

# FAU INVENTION DISCLOSURE INFORMATION and INSTRUCTIONS

## GENERAL INFORMATION

**Purpose for Submitting an FAU Invention Disclosure Form:** Making an invention and putting it to use for the benefit of the public is one way of supporting FAU's mission to promote effective teaching and research that fosters innovation, stimulates a spirit of inquiry and problem solving, and leads to the discovery of new knowledge. .

**The FAU Intellectual Property Policy (IPP) regarding Inventions:** University Personnel are required to disclose promptly, all Inventions, even those believed by the Creator to be unrelated to his or her University duties and not involving the use of University Support. In order to protect and commercialize your invention and determine whether to pursue patent protection for your invention, FAU needs the information requested in the Invention Disclosure Form.

(For details please read the complete IPP at: <http://www.fau.edu/research/ott/ipp.php>).

**Patentable Inventions:** To be patentable, the Invention must be novel and useful. It must not be obvious to a worker with average skills in that particular technology. It must not have been used by others in the USA or patented or described in a printed or oral form anywhere, prior to the date of invention. Such patentable items could include: integrated circuit boards, biological material, software, etc. which may have commercial potential.

US patent law allows one year to apply for a patent from the time of public disclosure, however, all foreign rights are lost at date of public disclosure. OTT can help Creators manage this matter, if the Creator(s) submit the Disclosure well in advance of any publications or presentations.

## FAU INVENTION DISCLOSURE PROCESS

1. Complete all sections and questions of the Disclosure Form.
2. Hand-deliver the original and one copy to the FAU OTT, Administration Bldg, Rm. 232, Boca Raton Campus.
3. OTT will mark the Disclosure with the date it is received by the OTT and assign the Disclosure an FAU Case #.
4. OTT will review the Disclosure for completeness and accuracy. OTT will contact the Creator(s) about any necessary clarification or missing information. Only if and when the Disclosure is properly completed will the 120 day FAU ownership election period begin as required by the FAU IPP, section D.4. OTT will:
  - a. send a memo (with a cc: to the Creator(s) and copy of the Disclosure to the Chair and Dean of the Creator(s) as notification that the Invention has been submitted to OTT and describe any details that need to be taken care of before the 120 election period begins. If the Chair(s) or Dean(s) contact the OTT with any objections regarding the Disclosure, the Disclosure will be returned to the Creator(s);
  - b. set up a meeting with the Creator(s) to gather additional information to better understand the Invention and its commercial potential; and
  - c. send a notification memo to the Creator(s) of acceptance of the Disclosure (with a cc: to the Chair and Dean of the Creator(s)), which will indicate start of the 120 day election period, and invite the Creator's to attend the next meeting of the FAU Intellectual Property Committee (IPC) to answer questions of the Committee concerning the Invention.
5. OTT will present the Disclosure at the next regular monthly meeting of the FAU IPC which will:
  - a. review the Disclosure and any additional information obtained by OTT;
  - b. ask questions of the Creator(s); and
  - c. make a recommendation to the V. P. for Research as to the FAU election of rights, which can be:
    - i. the Invention is premature/incomplete;
    - ii. acquire title; or
    - iii. waive FAU's rights to the Creator(s).
6. OTT will send memo to Creator(s), with copy to Chair and Dean of Creator(s), of the election decision:
  - a. If "premature/incomplete" the Creator(s) are asked to resubmit the Disclosure when additional information is obtained. The Disclosure is kept on file as a formal record that the Creator(s) have followed the IPC and submitted an Invention Disclosure as required.
  - b. If "elect to acquire title," the Creator(s) will assign title in the Invention to FAU. OTT will, in consultation with the Creator(s):
    - i. seek patent or other legal protection, if appropriate;
    - ii. identify and pursue best method to commercialize the Invention;
    - iii. negotiate a license agreement, once the best potential licensee has been selected. In some cases, OTT may elect to license the Invention to a company owned by the Creator(s);
    - iv. manage the process of FAU assigning its rights in the Invention or patent to the Florida Atlantic Research Corporation (FARC), the legal entity by which FAU licenses technology to third parties;
    - v. monitor the licensee for compliance with the terms of the license agreement;
    - vi. monitor the on going status of any intellectual property protection; and
    - vii. on behalf of FARC collect and distribute any net income resulting from the commercialization of the Invention per section C.5 of the IPP.

