
From: Joe Allen [jallen@allen-assoc.com]
Sent: 12/18/2016 10:13:43 PM
To: Rohrbaugh, Mark (NIH/OD) [E] [/O=NIH/OU=NIHExchange/cn=OD/cn=ROHRBAUM]
Subject: Re: Comment replying to me

I'd heard that, what about the impact on licensing?

On 12/16/2016 10:16 PM, Rohrbaugh, Mark (NIH/OD) [E] wrote:

NIH reported that number of CRADAs increased several fold after language was dropped

Sent from my iPhone

On Dec 16, 2016, at 9:36 PM, Joe Allen <jallen@allen-assoc.com> wrote:

Thanks, what was the impact of introducing the language on NIH exclusive licensing? If there was an impact (hopefully negative) that would be a very interesting topic to explore.

Have a great weekend!

On 12/16/2016 5:09 PM, Rohrbaugh, Mark (NIH/OD) [E] wrote:

The clause in CRADAs and in all exclusive licenses was concurrent. People often talk of it as if it was only used in CRADAs but it was both. The broader issue was discussed publicly and rescinded at the same time under Dr. Varmus. The press release in April 1995 mentions both in the first sentence .

From: Joe Allen [mailto:jallen@allen-assoc.com]
Sent: Friday, December 16, 2016 4:21 PM
To: Rohrbaugh, Mark (NIH/OD) [E] <RohrBauM@OD.NIH.GOV>
Subject: Re: Comment replying to me

1992? That seems really late for NTIS licensing NIH inventions. The problem is that this is a precedent the other side will seize upon. It's surprising that companies accepted such a clause in their license. Wasn't this the same time that Congress was pressuring you to include "reasonable pricing" language in NIH CRADAS? As discussed yesterday, this is the first I've heard of anything like this in a license. The only way to make lemonade out of this (as far as I can see) is to look at how such a clause impacted NIH licensing. If we can show a decline and subsequent rise after it was removed, that would certainly bolster the cause. Still, this language will probably come back to bite us from our pals at KEI.

You said you got a call from a reporter. Was it about this language in NIH licensing agreements? If so, the cat's out of the bag.

Anyway, enjoy the weekend. Even with rain at least we'll get above freezing, which seems pretty alluring right now...

On 12/16/2016 12:12 PM, Rohrbaugh, Mark (NIH/OD) [E] wrote:

b6

It seemed to have evolved. Just a quick survey...couldn't find it in a few late 80s agreements I looked at but found this clause in 1992 NTIS agreement. It does not use the term "practical application" like B-D

<mime-attachment.jpg>

From: Joe Allen [<mailto:jallen@allen-assoc.com>]
Sent: Thursday, December 15, 2016 11:21 AM
To: Rohrbaugh, Mark (NIH/OD) [E]
<RohrBauM@OD.NIH.GOV>
Subject: Re: Comment replying to me

Wow, never knew that . We had some really contentious meetings with our Deputy Assistant Secretary when I argued after passage of the FTTA that agencies shouldn't be forced to license through CUFT (Center for the Utilization of Federal Technology) at NTIS. They really fought that as they realized that if they had to compete they would go out of business (which they did). So they were putting reasonable pricing clauses in exclusive licenses? Do you have one you could send me? No wonder they were so ineffective. Do you think Norm Latker knew those clauses were being put into exclusive licenses for NIH inventions? I wonder how many were licensed with that provision

I learn something every day (and this is one thing I hate to have learned)...

On 12/15/2016 11:03 AM, Rohrbaugh, Mark (NIH/OD) [E] wrote:

Yes it was in all exclusive licenses and it may have started with Licenses coming out of Commerce before NIH took them over

Sent from my iPhone