University of Delaware Invention Disclosure Memo

I. INSTRUCTIONS

University of Delaware students, staff and faculty members are requested to complete the following form electronically whenever a new invention has been made and the invention is considered to have possible commercial value.

If you have questions regarding this invention disclosure memo, please call Denise Bierlein at 831-4005 or via email at deniseb@udel.edu. Please note that the gray box in each section where input is requested will expand as necessary to accommodate as much disclosure as you wish to provide.

PRELIMINARY VERSION

Please fill in this form as completely as possible, including the type of provisional application (Article VI) and submit it, without signatures, as a preliminary version by E-mail to: deniseb@udel.edu

Your memo will be assigned a UD numbers and you will be contacted by a patent attorney or patent agent from RatnerPrestia, an intellectual property law firm engaged by the University to assist in the evaluation and patenting of University inventions. You will discuss the invention with the attorney, and you may be asked to edit or supplement the Invention Disclosure. Once you have made the requested changes, please submit the final version of the form as discussed below.

FINAL VERSION

Print a copy of the final version and have it signed where indicated. Scan the signed document into PDF format. Forward the PDF file and a copy of the document in Word® format as email attachments to RatnerPrestia and to the University of Delaware Office of Economic Innovation and Partnerships (OEIP) at: UDel@RatnerPrestia.com and deniseb@udel.edu

Send the signed original to: Denise Bierlein
Office of Economic Innovation and Partnerships
210 Hullihen Hall

RatnerPrestia’s comments:

UD Approval:
II. CONTACT AND CONFERENCE INFORMATION

This Memo submitted by:

First discussed with RatnerPrestia Attorney/Agent (name) on:

UD contact for questions regarding this invention:

UD Department:

Phone: Facsimile: E-mail:

RatnerPrestia attorney/agent contact:

Phone: Facsimile: E-mail:

III. INVENTION DESCRIPTION

1. TITLE OF INVENTION:

2. NON-CONFIDENTIAL ABSTRACT OF INVENTION (for the UD website listing):

3. CONCISE DESCRIPTION OF INVENTION

   The invention may be a new or improved process for making, using or doing something, or it may be a new structure, device, mechanical assembly, software, computer code, circuit, compound, material, formulation, or a newly isolated product of nature, such as a gene or protein.

   Please provide a written description of the invention in the space provided below. The description should be sufficient to enable others to use the invention in the best way currently known, and it should include all known alternatives.

   Please also include or attach sketches, drawings, photographs, circuit diagrams and other materials that may help illustrate or describe the invention. Illustrations should include reference numbers that are keyed to the written description. For drawings or figures intended for filing as part of the patent application, please provide high quality drawings, such as original source drawings used in compiling PDF versions of research publications, CAD/CAM drawing files, or single-page JPG images with good resolution that can be imported into a Word document or other type of file to produce a semi-professional drawing for submission to the patent office.

   • For nucleic acid and peptide/protein inventions, please submit relevant sequences. Click on the following link for instructions on how to submit nucleotide and peptide sequences. Sequence instructions

   • For inventions in which software is important, please submit logic or block diagrams.

Concise Description (please take as many pages as needed):
4. **OBJECTIVE:** What is the objective or purpose of the invention?

5. **OTHER USES:** Does the invention have possible uses other than those mentioned in the Concise Description? Please consider areas that may be far removed from the original purpose of the invention, but which might exploit the same underlying principle either now or in the future.

6. **DEMONSTRATIONS AND TESTS**
   - Has the invention been prototyped, demonstrated or tested experimentally?
   - If so, please include or attach experimental data or other records. Notebook records of experimental results and procedures are particularly useful. If not available for attachment, please indicate who has possession of these records.
   - Have notebook entries or data been maintained and signed and dated by a witness who understands the work, but did not participate in it directly?
   - If so, please indicate who has possession of those notebooks.

7. **COMPARISON WITH PRE-EXISTING TECHNOLOGY**
   Compared with the pre-existing technology described in Section IV below:
   - How does the invention differ from the pre-existing technology generally? (Please elaborate)
   - Does the invention have any special advantages or disadvantages? What are the benefits of practicing the invention? (Please elaborate)
   - Does the invention solve any special problems not solved (or not solved as well) by the pre-existing technology? (Please elaborate)
   - Does the invention produce results which those skilled in that technology area would not have expected or could not have predicted? (Please elaborate)

8. **COMMERCIAL INTEREST:** If specific companies or individuals are known who have shown or would be expected to show commercial interest in the invention, please identify those companies and explain their potential interest:

IV. **PRE-EXISTING TECHNOLOGY**

   IMPORTANT: Please note that those applying for a U.S. patent have a legal obligation to disclose all information which is known to them that is potentially relevant in determining whether an invention (a) is new and (b) would not have been obvious in view of pre-existing technology to a person knowledgeable in the technology field of the invention. This information is provided to the Patent Office in an Information Disclosure Statement. Failure to meet this obligation may invalidate any resulting patent.

   Whenever you become aware of such information, even after filing the patent application, you should inform RatnerPrestia as soon as possible.

   If there is any question about whether particular information should be disclosed to the patent examiner, please consult with your RatnerPrestia attorney or
agent. It is best to err on the side of mentioning the information and have RatnerPrestia decide whether it should be disclosed to the Patent Office.

Potentially relevant information regarding pre-existing technology includes essentially all information made public in some way, regardless of source, and may include non-published information received from another party. Such information may for example take the form of journal articles and patents, but it may also include internet postings, abstracts, posters, presentations, talks, seminars, theses, commercial products or processes, etc. The contributors to the invention may themselves have been the source of technology that was publicly known at the time of the invention, and this information should also be included. Note also that potentially relevant information may include information about important parts or aspects of the invention, not necessarily the entire invention.

