

Guidebook of IP/Technology Transfer

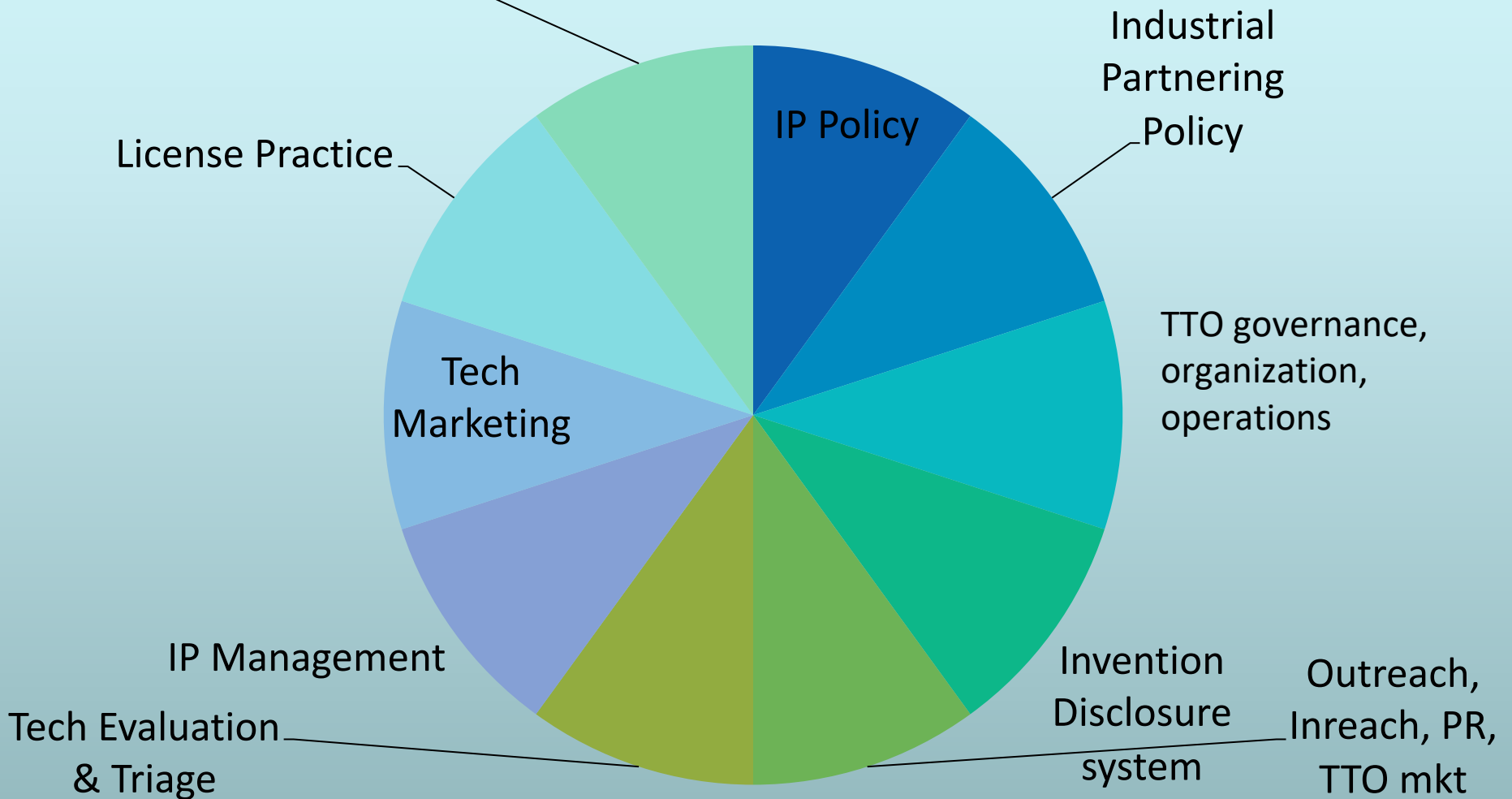
Track 1

Entry-level Tech Transfer Professional

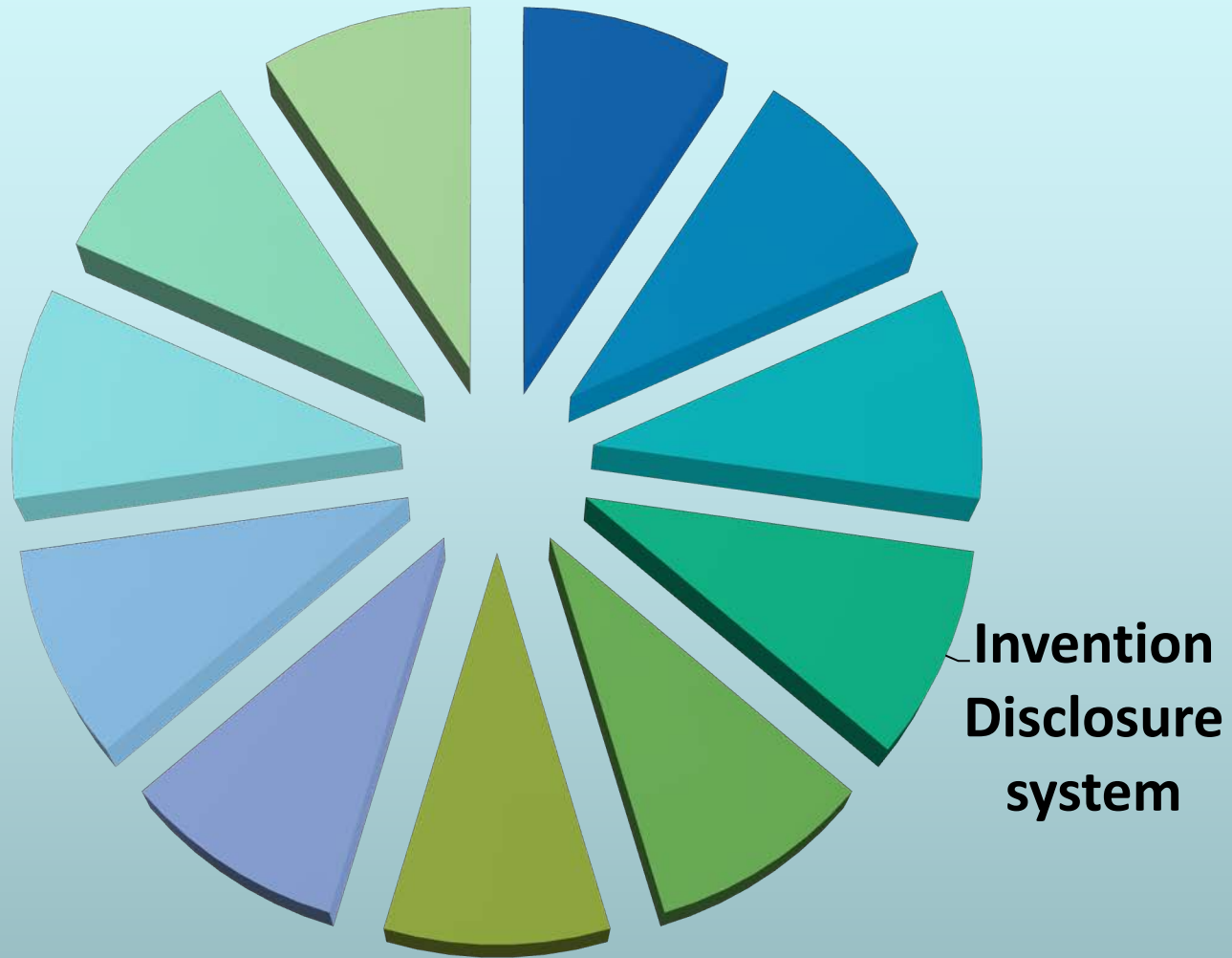
Topic 1.4.1

An Invention Disclosure and its Basic Elements

Technology Transfer system



Technology Transfer System



Invention Disclosure system

- Where the IP/TT process really begins
- The first formal description of the invention
- Structured form, and process
- Adequate information capture
title, inventors, sponsors, description, etc.
- Consider the burden on the inventor
- On-line system
- Systematic and error-free submission,
safe-keeping, and tracking
- Effective archiving and retrieval

Steps of the Technology Management and Pre-commercialization Process

1. Rapport & Discussions with (potential) inventors
2. **Receipt of Disclosures**
3. **Administrative Assessment (correct? intact?)**
4. Preliminary technology assessment
5. Preliminary IP assessment
6. Selection
7. Inventor conference, prep for IP filing and tech marketing
8. Technology Marketing
9. Initial contacts with interested parties
10. Serious license discussions

Steps of the Technology Management and Pre-commercialization Process

10. Pre-negotiation valuation
11. Term sheet negotiation
12. License drafting & negotiation
13. Closing the deal and signing
14. Ongoing license management



The IP/invention Commercialization Process



Interaction w/Inventors

- These are your primary clients
- Respect their time, be responsive & accessible
- Encourage early/often invention disclosures
- “walk the halls”, visit laboratories
- Go to department seminars
- Visit poster sessions
- Treat “bad” inventions with care & respect
- All inventors treated as equals

Receive disclosure

- This is where the process formally begins
- Initially all you need is: title, inventors, description
- Don't hassle the inventor for more detail at the beginning
- Treat the disclosure like it's a \$10,000 bill (very carefully!)
- Make sure it is properly registered into the system
- Schedule an appointment with the inventor(s) right away
- Start doing your homework about the invention

The IP/invention Commercialization Process

Administrative Assessment of disclosure

- Are all inventors named (and only inventors)?
- What is the institutional affiliation of all inventors?
(ownership issues)
- Sponsorship? Who funded work? Do they have IP rights?
- Publications planned or submitted? Timing?
- Did inventors use 3rd party materials (MTA?)
- Were special facilities used, which have IP “strings” attached?

