

SUPA file

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Dean of Research

Corvallis, Oregon 97331 (503) 754-3437

November 13, 1978

Mr. Howard W. Bremer  
Patent Counsel  
Wisconsin Alumni Research Foundation  
614 North Walnut Street  
Madison, Wisconsin 53705

Dear Mr. Bremer:

You state in your October 10, 1978, SUPA letter that you wish to collect case histories for review by GAO. The following are recent problems we have encountered when we submitted applications or queries to federal agencies for institutional patent agreements in June and July of this year.

1. National Science Foundation -- Institutional Patent Agreement application submitted June 26, 1978; agreement signed and executed October 16, 1978. Everything okay except exclusive license period is three years rather than five years as recommended by Office of Procurement in the Federal Register 43(23): 4427 and 4428, February 2, 1978.
2. National Institutes of Health -- Institutional Patent Agreement application submitted June 26, 1978; informed recently it was being held up because of Califano's anti-technology policy.  
  
Hope you can smoke this out. I gather the application was approved for its technical merit.
3. U.S. Department of the Interior -- Enclosed are letters received in response to my queries over the past 2½ years regarding an institutional patent agreement. Probably the Dole-Bayh bill will be required to correct this situation.
4. U.S. Department of Agriculture -- Enclosed are letters which are self-explanatory.

5. NASA -- See enclosed copies of letters.
6. U.S. Department of Energy -- We have had two interactions with ERDA-DOE. On April, 1977, we petitioned ERDA for an advanced waiver on an Oregon State University contract recently negotiated. This was the year ERDA was being reorganized into DOE. Our request was denied in April, 1978, because Oregon State University was not cost-sharing in the contract so did not have sufficient equity to justify an advanced waiver.

We followed this with a request by DOE for approval of our Technology Transfer program since the number of DOE contracts were increasing. These negotiations with Mr. Al Sopp have been going on for a year, and we have been advised by Mr. Sopp that he expects DOE approval.

I guess our only complaint so far with DOE has been the long time required to get decisions (one year or longer). This slowness might be intolerable if the University had an important patentable technology to which it was seeking extended rights.

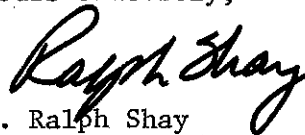
If we get DOE approval of our program, these excessive delays might be avoided.

7. U.S. Department of Commerce -- Two years ago we had a bad experience attempting to commercialize a fish vaccine developed under a joint research program -- OSU, USDC and USDI. Commerce denied us more than three years for an exclusive license and our prospective licensee couldn't recover his costs in that time. Consequently, the commercial development was stopped.

This summer I inquired if we could get an Institutional Patent Agreement. In September Mr. Robert Ellert requested us to send an application. I gather they are considering it since they discussed IPA's with Sea Grant directors at the annual meeting last week. They stated the Oregon State University application was a good one and suggested the directors get a copy if their institutions do not already have one drawn up.

I don't know that these experiences need special action by GAO except the NIH hold up. However, they might help illustrate the problems we have in trying to work with the six to eight federal agencies that fund most of our science, engineering and agricultural research.

Yours sincerely,



J. Ralph Shay  
Assistant Dean of Research

JRS:SLN  
Enclosures