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WISCONSIN ALUMNI RESEARCH FOUNDATION

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November 21, 1978 263-2831

PATENT BRANCH, OGC
DHEW

DEC 4 1978

Mr. Norman J. Latker
Department of Health, Education,
and Welfare

Mr. Jesse Lasken
National Institutes of Health

Dear Norm and Jesse:

Attached are some comments which I recently received from Ralph Shay at Oregon State relative to the amended Dole-Bayh bill. I have not tried to feed them into the new draft or consider them in that relationship at this time. They are sent to you as information and for your consideration.

Very truly yours,

Howard W. Bremer
Patent Counsel

HWB:rw
Enc.

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17 October 1978

Mr. Howard W. Bremer
Patent Counsel
Wisconsin Alumni Research
Foundation
614 W. Walnut Street
Madison, WI 53705

Dear Howard:

Recently I worked up the data on the number of patents issued per capita in each state and thought it might be of interest to you and other SUPA members so I enclose a copy for use as you see fit.

I look forward to seeing everyone again in Atlanta.

Sincerely,

Ralph L. Ely, Jr., Director
Office of University Relations

RLEjr:mlb

Enclosure

Dean of Research

Oregon State University

Corvallis, Oregon 97331 (503) 754-3437

November 13, 1978

Mr. Howard W. Bremer
Patent Counsel
Wisconsin Alumni Research Foundation
614 North Walnut Street
Madison, Wisconsin 53705

Dear Mr. Bremer:

It is generous of you to collect the suggestions for revision of the Dole-Bayh bill as you indicated in your October 10 letter from SUPA. I have gone over the bill copy I received September 18, 1978, and have the following suggestions:

1. Section 201(d): substitute "funding agreement" for "contract".

2. Section 202(b): in first sentence suggest 3 months be substituted for 6 months.

   Reason: I frequently receive an invention after a manuscript for a journal paper has been prepared or even submitted on the subject. Sometimes it will appear in print in less than 6 months from the time I am informed. I believe 3 months would be more workable at my level while still providing enough time for the federal funding agency.

3. Section 202(c)(8): This paragraph is not clear to me.

4. Section 202(c)(9): Suggest adding the following sentence or something similar to accomplish the purpose: "Federal employees who are co-inventors of any subject invention under this Chapter may share in inventor royalties awarded by the small business firm or non-profit organization who commercializes the invention."

   Reason: We have several federal research laboratories on the campus and a number of research

projects that are cooperative between the federal agency staff and our University staff. Also some of the federal staff are adjunct professors who may share inventions with graduate students who are employed by the University. It would make sense that such federal co-inventors receive benefits similar to that the University gives to its own staff co-inventors when the University obtains title to the invention and commercializes it.

5. Section 204: I gather some institutions are objecting to this provision. However, I think it is fair, and I would like to see the government (taxpayer) reimbursed for its contribution to the invention at these generous levels of income.

6. Section 205(a): How are we going to determine whether a corporation is foreign or substantially owned or controlled by foreign interests? I am not a student of corporate structures, but I understand the controlling interest may not always be common knowledge. Also what if the company is purchased by a foreign interest while a license agreement is in effect? Would it be automatically cancelled?

   I see trouble in meeting this provision unless some standard of determining foreign influence can be established.

I hope these suggestions are helpful.

With best wishes,

Yours sincerely,

Ralph Shay

J. Ralph Shay
Assistant Dean of Research

JRS:SLN