

February 5, 2018

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United States Patent and Trademark Office
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Dear Deputy Commissioner Bahr:

We respectfully request that the United States Patent and Trademark Office (USPTO) revise all rules that require disclosure of information relating an inventor's residential address, except in cases of *pro se* inventor applicants where there is no alternative means of contacting the applicant. In the interim, we further request that the USPTO consider *sua sponte* waiving the requirements in the current rules, *e.g.* 37 C.F.R. 1.76. This request is in keeping with the Presidential Executive Order Nos. 13771 and 13777 and the USPTO's Notice to Eliminate Unnecessary Regulations [83 Fed. Reg. 2759 (Jan. 18, 2018)] to reduce the burden on the public by eliminating unnecessary regulations.

Oblon represents a large number of foreign and domestic corporate clients. Those clients have raised privacy concerns regarding the disclosure of information relating to the residential addresses of inventors. The concerns are centered upon two specific issues: (1) the impending implementation of Regulation No. 2016/679 in the European Union (EU) and (2) identify theft.

On May 25, 2018, EU Regulation No. 2016/679, a/k/a the General Data Protection Regulation (GDPR), will enter into force in the EU. The GDPR strictly regulates the disclosure of any data that could be used to directly or indirectly identify a person (*i.e.* "personal data"), including, *e.g.* information relating to the residential addresses of individuals. Under the GDPR, a corporate applicant may not disclose personal data of EU resident-inventors without their documented affirmative consent which can be easily withdrawn. A person can even exercise the "right to be forgotten" under the GDPR and demand that their personal data be erased. Generally, the GDPR applies to EU organizations as well as non-EU organizations that provide services or goods in the EU.

Upon objection by an employee-inventor, an EU corporation (or even a U.S. corporation with EU resident employee-inventors) would be precluded under the GDPR from disclosing any information relating to the residential address of the objecting inventor. Any organization breaching the GDPR could result in maximum fines of up to 4% of annual global turnover or €20 million whichever is greater. Thus, if an inventor objects to the disclosure of information

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pursuant to the GDPR, an EU corporate assignee is placed in the untenable position of having its patent applications in the United States refused or denied because they fail to meet regulatory requirements or facing monetary penalties in the EU and being forced to withdraw the disclosed personal information in addition to civil remedies.

As a general matter, concerns regarding the potential for identity theft have also been raised. In recent years, there have been a number of targeted hacks of government databases that have resulted in the disclosure of large volumes of personal data. While in the abstract, a home address may seem less valuable to identity thefts, there have been recent reports of identity theft based solely upon discovery and use of a residential address. *See, e.g.,* <https://nypost.com/2017/06/03/scammers-can-steal-your-identity-just-by-using-your-address/>.

We gratefully acknowledge that the USPTO has affirmatively addressed the risk of identity theft. *See, e.g.,* 1360 OG 248 (Nov. 23, 2010) (decision to collect and publish only the city and country of origin of each inventor). However, the collection and inclusion of inventors' residential information in Public Pair continues to raise identity theft concerns. Inventors of commercially successful inventions may be a target of identity theft. Even the inclusion of the city, state, and country of origin may be sufficient to provide identity thieves with a means of identifying individual inventors.

It appears upon our review of the USPTO's use of an inventor's residential information, that use is largely restricted to occasions where the inventor is a *pro se* applicant and the residential address is necessary for correspondence regarding the prosecution of the application. This situation would be an exception under the GDPR because the data subject (the natural person who owns the data) is affirmatively disclosing their own personal information. Likewise, the risk of identity theft in this situation is a known risk and a consequence of choosing to prosecute one's application *pro se*.

We look forward to the USPTO's consideration of this issue and appreciate your attention to this important matter.

Sincerely,

OBLON, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



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