★ Hector's invention - cleared?

WARF'S OBLIGATIONS TO THE DEPARTMENT OF HEALTH, EDUCATION, AND WELFARE (DHEW)

I. Determinations under Section 8.2(b)

A. Green-Crane-Lester - Coenzyme Q
U.S. Patent No. 3,162,654, issued December 22, 1964
Determination - December 16, 1959

In accordance with Section 6 of the determination, U.S. Patent No. 3,162,654 was assigned to the U.S. Government, January 22, 1965.

WARF retained foreign rights and foreign patents were maintained by Merck & Co., Inc. through 1969, after which time they were allowed to lapse by nonpayment of tax by mutual agreement between Merck and WARF. The Canadian patent will remain in force until August 16, 1983, as there is no tax on Canadian patents.

B. Sih - Process for Preparing Steroids
U.S. Patent No. 3,507,749, issues April 21, 1970
Determination - Foreign - October 22, 1965
December 15, 1965
U.S. - July 11, 1967

1. Obligations complied with:

a. Copy of recorded assignment of U.S. patent application was sent to DHEW on November 21, 1967.
b. License to Government on U.S. patent application was executed on October 23, 1967.
c. Licenses to Government on each foreign patent application were executed on March 10, 1967.

2. Obligations outstanding:

a. Provide written annual reports commencing one year from the date of the determination agreement regarding the development and commercial use of the invention. The report for this invention is due annually by July 11.

b. Within three years from the date patent issues WARF must show cause why it should retain all right, title and interest in the invention. Deadline is April 21, 1973.
c. All licenses shall be subject to the conditions of the determination and copies of all licenses shall promptly be furnished to DHEW.

3. Obligation obsolete because of issuance of patent:

a. If WARF plans to abandon U.S. patent application it must offer to transfer rights to DHEW. If assignment is not requested within 90 days of receipt of offer, WARF may abandon patent application.

C. DeLuca-Blunt - 25-Hydroxycholecalciferol
U.S. Patent Application Serial No. 741,239, filed July 1, 1968
Determination - December 5, 1969

1. Obligations outstanding:

a. Furnish copy of recorded assignment of U.S. patent application to DHEW.
b. Grant license to Government on U.S. patent application.
c. Grant licenses to Government on each foreign patent application.
d. Provide written annual reports commencing one year from the date of the determination agreement regarding the development and commercial use of the invention. The report for this invention is due annually by December 5.
e. Within three years from the date patent issues WARF must show cause why it should retain all right, title and interest in the invention.
f. All licenses shall be subject to the conditions of the determination and copies of licenses shall promptly be furnished to DHEW.
g. If WARF plans to abandon U.S. patent application it must offer to transfer rights to DHEW. If assignment is not requested within 45 days of receipt of offer, WARF may abandon patent application.

D. Newhall - Internal Combustion Engine and Combustion Process
U.S. Patent Application Serial No. 15,345, filed March 2, 1970

A determination under Section 8.2(b) was requested from DHEW on February 27, 1970. To date we have had no reply.

II. Determination under Section 8.2(d)

A. West-Tobey - Cyclopropene Derivatives
U.S. Patent No. 3,335,194, issued August 8, 1967
Determination - April 29, 1966

1. Obligations complied with:

a. Copy of patent application and filing information was furnished to DHEW on November 10, 1965 and June 1, 1966.
b. License to Government on U.S. patent application was executed on February 2, 1967.

2. Obligations outstanding:

None

III. Institutional Agreement

A. Summary of WARF's obligations to the Department of Health, Education, and Welfare (DHEW)

A written report must be submitted to DHEW annually by September 30 reporting on inventions falling within the scope of the Institutional Agreement for the period July 1 thru June 30. In order that no inventions are omitted a separate list is kept for each reporting period. Also, a record is kept of the date each report is submitted and a copy of the report is attached to this record.

The attached invention record form has been prepared for complying with WARF's other obligations under the Institutional Agreement.

B. To date WARF has received two inventions under the Institutional Agreement.

1. Sih - Process for Preparing L-dopa (thru microbiological means)
U.S. Patent Application Serial No. 862,061, filed September 29, 1969.

A copy of the U.S. patent application, which was also considered to be the written invention report, was sent to DHEW September 25, 1969. The Serial No. and filing date was sent January 8, 1970. A copy of the recorded assignment was sent February 26, 1970. A license to the U.S. Government under the U.S. patent application was executed January 13, 1970.

The next pertinent date for this invention is the foreign filing deadline which is September 29, 1970.

2. Perrin - Method for Reducing Drug Availability in Combination with Highly Protein Bound Salts

A written invention report was sent to DHEW August 8, 1969.

A publication appeared in the Journal of Pharmaceutical Science, December 1969. The date of statutory bar to U.S. filing is November 30, 1970. If WARF decides not to file a U.S. patent application on this invention, it must notify DHEW 90 days prior to the statutory bar, or by August 30, 1970.

In order to assure complying with WARF's obligations set forth in the determinations from DHEW and the Institutional Agreement, all pertinent deadlines are recorded on the calendar for call-up and copies of the monthly calendar are sent to Messrs. Abrams, Bremer, and Woerpel in advance of the deadlines. They also receive memos reminding them of each due date a month or two in advance of the deadline.

NIH - Institute Agreement - Richardson
NSF - WALTERS

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