



# Metropolitan Water Reclamation District of Greater Chicago

100 East Erie Street  
Chicago, IL 60611

## Legislation Text

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**File #:** 18-0902, **Version:** 1

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### **TRANSMITTAL LETTER FOR BOARD MEETING OF SEPTEMBER 6, 2018**

#### **COMMITTEE ON MONITORING AND RESEARCH**

Mr. John P. Murray, Acting Executive Director

Authorization to enter into a Letter of Engagement between the Metropolitan Water Reclamation District of Greater Chicago and the law firm of Ulmer & Berne LLP to provide legal services to the District in connection with the application and prosecution of a joint patent for certain intellectual property co-owned by the District and Iowa State University Research Foundation

On June 21, 2018, the Board of Commissioners authorized the District to enter into a Joint Ownership Agreement ("JOA") with Iowa State University Research Foundation ("ISURF") for the purpose of pursuing the joint development of intellectual property ("IP") related to an algal biofilm treatment system. Under the terms of the JOA, ISURF has the responsibility to manage the development of the IP on behalf of ISURF and the District, which includes pursuing a joint patent for the IP. The JOA grants ISURF the authority to retain legal counsel to assist with this process, but the District has the right of approval. ISURF has recommended retaining the legal services of Ulmer & Berne LLP ("Ulmer") to pursue the jointly owned patent and any related legal work. Ulmer is a firm that is familiar to ISURF and its lead counsel, Vance VanDrake III, is a partner specializing in intellectual property law. As set forth in the JOA, the District is not obligated to pay any legal fees to Ulmer, but the District's share of the legal fees for this representation would be taken out of the District's share of any proceeds from the commercialization of patented IP. In the absence of generating income from the licensing of IP, the District is not obligated to pay any fees.

In connection with its co-representation of ISURF and the District, Ulmer has requested that the District execute a Letter of Engagement establishing the existence of an attorney/client relationship with the District, but acknowledging the District is not responsible for paying any legal fees. It is in the best interest of the District to execute the Letter of Engagement so that the process of patenting the joint IP may commence under the guidance of Ulmer.

Approval is requested from the Board of Commissioners to enter into a Letter of Engagement with the law firm of Ulmer & Berne LLP and to grant authority to the Acting Executive Director and the General Counsel to execute documents as necessary to effectuate the engagement of these legal services.

Requested, Susan T. Morakalis, General Counsel and Edward Podczerwinski, Director of Monitoring and Research

Recommended, John P. Murray, Acting Executive Director

Respectfully Submitted, Kari K. Steele, Chairman Committee on Monitoring and Research

Disposition of this agenda item will be documented in the official Regular Board Meeting Minutes of the Board of Commissioners for September 6, 2018