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COUNCIL ON GOVERNMENTAL RELATIONS

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July 5, 1984

TO: PRIMARY REPRESENTATIVES OF PARTICIPATING UNIVERSITIES

FROM: Milton Goldberg *WJ*

FROM: Vice President's
Office
DATE: 7/12/84

SUBJECT: Voluntary Invention Utilization Reporting to Federal Agencies
under P.L. 96-517

P.L. 96-517 (35 USC 202(c)(5)) provides for reporting by universities to a federal agency on the utilization or efforts at obtaining utilization being made by the university with respect to inventions that have arisen under an agency's funding and where the university has elected to retain patent rights.

OMB Circular A-124, effective March 1, 1982, designates the Department of Commerce as the lead agency, and gives it the responsibility for developing an information collection system relative to invention utilization. As provided by Article 10 of the Circular, the Council on Governmental Relations has held discussions with representatives of the Department of Commerce on the content of invention utilization reports, and the specific data elements that should be included.

Voluntary reporting of invention utilization by the university community will provide the information needed by the federal agencies, and will, in our opinion, preclude the need for a mandated reporting form. Such a mandated report would most likely include many more data elements, and place an unduly lengthy, burdensome, and unneeded requirements upon universities.

All universities, not just COGR members, are encouraged to voluntarily report on invention utilization.

Reports should be filed in duplicate with the Department of Commerce by September 30 for the preceding fiscal year ending June 30. If your fiscal year does not end on June 30 and a September reporting date causes an undue burden, contact the Department of Commerce and request a more convenient date.

An instruction sheet of explanation and the suggested data reporting form are enclosed.

Enclosure

cc: Bruce Merrifield, Department of Commerce

RECEIVED

JUL 10 1984

Univ. of Wis. Vice President
and Trust Officer

INSTRUCTIONS P.L. 96-517

INVENTION UTILIZATION REPORT

The use of the attached form, Public Law 96-517 Invention Utilization Report, by all universities is encouraged to meet the requirements of that law and OMB Circular A-124.

NOTE: Letters and numbers on the form are given only for the purpose of relating these instructions to the form.

WHAT TO REPORT: Provide only to the form the data elements shown on the form. If comments are necessary, include them under 16.

WHEN TO REPORT: Annually, no later than September 30 for the preceding fiscal year ending June 30.

HOW TO REPORT: Reports may be made using this standard form, or by a computer print-out containing the same information but in a different format. Reports should be stored as a set by each federal agency. Two copies of each set should be provided and mailed with a transmittal letter signed by an authorized official, to:

Invention Utilization
Office of Productivity, Technology, and Innovation
Department of Commerce
H4816
Washington, D.C. 20230

MULTIPLE AGENCY SUPPORT: Report only the one agency that has been designated pursuant to Paragraph 16(c) of Circular A-124.

DATA ELEMENT INSTRUCTIONS:

- a. Enter name of university *regardless* of whether the university or a patent management organization is actually doing the reporting.
- b. Enter year of reporting.
- c. 35 USC 202(c) (5) and Circular A-124 at 10(b) provide protection against the release by the agency of privileged and confidential information if the document is so marked. Include the "Privileged and Confidential" notice on all reports containing such information.
 1. To the extent practical, use full agency name or abbreviation, such as "DHHS", not "NIH" or other subdivision thereof.
 2. Enter full grant or contract number.
 3. Always report this date.
 4. Report only if an election has been made.
 5. Use same title as originally reported to agency where practicable. The title on a patent application may be different.
 6. Enter the university case number that was used on original report to agency. (See item 3.)
 7. Report same inventor name(s) as used in original report.
 8. and 9. Enter only if an application has been filed, and the filing date and serial number have been received from the U.S. Patent Office.
 10. and 11. Enter if available, as in 8. and 9. above.
 12. List countries other than the U.S. where filing has taken place.
 13. Enter date reported to you by licensee(s). (See c. above.)
 14. Enter only amount received during year of reporting in U.S. dollars. (See c. above.) Do *not* report total cumulative income.
 15. Enter number only, not names of licensees.
 16. Summarize briefly status of non-licensed inventions as instructed, along with relevant comments if any.
 17. Same as above, unless a patent management organization is doing the reporting, in which case that organization should be named.
 18. Sign individual sheets if only a few inventions are being reported. Otherwise, the transmittal letter signature is sufficient for all enclosed reports.