



United States Department of the Interior

BUREAU OF MINES
WASHINGTON, D.C. 20240

June 7, 1974

Mr. Robert E. Gentry
Associate Vice President
The University of Wisconsin System
1725 Van Hise Hall
Madison, Wisconsin 53706

Dear Mr. Gentry:

Your letter of April 11, 1974, concerning the disposition of patent rights in the invention, "Magnetic Ore Separator," by R. W. Boom, Y. M. Eyssa, and J. Sutton, Contract No. G0112149, (MIN-2195), has been carefully considered.

Since you did not disagree with our view that the invention was made in the performance of the contract work, we will not dwell on that point. With reference to your second assumption, however, the presence of the issue as to whether or not the invention was the primary objective of the grant is not borne out by the sense of the proposal submitted for this grant. Therefore, as to the aforementioned invention, the grant provides that the Government acquires ownership if either the conception or reduction to practice occurs through expenditure of Government funds and, for the reasons stated in my letter of March 29, 1974, we have no legal authority to relinquish our domestic patent rights.

The Bureau has reached no final decision regarding our future intentions with respect to the invention. In the form that it was disclosed to us the invention did not appear to be patentably distinguishable from the prior art cited in a February 5, 1974, letter from the Office of the Solicitor to Professor Roger W. Boom, one of the inventors of the subject invention. A copy of the February 5, 1974, letter is enclosed. Although we sought additional information upon which to base an application for patent, to date we have received no response from Professor Boom. Unless he can provide us with the information requested by the Office of the Solicitor, we see no basis for applying for a patent and have no plans for so doing.

I have been advised that Mr. Eyssa's thesis was presented on June 19, 1973. If this thesis included a written presentation which was made available for dissemination and if it disclosed the invention then a statutory bar against patent protection would exist one year from date of publication. In that event, this whole question would soon become moot. In this

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connection it should be recognized that any published written disclosure describing the invention has the effect of immediately barring patent rights in most of the more important industrialized foreign countries. If the invention has not been publicly disclosed then foreign patent rights would be available to the University upon its request.

Sincerely yours,

Thomas V. Falkie¹

Director

Enclosure

Copy sent 6/10/74 to
✓ Howard Bremer
Roger Boom