



DEPARTMENT OF HEALTH & HUMAN SERVICES

Office of the Secretary  
Office of the General Counsel

Public Health Division  
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September 30, 1999

Jonathan Cohen  
Director of Intellectual Property  
Ventana Medical Systems, Inc.  
209 Perry Parkway  
Gaithersburg, MD 20877

RE: DOE Petition  
Your Ref. No. 100/001

Dear Mr. Cohen:

This is in response to your letter to me dated September 21, in which you request the assistance of one or more members of the National Institutes of Health's Office of Technology Transfer (OTT) in connection with a petition Ventana Medical Systems filed with the Department of Energy (DOE).

Ventana has asked DOE to help Ventana obtain a sublicense from DOE's contractor, the University of California, and the University's exclusive licensee, Vysis, Inc., in an invention DOE waived to the University. You would like OTT staff members to provide expert testimony on Ventana's behalf, or to provide technical support to DOE, to ascertain what are "commercially reasonable licensing terms for the subject invention". In view of the Government's involvement in this matter your request is not considered a request under 45 CFR Part 2, applicable to requests for testimony by employees of the Department of Health and Human Services in proceedings where the United States is not a party.


I spoke with Paul Gottlieb, DOE's Assistant General Counsel for Technology Transfer and Intellectual Property, who informed me that he did not believe DOE needed OTT's assistance at this time. I consulted with representatives from OTT who have indicated a reluctance to provide testimony in this matter and suggested that companies providing diagnostic technologies might be a better source of information.

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Accordingly, inasmuch as DOE has not requested assistance and OTT does not desire to provide testimony, your request is denied.

Sincerely,

  
Richard A. Lambert  
Counsel for Intellectual  
Property

cc:

Marie Freire  
✓ Paul Gottlieb

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