

UC Office of the President

U.S. Department of Commerce

Title

UC Comments on USPTO's Notice of Proposed Rulemaking on Terminal Disclaimer Practice to Obviate Nonstatutory Double Patenting (Docket No. PTO-P-2024-0003)

Permalink

<https://escholarship.org/uc/item/3x1637k7>

Journal

N/A

Author

UC Office of the President

Publication Date

2024-07-09



OFFICE OF THE VICE PRESIDENT – RESEARCH AND INNOVATION

OFFICE OF THE PRESIDENT
1111 Franklin Street, 11th Floor
Oakland, California 94607-5200

Submitted through: www.regulations.gov (PTO-P-2024-0003)

July 9, 2024

Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property
Director, United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

RE: UC Comments to the Notice of Proposed Rulemaking re Terminal Disclaimer Practice to Obviate Nonstatutory Double Patenting (Docket No. PTO-P-2024-0003)

Dear Director Vidal:

I write on behalf of the University of California (UC) system responding to the Notice of Proposed Rulemaking (NPRM) re Terminal Disclaimer Practice to Obviate Nonstatutory Double Patenting (the “Proposed Rule”) issued by the United States Patent and Trademark Office (USPTO) on May 10, 2024.

The UC system is comprised of ten campuses, six academic health centers, and three affiliated U.S. Department of Energy national laboratories. UC Health, encompassing the six academic health centers, is the nation’s largest provider of health sciences and medical education training programs and the second largest provider of Medicaid inpatient services in California.

UC receives more than \$7 billion annually of extramural awards to support research conducted across all UC locations. UC's technology commercialization program takes inventions from the laboratory to the marketplace, benefiting the public in the form of countless innovative products, creating new jobs, training new talents, and contributing to the U.S. economy. UC is a leader in technology transfer and was granted more U.S. utility patents last year than any other university in the world.¹ Many of these patents resulted from research carried out with federal funding, illustrating the continued success of the Bayh-Dole Act and its importance to commercializing discoveries created through federally funded research. By allowing universities and other federal grantees to take title to inventions, the Bayh-Dole Act plays a critical role in ensuring that early-stage technologies have an opportunity to be licensed by capable industry partners, developed, moved through proper regulatory processes, and made available to the public.

¹ Source: [UC Technology Commercialization Reports](#)

UC supports and endorses the comment letter submitted on July 9, 2024 in response to this NPRM by the Association of University Technology Managers (AUTM). As detailed therein, the Proposed Rule will deter investments necessary to support America's innovation-based economy by jeopardizing the enforceability of validly issued U.S. patents. The Proposed Rule favors patent challengers over investors, licensees, and patent owners – including, importantly, universities who have elected title to federally funded inventions under long-standing and relied upon law. Through an administrative rule-making, the USPTO seeks to upset the predictability and stability of the U.S. patent system by razing the assumption of patent validity - a fundamental tenant underlying the United States' innovation ecosystem. Further, the Proposed Rule seeks to elicit the surrender of unchallenged property rights through a "voluntary agreement" of the patent owner, raising significant due process and coercion concerns. The Proposed Rule is a substantive change to patent law far beyond the USPTO's administrative rule-making authority. The Proposed Rule will deter the market introduction of new technologies, backsliding on decades of positive economic infrastructure established by Congress through the Bayh-Dole Act and implementing regulations.

For these reasons, and as further articulated in the AUTM comment letter, UC urges the USPTO to immediately withdraw the Proposed Rule.

Thank you for the opportunity to comment. We look forward to continued engagement on this important issue.

Sincerely,

A handwritten signature in dark ink, appearing to read 'Deborah Motton', with a stylized flourish at the end.

Deborah Motton, Ph.D.
Executive Director
Research Policy Analysis and Coordination
University of California, Office of the President