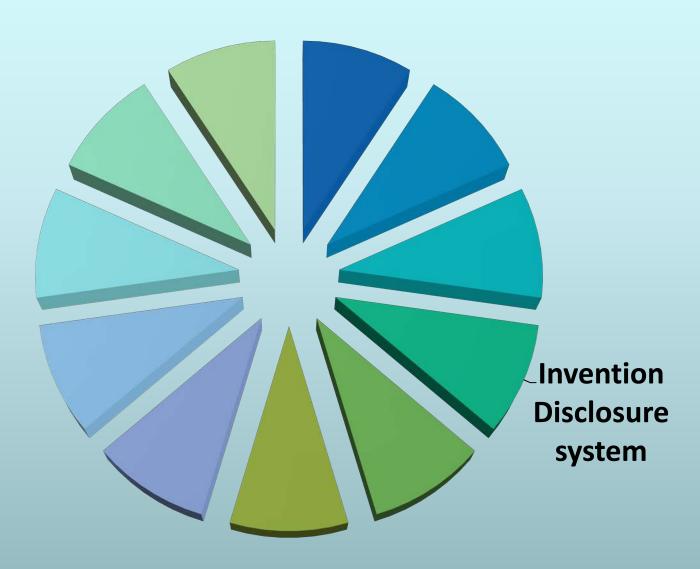
# Guidebook of IP/Technology Transfer

# Track 1 Entry-level Tech Transfer Professional

**Topic 1.4.3** 

**Managing the Invention Disclosure Process** 

### **Technology Transfer**

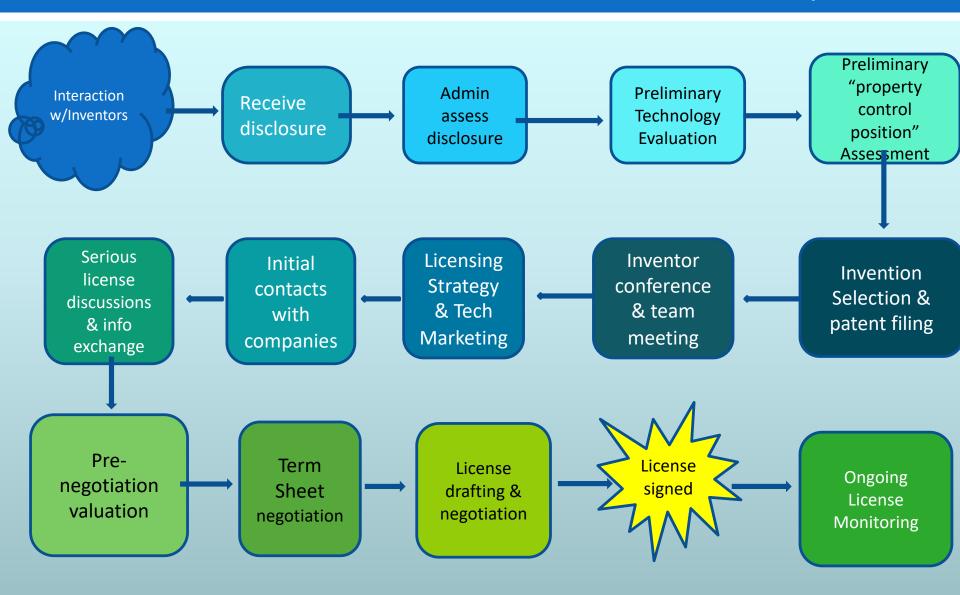


- Where the IP/TT process really begins receipt of an Invention Disclosure starts the formal process of evaluation and selection
- Structured form, and process
   this is essential in establishing a structured
   technology transfer function at an institution
- Adequate information capture title, inventors, sponsors, description, etc.
- The initiation of the invention file an essential part of creating an intellectual asset

- Consider the burden on the inventor
   balance the info needs of the TTO with the
   burden placed on the inventor inventors are
   busy and don't love bureaucracy
- Ok to ask many questions of inventor just don't expect all answered at the time of the disclosure
- On-line system may be the most efficient and effective; but hardcopy ok too
- The TTO MUST establish a systematic, error-free submission process, with adequate safe-keeping, tracking, and highlyeffective/foolproof archiving

- The TTO should require inventors submit basic and essential information
- TTO ask for but not require additional, useful information
- The TTP should meet with inventors to discuss Invention Disclosure that includes basic/essential info

to clarify and correct basic info, if necessary to expand Disclosure with additional information useful for IP and commercialization purposes



The IP/invention Commercialization Process

Receive Invention 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

- 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 3<sup>rd</sup> party materials (MTA?)

#### The IP/invention Commercialization Process

 After the TTP has met with the inventors and clarified/verified the administrative information....

discussion can transition into technical performance, inventiveness.....

and then,

...... Problems solved/opportunities created, applications, market relevance....

..... And the beginning of development of The Value Proposition

- What is the invention exactly?
- How does it work?
- What makes it unique?
- Is it superior in some way?
- What problems does it solve? What opportunities does it create?
- Are these problems of economic importance?
- What applications are important and why?
- Is the marketplace potentially profitable?
- Any inherent flaws that will make commercialization difficult?

Study the disclosure, do your own homework Make a list of questions. Meet with the inventor, Ask ??s

The IP/invention Commercialization Process

Preliminary Technology Evaluation

### The Invention Disclosure system

- The TTP must also be aware of the potential IP situation.
- The TTP's questions for the inventors must begin to assess the type of IP possible and appropriate
- At the earliest stage of managing the Invention Disclosure process, the TTP is developing an understanding of the potential IP position....

..... the inventiveness of the invention

the relationship of the invention to the research program of the inventors

possible humanitarian/philanthropic values, and potential for commercialization viability

- Prior art search formal and/or informal
- Patentability opinion
- Potential scope of claims meaningful?
- Will potential claims be enforceable?
- Publication schedule
- Other IP possible?
- Tangible biological material?

Preliminary

"property

control position"

Assessment

The IP/invention Commercialization Process

- Can you make a compelling case for the commercial potential?
- Is potential "property control position" sufficient?
- Are you convinced that you can convince others of it's potential?
- Will the inventor(s) be helpful? Are they committed?
- Get going in parallel: patent filing & tech marketing

Other factors

- Inventor's longevity at institution is important
- "Capturing" a potentially good inventor/client
- Scientific reputation of inventor(s)
- Are there humanitarian/philanthropic issues?

The IP/invention Commercialization Process

Invention
Selection &
patent filing

### The Invention Disclosure system

- Management of the Invention Disclosure form and the process is often the first opportunity for the TTP and inventor to meet and interact
- It is an opportunity for the TTP and TTO to display competence, efficiency, knowledge, empathy, and understanding.
- These early impressions are usually long-lasting
- TTPs should use this opportunity to establish a reputation as a high-functioning professional
- This reputation will serve the TTP and TTO very well, long into the future

# Track 1 Entry-level Tech Transfer Professional

Topic 1.4.3

Managing the Invention Disclosure Process

**Thank You**