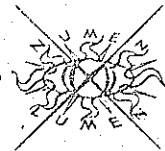


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THE UNIVERSITY OF WISCONSIN



FRED HARVEY HARRINGTON, *President*
Telephone (608) 262-2321

MADISON, WISCONSIN 53706

April 18, 1967

Mr. Charles B. Brown
Special Assistant for
Patent Policy
Office of the Secretary
Department of Health, Education,
and Welfare
Washington, D. C. 20201

Dear Mr. Brown:

I am submitting herewith a Petition for an institutional agreement with the Department of Health, Education, and Welfare to cover patents which may arise at the University of Wisconsin from research supported wholly or in part by the Department.

I believe that over the course of the last several years we have abundantly demonstrated our desire to cooperate with the Department in achieving the maximum benefit of our joint research efforts and, further, that we have tried diligently to make the case-by-case system of determinations work. I am satisfied that the only workable procedure for handling of these matters is an institutional agreement. I, therefore, earnestly request your favorable consideration of this Petition.

Sincerely yours,

Fred Harvey Harrington
President

FHH/pkg
Encl.
cc: Ward Ross

4/20/67 Copies to
Ward Ross
Brennan ✓
Albano

PETITION

The University of Wisconsin, situated at Madison, Wisconsin, hereby petitions the Department of Health, Education and Welfare to enter into an agreement with the University under the authority vested in the Department by Section 8.1(b) of the Regulations and Procedures of the Department of Health, Education and Welfare, whereby the ownership and disposition of all rights in inventions arising as the result of or under any grants, contracts, fellowships or other awards to the Regents of the University of Wisconsin and/or the University of Wisconsin shall be left with the University for administration.

Pursuant to and in support of the foregoing request petitioner alleges:

1. That the University of Wisconsin is in receipt of substantial funds from the Department of Health, Education and Welfare in the form of research grants and contracts, fellowships and other awards;
2. That the University of Wisconsin is fully cognizant that all such research grants and contracts, fellowships and other awards are accepted by the University under the imposition of conditions governing the assignment and/or other disposition of rights to inventions which may be conceived and/or reduced to practice during the course of investigative work supported by such funds, or where such conception and/or reduction to practice has been assisted by such funds;

3. That the University of Wisconsin at all times assumes the responsibility for the fulfillment of any and all terms and conditions which accompany or are made a part of any such research grants and contracts, fellowships or other awards and to this end apprises its investigators who are recipients of any such funds of the terms and conditions attaching to such funds and of the obligation to report any and all inventions the conception and/or reduction to practice of which are made with or assisted by such funds;
4. That although the University of Wisconsin does not engage in the evaluation and subsequent patenting and licensing of inventions and has no facilities or staff for doing so, it has and maintains a close relationship with the Wisconsin Alumni Research Foundation, a corporation not-for-private-profit organized and existing under the laws of the State of Wisconsin, which engages in the evaluation, patenting and licensing of inventions which are voluntarily brought to it, and has in fact for many years provided the avenue for evaluating, patenting and licensing inventions originating with University of Wisconsin personnel for the benefit of the University and the public;
5. That the Wisconsin Alumni Research Foundation recognizes the presence of substantial monies in the University community arising from grants and contracts, fellowships and other

awards from agencies of the Federal Government and of the obligations which the University has with respect to inventions conceived and/or reduced to practice under or with the assistance of such monies, and to this end the University of Wisconsin and the Wisconsin Alumni Research Foundation have entered into an agreement recognizing the existing obligations which the University has to the funding agency and prescribing the conditions under which the Wisconsin Alumni Research Foundation will proceed with the evaluation and subsequent patenting and licensing of any inventions voluntarily brought to it by the investigator. (A copy of the University-WARF agreement is attached to this petition as Appendix A.)

6. That under an institutional agreement with the Department of Health, Education and Welfare the University will expect that the investigator who has made an invention with the use of Department of Health, Education and Welfare funds and believes that patenting and licensing is essential to bring the invention more rapidly to the benefit of the public will take such invention to the Wisconsin Alumni Research Foundation for evaluation, patenting and licensing of the invention;

7. That based upon its past experiences in petitioning the Department of Health, Education and Welfare jointly with the University of Wisconsin for a determination for the disposition of inventions under Section 8.2 of the Regulations and Procedures of the Department of Health, Education and Welfare, the Wisconsin Alumni Research Foundation has agreed that in addition to the limitations imposed upon it by the terms and provisions of the agreement in Appendix A it will voluntarily accept and be bound by additional provisions including:

- a. A provision for the submission of reports to the Department when requested by the Department relating to the progress of the invention;
- b. A provision limiting the exclusivity period of any licensing arrangement when such licensing is necessary to bring the invention into public use;
- c. A provision authorizing the Government to require the granting of nonexclusive, royalty-free licenses where, after a prescribed period (normally 3 years after the patent issues) efforts to bring the invention to the point of practical application have been unsuccessful, or for other reasons inconsistent with legitimate efforts to bring the invention into public use;

- d. A provision for the Government to acquire a non-exclusive, royalty-free, irrevocable license for governmental purposes and further providing that all sales to the Government be royalty-free.
8. That the only available alternative to an institutional agreement is the case by case system of determination, largely under Section 8.2(b) of HEW regulations and that the University has conscientiously sought to use this procedure but that it is largely unworkable.
9. That, finally, the interests of the Department and the University are substantially identical: to make the results of its research efforts available to the general public as quickly and efficiently as possible.

Wherefore, the University of Wisconsin prays that this petition for an institutional agreement be granted.