

FSU Guidelines for Disclosing an Invention

The primary purpose of the Invention Disclosure Form is to capture information necessary for the evaluation of your invention for patentability and commercial potential. The form also serves to establish a legal record of the date of conception of the invention. The Invention Disclosure Form, when filled out, should be treated as Confidential and Proprietary.

Patentability of your invention depends upon several things. The first is public disclosure. A descriptive public disclosure made before a patent filing eliminates all possibility of foreign patent protection, and initiates a one-year period within which U.S. patent protection may still be obtained. Public disclosure can include, but is not limited to: abstracts, publications, presentations, poster sessions, shelving of theses, and even informal discussions. Should FSU choose to pursue a patent, the Intellectual Property Advisory Board (IPAB) will need to further determine the patentability of your invention. This is done by comparing it to existing technology, referred to as "prior art." Prior art includes, but is by no means limited to: existing patents (foreign or U.S.) and scientific publications.

The commercial potential of your invention is also important. It's difficult for an outside company or Ferris to justify investment in a patent if it can't be reasonably certain of at least recovering the patent costs. Key factors in determining commercial potential include: the size and nature of target markets, market accessibility, patent enforceability, and remaining development required. Your inputs are crucial here.

You (the inventor) know your technology and your field much better than we do and can tell us what commercial applications you envision for it, what makes it better than existing technology and how it will benefit a potential licensee.

The following guidelines apply to the correspondingly numbered sections of the FSU Invention Disclosure Form.

1. Title:

Create a brief title, no more than five to ten words. It should be descriptive enough to identify the nature of the invention, but not so descriptive that it would enable others to reproduce it.

2. Innovator(s):

List all people who have actively participated in developing the invention (including students, post-docs, scientists and non-Ferris University personnel). Should Ferris choose to file a patent application, actual inventorship will be legally determined by a patent attorney. It is important to note that a patent can be invalidated for either including as an innovator someone who did not have creative input, or omitting someone who did.

3. Brief Summary of Invention:

This should be about a paragraph long, including a summary-level description of the invention and focusing on its specific advantages over current technology.

Detailed Description of Invention (attachments):

This is the heart of the disclosure. The more information you provide, the better equipped we are to make a decision and to adequately file a provisional patent application if needed. Describe specifically what you consider to be the invention, as distinct from existing technology. Very often, a draft manuscript will suffice. Your description should enable someone in the field to understand the invention. Please include:

- A. general purpose or utility of the invention;
- B. background of the invention, including existing technology or the state of the art prior to the invention ;
- C. technical description – how it functions in detail and including those features believed to be new and original; you can attach drawings, diagrams, manuscripts, research proposals, etc. ;
- D. the best way of practicing the invention including possible variations and modifications;
- E. commercial uses and applications, including its advantages or improvements over existing practices;
- F. stage of development: is it just a concept? has it been reduced to practice? has it been tested?
- G. why someone would pay to license this invention. Attach any descriptive illustrations or written materials.

4. Funding sources:

Give an estimate of the total time and money spent to-date (from all sources) in developing the invention. List all sources of funding (external and/or internal) that were used to fund the research resulting in the invention. It is important that this information is accurate and complete because sponsors may have certain rights in the invention. In addition, certain reporting requirements exist for inventions stemming from federally sponsored research. The contract number and FSU grant account number (FOAP) are especially important to us in researching the terms of your sponsor's agreement.

Also in this section, please let us know if you've used any proprietary materials or services that could create obligations to intellectual property derived from such research:

- A. Identify the sources of any proprietary materials (e.g. cell line, components, polymers, computer software, chemical compound, etc.) obtained from outside your laboratory used to develop this invention. Did your invention utilize materials from any of the following? If material was obtained under a restrictive written or oral transfer agreement please attach a copy or summary.
- B. Identify the sources of any University materials (e.g. Testing Equipment, Imaging Equipment, Labs, Print Shop, Secretarial Help, Drafting/Engineering Facilities and Equipment) used to develop this invention. Did your invention utilize materials from any of the following? If material was obtained under a restrictive written or oral transfer agreement please attach a copy or summary.

