

January 23, 2008

Senator Mitch McConnell  
A361 Russell Senate Office Building  
Washington, DC 20510-1702

Senator Jim Bunning  
316 Hart Senate Office Building  
Washington, DC 20510-1703

Dear Senators McConnell and Bunning:

On behalf of the undersigned Kentucky-based companies, universities, innovation centers, and investors in their technologies, we are writing to raise our continuing concerns regarding S. 1145, the Patent Reform Act of 2007.

This bill, as reported by the Senate Judiciary Committee, contains numerous provisions that will weaken patent rights, reduce incentives for innovation, create business and investment uncertainty, and negatively impact Kentucky's growing technological leadership in a competitive national and global economy. In particular, the bill puts at risk the increasing economic development in the Commonwealth of Kentucky that has been spurred by technology transfer of university-based patents to start-up companies across the spectrum of technological innovation, funded by venture capital and other public and private sources throughout the Commonwealth.

The bill's harmful provisions include expanded apportionment of damages, an indefinite post-grant opposition system, excessive venue restrictions, and burdensome mandatory search and analysis requirements, among others. The bill also codifies the current and much-maligned "unenforceability doctrine," rather than to make broadly supported reforms to eliminate litigation abuse of this doctrine and permit more thorough information exchange between patent applicants and examiners.

We understand that efforts are underway within the U.S. Senate to develop a more consensus-oriented patent reform bill that could be considered by the full U.S. Senate early next year. We applaud such efforts, and would urge you to ensure that any revised bill, at a minimum, meet the following criteria before being brought up for consideration by the full U.S. Senate:

- (1) The "second window" in any post-grant opposition system should either be eliminated entirely or strictly limited in a manner consistent with the language as passed by the House of Representatives.
- (2) Any statutory language on the calculation of reasonable royalty damages should –
  - a. Preserve the discretion of courts and juries to apply any and all applicable factors and methodologies under current law;

- b. Not direct courts or juries to engage in “prior art subtraction” or otherwise seek to separate out certain elements of a patent claim;
  - c. Not restrict the ability of courts or juries to use the value of the infringing product or process as a base for calculating a reasonable royalty.
- (3) The PTO Director should not be given any authority to promulgate substantive rules of patent law, including any restriction on the manner in which applicants may claim their inventions or seek continued examination of their applications.
  - (4) The “applicant quality submissions” provision should either be eliminated, or carefully restricted and pre-conditioned on meaningful reform of the “unenforceability doctrine,” as described below.
  - (5) Any bill must contain major reforms of the current “unenforceability doctrine,” as recommended by the National Academies of Science and the PTO, under which application of this draconian penalty would be limited to patent applicants who deceive the PTO into allowing an invalid patent claim and where such deception was the cause for the claim’s issuance.
  - (6) Any reforms to the statutory venue provisions should, at a minimum, permit patent owners to sue in districts in which the claimant has its principal place of business or has engaged in substantial research, development or manufacturing activities.

We remain committed to strengthening the U.S. patent system in ways that will preserve and promote innovation across the broad spectrum of the American and Kentucky economies, and we look forward to working with you in this regard.

Thank you for considering our views in this crucial matter.

**UNIVERSITIES**

***University of Kentucky***

Lee T. Todd, Jr., President  
Lexington, Kentucky

***University of Louisville***

James R. Ramsey, President  
Louisville, Kentucky

***Eastern Kentucky University***

Charles D. Whitlock, President  
Richmond, Kentucky

***Northern Kentucky University***

James C. Votruba, President  
Highland Heights, Kentucky

***Western Kentucky University***

Gary A. Ransdell, President  
Bowling Green, Kentucky

**COMPANIES**

***Advanced Cancer Therapeutics (ACT)***

Randall B. Riggs, President & CEO  
Louisville, Kentucky

***Advanced Dynamics, Inc.***

Patrick Hu, President & Chairman  
Lexington, Kentucky

***ALKYMOS***

Robert Yokel, President  
Lexington, Kentucky

***Alltech, Inc.***

Dr. Pearse Lyons, President and Founder  
Nicholasville, Kentucky

***AllTranz***

Audra L. Stinchcomb, CEO & Founder  
Lexington, Kentucky

***Amgen***

David Beier, SVP, Global Government  
Affairs  
Louisville, Kentucky

***ApoImmune, Inc.***

Haval Shirwan, Ph.D., Chief Scientific  
Officer and Scientific Founder  
Louisville, Kentucky