1. LISTING OF INFORMATION: With the foregoing in mind, please list all potentially relevant information regarding pre-existing technology known to the individuals identified below as contributors to this invention. Please provide full citations, including titles and page numbers, for published material.
2. SEARCHES: The University recommends, and may require, that those responsible for an invention make a search, such as a literature or patent search, to locate potentially relevant information regarding pre-existing technology. If a search has been conducted, please describe where and how the search was conducted and any keywords used, and provide a copy of the search report. If a search has not been conducted, please suggest keywords in the box below and contact Thomas Melvin at the Morris Library at 831-6230 or tmel@udel.edu for assistance on searching. The box will expand as necessary to accommodate text entry:

3. PRIOR DISCLOSURES OF THE INVENTION:

Has the invention been described publicly, either in specific detail or in a general way? (This includes abstracts, oral presentations, news stories, internet postings, etc., as well as published scientific papers.) If so, please describe where, when and how all such disclosures were made and provide copies of any written or published disclosures:

If YES, enter description here. Space will expand as needed.

Is a publication or oral disclosure descriptive of the invention planned within the next six months? If so, please provide the date (estimate if unknown) of the planned disclosure and attach copies of any existing manuscripts, preprints, or abstracts:

If YES, enter description here. Space will expand as needed.

Has the invention been disclosed to anyone outside the University, such as other scientists, industry representatives, etc? If so, identify when and to whom such disclosures were made:

If YES, enter description here. Space will expand as needed.
V. SPONSORSHIP

1. RESEARCH SPONSORSHIP:

Was the invention developed with the use of grant or contract funding?

a.) Federal Funding  [ ] No  [ ] Yes: Federal Award Number and PI Name:

b.) Sponsored Research  [ ] No  [ ] Yes: Sponsor Name and PI Name:

To the extent the following information has not already been provided above, if the work which led to the invention was sponsored, please identify:

• the sponsoring government agency, if any:

• the contract or grant number(s) if any:

• the industrial sponsor(s), if any:

• type of university support, if any:

• other sponsor(s), if any:

• University account number(s) charged, if any:

Was the invention developed under a formal Collaborative Research Agreement with a third party or using biological or other proprietary materials obtained from a third party under a Material Transfer Agreement?

a.) Collaborative Research Agreement:  [ ] No  [ ] Yes:

   Institution/Corporation:

b.) Material Transfer Agreement:  [ ] No  [ ] Yes:

   Institution/Corporation:

PLEASE ATTACH COPIES OF ALL ABOVE-MENTIONED GRANTS, CONTRACTS, OR AGREEMENTS TO THE FINAL VERSION OF THIS MEMO.
VI. SELECTION OF APPLICATION TYPE

☐ Simple Provisional Application -- Initial cost: $450. Recommended only when public disclosure is imminent that could otherwise result in loss of rights. Includes little to no review by patent attorney before filing. Substantial risk of disclosure being inadequate to support later claimed inventions and inability to rely on this filing for a priority date. Should be followed by Intermediate or Fully-Formed Provisional Application as soon as possible. Incurs greatest cost overall if a non-provisional application is eventually filed.

☐ Intermediate Provisional Application -- Initial cost is approximately 1/3 to 1/2 (not guaranteed) of the flat rates for Fully-Formed provisional application, but typically has a greater total cost overall if a non-provisional application is eventually filed. Includes review/discussion with inventor and drafting of at least one claim by a patent attorney. Substantially less risk of losing priority date than Simple Provisional Application. Can be filed on relatively short notice before public disclosure, given at least about 2 weeks lead time.

☐ Fully-Formed Provisional Application -- Cost not to exceed negotiated flat rates (Bio = $10800; Chem/Elec/Computer = $9000; Simple Mechanical = $5850; Complex Mech = $7740). Includes full review by patent attorney and drafting of application meeting all requirements of non-provisional application. Relatively inexpensive to convert to non-provisional / PCT application(s) 1 year later, unless substantial additional disclosure added when converted. Expected to incur the least cost overall if a non-provisional application is eventually filed.

VII. DESCRIPTION OF CONTRIBUTION

For each listed inventor in Section VIII, please briefly describe the contribution to the invention by that contributor, and attach any information relevant thereto:
VIII. CONTRIBUTORS (Signatures Required in Final Version Only; Description of contribution required in both versions)

By signing and dating below, I acknowledge that the University of Delaware owns all patent and other rights to this invention, and, if I am found to be an inventor, I agree to review and sign whatever documents may be necessary for the legal protection of this invention.

1. NAME (PRINTED):
   
   HOME ADDRESS*:
   
   CITIZENSHIP*:
   UD DEPARTMENT:
   PHONE # (WORK):
   E-MAIL (WORK):

   SIGNATURE:______________________ DATE:__________________

2. NAME (PRINTED):
   
   HOME ADDRESS*:
   
   CITIZENSHIP*:
   UD DEPARTMENT:
   PHONE # (WORK):
   E-MAIL (WORK):

   SIGNATURE:______________________ DATE:__________________

3. NAME (PRINTED):
   
   HOME ADDRESS*:
   
   CITIZENSHIP*:
   UD DEPARTMENT:
   PHONE # (WORK):
   E-MAIL (WORK):

   SIGNATURE:______________________ DATE:__________________
VII. ADMINISTRATIVE APPROVALS

The IP Center will evaluate this preliminary invention disclosure and determine whether the technology demonstrates sufficient commercial potential to proceed with the filing of a provisional patent application.

Before filing a patent application, the IP Center will send the dean, department chair, inventors, and outside counsel an email indicating the intent to file and giving them the opportunity to raise any issues. Likewise, if the decision is to not file, the dean, department chair, inventors, and outside counsel will be notified and given the opportunity to raise any issues with the decision.