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Ms. Sharon Leu
U.S. Department of Education
400 Maryland Avenue SW, Room 6W252
Washington DC 20202-5900

Reference: Docket ID ED-2015-OS-0105

Subject: Notice of Proposed Rulemaking: Open Licensing Requirement for Direct Grant Programs (NPRM)

Dear Ms. Leu:

I appreciate the opportunity to comment on the proposed changes to the Department's Uniform Administrative Requirements, Cost Principles, and Audit Requirements for Federal Awards. I am an Associate Professor at the University of Utah S.J. Quinney College of Law and a Senior Policy Fellow at American University Washington College of Law. I teach and write about intellectual property law and technology-related transactions. Prior to entering academia, I was a partner at the international law firm Wilmer Cutler Pickering Hale and Dorr LLP, where I practiced technology licensing law for seventeen years and represented several major U.S. research universities. I also serve as a testifying expert on behalf of the United States government in the area of international intellectual property licensing, as a member of the Advisory Council of NIH's National Center for Advancing Translational Science (NCATS), and a member of the NIH Council of Councils.

I write today for the sole purpose of addressing what I perceive to be potentially misleading statements by certain other commenters on the scope and effect of the Patent and Trademark Law Amendments Act (Pub. L. 96-517, December 12, 1980), more commonly known as the Bayh-Dole Act. Specifically, it has been suggested that the proposed Open Licensing Requirement may be inconsistent with the legal requirements of the Bayh-Dole Act, especially in the case of computer software source code, which may be patented as well as copyrighted. It is my view that the Bayh-Dole Act, which relates to patents and not to copyrights, is inapplicable to the proposed Open Licensing Requirement and that the Open Licensing Requirement is neither inconsistent nor incompatible with the Act. On the contrary, the release of software under open copyright licensing terms, a practice well-known in the industry, has little effect on the patent rights with which the Act is concerned.

As you know, copyright protects the expressive content of computer source code. Patents, on the other hand, protect inventive ideas which can typically be implemented in a large number of code variants reflecting different programming languages, system architectures and logical approaches. Actual computer code rarely if ever appears in patents. The value of a patent lies not in its coverage of a specific computer program, but in the inventive concept that it embodies. Thus, two programs that are utterly dissimilar from a copyright

standpoint may infringe the same patent. Requiring open licensing of a copyrighted program does not diminish the value of a patent claiming the same software.

However, even if the value of one or more patents *were* diminished by the release of protected software under the Open Licensing Requirement, the Bayh-Dole Act does not purport to guaranty the value of particular patents. Rather the Act encourages institutions to seek and obtain patent protection for their federally-funded inventions. Given that nothing in the Open Licensing Requirement prevents an institution from filing a patent application before a software program is released to the public, the Open Licensing Requirement does not impair the institution's ability to obtain patent protection for its software-based inventions and does not conflict with the Bayh-Dole Act.

I thank you for this opportunity to comment.

Very truly yours,

Jorge L. Contreras