Will & Emery LLP on behalf of Komipharm provides, on page 2, that Yang is the president of Komipharm and not an inventor in the present application as indicated on the original declaration and assignment recorded at reel 016661 and frame 0653. This petition attempted to correct the inventorship through the deletion of Yang and addition of Bernardus Rademaker (Rademaker) such that the inventive entity would be recognized as Rademaker and Lee as the first and second inventors, respectively. A decision dismissing this petition was mailed on September 17, 2008.

On November 12, 2008, Komipharm filed a revocation of power of attorney and appointment of new attorney by an assignee under 37 C.F.R. 1.36(a).

A request under 37 C.F.R. 1.48(a), filed November 17, 2008, desired to delete Yang and Lee entirely and set forth Rademaker as the sole inventor. This request was accompanied by a

petition under 37 C.F.R. 1.183 requesting a waiver of the rules to permit the deletion without the cooperation of Lee. Lee opposes his deletion as inventor.

On March 5, 2009, the request under 37 C.F.R. 1.48(a) was dismissed along with the petition under 37 C.F.R. 1.183 requesting a waiver of the rules to permit the deletion without the cooperation of Lee. The March 5, 2009 decision also prevented Komipharm from revoking the power of attorney and appointing a new attorney under 37 C.F.R. 1.36(a).

The petition requesting that the Director exercise his supervisory authority was then filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

35 U.S.C. 116 provides, in part, that:

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

37 C.F.R. 1.48(a) provides that:

If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. 3.54 provides that:

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

37 C.F.R. 3.71(b) provides that:

The assignee(s) who may conduct either the prosecution of a national application for patent or a re-examination proceeding are:

- (1) *A single assignee*. An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or
- (2) *Partial assignee(s) together or with inventor(s)*. All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

37 C.F.R. 1.36(a) provides in pertinent part that:

... the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

The Manual of Patent Examining Procedure (MPEP) 2301 provides in pertinent part that:

An interference is a contest under 35 U.S.C. 135(a) between an application and either another application or a patent. An interference is declared to assist the Director of the United States Patent and Trademark Office in determining priority, that is, which party first invented the commonly claimed invention within the meaning of 35 U.S.C. 102(g)(1).

OPINION

Petitioner asserts that 37 CFR 1.48 was not applied correctly and, in any event, an extraordinary situation exists for a waiver of 37 CFR 1.48 under 37 CFR 1.183. Also, petitioner requests that

the March 5, 2009 petition decision be designated as a final agency decision so that Petitioner may seek judicial review of that decision under the APA with the desire of having the substantive issue of inventorship determined. After reconsideration, the decision of March 5, 2009 is maintained.

35 U.S.C. 116 is not so liberal that it provides for the resolution of inventorship disputes by way of petition and the protections afforded by 37 C.F.R. 1.48 are consistent with that statute, contrary to petitioner's contention. Since the provisions of 37 C.F.R. 1.48 should not be casually cast aside through a waiver under 37 C.F.R. 1.183, the requirements of 37 C.F.R. 1.48(a) must be satisfied before inventorship will be changed absent an extraordinary circumstance supporting the waiver.

In particular, 37 C.F.R. 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) A request to correct the inventorship that sets forth the desired inventorship change; (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47; (4) The processing fee set forth in § 1.17(i); and (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

The petition filed November 17, 2008 clearly lacks the statement from Lee that the error in inventorship occurred without deceptive intention on his part. The record shows that Lee was presented with an opportunity to make such a statement but did not make the statement as he disagrees with his deletion as inventor.

Lee's refusal to make this statement cannot be remedied through a petition under 37 C.F.R. 1.47. See MPEP 201.03 II.A. On very infrequent occasions, the requirements of 37 C.F.R. 1.48(a) have been waived upon the filing of a petition and fee under 37 C.F.R. 1.183 (along with the request and fee under 37 C.F.R. 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). Here, the facts of record do not unequivocally support the correction sought since the question of inventorship between the diverse parties is vigorously contested.

Furthermore, a petition under 37 C.F.R. 1.183 must show that an extraordinary situation exists in which justice requires waiver of the rules. However, there is no evidence of record showing that such an extraordinary situation exists or that justice requires the requested waiver. The numerous documents and explanations of record establish that a dispute exists, but do not present a conclusive determination on inventorship that establishes an extraordinary situation. For example, the record does not include a decision regarding inventorship from an appropriate forum. Petitioner should note that disputes regarding inventorship may be addressed by the USPTO through an interference proceeding before the Board of Patent Appeals and Interferences. See MPEP 2301. Such a dispute cannot be resolved by petition under 37 C.F.R. 1.48(a). As 37 C.F.R. 1.48(a) is intended as a simple procedural remedy and does not represent a

substantive determination as to inventorship, the numerous papers filed relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in this *ex parte* proceeding in determining whether the record unequivocally supports the correction sought. Accordingly, the USPTO will not relax the requirements of 37 C.F.R. 1.48 by way of petition under 37 C.F.R. 1.183.

