



COUNCIL ON GOVERNMENTAL RELATIONS

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August 1, 1984

TO: Roger G. Ditzel
FROM: Milton Goldberg *MG*
SUBJECT: Uniform Patent Procedures Act - S. 2171

File
H 195003

It has been agreed by the Senate Subcommittee on Patents, Copyrights, and Trademarks that the big business portion of the Uniform Patent Procedures Act would be dropped from the subject bill, but those provisions beneficial to universities and small business would be preserved. As I recall, there were six provisions of interest to universities. They were:

1. The addition of sexually propagated plants to the definition of "invention" in P.L. 96-517;
2. Favorable reporting requirements;
3. Federal agency waiver of the conditions that attach to ownership of university inventions;
4. Amendments to P.L. 96-517 to create a management focus in the Department of Commerce;
5. Repeal of the five year cap on the grant of an exclusive license; and
6. Assurance that universities that manage GOCOs can retain title to GOCO inventions.

It appears that Senator Mathias (R-MD), Chairman of the Senate Subcommittee on Patents is sympathetic to a bill containing these provisions, but provisions 5 and 6 are not receiving needed support from Senator Metzenbaum (D-OH). Mr. Metzenbaum is reported to be willing to relinquish title to university managed GOCO inventions, if there were a provision for recoupment to protect against so called windfall income.

With respect to extending the period of exclusive licensing, Senator Metzenbaum is reported to be opposed, but open to discussion to extend the five year cap.

The bill is expected to be marked-up within several weeks. April Burke of the AAU is attempting to arrange a meeting with Senator Metzenbaum. I hope you can come to Washington to help convince the Senator that his concerns can be accommodated.

cc: Patents, Copyrights, and Rights in Data Committee
Executive Committee