

From: David Brown

Sent: Monday, November 05, 2012 3:57 PM

To: fitf_guidance

Subject: Proposed First-Inventor-to-File Rules (77 Fed Reg 43742 and 77 Fed Reg 43759) -- Comments from Brigham Young University

This e-mail constitutes the comments of Brigham Young University ("BYU") relating to the USPTO's proposed Changes to Implement First Inventor to File Provisions of the Leahy-Smith America Invents Act (77 Fed Reg 43742) and Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act (77 Fed Reg 43759).

As of this writing, three academic and research institutions have submitted comments: (1) a group of six higher education associations, (2) the University of California, and (3) the Wisconsin Alumni Research Foundation ("WARF"). These institutions have articulated well the concerns of university technology transfer offices relating to the proposed regulations.

BYU writes to join in these submitted comments. The proposed regulations would weaken the statutory grace period, thereby impairing the ability of universities to simultaneously (1) share inventions with the world and (2) obtain patent protection for such inventions so that they can create new businesses and new jobs. As WARF stated the problem:

"In the PTO's view in order to benefit from a grace period, researchers and investigators are restricted to disclosures of patent claims, whereas other disclosing communications, such as a printed publication explaining an invention or a communication with venture investors, would not be available to serve to disqualify 'prior art.' Such reading of the statute would be an 'absurd' result contrary to the underlying job-creation goals, and the legislative history accompanying the AIA grace period provision,..."

We at BYU do not wish to see U.S. professors deterred from publishing their discoveries. Nor do we wish to see those discoveries – many of which are funded by the federal government – rendered unpatentable and therefore non-commercializable because of a defect in our patent regulations.

We respectfully request, therefore, that the USPTO revise its proposed regulations along the lines suggested by the University of California in Appendix A to its comments.

Respectfully yours,

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