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October 30, 1978

263-2831

Ms. Lucy Petitt
Mr. Martin Lefcowitz
Office of the General Counsel
National Science Foundation
Washington, D. C. 20550

Dear Lucy and Martin:

Pursuant to the discussion Niels Reimers of Stanford and I had with you and Chuck Herz you will find enclosed a copy of the report which we recently submitted to DHEW under the provisions of the Institutional Patent Agreement with that Agency. The report is cumulative and, we believe, is more informative of activity under each identified invention than a mere recitation of royalties received in any defined period.

Also, in response to one of Chuck Herz' questions, we, at Wisconsin, have a standard procedure which we follow in considering disclosures under the NSF Institutional Patent Agreement. In all situations, prior to the Wisconsin Alumni Research Foundation, as the designee of the University of Wisconsin under the Institutional Patent Agreement, accepting assignment of any invention and patent application, an accounting check is made by the central administration of the University of Wisconsin System to determine what obligations the University might have to any funding parties with reference to the particular invention. It is only after the University determines what their obligations are and that clear title is available, that an assignment of the inventions from the inventors to our Foundation is acquired.

In the course of examining the funds which may have been used for making a particular invention, where multiple support has raised the question of multiple obligations, clarification of those obligations or a waiver of one funding party to another is obtained, before assignment is acquired. There have been several such situations involving NSF funds and you will note that in the enclosed report to DHEW some of such multiple funding situations are recognized beginning on page 21.

Ms. Lucy Petitt
Mr. Martin Lefcowitz

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Depending upon the particular urgency involved because of the possibility of a statutory bar based upon publication, we consider every disclosure for patentability and, where patentability appears to be probable, file a patent application. Appropriate reports are made of this activity to NSF, not only by way of the annual report under the Institutional Patent Agreement but also on an invention-by-invention basis. Sometimes the report to NSF of a specific invention is in the form of a patent application where urgency in filing to preserve the intellectual property right has been necessary.

We trust that the enclosed report and the foregoing explanation will be helpful to you in addressing the various patent matters within your Agency. If additional information appears to be necessary, please do not hesitate to get in touch with us.

Very truly yours,

Howard W. Bremer
Patent Counsel

HWB:rw
Enc.

cc--Mr. Herz
bc--Pike-Woerpel-Hinkes