



DEPARTMENT OF HEALTH, EDUCATION, AND WELFARE

PUBLIC HEALTH SERVICE

BETHESDA, MD. 20014

NATIONAL INSTITUTES OF HEALTH
Area Code 301 Tel: 656-4000

January 22, 1965

Re: E-G3-64

Dr. William H. Young
Assistant to the President
The University of Wisconsin
Madison 6, Wisconsin

Dear Dr. Young:

As you will recall, we discussed the petition submitted by the University of Wisconsin covering Dr. Lichtenstein's invention when you were in Washington last September. At that time, it was agreed that you, in collaboration with Mr. Woerpel, would submit a supplement to the petition to include the following points:

1. Paragraphs (e), (f), (g), and (h) from Section 1 of the President's Statement of Government Patent Policy dated October 10, 1963. These paragraphs are attached.
2. A statement on the reasons for the selection of Union Carbide as the exclusive licensee and the possibility of submission to the Public Health Service the license agreement before execution by the University of Wisconsin.
3. A statement on release of data covering experiments to be carried out by the Department of Agriculture.
4. Issuance to the Government of the United States (including any agency thereof, State, or domestic or municipal government) a nonexclusive, irrevocable royalty-free license with power to practice and have practiced (made or have made, use or have used, sold or have sold) by or on behalf of the Government of the United States and on behalf of any foreign government pursuant to any existing or future treaty or agreement with the United States.

I have taken the above from the notes I took at the meeting and trust I have covered the various subjects discussed. May we hear from you soon in regard to this matter?

Sincerely yours,

(Miss)

Katharine A. Parent
Katharine A. Parent

Special Assistant for Extramural Patents
Division of Research Grants

PRESIDENT'S STATEMENT OF GOVERNMENT PATENT POLICY

October 10, 1963

Section 1.

(c) Where the principal or exclusive (except as against the government) rights in an invention remain in the contractor, he should agree to provide written reports at reasonable intervals, when requested by the government, on the commercial use that is being made or is intended to be made of inventions made under government contracts.

(f) Where the principal or exclusive (except as against the government) rights in an invention remain in the contractor, unless the contractor, his licensee, or his assignee has taken effective steps within three years after a patent issues on the invention to bring the invention to the point of practical application or has made the invention available for licensing royalty free or on terms that are reasonable in the circumstances, or can show cause why he should retain the principal or exclusive rights for a further period of time, the government shall have the right to require the granting of a license to an applicant on a non-exclusive royalty free basis.

(g) Where the principal or exclusive (except as against the government) rights to an invention are acquired by the contractor, the government shall have the right to require the granting of a license to an applicant royalty free or on terms that are reasonable in the circumstances to the extent that the invention is required for public use by governmental regulations or as may be necessary to fulfill health needs, or for other public purposes stipulated in the contract.

(h) Where the government may acquire the principal rights and does not elect to secure a patent in a foreign country, the contractor may file and retain the principal or exclusive foreign rights subject to retention by the government of at least a royalty free license for governmental purposes and on behalf of any foreign government pursuant to any existing or future treaty or agreement with the United States.