

Process Flow for Patent Submission: Consecutive Action Bullet Points.

- Work on a potentially patentable “product or process” is underway. This can be internally or externally funded.
- Discuss the patent idea with Director of Technology Transfer if you have questions (note that this is optional)
- Once you think you want to pursue a patent, you will need the following information:
 - Produce a 100 to 150 word abstract describing the “invention”.
 - Answer the following three questions:
 - VERY BRIEFLY, identify relevant Prior Art, this means:
 - Publications or presentations by you, relevant to this invention, that were released or presented one year or more ago
 - The state of the art: i.e. what in your invention is “not new”... i.e. items that are part of existing “prior art”.
 - What is “Novel, New, and why is your innovation not obvious”
 - Provide answers to the above questions to the Office of Technology Transfer (OTT)
 - The OTT will:
 - In cases where time is of the essence, make a “director’s determination”
 - Where there is not an imminent difficulty with prior art or immediate need to protect a technology, the university may use the technology transfer steering committee or input from the patent attorney to determine if the patent should move forward. The intent of this phase is to provide an early decision for investigators on the patentability of their work. If an investigator’s work is not patentable or will not be supported by the university, the investigator should not invest the time in pursuing a patent.
 - The technology transfer office will provide a decision to the investigator.
- If a decision is positive, the investigator should work with the OTT to define a “due” date for the formal patent disclosure.
 - This date needs to be chosen to provide protection of potential IP and to avoid patent nullification by the investigator’s presentations or publications.
 - Ideally, when an investigator is at the point of filing a patent disclosure, he/she will have formal written material that can be used as material for the patent disclosure.
- Elements of a patent disclosure:
 - Naming of lead contributor
 - Detailed description of the invention, here a manuscript is a convenient way to get this done.
 - Statement of funding source
 - Statement of other affiliations for co-inventors
 - Source of materials used to create this invention (here, this is looking to see if there are agreements over materials, etc.).

- Statement of if (and if so, where) non-confidential disclosure of an invention has been made.
- Statement regarding the inventor's intent to publish or in other ways disclose the invention in the future (presentations, poster sessions, etc.)
- Known prior art.... Is there information in print that is similar to the invention
- Commercial Interest... has a commercial entity expressed interest in the invention.
- Contributors... list the persons who have contributed to the conception or reduction to practice of this invention.
 - Here, we will need to establish how "inventors" are named and work to have all inventors named at the time of the disclosure, including the fractional credit for the invention.
- Patent disclosure is reviewed by Director Technology Transfer and if necessary by internal committee or external counsel
 - Review of the inventors and their contributions is handled internally at this stage.
 - Collection of assignments of rights documents from investigators is handled at this point-in-time (unless there is a mitigating reason to submit and collect documents at the same time).
- Patent if moving forward is submitted to patent attorney
 - Note checking with Office of General Counsel (OGC) over any unexpected difficulties and also verifying budget availability.
 - Investigators may not submit patent disclosures on their own to the University external counsel.
- Prior Art: based on a search of patents, publications, and other relevant documents to identify inventions that might be considered prior art
 - The patent must be "Novel and Not obvious"
 - Investigators should be aware of the literature to establish prior art and be mindful that their idea must be Novel, not obvious, and not established in prior art.
 - The Technology Transfer office may in the future have capacity to search patent databases to help with this part of the patent process.