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UNIV. OF WIS. VICE PRESIDENT
AND CONTROLLER

MAR 27 1974

Mr. Robert E. Gentry
Associate Vice President
The University of Wisconsin System
1752 Van Hise Hall
Madison, Wisconsin 53706

Subject: Amendment to Institutional Patent Agreement

Dear Mr. Gentry:

This letter is being sent to all holders and certain prospective holders of Institutional Patent Agreements. We are considering issuing an amendment to our IPA's and revising the standard IPA. The following changes are being considered:

1. Revise paragraph VI(e) to read as follows:

"(e) Royalties shall not be in excess of accepted trade practices. The Institution also agrees that no royalty shall be payable with respect to any subject invention in connection with procurements for or on behalf of the Government and to so provide in any instrument transferring to any person rights in any subject invention."

2. Add a new paragraph VI(h) as follows:

"(h) Notwithstanding the provisions of VI(c) and (d), no license, either exclusive or nonexclusive, shall be granted by the Institution to any of the following persons or organizations, except with the approval of the Foundation:

(i) Any person who participated as an employee of the Institution in the research leading to the conception and/or actual reduction to practice of the subject invention;

(ii) An organization of which a person described in (c)(i) was a promoter or organizer or in which such a person is an officer, director, or holds a substantial financial interest;

(iii) An organization of which the Institution was a promoter, organizer, or financier.

In such cases the Foundation's approval will normally be given only if the Institution can show that a bona fide effort was made without success to interest other organizations known to be interested in the subject matter of the invention in licensing and further developing the subject invention, or otherwise can show why the public interest will best be served by the proposed licensing arrangement."

Time frame?

3. Amend paragraph VIII(a) by changing the period at the end to a comma and adding "except rights in any country where a patent application has been filed prior to the time the Government has requested a transfer of right, title, and interest."

4. Amend paragraph VIII(h) deleting everything in the last two lines after the word "invention" and substituting the following:

" , except rights in any country where a patent application has been filed prior to the time the Government has requested a transfer of right, title, and interest. "

5. Review paragraph IX by adding the following at the end of subparagraph (a):

"However, if an application has been filed in a foreign country after these times but prior to such request by the Government, the Institution shall retain right, title, and interest in the subject invention in the country involved."

keep. since after what is in

6. Amend paragraph VIII(g) by deleting the second sentence thereof.

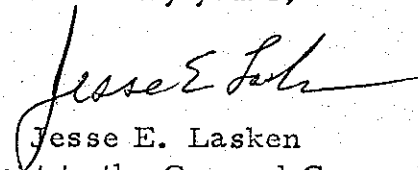
The first amendment revises the royalty provisions to make clearer what is expected of the Institution.

The second amendment is necessary to implement the requirements of our soon to be issued patent regulations. This requirement was previously included in § 25-9.150-6 of our proposed regulations appearing in the January 22, 1974, Federal Register.

Amendments 3-6 are designed to clear up what appear to us to be ambiguities or shortcomings in the current IPA concerning foreign rights in certain situations, particularly where no U.S. Patent Application is filed or where a U.S. Patent Application is abandoned.

Your comments on these proposed changes are requested by April 15, 1974. ✓

Sincerely yours,



Jesse E. Lasken
Assistant to the General Counsel