

**BEFORE THE
UNITED STATES PATENT AND TRADEMARK OFFICE
U.S. DEPARTMENT OF COMMERCE**

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Changes to Require Identification)
of Attributable Owner)
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Docket No. PTO-P-2013-0040

Submitted to: AC90.comments@uspto.gov

**COMMENTS OF THE
WISCONSIN ALUMNI RESEARCH FOUNDATION**

The Wisconsin Alumni Research Foundation (“WARF”) respectfully submits these comments in response to the Notice of Proposed Rulemaking (“NPR”) issued on January 13, 2014 by the United States Patent and Trademark Office (“USPTO”) concerning changes to the rules of practice to improve the examination of patent applications and to provide greater transparency concerning patent applications and ownership. 79 Fed. Reg. 405 (Jan. 24, 2014).

WARF supports the aspirational goals underlying the NPR: to ensure the highest quality patents, to disclose to the public information about patent ownership, and to enhance technology transfer and reduce costs associated with patent licensing and related transactions. However, the proposed rules do not meet these goals and therefore WARF submits that the NPR should be withdrawn.

BACKGROUND

WARF is a private, nonprofit patent licensing organization for the University of Wisconsin–Madison. Pursuant to agreements, WARF also represents the patent interests of the University of Wisconsin System through its non-profit subsidiary, WiSys. The WARF mission,

to support scientific research at the University of Wisconsin, is accomplished by transferring university technology to the marketplace for the benefit of the university, the inventors and the public. Licensing income is returned to the university to fund further scientific research.

WARF was founded in 1925 and is a pioneer and innovator among university-based technology transfer offices. Over its 89-year existence, WARF has not only protected the fruits of scientific research, it has actually contributed close to \$1 billion of licensing income to cutting-edge UW-Madison scientific research. Of greater significance is the fact that WARF's technology transfer successes have had a profound and positive effect on the welfare, health, and safety of humankind. For more information about discoveries patented and licenses by WARF, *see* our website (<http://www.warf.org>).

COMMENTS OF HIGHER EDUCATION ASSOCIATIONS

WARF is aware of the comments of the higher education associations (“higher ed comments”) and wishes to associate itself with those comments. The benefits of the proposed rules do not justify the burdens. As observed by the associations, “[t]he proposed rules will not enhance innovation or technology transfer, and may actually have the opposite effect.” Given the potentially adverse consequences, coupled with the fact that congressional activities are ongoing on patent transparency issues, WARF agrees with the conclusion in the higher ed comments that the USPTO should withdraw the proposed regulatory requirements.

The higher ed comments focus on the definition of “Attributable Owner” as “an entity necessary to be joined in a lawsuit in order to have *standing* to enforce the patent or any patent resulting from the application.” *See* page 4119 in proposed 37 CFR 1.271(a)(2) (emphasis added). Indisputably, the USPTO may decide questions of patentability in a reexamination proceeding without regard to the “case and controversy” requirements of Article III of the

Constitution. But a federal court cannot review USPTO decisions unless Article III jurisdiction is present. The requirement of an injury-in-fact provides the “hard floor of Article III jurisdiction” *Summers v. Earth Island Institute*, 555 U.S. 488, 497 (2009). Accordingly, standing is a conclusion of law with constitutional ramifications. Because standing can become an issue raised before a federal appellate court even without any parties raising it in an administrative proceeding, this fact potentially raises the possibility of a party acting in good faith later being penalized. This misallocation of authority in Section 1.271 to an administrative tribunal serves as one example of why the NPR should be withdrawn.

Respectfully yours,

Carl Gulbrandsen
Managing Director
Wisconsin Alumni Research Foundation

April 24, 2014