

The University of Wisconsin
INSTRUMENTATION SYSTEMS CENTER

1500 Johnson Drive
263-1552

MEMORANDUM

To Marv Woerpel and Howard Bremmer

Date June 18, 1976

From N. E. Huston

Subject _____

Enclosed are some trial woods for the application for advance waiver of domestic rights for the NASA BATEam program.

We are going to have to justify this on the basis of exceptional circumstances -- that it is in the best interests of the government and will significantly advance the availability of inventions to the general public. (See section (b) (2) of 1245.104 of Patent Waiver regulations -- and especially phrase on "a contract having as a principal objective the application of aerospace related technology to other uses").

Section (i) and (i) (1) of the form, in particular, need your fine touch and appropriate words as to why the "exceptional circumstances" apply.



Norm Huston

W/enclosure
cc: H. Hess

- (1) The University of Wisconsin does not itself apply for nor hold patents. Such endeavors are handled through the Wisconsin Alumni Research Foundation which was established in 1925 for the purpose of assisting University of Wisconsin personnel in transferring their research results to the industrial sphere through patent licensing.

WARF, though not part of the University, exists for the sole purpose of assisting this University in the patent licensing matters and through the support its earnings provide for the research program of the University. Except for a 15% share for the inventor(s) all of the net royalty income is granted to the University of Wisconsin each year for distribution by the University Research Committee.

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DRAFT 7/21/76

In reviewing this petition for an advance waiver of domestic and foreign rights to inventions made under the subject grant, we respectfully submit that the authorizing board or committee should consider how it can best motivate the timely transfer of new knowledge obtained by our research to the public sector. The two factors of foremost importance will be:

1. Time
2. Effectiveness

NASA needs the assistance of a technology transfer force to accomplish its avowed purposes. Our answers to questions (i) and (i)(1) in the petition for advance waiver have qualified the skills and good record of the University of Wisconsin's Technology Transfer group, namely, the Licensing Division of the Wisconsin Alumni Research Foundation (WARF). This group is in almost daily contact with representatives from commercial companies who are seeking new technology. In fact, one of its greatest assets for accomplishing the licensing function is the many acquaintances it has throughout the United States and to some extent foreign industry.

Until it has rights to an invention, however, WARF has no reason or incentive to work on its placement with industry, nor will industry be receptive. Early knowledge and early possession by WARF

of a particular invention will enable it to be promptly placed for consideration with many potentially interested companies.

On the contrary, without advance waiver, the first energy of WARF will be diverted to the task of submitting reasons why rights to the particular invention should be left with it by NASA. This can only mean that a substantial time will be lost before WARF will feel justified in introducing the new discovery to its industrial contacts. Experience with the "case by case" determination at DHEW and NSF taught how long that delay can be, and demonstrated the inefficiency of this procedure. The eminently workable arrangement for advance waiver now formalized in the Institutional Patent Agreements between those agencies and the University of Wisconsin has proven the value of the latter procedure.

We suggest that it is in the public interest to have WARF "put to work" on transferring any new discovery arising out of research supported by the subject grant at the earliest possible date. That will be accomplished by NASA granting the advance waiver here requested.

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Title: University of Wisconsin Biomedical Applications Team Program

RFP No.: RFP-78041/227

Board of Regents, University of Wisconsin System

- (a) To continue the operation of the UW BA Team with the overall goal to expedite the transfer of aerospace technology to the biomedical field, in response to user problems and requirements. This shall require the development and application of methods to facilitate the utilization of aerospace technology to solve significant biomedical problems which meet professional criteria for technical significance in the biomedical engineering field and which represent an advance in the "state-of-the-art" in medicine. Emphasis shall be on those problems which, if solved, will benefit the overall medical practice to the greatest extent (Work statement attached).
- (b) The principal purpose of the contract is to achieve beneficial applications of aerospace technology for the improvement of health care.
- (c) \$263,000; 1 July 1976 through 31 December 1977
- (d) The reference contract for the UW-Biomedical Applications Team has the objective of identifying and developing application of aerospace technology to other uses, specifically in the biomedical area, in accordance with the established NASA technology application component of the NASA Technology Utilization Program. It is the intention that, to the extent practicable, the application developments be carried to the point where commercialization by appropriate industrial firms can be implemented.

- (e) No
- (f) In accordance with the objectives and intent of the UW-Biomedical Applications Team program, as delineated in items (a) (b) and (d) above, the contract requires exploration into applications of aerospace technology in the biomedical field with the aim of utilization and beneficial impact in the delivery of health care in the public sector.
- (g) No
- (1) No
- (h) The field of science and technology of the work of the contract is biomedical engineering. The application of engineering methodology and aerospace technology for the solution of problems and needs in biomedicine is encompassed in the fundamental definition of biomedical engineering.
- (1) No
- (i) The University of Wisconsin-Madison has a very large and varied program in biomedical engineering involving more than fifty faculty and academic staff and more than fifty graduate students. The Medical School is one of the nation's major schools with many nationally and internationally recognized specialists. UW-Madison has enjoyed the distinction of two Nobel Laureates in the biochemistry and biomedical areas. Many UW-MSN generated patents have been successfully commercialized through the Wisconsin Alumni Research Foundation (WARF). The WARF record for achievement in the commercialization of innovative advances in the biomedical and life sciences field is outstanding.

This section needs help from WARF

(1) The University of Wisconsin does not itself apply for nor hold patents. Such endeavors are handled through the ~~link~~ with the Wisconsin Alumni Research Foundation. ~~The commercial position is indirect since the implementation of wide-spread use of patented processes, techniques and devices is accomplished via licensing arrangements.~~

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