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May 22, 1978

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CHD ____ ____ ____

MAY 25 1978

William O. Burke
Vice President, Eastern Region
Society of University Patent Administrators
University of Georgia
Athens, Georgia 30602

Dear Bill:

In reply to your letter of April 28, 1978, the following comments are submitted:

(1) During the past five years, I can not recall one instance where a sponsor lost interest in funding a project because of government claims to patents. We have had several turndowns, but the potential sponsor did not base his refusal on any government claims. However, one patent, 3,827,427, issued August 6, 1974, "Apparatus for Measuring Radioactivity in the Human Eye", (sponsored by AEC) might prove interesting. We were unable to generate any interest, so we notified AEC which filed. Upon issuance, a firm known as Technical Associates asked and received a license from the AEC. Subsequently, Technical Associates contacted the inventor and asked if it could use his name; of course, it was denied. This whole procedure was rather disturbing to us; we developed a good diagnostic tool for ocular melanoma; it was patented by AEC, and that agency readily issued a non-exclusive license. There was no credit to the University, inventor or sponsor. The end result was that Technical Associates, while it did not contribute a dollar to the development of this idea, ended up with what amounts to an exclusive license since no other licenses were issued. We have no way of predicting the dollar value that we may have lost.

(2) None.

(3) We have a batting average of 1.000 in those cases where the IPA's were utilized. Nine patents issued during this reporting period, and two are pending. I feel that the efforts that we extended during 1970-73 towards selling the IPA program has begun to pay off. It has been a mutual educational process both for ourselves and industry.

(4) Title in the government is an outdated principle; it is almost an insurmountable roadblock to an effective transfer technology program. The majority of disclosures resulting from campus research are so basic; they require considerable capital for their further development and application. The principle of "title in the government" acts as a caution sign to any perspective investor. In brief, "a license to all is not a license to anyone." There is no benefit to either the inventor or to the institution.

Finally, there is a good possibility that no one will pursue the preliminary disclosure and hence, everyone loses. I have an equally strong objection to the deferred determination policy. The loss of 3 to 6 months' time to receive a determination could be most damaging for patenting processing.

At the University of Michigan, we feel that the IPA's have been a giant step forward. It would ease the paper load and expedite the transfer of ideas to the market place if we had one federal IPA. The Thornton Bill would do this.

Thanks for the opportunity of participating and wishing you every success in your survey.

Sincerely yours,

Joseph J. Keeley
Associate Director

JJK:cw