

★

COUNCIL ON GOVERNMENTAL RELATIONS

Eleven Dupont Circle, Suite 480 Washington, D.C. 20036 (202) 861-2595

September 4, 1984

TO: Patents, Copyrights and Rights in Data Committee

FROM: Milton Goldberg

SUBJECT: Voluntary Reporting of Patent Use *ms*

The attached memorandum from D. Bruce Merrifield, Assistant Secretary for Productivity, Technology and Innovation, explains how the Department of Commerce intends to handle reporting of inventions.

Attachment



UNITED STATES DEPARTMENT OF COMMERCE
The Assistant Secretary for Productivity,
Technology and Innovation
Washington, D.C. 20230

(202) 377-0659

AUG 31 1984

RECEIVED

MEMORANDUM FOR MEMBERS OF THE FCCSET COMMITTEE ON INTELLECTUAL
PROPERTY (See Attached List)

'84 SEP -4 P118

SUBJECT: Reporting of Patent Use by Universities

Public Law 96-517 allows agencies to require small business and nonprofit organizations to report the use of patents they obtain as a result of Government-funded research and development. The Office of Management and Budget (OMB) Circular A-124 says that agencies should not impose such requirements until Commerce develops instructions.

We did not believe that patent use reporting was a high priority issue in the years immediately after passage of the Act. This is because of the time lag between funding of research and licensing or other use of the patented results. Now, however, with several years of experience, it should be possible to begin to learn how inventions funded under the Act are being used.

As you know, OMB has rules that agencies must follow before they can ask the public for data. Those rules require analysis of reporting burdens, justification of needs, and OMB approval of proposed collection forms. Through informal discussions with OMB staff some time ago, we learned that justification might be difficult, and that the reporting burdens would have to be charged to the reporting burden budgets of individual agencies.

The universities, recognizing that they have an obligation to report patent use and desiring to keep reporting as simple as possible, worked through the Council on Governmental Relations (COGR) and developed a proposal for a voluntary report. That proposal includes data that most of the major research universities have in their automated systems. In discussing the proposal with university representatives, we learned that they were most interested in four factors:

1. A single, standard reporting format that could be readily produced from their automated systems.
2. A single Government point of contact for mailing all reports, with the point of contact being responsible for routing copies to the agencies involved.
3. Reporting geared to university fiscal years rather than the Federal fiscal year.



(a) _____
(Grantee Institution)

(c) Privileged and Confidential

PUBLIC LAW 96-517
(b) INVENTION UTILIZATION REPORT
Year Ending 30 June, _____
Year

- 1. Federal Agency _____
- 2. Grant or Contract No. (s) _____
- 3. Date Reported to Sponsor _____
- 4. Date of Election to Retain Rights _____
- 5. Title of Invention _____
- 6. Case No. of Reporting Entity _____
- 7. Inventor(s) _____

Filing Status

- 8. U.S. Patent Application No. _____
- 9. Filing Date _____
- 10. U.S. Patent No. _____
- 11. Issue Date _____
- 12. Countries in which foreign patent applications are pending or patents have issued:

Status of Development

- 13. Date of First Commercial Sale or Use, if any: _____
- 14. Gross Royalties Received During Reporting Period \$ _____
- 15. Number of Licenses or Related Agreements Issued _____
- 16. If invention has not been licensed or is not currently under development, a) describe actions taken to obtain utilization and b) comment on probability of having the invention licensed and brought to the point of practical application.

17. Reporting Entity
(Grantee Institution or Assignee)

18. Signed _____
Title _____
Date _____