## **INSTRUCTIONS FOR COMPLETING THE FAU INVENTION DISCLOSURE FORM**

All questions are important. Please respond to each one even if the answer is "none" or "not applicable." *If more space is needed, feel free to insert into the form or use additional sheets.* The Disclosure Form is an important document, which should be prepared carefully. The Disclosure will be treated confidentially. For any questions regarding this process or the form, please call the FAU Office of Technology Transfer on the Boca Raton Campus at 7-1165.

1. Give the full title of the invention.
2. This is the name of the Creator with whom OTT should communicate.
3. The Invention:
  - a. Give a brief description that OTT can use for marketing this Invention.
  - b. If available provide a complete yet concise description including sketches, diagrams, photographs and any other data that would be sufficient to enable another person skilled in the field to reproduce the invention. Include any data that shows how the invention works. This could be a manuscript, report to sponsor, slides, copies of lab note book etc. If you have excessive amounts of data, such as software code, please submit a floppy disk or CD with that information.
  - c. If you have conducted any patent searches, please list details. If not, please provide "key words".
  - d. To be patentable an invention needs to be unique or novel. Give the reasons for this Invention.
  - e. "Check" the terms that best describe the stage of development of the Invention.
  - f. Indicate if there is current research on the project.
  - g. Indicate if the invention needs more work and how much money and time it will take.
  - h. Date invention was first conceived.
4. Please indicate if any third party material was used to develop this Work.
5. Please indicate all the sources of support that were used to develop this Invention. Be sure the total support equals 100%.
6. Publishing and applying for patent protection are not mutually exclusive. US patent law allows one year to apply for a patent from the time of public disclosure, however, all foreign rights are lost at date of public disclosure. OTT can help Creators manage this matter, if the Creator(s) submit the Disclosure well in advance of any publications or presentations. Complete all information that applies. All of these questions are very important and should be completed with care and accuracy. Under CDA (Confidentiality Agreement) and MTA (Material Transfer Agreement) mark "Y" for yes or "N" for no or "NA" if not applicable.
7. Please describe to the best of your knowledge the economic aspects of the invention and market information.
  - a. Market impact from marginal to disruptive.
  - b. Immediate and future applications for the technology.
  - c. Describe any competing technologies.
  - d. Briefly describe the overall market conditions.
  - e. List competitive market advantages for a potential licensee
  - f. Provide your best estimate of annual revenues if successfully commercialized
  - g. Is this invention worth spending \$10,000 on to get a patent?
  - h. Please list any experts in this field if known.
8. Include all FAU employees faculty, staff or students and any non-FAU persons that made an intellectual contribution to the Invention. The contact information is important for distribution of income from the Invention.
9. Check the commercialization method that Creator(s) think is the best way to serve the public interest with this Invention/technology.
10. Any additional information that is important to this matter.

# FAU Confidential INVENTION DISCLOSURE FORM

## For FAU Office of Technology Transfer Use Only

Received at OTT on: \_\_\_\_\_, by: (name) \_\_\_\_\_ (initials) \_\_\_\_\_  
 OTT reviewed and accepted as complete: \_\_\_\_\_ (This date starts 120 day FAU ownership election period.)  
 OTT person determining completeness: (name) \_\_\_\_\_ (initials) \_\_\_\_\_  
 OTT sent copy of Form to Chair(s) and Dean(s) of Creators as notification: (date) \_\_\_\_\_  
 Disclosure presented to FAU Intellectual Property Committee for Recommendation of FAU ownership: (date) \_\_\_\_\_  
 FAU Election of Rights: \_\_\_\_\_ acquire title; \_\_\_\_\_ premature or incomplete; or \_\_\_\_\_ waive FAU's rights  
 Comments: \_\_\_\_\_

Signed by Vice President for Research or designee: \_\_\_\_\_ Date: \_\_\_\_\_  
 (Name) \_\_\_\_\_ (Signature)

To be completed by the FAU employee.

