December 13, 1977

Representative Robert Kastenmeier
The House of Representatives
Washington, D. C. 20515

Dear Congressman Kastenmeier:

At the suggestion of your associate, Mr. Otto Festge, I am sending you this letter relative to two matters of great concern to me. I would like to think that your interest in these matters will be such that it will be possible for us to meet and discuss them on one of your trips to Madison.

I have for twenty-five years been responsible for various aspects of licensing inventions made at the University of Wisconsin, as a result of my employment at the Wisconsin Alumni Research Foundation. This experience has acquainted me with the technology transfer process, particularly as it relates to technology emanating from the University sector. It is from this background that I have become terribly concerned about the negative impact of certain well-intended legislation. I am referring to the combined effect of the Freedom of Information Act, the Sunshine Act, and the Federal Advisory Committee Act on the intellectual property of scientific research personnel and upon the critically important peer review system which is directly associated with such property.

Although there is some confusion over the limits to which these public disclosure acts can be stretched to obtain access to information, it is my understanding that under the provisions of the Freedom of Information Act any member of the public can request and receive a copy of a research proposal submitted by a non-commercial organization to a government agency. As you are aware, the patent laws of the U.S. bar the patenting of any invention which has been made the subject of a public disclosure for more than 12 months prior to the date of filing. (The time period is even shorter in most foreign countries.

I can assure you that when such a proposal is submitted by a University professor, he is exposing his best research ideas and hypotheses. In today's intense competition for research funding, those ideas are valuable intellectual property. The concept that those ideas should be publicly disclosed by his act of filing a proposal is particularly onerous because the probability of his even being funded is low (only about 15% of all proposals received are even funded).

The several government agencies are administratively handling this problem in different ways. The DHEW, for example, believes that it can refuse a request for a proposal unless that proposal has, in fact, been funded. While this is clearly better than the picture painted above, it still will require the scientist to identify the patentability of his discovery within twelve months after the grant. Unfortunately, most research at a university cannot be brought to the point where patent applications could be filed in less than one year after the grant award.

We see the public availability of research proposals as having the potential to destroy the system which, operating through the Wisconsin Alumni Research Foundation, has produced a total of over $80 million to support research at the University of Wisconsin. More importantly, this is the system that has produced incalculable public benefit through products which have been the result of research discoveries made at the University of Wisconsin. Certainly, our strong and combined efforts are called for to remove such a threat.

My second, and related, concern is for prompt passage of HR-8596, the Thornton Bill. Certain provisions of this bill will operate to redress the problems outlined in this letter. Furthermore, it would put all government agencies into a position of operating on the same basis when dealing with intellectual property rights. I, therefore, strongly recommend and urge that you become a co-sponsor of this Bill.

The Bill would be even better for the purposes of the relationship between the university and the federal government, if in the definition section universities could also be identified and named as contractors. We believe, however, the word contractor as used within the Bill could be read to include universities. We also believe that the provisions of Section 313(b) should apply to the conditions of paragraphs 313 (a)(2)(C) as well as to the following paragraphs D and E, as is already provided.

With these small changes, we can assure you and the rest of your constituency that the future inventions made within the University of Wisconsin, most of which will be funded in part by Federal monies, will continue to be made available for the benefit of mankind under the U.S. patent system. It is patent protection which provides the incentive to commercial companies to transfer research ideas into product realities.

Thank you for your consideration of these matters. If at any time my associate at WARF, Mr. Howard Bremer, and I could meet with you in Madison for further discussions, we promise to be available.

Very truly yours,

Marvin D. Woerpel
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