

From:

Sent: Tuesday, June 01, 2010 5:17 PM

To: extended_missing_parts

Cc: Janna Tom; William Tucker; Wendy Streitz

Subject: Request for Comments on Proposed Change to Missing Parts Practice

Dear Ms. Jones:

Attached are comments provided by the University of California in response to the USPTO request for comments on the proposed change to the Missing Parts Practice. (75FR16750)

Thank you for the opportunity to comment.

Janna Tom

Research Policy Manager



OFFICE OF RESEARCH AND GRADUATE STUDIES

Innovation Alliances and Services
1111 Franklin Street, 5th Floor
Oakland, California 94607-5200
Tel: (510) 587-6000
Fax: (510) 587-6090

June 1, 2010

Submitted via e-mail to extended_missing_parts@uspto.gov

Ms. Eugenia A. Jones
Senior Legal Advisor
Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUBJECT: Request for Comments on Proposed Change to Missing Parts Practice (75FR16750)

Dear Ms. Jones:

The University of California (UC) is pleased to respond to the request for comments issued on April 2, 2010, by the U.S. Patent and Trademark Office (USPTO) regarding a proposed change to the missing parts practice. UC is comprised of ten research-intensive campuses, and is involved in the management of three national laboratories, each of which files patent applications on discoveries made in their laboratories. Strong and predictable patent protection can provide an incentive for industry partners to invest the effort and resources in developing a university invention into a useable product.

Many university inventions, however, are very early stage, requiring additional research, time and resources before a company is interested in pursuing any of the myriad ways a technology can benefit the public. Until such time, the university must either tap into its limited resources to seek patent protection on promising, but early stage, inventions, or let the opportunity pass by. Any strategies that can help to limit or delay prosecution costs or provide greater flexibility in seeking patent protection for early stage, high-risk university inventions would be welcomed. Therefore, UC supports the proposed change to the missing parts practice.

The USPTO indicates that it is considering an optional international style search report. Having the option to obtain such a report during the pendency of the provisional application would provide a

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valuable tool as one determines the appropriate path toward protecting and commercializing a new technology. UC supports the proposed option to secure a international style search report.

UC appreciates the thoughtful consideration and creative approaches that the USPTO leadership is pursuing to develop a variety of potentially useful tools for patent applicants while easing the burdens of the examining staff.

Sincerely,



William T. Tucker
Executive Director
Innovation Alliances and Services

cc: VP Research and Graduate Studies Beckwith
Managing Counsel Simpson