

From: Mitchel Foote, Jr. [redacted]
Sent: Monday, November 22, 2010 6:26 PM
To: HumanitarianProgram
Cc: [redacted]
Subject: PTO Humanitarian Youth Pilot program

Dear Ms. Chang,

Due to office absences, vacations, etc., we missed the deadline date, but hope that you will still take our comments into consideration.

Thank you,

Mitchel Foote, Jr.

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November 22, 2010

Electronic transmission to *HumanitarianProgram@uspto.gov*
Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Jodi Y. Chang

Re: Request for Comments on Incentivizing Humanitarian Technologies and Licensing Through
the Intellectual Property System (75 FR 57261)

Docket No. PTO-P-2010-0066

Dear Ms. Chang:

The University of California is pleased to have this opportunity to provide input on the U.S. Patent and Trademark Office's (PTO) proposal for a fast-track *ex parte* reexamination voucher pilot program that could incentivize technology creation or licensing that addresses humanitarian needs. The University of California is comprised of ten campuses, each with its own technology licensing office, and is affiliated with three national laboratories who also engage in innovation and licensing activities.

The University of California (UC) supports efforts by the PTO and other organizations to explore novel approaches to incentivize innovative technologies that can benefit mankind by addressing humanitarian needs. UC campuses actively participated in the development of, and heartily endorsed the *Nine Points to Consider in Licensing University Technology* of which the ninth point focuses attention on "unmet needs, such as those of neglected patient populations or geographic areas, giving particular attention to improve therapeutics, diagnostics and agricultural technologies for the developing world." Operationally, UC technology licensing offices are raising awareness of humanitarian uses of technology with prospective licensees and encouraging their participation in this endeavor. An example is UC Berkeley's Socially Responsible Licensing Initiative that seeks the widespread availability of UCB-developed technologies and healthcare products in developing countries.

UC personnel participated in the formal response to this proposal submitted by the higher education associations, and supports the comments submitted by the Association of American Universities and

the Council on Governmental Relations. We would like to take this opportunity to emphasize certain points and provide additional feedback.

We feel that it is important for the PTO to carefully consider how best to identify innovative patents that actually address compelling humanitarian needs. Administratively, the challenge the PTO faces is that documenting actual humanitarian use is difficult at patent filing since the data needed is available only after the product is on the market. On the other hand, providing a fast-track voucher only after product introduction acts as a reward rather than an incentive to invest in technologies that address humanitarian need. In addition, the PTO will need avoid rewarding patents that purport to address humanitarian needs but never result in actual humanitarian benefit.

The University encourages the PTO to consider a broad view of humanitarian needs that can be met with technologies that extend beyond the pharmaceutical industry. For example, availability of potable water could significantly enhance the viability of a whole population whereas a disease-specific therapy may affect a subset of the same population. In addition, humanitarian needs exist in developing and developed countries as many diseases are global in nature and impacted populations exist in every country.

The PTO proposes vouchers for fast-track *ex parte* reexamination, but having a voucher for fast track initial examination might possess greater value for some patent applicants, such as universities. Alternatively, the PTO could consider allowing the voucher holder to select fast-track either *ex parte* reexamination or initial examination.

Finally, in light of the current budgetary environment, the USPTO should give thoughtful consideration of how to effectively and efficiently implement such a pilot program and how to provide adequate resources to conduct fast-track *ex parte* reexamination or initial examination.

Thank you for seeking feedback from the patent community as the PTO determines how best to structure such a pilot program. Since this proposal is still in its infancy, we encourage the PTO to request further comment as it formulates the parameters and processes of a formal pilot program.

Sincerely,



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