



The University of Wisconsin System




VICE PRESIDENT AND TRUST OFFICER

1752 Van Hise Hall 1220 Linden Drive Madison, Wisconsin 53706 608-262-1311

August 20, 1981

TO: Howard Bremer

FROM: Reuben H. Lorenz 

SUBJECT: Information Request from NIH Regarding UW's IPA with HHS

It appears from the attached materials to President O'Neil that we will need your assistance in complying with NIH's information request. I would appreciate your reviewing the materials and, where appropriate, providing the information.

Again, thanks for all the fine assistance you continue to provide. Sometime when time permits, Kent and I would like to meet with you for a briefing on the new patent legislation. Whenever this would be convenient for you, let us know.

RHL:ers
Enclosures



August 11, 1981

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President's Office
UW System

Dr. Robert O'Neil
President
The University of Wisconsin
Madison, Wisconsin 53707

Dear Dr. O'Neil:

We have reviewed the annual reports submitted to NIH by organizations holding Institutional Patent Agreements (IPA's) with the Department of Health and Human Services. Our review covers all IPA reports submitted by your institution dating back to the signing of your IPA. Your cooperation in responding to the information requested below will ensure that your institution is in full compliance with IPA reporting requirements. You are no doubt aware that the reporting requirement stipulated in your IPA became a matter of statutory mandate as of July 1, 1981 (P.L. 96-517).

For universities, the practical effect of P.L. 96-517 is to make the IPA, which has been an elective option in the past, into law applicable to all federally assisted research and development activities. The reporting requirement you have had under the IPA is now extended to all nonprofit and small business contractors and grantees of the NIH.

We have abstracted the information you provided in your annual IPA reports and have recorded it on the enclosed Patent Activity Report forms [each form refers to one invention]. We would appreciate your checking the entered data for accuracy and completeness. Please make any corrections directly on the form. The completed forms should be signed by the preparer and returned to Mr. Leroy Randall, Patent Branch, National Institutes of Health, Westwood Building, Bethesda, MD 20014.

In addition, we would like to have the following information about your IPA activity since the signing of the agreement:

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- Please indicate whether there have been changes in your institution's formal patent policy that may affect the IPA. If such changes have been made, what are they and when were they implemented?
- The IPA information on file for your institution does not describe your institution's practices in identifying and reporting inventions and in evaluating inventions for inclusion in the required reports. The level of detail provided should enable the NIH Patent Office to understand your institutional practices. Extensive information is not required. Please describe your activities in these areas.
- Have faculty agreements been signed indicating researchers' obligations regarding the disclosure and patenting of inventions made at your institution?
- Does your organization have a patent committee? If so, please list the membership of the committee. What is the established schedule of meetings for this committee?
- Please describe any organized efforts to bring to the marketplace inventions for which title has been retained by the institution. (Include data on capital commitment made by licensees of patents held by your institution on the attached Patent Activity Report forms.)
- Does your institution have formal agreements with any patent management organization, e.g., Research Corporation, Battelle, or University Patents? We would appreciate receiving a copy of any current agreements.
- Your IPA with the NIH covers all components of your institution. Do your IPA reports reflect patent/invention activity at all of the components of your institution? Please identify the components that are addressed by your current IPA report and provide any missing invention report information.

We appreciate your cooperation in providing this information as quickly and accurately as possible. We will hold the information you provide as commercial and financial privileged information. According to Section 209 of P.L. 96-517, when the agency intends to treat such information as confidential, its release may not be required under the Freedom of Information Act. If you have any difficulty in providing this information,

*Not recorded
PL 96-517*

not recorded

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we will be glad to provide assistance and guidance. If you have questions, please call Dr. Carol Schulz at (301) 468-0696. Any constructive comments on ways the attached forms can be made easier for you to use will be given full consideration.

Kindly return the verified and completed Patent Activity Report forms and all other requested information to Mr. Leroy Randall by October 1, 1981.

Thank you for your helpful cooperation.

Sincerely,



Charles U. Lowe, M.D.
Chairman, NIH Patent Board