



NIH IPA 9

Office of the Assistant Secretary
for Health
Washington DC 20201

APR 13 1984

Mr. Howard Bremer
Patent Counsel
The Regents of the University of Wisconsin
P.O. Box 7365
Madison, WI 53707

Dear Mr. Bremer:

Enclosed is a new form license to the United States Government to be attached to your Institutional Patent Agreement as a replacement for the present EXHIBIT A. The license excludes state and domestic municipal governments from the royalty-free use of the invention licensed unless they are using the invention in connection with programs funded in whole or in part by the Federal Government. The change is intended to bring the license reserved to the Government into conformity with Public Law 96-517 and OMB Circular A-124, in the interest of uniformity.

Please note that the new license to the Government is to be used only with respect to inventions made prior to July 1, 1981, for which a license to the Government has not previously been submitted. The new license does not change the terms of licenses already submitted.

Sincerely yours,

Edward N. Brandt, Jr.
Edward N. Brandt, Jr., M.D.
Assistant Secretary for Health

Enclosure

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LICENSE TO THE UNITED STATES GOVERNMENT

WHEREAS, _____, of _____, has invented
(Inventor)
_____ and filed a patent application thereon in _____
(Invention) (Country)
bearing Serial No. _____, filing date _____; and

WHEREAS, the invention was made in the course of research supported by the Department of Health and Human Services; and

WHEREAS, the United States Government is entitled to certain rights in and to said invention and application by reason of the terms of such support; and

WHEREAS, the _____, hereinafter called the "Licensor" has
(Institution)
acquired by assignment from the inventor the entire right, title, and interest of the inventor to such invention;

NOW, THEREFORE

1. The Licensor, in consideration of the premises and other good and valuable consideration, hereby grants and conveys to the United States Government a royalty-free, nonexclusive and irrevocable license for governmental purposes and on behalf of any foreign government pursuant to any existing or future treaty or agreement with the United States under the aforesaid patent application, and any and all divisions or continuations, and in any and all patents or reissues which may be granted thereon during the full term or terms thereof. As used herein, "governmental purpose" means the right of the Government of the United States, including any agency thereof, to practice and have practiced (made or have made, used or have used, sold or have sold) in connection with programs funded in whole or in part by the Federal Government throughout the world by or on behalf of the Government of the United States.

2. The Licensor covenants and warrants that he has the right to grant the foregoing license, and that any assignment which he may make of the invention or the said patent applications or patents thereon, shall expressly be made subject to this license.

3. The Licensor agrees that the Government shall not be estopped at any time to contest the enforceability, validity, scope of, or title to, any patent or patent application herein licensed.

(Institution)

(Signature)

(Print or type name)

(Date)

(Official Title)

CERTIFICATE

I, _____, certify that I am the _____ of the
Institution named as Licensor herein; that _____, who signed
this License on behalf of the Institution is _____ of said
Institution; and that said License was duly signed for and in behalf of said
Institution by authority of its governing body, and is within the scope of its
corporate powers.

(Signature) (Date) 2367