5. Dates of Conception and Public Disclosure:

- A. Conception, in patent law, is the formulation of the complete means for solving a problem, rather than just the recognition of a desired result, or a problem to be solved. In the U.S, it is the first to invent, rather than the first to file who gets the patent. Therefore, this date can be of significant legal importance. This is also why we ask for the date of the first written record of the invention in item #7.
- B. First publication is the first time any member of the general public (outside Ferris) without the restriction of confidentiality, would have been able to legally gain access to your written description of the invention.
- C. Oral disclosure - same as B, above, but in the form of an oral presentation of any sort.
- D. If publication or presentation is imminent, then we may need to move quickly to preserve patent rights, particularly non-domestic rights.

6. Development status:

Let us know how far the technology has been practically implemented: whether it's a theory or has been verified by computer model, bench scale tests, prototype, etc. This helps IPAB to determine the marketability of the invention, and what next steps may be needed in order to enhance such marketability. It can also help to determine if reduction to practice has been achieved. In patent law, this means the actual and complete use of the invention for its intended purpose has been completed. It is not always a necessary prerequisite to a patent application, but it helps.

7. Date of first written record:

This can be helpful in determining who invented first in the rare event that there be a dispute with other innovators that submitted the same invention on a similar time frame. (See 5A above.)

8. Prior art:

This consists primarily of existing patents and publications. We ask that you provide what you have regarding a literature search and a preliminary patent search. Additional efforts are appreciated but not required, however it should be noted that IPAB will typically rely on the researchers to provide a thorough understanding of the published scientific literature.

There are a number of excellent resources available to you to perform a preliminary patent search. We ask that you do this because, since you are the person most familiar with your invention, your choice of search terms could be more accurate. You will also be more able to point out the differences between existing patents and your invention. There are several very good searchable databases on the internet:

<http://www.uspto.gov/patft/> - This provides claims, specifications, examples and abstracts of both issued patents and published patent applications.

<http://www.google.com/patents/> - This provides claims, specifications, examples and abstracts of both issued patents and published patent applications.

<http://www.espacenet.com/> - This provides images, descriptions and claims.

FSU's FLITE library has patent searching resources as well. As an official Federal Depository Library, it has an actual computer tie-in to the U.S. Patent & Trademark Office, as well as people who are very helpful. Please contact Paul Kammerdiner, Patents/Trademarks librarian (PaulKammerdiner@ferris.edu, FLITE Room 331, 231-591-3037) for more information.

As part of the prior art search, you should also reference any other publications (e.g., journal articles) that are relevant, attaching copies of such articles, if available.

9. Additional Development Plans:

This optional section can also be helpful in determining the marketability and marketing strategy for an invention.

10. Commercial Interest:

Your inputs and ideas here are helpful to our attempts to identify potential licensees for your technology. It's estimated that 50% of licenses result from contacts stemming from the innovators. In addition, ideas of companies that may have an interest will be a good start in determine additional companies that could be approached. If you have a commercial contact who has expressed interest, that is the ideal place for us to begin our marketing efforts. In filling out this section of the form consider the following questions:

- A. Who has approached you at conferences?
- B. What companies/industries have sponsored your research in the past?
- C. Who do your industry colleagues work for?
- D. Please provide your contact's name, company, address and phone number, if at all possible. In the absence of individual contacts, please suggest specific companies who may be interested in your technology.

If you have any questions as you complete this form, please call the Office of Research and Sponsored Programs at (231) 591-2547. We are here to assist you.

Please submit the typed Invention Disclosure Form, with original signatures, to:

Ferris State University

Office of Research and Sponsored Programs

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Big Rapids, MI 49307

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