The IP/invention Commercialization Process

The Invention Disclosure Form:

Essential Information

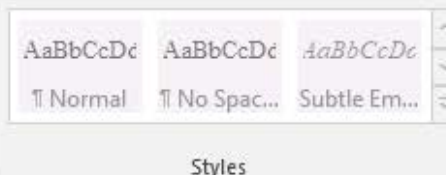
1. Invention Title
2. Names, affiliations of ***all*** (but only) inventors
3. Description of invention
4. Funding source(s)
5. Biological materials used
6. Publication schedule

The Invention Disclosure Form:

Useful Information

1. Prior art publications and patents
2. Problem the invention solves or opportunity created
3. Potential applications, industries, markets
4. Possible types of company partners
5. Names of companies potentially interested
6. Manuscript drafts of publications of invention

File Home Insert Design Layout References Mailings Review View Help Acrobat



INVENTION DISCLOSURE FORM

The purpose of this form is to obtain a description of your invention to assist in the patent process. Please answer the following questions as well as possible. Attach additional sheet(s) if needed. *(The spaces will expand automatically for electronic users).* (For help, please consult the Example Completed Invention Disclosure on www.epri.com.)

Work ID: _____ Project ID: 063882

Date of Submission to IP Dept. September 23, 2012

EPRI

Project Manager: Elaine Epri Sector: PDU

1. **TITLE:** Provide a title that is descriptive of your invention.

ADVANCED HYBRID POWER TRAIN FOR AN AUTOMOBILE

2. **IDENTIFICATION OF INVENTOR(S):** Identify the key inventor to whom questions can be directed. For each inventor, provide the following:

A. (Key) Full legal name	Jonathan Simple Doe
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Invention Disclosure – CONFIDENTIAL
UA FILE #

How to Use This Form

This is a protected Microsoft Word form. Simply tab or use your mouse to move between form fields. Each field will expand as you type. Please make your responses brief but complete. See page 3 for detailed instructions.

Title of Invention (Broad, non-confidential – See Guidelines)

Brief Summary (Attach abstracts, manuscripts, additional information – See Guidelines for help)

This is:

☐ Software

☐ ITAR project-related

☐ a Banner-covered study

Voice of the Inventor (One or two sentence description of your vision for the technology)

Invention Support (Check where appropriate and add information as necessary)

Internal Funds Identify the source of the internal (UA) funding used to make this invention.	<input type="text"/>
State or Federal Funds Sponsor Name & Grant/Contract Number – Information should be consistent with information provided to sponsoring agency in reports.	<input type="text"/>
Commercial, Corporate or Other Funds Industry Sponsor Name, Grant/Contract Number and (%) contribution by grant to your invention.	<input type="text"/>
3rd Party Materials or Data Any materials or data from another party? If so, please list the materials and the third party.	<input type="text"/>

Publication Date(s) Papers, posters, etc., including those that are planned/future – See Guidelines.

Event	Date	Reference/Comments
<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>

Commercial Potential

Current known product technology: <input type="text"/>
Patent law expertise: <input type="text"/>
If additional, identify any 3 rd party elements incorporated into the work, including developers: <input type="text"/>

Contributors (List any contributors [e.g., inventors]. Contribution % must add to 100% for all UA Contributors. First listed is Primary Contact. See Guidelines for additional info. Use additional page if needed.)

Primary Inventor / Primary Point of Contact			
First: <input type="text"/>	Last: <input type="text"/>	Citizenship: <input type="text"/>	
Position: <input type="text"/>	Department: <input type="text"/>	Work Phone: <input type="text"/>	
Work Address: <input type="text"/>		Email: <input type="text"/>	
Home Address: <input type="text"/>		Gender: <input type="text"/>	Contribution %: <input type="text"/>

- https://www.neustel.com/wp-content/uploads/2017/01/pdf/invention_disclosure_form.pdf
- https://www.wipo.int/edocs/mdocs/aspac/en/wipo_ip_bkk_17/wipo_ip_bkk_17_8.pdf

Track 1

Entry-level Tech Transfer Professional

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An Invention Disclosure and its Basic Elements

Thank you