

DATE: February 1, 1980

To : NJR

FROM : JKP 

SUBJECT: Status Report Wrap-Up

The following comments summarize the status and next action, if any, for each of the dockets I have been handling.

## UNLICENSED INVENTIONS

## 1. S78-76 (Stocker) Live Salmonella Vaccine

Comprises license of present disclosure with option covering corporate research effort with Smith Kline, \$47,500/year. Glaxo (UK) was also interested, and Dr. Stocker wants to wait until all deals are signed before turning them down.

Bert Rowland is filing. I have sent SK copies of our "standard" license and option agreements. No specific terms (e.g. front payment or royalties) have been agreed to. Final license and option agreements have been drafted. I have discussed with GFM, and I think he would enjoy helping you on this one to experience closing a deal.

## 2. S79-50, S78-33, S77-49 (Auld) Ferromagnetic Probe

Nortec has our "final draft" license under review of their UK parent company. I recently called Chuck Frederick, and he is to get back to us. I recommend GFM keep in touch with Nortec on a regular basis. Also, when the Nortec license is finalized, a brief (Aldo sez one page) non-exclusive license to Rockwell is needed (\$4000).

## 3. S79-66 (Levy) Hybridomas

Per our recent letter agreement with B-D, Levy was to forward clone L17F12 to B-D to start the relationship. Before the license can be finalized, B-D needs to tell SU which of the cell lines it intends to market. A front payment of \$1000 per clone has been agreed to by Bernie S.

## 4. S74-43 (Charron, McDevitt) HLA Antibodies

As with Levy above, a letter agreement is in process to allow McDevitt to transfer his two anti-HLA clones to B-D. B-D already has your license agreement which Bernie has agreed to sign.

## 5. S79-32 (Schrier) Spectrin and Actin Antibodies

Needs marketing - potential applications unknown. Check with Bernie again re his interest.

## 6. S80-07 (Robinson) New Organisms

Per your note, Abbott is interested. However, I have had no response to my recent memo to Robinson asking for completed disclosures (we don't know what he's got).

## 7. S79-44 (Young) X-ray Contrast Agents

Dr. Young has been approached by GAF and others re acquiring patent rights and sponsoring research. Young would go through us if we would patent - however, Bert determined that there was little, if anything, to patent. I have tried to convince Young to have us interact with GAF, etal, to work out a deal wherein GAF would pay patent expenses, etc. Next action could be (a) try again with Young or (b) drop.

## 8. S79-17 (Davis/Sherer) Chromosome Segments...

We have a pre-print of a paper and no disclosures as yet. Since Davis did not show for our meeting with Bert, I learned nothing further re patentability or utility. (Bert has reviewed the paper and can explain its significance.)

## 9. S79-10 (Davis) Sterile Host Yeast (SHY)

See above re Davis no-show. Patent application has been awaiting his review and signature for many months. Diligence with Patent Office could become a problem, and NSF wants to know what's happening. A UC-type deal has been proposed to MIT to include co-inventor (Botstein). Nothing can be done at this point without Davis, and I feel OTL (not Bert) should nail him down.

## 10. S79-09 (Stark/Wahl) DNA Print

Need to find market and company. Suggest talking with Stark and then Bernie. May only be a research market for some time.

## 11. S79-07 (Brody) Timing of X-ray Exposure

This is "Invention B" of the GE Radview deal. GE can file on it at its sole discretion and expense. I have discussed with Stoner several times, and he has yet to make a decision.

## 12. S78-77 (Cohen/Nunberg) Ribosomal Binding Site

Need to understand more about this technique and its potential applications for protein synthesis. Suggest discussing it with Bert Rowland and Upjohn, then with each company you deal with on the Cohen/Boyer license (keeping the deals separate).

## 13. S78-72 (Gerzberg) PROM

In my last contact with Levy, he requested that we hold off on approaching companies because he was making some contacts of his own.

## 14. S78-66 (Byer) Tomographic Pollution Measurements

I believe GFM has a good handle on this one following our recent meeting with Byer, and we now have Byer's problems with the Rights Agreement cleared up.

## 15. S78-46 (Trutna) Raman Cell

Byer said recently that we should consider bringing the patent through to issuance because "lots of people are using this technique now." However, royalty-bearing sales of licensed products are not presently foreseen. Perhaps further discussions with Byer would give you some new data on which to make the patent issuing decision.

## 16. S78-45 (Gerzberg/Meindl) RC Device

The Western Digital license could be considered "in final form" at this time, depending on which prints you would care to continue negotiating. Japan rights need to be finalized with Yamaha, and I have sent Kamiya a telex. Also, I asked Aldo and Hank to think about a fixed royalty amount per device vs. the 3% and 5% numbers.

## 17. S77-03 (Maginness) Transducer Assembly

Probable drop. This is one of the ultrasonic imaging package we have been unable to license. No hot leads at the moment.

## 18. S78-17 (Macovski) Ultrasonic Electronic Lens

Similar to S77-03, except that we have patent money invested in it. Varian wanted an option at one time, but I had hoped another company would pick it up - given our experiences with Varian. Probably should contact Al M. and find out what he knows/thinks.

