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July 6, 1998

William J. Dalton
Corporation Counsel
American Cancer Society
1599 Clifton Road
Atlanta, GA 30329

Re: Request for Standing Exception to American Cancer Society Policies on Research and Clinical Investigation Grants for the University of California

Dear Mr. Dalton:

The American Cancer Society (ACS) and the University of California (UC) have had a long and beneficial research relationship. The University appreciates the ACS's research support and shares its commitment to promptly make the results of that research available for the public benefit. UC has successfully transferred research results for over 40 years. The UC Office of Technology Transfer is comprised of approximately 70 individuals dedicated to the prompt transfer of all potentially beneficial discoveries. Among our successfully licensed products and processes are the Cohen-Boyer Process for Splicing Genes that launched the biotechnology industry, the Hepatitis-B Vaccine, the Human Growth Hormone, and the Nicotine Patch. A copy of our FY97 Technology Transfer Program Annual Report is enclosed for your review. We are concerned, however, that certain provisions of the American Cancer Society Policies on Research and Clinical Investigation Grants (Policy) seriously compromise our ability to transfer the results of ACS-funded research. I have outlined our concerns, below.

Pursuant to the Policy, UC has an obligation to report to ACS all inventions that arise from its sponsorship. To ensure effective licensing of these technologies, we routinely request a waiver of certain provisions in the Policy. Historically, ACS has granted our requests for waiver in all cases. The purpose of this letter is to request that ACS consider granting a standing exception to its Policy, as discussed below. This standing exception would apply to all recently disclosed and future ACS-related invention disclosures for any University of California campus.

The first ACS provision of concern is:

"That the grantee will not grant an exclusive license under such patent to any for-profit person or organization for a period to exceed ten (10) years without written permission of the Society."

"UC agrees that when it licenses any invention or intellectual property to a third party for commercialization that it will include provisions in the license to obligate the licensee to commercialize the technology in a diligent manner, and to include specific diligence requirements and milestones. UC will be responsible for monitoring such diligence provisions, and in the event that the licensee has failed to commercialize the technology in accordance with such diligence provisions, UC shall have the right to either terminate the license or convert an exclusive license to a non-exclusive license so that it may seek other licensees."

If ACS agrees to grant a standing exception to Policy for UC, as outlined above, please sign below and return one copy of the letter to my attention at the address above. Approval of this request would eliminate the need for UC to repeatedly request waivers for each invention and for ACS to re-visit these issues for each UC invention.

If you would like to discuss this further, I can be reached at (510) 587-6061. If I have not heard from you by July 24, 1998, I will give you a call. We believe that approval of this request will support our mutual interest in making research results available for the public benefit in a timely manner while adding administrative efficiencies to the process. I look forward to your reply.

Sincerely,



M. Jeremy Trybulski
Campus/Sponsor Liaison Analyst

Enclosure

Approved:

American Cancer Society

Name

Title

Date

cc: Associate Director Acanfora