

TABLE ICOMPARATIVE ANALYSIS OF PROVISIONS IMPORTANT TO UNIVERSITIES
Public Law 96-517 vs. H.R. 4564 (Ertel Bill)

<u>P.L. 96-517</u>	<u>H.R. 4564</u>	<u>Comments</u>
1. Reporting of invention to government within a reasonable time is required. 202(c)(1)	Prompt reporting is required. 305(a)(1)	Universities can only report once the invention has been identified through the university patent administrator. The thrust of H.R. 4564 would require reporting when the invention was made.
2. Reasonable time is allowed to elect after disclosure. 202(c)(2)	Requires election at time of reporting. 305(a)(2)	By the nature of the university system, reasonable time to elect after disclosure is required. H.R. 4564 election time requirements are unreasonable in a university situation.
3. Time to file is reasonable.	No requirement to file.	H.R. 4564 should contain a requirement to file.
4. Periodic reporting is optional with agency. 202(c)(5)	Reporting is not specified.	Universities want uniform reporting requirements if agency requires reports.
5. No recoupment is a certainty (no provision).	Recoupment. 307(a). Agency option to waive.	Universities want the certainty of no recoupment provision, not an agency option.
6. Prohibition against assignment without agency approval. 202(c)(7)	No prohibition against assignment.	Universities want prohibitions against assignment without agency approval.
7. Royalty sharing with inventors is required. 202(c)(7)(C)	No royalty sharing with inventors is required.	Universities want a requirement for royalty sharing with inventors.
8. Transfer of rights to university is at agency discretion when federal employee is co-inventor. 202(e)	No such provision exists.	Universities want agency discretion to waive title to university where a federal employee is a co-inventor.
9. Limited to exclusive license. 202(c)(7)	No limit exists.	Universities have no objection to deleting limits to exclusive licenses. H.R. 4564 is satisfactory on this point.
10. Limits use of royalties to research and education after expenses and inventor shares. 202(e)(7)(D)	No limitation on royalty use exists.	Universities have no objection to limiting the use of royalties for research and education. This is far better than any recoupment provision.
11. Preference given to U.S. manufacturer. 204	No preference given to U.S. manufacturer.	Universities have no objection to lack of U.S. preference provision. H.R. 4564 is satisfactory on this point.

TABLE I, continued

<u>P.L. 96-517</u>	<u>H.R. 4564</u>	<u>Comments</u>
12. Uniform regulation clauses provided for all agencies. 206	Uniform regulation clauses provided for all agencies.	Clauses for universities would have to be different, i.e., universities support sectoral uniformity, not total uniformities of regulations.
13. Regulations from OFPP; OSTP review. 206	GSA and DOD to issue regulations. 305(a)	GSA and DOD are inappropriate agencies for issuing and administering university regulations, since they take a pure contract philosophy as opposed to an assistance philosophy of other agencies which provide university research support.