**1. TITLE OF INVENTION:** \_\_\_\_\_

**2. SUBMITTING INVENTOR/CREATOR:**

Name: \_\_\_\_\_  
 Work Phone: \_\_\_\_\_ Fax: \_\_\_\_\_ Email: \_\_\_\_\_

**3. THE INVENTION:**

**A.** Brief description.

**B.** Attach detailed description of the invention.

**C.** State of the Art (Include literature, patents or presentations of which you are aware.)

Have you conducted a patent search? \_\_\_ YES \_\_\_ NO

If yes, please give results and list name, issue number and date of each patent you have read.

If No, please give several key words for OTT to use to due a patent/market search:

**D.** How this invention is unique or novel?

**E.** Stage of development (Check those that apply.)

\_\_\_ concept \_\_\_ able to demonstrate \_\_\_ working prototype \_\_\_ tested \_\_\_ ready to manufacture

**F.** Is work on the Invention continuing? \_\_\_ NO \_\_\_ YES

**G.** Does the Invention need more work? \_\_\_ NO \_\_\_ YES Funds needed - \$ \_\_\_\_\_ Time needed- \_\_\_\_\_

**H.** Date Invention was conceived \_\_\_\_\_.

**4. MATERIAL(S) from third parties:**

	Material	Source	Contact Name	Phone	License (Y/N)
A.	_____	_____	_____	_____	_____
B.	_____	_____	_____	_____	_____

**5. SUPPORT** NOTE: percentages of all support for this invention should add up to 100%

**A. FAU SUPPORT:** \_\_\_\_\_%

Place \_\_\_\_\_ Location \_\_\_\_\_

**B. OTHER SUPPORT:** \_\_\_\_\_%

Name \_\_\_\_\_  
 Grant/Contracts Number \_\_\_\_\_  
 Address \_\_\_\_\_  
 Contact Person \_\_\_\_\_ Phone \_\_\_\_\_ Email \_\_\_\_\_  
 Grant Title \_\_\_\_\_  
 P.I. Name \_\_\_\_\_ Phone \_\_\_\_\_ Email \_\_\_\_\_

If this Invention has been supported by the United States Government and is included in a license agreement to a third party, it is understood that no earned royalties will be collected or paid to Florida Atlantic University for sales to the United States Government due to overriding obligations to the United States Government including those set forth in 35 U.S.C. §200-212 and applicable governmental implementing regulations and the obligation to report on utilization of the Invention set forth in 37 CFR §401.14(h).

**C. FUTURE SUPPORT** – Do you intend to apply for Federal funding to reduce this Invention to practice? \_\_\_NO \_\_\_YES.  
 If yes, you must notify the FAU-OTT and report the Invention on your closing grant reports.

**6. DISCLOSURE** Which of the following have you done or do you intend to do with the Invention?

	<u>NO</u>	<u>YES</u>	<u>DATE</u>	<u>CDA</u>	<u>MTA</u>	<u>GIVE PUBLICATION, MEETING, OR COMPANY</u>
A. Publish	___	___	_____	___	___	_____
b. Oral Presentation	___	___	_____	___	___	_____
C. Poster Session	___	___	_____	___	___	_____
D. Disclose to Industry	___	___	_____	___	___	_____
E. Posting on Internet	___	___	_____	___	___	_____
F. Offer for sale	___	___	_____	___	___	_____
G. Sold	___	___	_____	___	___	_____
H. Seen by non-FAU persons	___	___	_____	___	___	_____

**7. ECONOMIC AND MARKET INFORMATION**

**A.** Please briefly describe the technical impact the Invention is likely to have on the field of endeavor (i.e., marginal improvement, significant change, revolutionary upheaval, creates new field, etc.) and why

**B.** What are the immediate and/or future applications of the Invention?

**C.** What present technology exists that solves the same or similar problems? Why is the Invention better or more advantageous than present technology? What problems does it solve? What are its novel and unusual features?

