



American Intellectual Property Law Association

March 23, 2020

The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Attention: *James Engel*
Senior Legal Advisor

Via email: AD33.comments@uspto.gov

RE: AIPLA Comments On Notice of Proposed Rulemaking Regarding “Small Entity Government Use License Exception” 85 Fed. Reg. 6476 (February 5, 2020) [Docket No. PTO-P-2019-0009]

Dear Director Iancu:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have this opportunity to present its views on the Department of Commerce Patent and Trademark Office (“USPTO”) Notice of Proposed Rulemaking regarding Small Entity Government Use License Exception published in the Federal Register dated February 5, 2020, 85 Fed. Reg. 6476 (hereinafter “the Notice”).

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 12,000 members who are engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

We agree that the proposed 37 CFR §1.27(a)(4)(i)(B) will provide clarity regarding the exception for a government use license under 15 U.S.C. § 3710d(a) that a Federal employee is obligated to grant if he/she is allowed to retain title to the workplace invention. We also agree with the new exception set forth in the proposed section 1.27(a)(4)(i)(C).

We further agree that government use licenses for inventions made under Cooperative Research and Development Agreements (“CRADAs”) are akin to those for federal funding

agreements under Bayh-Dole Act such that the same exception should be provided for small entity status with respect to both types of agreements.

We therefore agree that the proposed rule changes will encourage persons, small businesses, and with the nonprofit organizations to collaborate with the Federal Government by providing an opportunity to qualify for the small entity patent fees discount for inventions made during the course of federally-funded or federally-supported research. Thus, we fully support the proposed rule changes set forth in the Notice.

We also suggest that the USPTO remain cognizant of regulatory changes regarding federal funding and/or collaboration in the future, and update its regulations as appropriate.

We thank you again for the opportunity to make these comments. AIPLA supports the USPTO’s efforts to improve the IP system and looks forward to an opportunity to further discuss this important subject.

Sincerely,

A handwritten signature in blue ink that reads "Barbara Fiacco". The signature is written in a cursive, flowing style.

Barbara Fiacco

President

American Intellectual Property Law Association