***Artemetrx***

Matthew J. Wiley, CFO – VP  
Lexington, Kentucky

***Cherry Orchard Products, LLC***

Susan Jay, Manager  
Lexington, Kentucky

***Coldstream Digital, LLC***

Mike Barclay, President  
Lexington, Kentucky

***Coldstream Laboratories, Inc.***

Joseph W. Wyse, President & CEO  
Lexington, Kentucky

***Corning***

Vaughn Hall, Plant Manager  
Corning Display Technologies  
Harrodsburg, Kentucky

***Emagin Therapeutics***

Peter Crooks, President  
Lexington, Kentucky

***Four Tigers***

Paige Shumate Short, CEO  
Paris, Kentucky

***Gates Corporation***

John Bohenic, President  
Elizabethtown, Kentucky

***InfraReDx, Inc.***

Robert A. Lodder, Founder  
Lexington, Kentucky

***Kentucky BioAlliance***

Ben Keeton, Executive Director  
Louisville, Kentucky

***Kentucky Seed Capital, LLP***

George Emont, Managing Partner  
Louisville, Kentucky

***Kentucky Technical Textiles***

Dan Short, President  
Paris, Kentucky

***Lawrence Pharmaceuticals, LLC***

Jeff Lawrence, President  
Lexington, Kentucky

***Leuchemix***

Peter Crooks, President  
Lexington, Kentucky

***LevTech, Inc.***

Philip M. Mantey, President  
Lexington, Kentucky

***Medical, Inc.***

Robert A. Lodder, Founder & President  
Lexington, Kentucky

***Metal Separation Technologies***

Eric Grulke, President & CEO  
Lexington, Kentucky

***Nano-Mite Technologies, LLC***

Greg Johnson, CEO  
Georgetown, Kentucky

***Naprogenix, Inc.***

Cindy Burklow, CEO  
Lexington, Kentucky

***Neatherly Technologies***

Jim Neatherly, President  
Lexington, Kentucky

***Novera Drugs, LLC***

Patrick Migliore, CEO  
Louisville, Kentucky

***Ocular Transplantation, LLC***

Norman D. Radtke, M.D., Founder,  
President & CEO  
Louisville, Kentucky

***Oraceuticals, Inc.***

Cindy Burklow, CEO  
Lexington, Kentucky

***Outrider Technologies***

John Beran, CEO  
Lexington, Kentucky

***Pradama, Inc.***

William M. Pierce Jr., President & CEO  
Louisville, Kentucky

***Reflectronics, Inc.***

Fred Payne, President  
Lexington, Kentucky

***RhinoCyte***

Fred J. Roisen, Ph.D., Founder,  
President and CEO  
Louisville, Kentucky

***Scout Diagnostics***

John Beran, CEO  
Lexington, Kentucky

***Secat, Inc.***

Subodh K. Das, President & CEO  
Lexington, Kentucky

***Sentinel Pediatric Biosystems, LLC.***

Paul Lederer, President and CEO  
Louisville, Kentucky

***Spherix Inc.***

Robert A. Lodder, President  
Lexington, Kentucky

***Suregene, LLC***

Tim Ramsey, CEO  
Louisville, Kentucky

***The Gates Corporation***

Elizabethtown, Kentucky

***Stallion Therapeutics, Inc.***

Edward D. Hall, President & CEO  
Lexington, Kentucky

***TranSecurity Systems, Inc.***

Fred Payne, President  
Lexington, Kentucky

***UltraTrace Detection, LLC***

Paul Lederer, Founder, President & CEO  
Louisville, Kentucky

***VitaTech, LLC***

Patrick Migliore, CEO  
Louisville, Kentucky

***Vortecone***

Kozo Saito, President,  
Lexington, Kentucky

***Yaupon Therapeutics***

Peter Crooks, President  
Lexington, Kentucky