**D.** Describe the overall Market:

**E.** What are the advantages (and disadvantages) that may give a licensee a competitive advantage in the market?

- 1). What are the Marketing Advantages?
- 2). What are the Marketing Disadvantages?
- 3). What is needed to overcome these disadvantages?

**F.** Who would be interested in this invention (potential licensees)?

**F.** Please give your best guess as to the economic potential of this Invention if successfully commercialized, in terms of annual revenues:

\_\_\_ Less than \$10,000    \_\_\_ \$10,000-\$100,000    \_\_\_ \$100,000-\$1 million    \_\_\_ over \$1million

G. If the Invention is of a type for which patent(s) may be pursued, do you consider it worthwhile to spend up to \$10,000 to obtain a U.S. Patent?

\_\_\_ Yes    \_\_\_ No (Please indicate the reason(s) for either response.)

H. Experts in the field (FAU and non-FAU):

Name	Reference Information	Phone	Email
_____	_____	_____	_____
_____	_____	_____	_____

**8. CREATORS/INVENTOR(S):**

FAU CREATOR(S) (including students)

Name: \_\_\_\_\_  
Official Title/Position: \_\_\_\_\_ Citizenship: \_\_\_\_\_  
Department: \_\_\_\_\_ College: \_\_\_\_\_  
Work Address: \_\_\_\_\_  
Work Phone: \_\_\_\_\_ Fax: \_\_\_\_\_ Email: \_\_\_\_\_  
Home Address: \_\_\_\_\_  
Home Phone: \_\_\_\_\_ Fax: \_\_\_\_\_ Email: \_\_\_\_\_

I agree that any income from this invention will be distributed equally among the Creator(s). \_\_\_ Yes \_\_\_ No  
If NO to the above question, what percentage should you receive? \_\_\_\_\_

**Signature:** \_\_\_\_\_ **Date:** \_\_\_\_\_

NON-FAU CREATOR(S) (industry and/or university)

Name: \_\_\_\_\_  
Official Title/Position: \_\_\_\_\_  
Employer: \_\_\_\_\_ Department: \_\_\_\_\_  
Work Address: \_\_\_\_\_ Citizenship: \_\_\_\_\_  
Work Phone: \_\_\_\_\_ Fax: \_\_\_\_\_ Email: \_\_\_\_\_  
Home Address: \_\_\_\_\_  
Home Phone: \_\_\_\_\_ Fax: \_\_\_\_\_ Email: \_\_\_\_\_

I have disclosed this invention to my employer. \_\_\_ YES \_\_\_ NO  
I agree that any income from this invention will be distributed equally among the Creator(s). \_\_\_ Yes \_\_\_ No  
If NO to the above question, what percentage should you receive? \_\_\_\_\_

**Signature:** \_\_\_\_\_ **Date:** \_\_\_\_\_

**9. COMMERCIALIZATION OF THE INVENTION – (Check those that apply.)**

- A. \_\_\_ The Creator(s) wish to continue research on this invention.
- B. \_\_\_ The Creator(s) want FAU to commercialize this invention.
- C. \_\_\_ The Creator(s) wish to obtain the rights to this invention if the university elects to waive its rights.
- D. \_\_\_ The Creator(s) want FAU to license this invention a company owned by the Creator(s).
- E. \_\_\_ The Creator(s) want this invention dedicated to the public domain.

**10. ADDITIONAL COMMENTS FROM THE CREATOR(S):**

**HAND DELIVER ORIGINAL AND ONE COPY TO THE DIVISION OF RESEARCH  
OFFICE OF TECHNOLOGY TRANSFER, BOCA RATON CAMPUS, ADM 232 (EXTENSION 7-1165)**