

From: Robin Muthig [redacted]
Sent: Friday, November 19, 2010 1:42 PM
To: HumanitarianProgram
Cc: [redacted]
Subject: IPO Comments

Please see attached comments from Intellectual Property Owners Association in response to 75 Fed. Reg. 57261 (September 20, 2010)

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November 19, 2010

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Joni Y. Chang
VIA E-MAIL

**RE: IPO Comments on “Request for Comments on Incentivizing
Humanitarian Technologies and Licensing Through the Intellectual
Property System,” 75 Fed. Reg. 57261 (September 20, 2010)**

Dear Under Secretary Kappos:

I write on behalf of Intellectual Property Owners Association (IPO) to comment on the proposed fast-track *ex parte* reexamination voucher program published at 75 Fed. Reg. 57261 on September 20, 2010. We appreciate the opportunity to comment.

Although the proposed voucher program may provide a mechanism to gather information about ongoing humanitarian uses of technology, IPO believes other, more efficient ways of gaining this information can be developed which could offer viable alternatives to incentivizing additional development or patenting of such technologies. Unfortunately, IPO does not believe this program incentivizes or efficiently collects information about these technologies. Instead, the proposed program raises significant concerns regarding access to and availability of reexaminations for all patent applicants and risks unintended consequences. For example, the Notice envisions that a patent owner could use its voucher for a different patent in its portfolio or to transfer it “on the open market” to another party. As a result, *ex parte* reexaminations of patents wholly unrelated to humanitarian uses might be accelerated. Also, the Notice could adversely impact small businesses that are not in the position to get such vouchers because of their limited resources and may find reexaminations they filed for the purpose of having validity determined delayed unfairly in the face of larger entities that have the potential and resources to take advantage of these rules. By creating a market for vouchers, the Notice might also incentivize parties to obtain marginal or low-quality patents, or could encourage the filing for patents on inventions that would otherwise be made available to the public. The Notice envisions a “significance” requirement for the program, but any meaningful evaluation of this criterion would be burdensome to administer, especially if voucher-seekers had recourse to challenge denials.

At the same time, we are concerned that the program overlooks the USPTO’s own obligations under domestic patent law and TRIPS. The program might be understood to conflict with the statutory mandate to conduct *all* reexamination proceedings with

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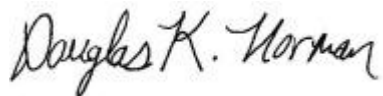
INTELLECTUAL PROPERTY OWNERS ASSOCIATION

“special dispatch,” to the detriment of patent owners who do not demonstrate “humanitarian uses” of their patented technology and may not be able to obtain the necessary vouchers on the open market. We are equally concerned that the proposed voucher program may violate treaty obligations under TRIPS, providing that “patent rights [shall be] enjoyable without discrimination as to ... the field of technology.” TRIPS Art. 27(1).

Even the task of defining “humanitarian technologies” poses problems. Determining whether a use of a patented technology is “humanitarian” may simply be too subjective to serve as the basis for a fair, predictable program. The focus on “access” as a determining factor for defining humanitarian research is also troubling. In evaluating candidate patents for the program in part by whether “the patented technology was made available to researchers on generous terms,” the Notice suggests that patentees who choose to license their technologies are more deserving (of, in this case, vouchers) than those who choose to develop their technologies by themselves. But the patent right is, at its core, a right to exclude. By emphasizing “access,” the Notice wades into a policy debate far beyond the scope of incentivizing humanitarian technologies.

IPO strongly supports appropriate strategies that would effectively incentivize the development and distribution of technologies that address humanitarian needs. For the reasons stated above, however, we cannot support the USPTO’s proposal to limit fast track *ex parte* reexamination to patent owners who hold a voucher demonstrating humanitarian practices with patented technologies.

Sincerely,

A handwritten signature in black ink that reads "Douglas K. Norman". The signature is written in a cursive, slightly slanted style.

Douglas K. Norman
President