Petitioner further challenges the alleged determination that Komipharm is not currently the *owner* of the entire right, title, and interest in the instant application based upon the assignment documents filed. However, the decision of March 5, 2009 never made a determination of ownership. As noted in the decision, "while documents may be characterized as 'assignments' and recorded with the USPTO under 37 C.F.R. 3.11, the recording of a document with the USPTO is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. See 37 C.F.R. 3.54. That is, the recording of a document with the USPTO is merely a ministerial act and not an Office determination of the effect of the assignment document on the ownership of the patent property." Rather, the "assignment" documents recorded with the USPTO were considered to determine the extent to which Komipharm may take action in the application pursuant to 37 C.F.R. 3.54, and the determination was made that Komipharm may not act as assignee of the entire right, title, and interest in the instant application.

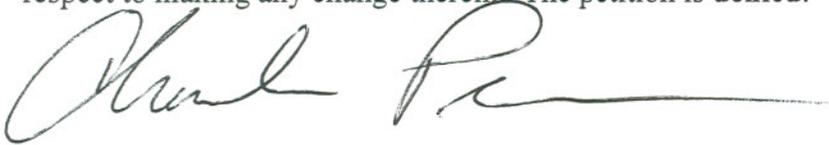
The determination that Komipharm may not act as assignee of the entire right, title, and interest in the instant application has been reconsidered and is maintained. The record offers an agreement made between Komipharm, Yang and Lee on May 16, 2005 [Exhibit 3 of the November 17, 2008 petition] as evidence of the transfer of all of Lee's rights to Komipharm. This agreement shows, among other things, that Komipharm, Yang and Lee are co-owners of any intellectual property resulting from the subject invention (section 3 (1) and (2)) and that Yang and Lee only delegated to Komipharm the power to dispose of the products (e.g.: intellectual property) related to the invention, including the grant of a license to a third party (section 4 (2)). This agreement merely establishes a business relationship between Komipharm, Yang and Lee in which each of Yang and Lee had a one-third ownership interest in the invention. Also, since the delegation by Yang and Lee to Komipharm of the power to dispose of the products (e.g.: intellectual property) related to the invention is not a transfer of ownership, neither Yang nor Lee delegated an ownership interest by this agreement.

The record further offers a letter of confirmation from Komipharm to Lee, signed August 11, 2005, [Exhibit 5 of the November 17, 2008 petition] as evidence that Lee bargained for and received consideration for the assignment of his ownership rights to Komipharm before signing the assignment of the instant application. However, this letter, as translated, expressly states that "On May 16, 2005, 'B' (Yang) and 'C' (Lee) entered into an agreement by which 'B' (Yang) and 'C' (Lee) gave to 'A' (Komipharm) the power to dispose of patent rights for Kominox. The contents of the assignment agreement currently requested for the U.S. Patent Office is in line with the above agreement. ... The old agreement continues to be valid and effective even after 'B' (Yang) and 'C' (Lee) assign the applicantship to 'A' (Komipharm) for the U.S. patent application." Rather than addressing consideration, this letter confirmed that Lee retained his ownership interest, as previously agreed, and merely gave to Komipharm the power to dispose of patent rights for the invention recognized as Kominox.

None of the documents recorded in the USPTO for the instant application establish that Lee transferred his entire right, title, and interest in the instant application to Komipharm. Accordingly, the recorded documents do not show that Komipharm is the assignee of the entire right, title, and interest in the instant application. Moreover, the record identifies Yang as the president of Komipharm and not an inventor in the present application, and rights to a patent application are assigned first by inventors. Yang did not have the rights of an inventor to assign to Komipharm. Therefore, the record does not show that Komipharm is currently an assignee with the right to act in the instant application. Komipharm cannot act as the assignee with the entire right, title, and interest in the instant application to revoke a power of attorney and appointment a new attorney under 37 C.F.R. 1.36.

DECISION

The Decision on Petition mailed March 5, 2009 is maintained as set forth above. The petition is granted to the extent that the decision of March 5, 2009 has been reviewed, but is denied with respect to making any change therein. The petition is **denied**.



Charles Pearson
Director, Office of Petitions

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02.