## 19. S78-16 (Schawlow/Kowalski) Spectrometer

No known potential licensee. Suggest a contact to Kowalski re present level of development and application.

## 20. S78-19 (Byer) Wavelength Meter

Major development program with DOE money for a few prototype systems should be nearing completion. Check with Byer.

## 21. Software

SPIRES: Ill be having lunch with Yundt soon and will "debrief" him re Tymshare

SPRINT/DDI (Van Cleemput): Next step may be obvious following next meeting with Adrian and Van C. Two venture capital firms are talking with Van C., and I would suggest a cooperative effort with Van C. to put together whatever package of rights and knowhow will attract those investors.

## 22. S79-28 (Macovski) X-ray Scanner Grating Systems

GE has disclosure. Agency wants to know status. Al would consider filing the application himself under terms similar to the Radview deal.

## 23. S75-27 (Shott/Meindl/Melen) Cascade CCD

Don Specht at Smith Kline Instruments is interested in licensing the patent rights provided that Meindl's lab has had some positive bench results on subsequent versions of this device. Meindl has not responded (of course) to my memos.

RESEARCH/OPTION AGREEMENTS

## 1. S78-16 (Brody/Macovski) Radview

See S79-07 above re patent filing decision. Might be a good idea to read both the License/Option and Research Agreements fairly carefully and check with Macovski re patent prosecution.

## 2. S78-48 (Michaels) Dialysates

See Alan Michaels' last letter to Cobe. Cobe to verify their decision to not exercise their option. Who pays on-going patent expenses?

LICENSED INVENTIONS

## 1. S79-19 Stanford Trademarks (Bookstore)

The license provides for regular reporting (see Eldon's recent

one-liner!) Aldo has TM filings under control--with the exception of Descente in Japan. Check with Eldon and George Gregory.

2. WYLBUR

Per Yundt, OBS is drafting a new license to incorporate all amendments, including some new ones. My suggestion to Yundt was to give OBS everything reasonable, considering the \$38,000 quarterly royalty payment we received recently.

3. S76-47 (Plummer) TRIMOS

Patent should issue soon. Second annual exclusivity minimum due August (\$5,000). Probably should inquire re progress to market. Is Western Digital still interested in a sublicense?

4. S76-18 (Macovski/Alvarez) Energy Reconstruction

Assignment to GE acknowledged. Check with Stoner re GE's own use and sublicensing activities (or are they using it as "trade bait" in crosslicensing?)

5. S75-49 (Chowning) Digital Synthesis (Option)

Per Amendment No. 2, the Option with Systems Concepts expired December 31, 1979. I recall that Chowning was to reach an understanding with them whether to extend again. This equipment (for which we grant back software development rights) is presently without computer power due to CCRMA's recent move.

6. S75-48 (Macovski/Boyd) Rectilinear/Orthogonal CAT Scanning

Assigned to GE. Check with Stoner whether any development is in process or if these are just part of his patent ammo supply.

7. S75-33 (Powell) Spark Timing System

Long lost Wally P. I sent him a close patent assigned to GM--no reply. Perhaps GM can follow up. I've read about competitive approaches nearing the market, so you may want to resurrect this one and check it for present value, if any.

8. S74-56 (Sherby) Superplastic Steel

Option to SP TEK extended another 6 months. I think Oleg/SP TEK is the best chance you've got (see his last letter and my notes for marketing status).

9. S74-32 (Boyd) The CAT Scanner Trio

a) Fan Beam -- need to check with Stoner re progress of EMI Interference. Sally now has Stoner straightened out on GE's reimbursement of expenses.

OR  
b) Detector -- Could be a "sleeper" goldmine. Semi-annual royalty payment due soon (\$30,000). On this one, obviously keep Stoner happy!

c) Rebinning -- I agreed to cover patent reissue fees (approximately \$1,000) especially considering the detector pay-off. (Stoner mentioned he was feeling a little "fleeced" by SU these days!)

10. S73-64/65 (SCIP) BASIC/LISP

Doubt Fujitsu will request any further amendments, but the last one, for European sublicensing rights, (we got \$6K) was a nice surprise. Yundt will probably hear about anything first.

11. S73-42, et al (Byer) Tunable Laser and Raman Mixing

Quanta Ray may be getting close to using our technology (Raman Mixing) soon. Guy Conger is evaluating a fairly detailed business plan describing Quanta Ray's growth plans. Byer is usually well-informed, and Mortensen is accessible.

12. S72-45 (Moffat/Hackel) Infant Transporter

Considering that we have no patent rights here, Cavitron is being nice in their observance of the license terms. Gravy.

13. S71-17 (Chowning) Digital FM Sounds (Amendment No. 3)

The \$100,000 (or \$90,000) payment is tied to Mike's efforts to get the Japan Tax Exemption. Dean Rosse and I agreed that it was worth a shot at \$10,000 to wait two more weeks when Mike's chief lawyer contact will be in Japan and will report back to him re status of our application.

cc: George Murphy  
Kent Peterson  
JKP:sh