



The Ohio State University

Research Foundation

1314 Kinnear Road
Columbus, Ohio 43212

April 23, 1985

Mr. Norman Latker
Director
Federal Technology Management Policy
Division
Office of Productivity
Technology and Innovation
Department of Commerce
Room H4867
Washington, D.C. 20230

SUBJECT: Proposed 37 CFR 401 -- Docket No. 41278-4178

Dear Mr. Latker:

With respect to proposed 37 CFR 401.13(c), as published at 50 F.R. 13524ff, it would appear to be both desirable and compatible with the overall tenor of these proposals and the underlying legislation that the direction to agencies to liberally grant requests from nonprofit organizations for waiver of limitations on the duration of exclusive licenses for subject inventions arising from incorporation in funding agreements of the provisions of OMB Circular A-124 or OMB Bulletin 81-22 should be expanded to also direct liberal granting of requests for waiver of similar limitations imposed under earlier funding agreements.

To effect this modification, the following amendment of proposed 37 CFR 401.13(c) is suggested:

In the first sentence, delete "under paragraph k.(2) of the clauses prescribed by either OMB Circular A-124 or OMB Bulletin 81-22" and substitute --for waiver of any limitation on the duration of an exclusive license for a subject invention imposed under a funding agreement to the extent that such limitation does not conform to the standard patent rights clause of §401.14(a) approved for incorporation in new funding agreements at the time of such request,--.

Mr. Norman Latker
April 23, 1985
Page 2

Similarly, it is suggested that the second sentence of proposed 37 CFR 401.13(c) be amended as follows:

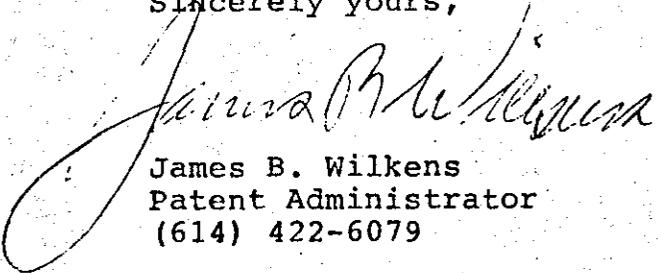
Delete "paragraph k.(1) of the clauses specified by either OMB Circular A-124 or OMB Bulletin 81-22" and substitute --the terms of a funding agreement--.

As a more comprehensive alternative to both of these suggestions, it would appear to be desirable to provide for liberal granting of waivers from all obsolete provisions of funding agreements within the scope of these regulations. To effect such a modification, complete substitution of the following for the full text of proposed 37 CFR 401.13(c) is suggested:

--Agencies shall promptly grant, unless there is a significant reason not to, a request by a nonprofit organization for waiver or modification of any requirement imposed under a patent rights clause of a funding agreement to the extent that such requirement does not conform to the standard patent rights clause of §401.14(a) approved for incorporation in new funding agreements at the time of such request.--

It also appears that an error was made in transcribing the language of section k.(4) of A-124 into proposed 37 CFR 401.14(k)(3) in that the second occurrence of the word "inventions" was transcribed in the singular. In order to avoid possible confusion, this should be corrected to read in the plural.

Sincerely yours,



James B. Wilkens
Patent Administrator
(614) 422-6079

JBW/sl