December 13, 1972

RE: NSF P 213300

NSF HI 36599

Mr. Gaylord L. Ellis
Grants Administrator
National Science Foundation
1800 G Street, N.W., Room 638
Washington, D. C. 20550

Dear Mr. Ellis:

Thanks for the time you gave to our meeting on December 7. There are times when telephone calls and letters will not substitute for personal discussions. Our meeting was one of those times.

For the record, I will attempt to summarize the present situation.

1. NSF is considering a research proposal entitled "Superconductive Energy Storage" prepared by Professors R. W. Boom and H. A. Peterson, submitted by the University of Wisconsin, requesting funds in the amount of $124,500 for a one-year study, beginning January 1, 1973. If this grant is awarded, it is possible that inventions or improvements of inventions will be developed with grant support which will be related and interdependent on inventions already conceived.

2. Professors Boom and Peterson have submitted several invention disclosures to the Wisconsin Alumni Research Foundation (WARF) which are being reviewed for possible patent applications.

3. The University has accepted a $25,000 unrestricted grant from the General Electric Company for support of the research efforts of Professors Boom and Peterson.

It is requested that the National Science Foundation enter into an institutional agreement concerning inventions and patents with the University of Wisconsin similar to the one the University has entered into with the Department of Health, Education and Welfare. I forwarded a copy of that agreement with my letter of November 17. This agreement was entered into after an investigation by HEW which provided assurance that the University of Wisconsin, using the services of WARF was capable of promptly arranging for the development of inventions into commercial patents.

in a manner consistent with the best interests of the general public. WARF has been providing patent management services and unrestricted funds to the University for the support of research since 1925.

If it is not possible to enter into an institutional agreement prior to or concurrent with the awarding of the NSF grant referred to above, I request that language accomplishing the purposes of an institutional agreement be developed for inclusion in the NSF award letter. This action will clarify in advance the rights of all the parties and thus eliminate uncertainties which are difficult and time-consuming to deal with at a later date. If our optimism is justified and patentable inventions are developed, the process of making these inventions available to the public should be much smoother as a result of this advance determination by NSF.

Thank you.

Sincerely,

Robert E. Gentry
Associate Vice President

REG:IB

cc: R. W. Boom
H. A. Peterson
Dean W. R. Marshall
H. Bremer

Comments of Gaylord Ellis
12/11/72

1. WARF serving as patent manager -- long-standing -- trusted -- speeds up development of patentable processes -- gives patent advice -- assures proper handling.

2. Current project being supported by "no strings" grant from G.E. -- several patentable processes already being reviewed by WARF. Work under proposed project NSF #P213300 "Superconductive Energy Storage for Power Systems," should result in improvements to these processes, which will be incorporated in whatever models are constructed as a result of future NSF support.

3. First choice would be the execution of an NSF-Wis. U agreement, to cover this and other NSF supported projects, similar to that in effect for HEW projects for _____ years. The researchers are comfortable with HEW - WARF and most importantly with "knowing in advance" with whom their cases will be negotiated.

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