

The University of Wisconsin System



VICE PRESIDENT AND CONTROLLER / 1752 Van Hise Hall / Madison, Wisconsin 53706 / 608/262-1311

August 12, 1974

~~Mr. Howard Bremer~~
Patent Counsel
13th Floor, WARF Building
Madison Campus

Dear Howard:

Enclosed is a copy of a proposed amendment to the NSF
Institutional Patent Agreement. Please look it over and give
me your comments before I execute it on behalf of the University.

Sincerely,

Robert E. Gentry
Associate Vice President

REG:IB
Enclosure¹

*Copy to
Robert Gentry
8/20/74*

Parties: The National Science Foundation and the Board of Regents of the University of Wisconsin System

Pursuant to the mutual agreement of the parties, the above referenced Institutional Patent Agreement is hereby amended as follows:

1. Section VI. (c) is revised to read as follows:

"(e) Royalties shall not normally be in excess of accepted trade practice. The Institution also agrees that no royalty shall be payable with respect to any subject invention in connection with procurements for or on behalf of the Government and to so provide in any instrument transferring to any person rights in any subject invention."

2. A new subsection (h) is added to Section VI as follows:

"(h) Notwithstanding the provisions of VI. (c) and (d), no license, either exclusive or nonexclusive, shall be granted by the Institution to any of the following persons or organizations, except with the approval of the Foundation:

(i) Any person who participated as an employee of the Institution in the research leading to the conception and/or actual reduction to practice of the subject invention;

(ii) An organization of which a person described in (h)(i) was a promoter or organizer or in which such a person is a director or holds a substantial financial interest; or

(iii) An organization of which the Institution was a promoter, organizer, or financier.

In such cases the Foundation's approval will normally be given only if the Institution can show that a bona fide effort was made without success to interest other organizations, known to be interested in the subject matter of the invention, in licensing and further developing the subject invention, or can show why the public interest will best be served by the proposed licensing arrangement."

3. Section VIII. (a) is amended by adding the words "in the United States" after the word "invention" in the last line thereof.

4. Section VIII. (h) is amended to read as follows:

"If the Institution elects to file no U.S. patent application or to abandon prosecution of a U.S. patent application on a subject invention, it shall, upon request, execute, or require

the execution of such instruments and other papers prepared by the Foundation as deemed necessary to vest in the Foundation all right, title, and interest in the subject invention in the United States and to enable the Foundation to apply for and prosecute U.S. patent applications."

5. Section IX.(a) is amended by adding the following paragraph at the end thereof: "However, if an application has been filed in a foreign country after these times but prior to such request by the Government, the Institution shall retain right, title, and interest in the subject invention in the country involved."

6. Section I. is amended by adding the following sentence after the first sentence thereof: "This agreement shall not apply to subject inventions in cases when the Institution is a subcontractor under a prime contract of the Foundation."

IN WITNESS WHEREOF, the parties have executed this Amendment No. 1 to Institutional Patent Agreement IPA-0001.

THE UNITED STATES OF AMERICA:

INSTITUTION:

By _____

By _____

(Official Title)

(Signature)

(Print or type name)

(Date)

(Title)

(Date)

CERTIFICATE

I, _____, certify that I am the _____ of the Institution named above; that _____, who signed this agreement on behalf of said Institution was then _____ of said Institution; and that this amendment was duly signed for and in behalf of said Institution by authority of its governing body and is within the scope of its powers.

Witness my hand and the seal of said Institution this _____ day of _____, 1974.
