\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**Disclosing Your Invention**

**What is “invention disclosure?”**

An invention is defined as any new or useful process or discovery, art, method, technique, machine, device manufacture, software, composition of matter, or improvement thereof.

An “invention disclosure,” once completed and signed, is the first official record of the invention and is a legal document that notifies and describes the invention to the University.

**Who should disclose?**

If you are a Marquette faculty member or employee who conceives or develops something new and useful during the course of your employment, you have an affirmative duty to disclose.

**Why should you disclose your invention?**

Disclosure permits evaluation of your invention to determine whether it is patentable and if commercial development is feasible. Failure to disclose may result in the loss of intellectual property protection of your invention.

If your work is funded by an outside sponsor, disclosure is particularly important as there may be contractual obligations to the external sponsors who provided such support. In addition, Marquette is under special reporting obligations when the invention results from federally funded projects.

**When should you disclose your invention?**

An invention disclosure should be made when something new and useful has been conceived or developed, or when unusual, unexpected, or unobvious research results have been achieved and can be utilized. You are encouraged to disclose your inventions as soon as they have been reduced to practice.

Non-confidential disclosure of your invention (to people outside the University), including publishing/presentation, may constitute a bar to intellectual property protection. To preserve options for worldwide protection, disclosures should be submitted for timely review no later than three months prior to any public disclosure.

**How should you disclose your invention?**

As stated in the University’s Intellectual Property Policy, you are required to disclose inventions conceived or developed in the course of your employment to the Office of Research and Sponsored Programs, using the attached Invention Disclosure Form.

**What happens after you disclose your invention?**

The University determines whether or not to seek patent protection. That determination is based on availability of funds and an assessment of the invention’s commercial value.

**How can an inventor help?**

You can help the University accurately and quickly act on the invention by taking the following steps.

1. Contact ORSP as soon as you think you have an invention.

2. Complete the disclosure form.

3. List companies/organizations who may be interested in the invention. As an expert in this field, you are the best resource for identifying potential licensees for your invention.

4. Be responsive to information requests. Although some of the requests may be frequent and time consuming, the better the information that is received from you, the more successful and faster the process will be.

5. Inform ORSP of impending publications or discussions with companies about the invention.

6. Call ORSP if you have any questions or concerns.



# 

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**INVENTION DISCLOSURE FORM**

The business of a university is the gathering and dissemination of knowledge. Making an invention and putting it to use in the service of the public is one mode of accomplishing this objective.

Accordingly, the University encourages the inventive process; and within the limits of financial practicality, can often provide assistance and advice in bringing inventions to the point of public use.

In the sense used here, an “invention” has a presumed commercial use and value. From this, certain caveats follow as a consequence.

1. Disclose first, publish later.

Disclosing your invention by no means impedes subsequent publications. Publishing before submitting a disclosure can have disastrous consequences, both legal and tactical, on efforts to commercialize an invention.

2. Leave procedural questions to the specialists.

What constitutes a patentable invention is sometimes a complex legal question. If you think you have made an invention, but you are not sure, then say so in your disclosure. Similarly, if you think, but are unsure, your invention may have commercial merit, simply say so on your disclosure.

Disclosure using this form is required by the University’s Intellectual Property Policy. **Once the form is completed, it should be sent to Sherri Kirsch, Contract Administrator, Office of Research & Sponsored Programs, Holthusen Hall, 341.**

Definitions:

A patentable invention may be any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Under patent law, this is also interpreted to include drugs, newly discovered, mutated or genetically engineered microorganisms or plants, new or altered forms of plant life, vaccines, cells, tissue and organ cultures, products of recombinant DNA research, hybrid cell cultures, processes involving microorganisms, monoclonal and polyclonal antibodies, engineered proteins, some computer programs, designs.

**\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_**

1. TITLE OF THE INVENTION: Brief, but comprehensive, technically accurate and descriptive.

2. CONCISE DESCRIPTION OF THE INVENTION: Your disclosure should enable someone having knowledge of the field to understand the invention.

a) Include all essential elements (features, concepts, or new results), their relationship to one another and their mode of operation.

b) Identify the elements that are considered novel.

c) Identify date of conception, whether this has been documented (lab book, etc.) and whether the invention has been reduced to practice.

d) If the invention is an apparatus or system, attach drawings or a sketch and indicate if it has ever been built or tested.

e) Attach additional pages, drawings, manuscripts, papers or other supporting material to facilitate understanding of the invention.

3. USES / USEFULNESS / ADVANTAGES OF THE INVENTION OVER CURRENTLY AVAILABLE TECHNOLOGY:

a) Describe what is presently available in the field.

b) Identify existing devices or processes and list any published material such as patents, commercial literature, and scientific articles relating to the invention.

c) Describe the advantages or benefits your invention has over currently available technology, (i.e., efficiency, cost benefit, simplicity, overcoming a defect).

d) Identify current or future uses of the invention (especially important if the invention is a chemical compound).

4. POTENTIAL COMMERCIAL APPLICATIONS OF THE INVENTION / POTENTIAL LICENSEES:

a) Have you been contacted by any party about licensing your invention?

b) What companies in the field might be interested in your invention?

c) Are there current plans to use your idea commercially?

5. PUBLIC DISCLOSURE / PUBLICATION PLANS:

a) Public disclosure includes abstracts and presentations at scientific meetings (including poster sessions), public seminars, shelving of theses, publications, disclosure to others outside the University who have not signed a confidentiality agreement, and use, sale, or offer of sale of the invention.

b) Identify specific dates and circumstances of any such disclosures.

c) Indicate your future disclosure or publication plans and notify ORSP if the invention is publicly disclosed or published in the future (either intentionally or inadvertently).

6. FINANCIAL SUPPORT / CONTRACT IDENTIFICATION (*This information is needed to determine if the invention is subject to additional disclosure or any other commitments or restrictions arising from the terms of sponsorship*):

a) Specify the funding entity (governmental agencies, corporate sponsors, private agencies, or others) that supported the research this invention resulted from.

7. IDENTIFICATION OF CONTRIBUTOR(S):

a) List all persons who are believed to have contributed to the conception or reduction to practice of this invention.

b) Please provide addresses and phone numbers where they may be contacted.

Pursuant to the University’s Intellectual Property Policy in effect at this time, as well as the terms and conditions associated with my employment by Marquette University, the undersigned, being the inventor(s) of the disclosed invention, hereby agree to assign all right, title and interest to this invention to Marquette University and agree to execute all documents as requested, assigning to Marquette University my/our rights in any patent application filed on this invention, and to cooperate with the Office of Research and Sponsored Programs in the protection of this invention. Marquette University will share any royalty income derived from the invention with the inventor(s) according to the distribution outlined in the University’s Intellectual Property Policy.

READ AND UNDERSTOOD BY:

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Signature of Inventor Date

Witnessed By\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ Signature\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_