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Sent: Friday, November 19, 2010 3:06 PM

To: HumanitarianProgram

Subject: WARF comments on the USPTO's proposal for fast-track re-exam for humanitarian issues

Please see attached.

**Before the
UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE
Washington, DC**

In the Matter of)

**INCENTIVIZING HUMANITARIAN)
TECHNOLOGIES AND LICENSING)
THROUGH THE INTELLECTUAL)
PROPERTY SYSTEM)**

DOCKET NO. PTO-P-2010-0066

COMMENTS OF THE WISCONSIN ALUMNI RESEARCH FOUNDATION

On September 13, 2010, the United States Patent and Trademark Office (“USPTO”) requested comments regarding a proposed fast-track *ex parte* reexamination voucher pilot program intended to create incentives for technologies and licensing behaviors that address humanitarian needs. *See* 75 Fed. Reg. 57261 (September 20, 2010). The Wisconsin Alumni Research Foundation (“WARF”) agrees that a fast-track reexamination proceeding could allow patent owners to less expensively affirm the validity of their patents, and applauds the USPTO for its leadership and vision on this proposal. At the same time, WARF believes that the greatest opportunity to facilitate humanitarian efforts related to patented technologies is not in the reexamination stage, but in the initial examination stage.

I. Background about WARF

WARF is the non-profit patent licensing organization for the University of Wisconsin-Madison. Created in 1925, WARF was the first university patent licensing organization in the world. Dr. Harry Steenbock, a UW-Madison scientist who discovered a cure for rickets,

obtained a patent and licensed it broadly to the private sector. This partnership eradicated rickets not only in this country but worldwide. This early success, replicated many times, promoted the development and widespread distribution of technologies that address humanitarian needs.

WARF has protected and licensed many technologies (e.g., the blood thinning agent coumadin/WARFarin) whose worldwide lifesaving benefits continue to this day, far exceeding WARF's involvement with the technologies. WARF continues to work to protect and license technologies relevant to orphan medical indications and to problems of particular relevance to the developing world. As one facet of its interest in humanitarian concerns, for the past two years WARF has focused its Gilson Discovery Series seminars, which traditionally relate to entrepreneurship, on business ventures that benefit society by solving problems that affect daily living around the world.

Throughout its entire history, WARF has operated to represent the technology licensing needs of UW-Madison which, as one of this country's premier research universities, has committed itself to the Wisconsin Idea – the boundaries of the University are the boundaries of the State, and indeed the country and the world. Improving humanitarian needs, wherever they occur, is therefore part of WARF's core mission.

II. Discussion

The proposed program has tried, admirably, to consider many different mechanisms by which a patent owner's or licensee's efforts could address humanitarian needs of many different types. However, the extensive administrative burden of trying to provide for and evaluate the requests from applicants for vouchers seems to not be in accordance with the small late-stage benefit provided by such a fast-track reexamination process. Such requests, as they related to

downstream development and commercialization efforts, could take an enormous number of forms and prove exceedingly difficult to evaluate. As a university-associated technology transfer organization that owns and licenses technologies, WARF envisions additional potential complications in the proposed plan related to the fact that the awarding of such a voucher would likely be based on downstream developments and plans related to the work of licensees alone or in collaboration with the university inventors, so a variety of issues could provide significant legal challenges, such as ownership of data, full disclosure of business development plans, and rights to the voucher.

In contrast, WARF sees far more value and benefit in a fast-track examination process, so that potential licensees could confirm at an early stage that adequate protection is available for the patented technology, which would provide motivation to invest earlier in the development, testing, and commercialization of such technologies. Licensing such technologies at an early stage can be critical for ensuring that licensees are willing to invest significant development costs with the expectation that adequate patent life will remain available following commercialization for the intended benefits to be achieved (be they financial or related to humanitarian goals). A fast-track reexamination process that follows a lengthy examination process would not facilitate the licensing and development of a technology as much as a fast-track proceeding for the initial examination.

A fast-track examination process should also simplify the administrative burdens associated with evaluating the program applications, since the focus would be on accelerating the patenting process of specific technologies that promote humanitarian issues, to the benefit of both the patent owners and licensees. An additional mechanism to promote humanitarian practices could involve authorizing qualifying patent applications to pay small-entity fees

throughout patent prosecution. Ultimately, providing a more rapid and less expensive prosecution mechanism should incentivize the protection of technologies that benefit humanitarian uses and research, and would accelerate the rate at which such technologies reach the commercial market and the intended beneficiaries.

Conclusion

In summary, WARF appreciates the opportunity to submit comments in connection with the USPTO's proposal to incentivize humanitarian technologies and licensing through the intellectual property system. WARF applauds the goals of the proposed fast-track *ex parte* reexamination voucher pilot program. However, WARF believes that a fast-track reexamination procedure would not benefit humanitarian causes as much as a more rapid and less expensive process for the initial prosecution, such as that achievable through a fast-track examination program and/or requiring small entity fees during patent prosecution.

Respectfully yours,



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