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April 24, 2014

Submitted via e-mail to [AC90.comments@uspto.gov](mailto:AC90.comments@uspto.gov)

Mail Stop Comments-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Mr. James Engel, Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy

SUBJECT: Notice of Proposed Rulemaking 79 FR 4105  
Changes to Require Identification of Attributable Owner

Dear Mr. Engel:

This letter is in response to the January 24, 2014 Federal Register Notice of Proposed Rulemaking (NPRM) in which the United States Patent and Trademark Office (USPTO) proposes changes to require identification of attributable owner(s) in an effort to promote greater transparency concerning the ownership of patent applications and patents. While we support the USPTO's goal of improving the patent system, we have serious concerns about elements of this Federal Register Notice and the challenges of complying with these requirements that may lead to inadvertent loss of patent rights. Therefore, we request the USPTO to withdraw this NPRM.

The University of California is comprised of ten research-intensive campuses and is involved in the management of three national laboratories, each of which is actively engaged in the transfer of research discoveries to industrial partners who use them to make products that benefit the public. Usually, a company will not invest the substantial time, resources, and capital necessary to turn an innovation into a commercial product unless the invention has patent protection. Thus, secure patent protection is critical to the transfer of technologies from academia to the private sector.

We agree with and strongly echo the concerns raised in the comment letter submitted by the higher education associations, AAU, ACE, AAMC, APLU, AUTM, and COGR. The ability of university licensors and our industry licensees to comply with these requirements, especially within the proposed

timeframes, and without harming legitimate business interests is questionable, and the penalty for non-compliance, i.e., abandonment of the patent application, is extremely severe. We are especially disturbed that if implemented, the proposed rule will force us into the untenable position of having to disclose to the USPTO sensitive or confidential information of our licensees, which may prejudice their willingness to license our technologies. In the case of existing licensees, the proposed rule could force us to choose between breaching our license agreements or risking the forced abandonment of our patents. These proposed requirements would establish yet another hurdle and be counterproductive to the many efforts in the Federal and State governments, Congress, academia, financing community, and private sector to accelerate the transfer of technologies for the public benefit.

Thank you for the opportunity to provide comments on these proposed rules. We hope the USPTO will seriously reconsider these proposed rules and withdraw them from consideration. We look forward to continuing the open dialogue with the USPTO on ways to improve the patent system.

Sincerely,



William T. Tucker  
Executive Director, Innovation Alliances and Services  
University of California, Office of the President

Cc: Associate Vice President Falle  
Managing Counsel Simpson  
Executive Director Streit  
Associate Director Tom  
Council on Governmental Relations