**IDF COMPLETION INSTRUCTIONS**

*Invention Disclosure Forms must be fully executed with all signatures in order to be valid.*

*Please contact the Office of Technology Commercialization at 330-672-2692 or (330) 672-0701 with any questions concerning the process.*

**1. What is the information in the IDF used for? Does the submission of an invention disclosure lead to a patent application?**

The invention disclosure form is an internal KSU form used to provide a written record of your intellectual

property. The information described herein will enable OTC to establish a record of the date of conception of the invention for legal purposes. The information will be used to evaluate the technology for its commercialization potential, legally protect the intellectual property and to identify potential licensees and to comply with sponsor reporting requirement. Submission of an Invention Disclosure does not insure that a patent application will be filed. Kent State University reserves the right in its sole discretion to determine those inventions upon which it will seek patent protection. The University Patent and Copyright Board will review all disclosures periodically and determine whether to protect the invention of not.

**2. Why is the relevant support information (contract/grant) important?**

Under federal law, the University is required to report to the U.S. Government, inventions created under sponsored research with the U.S. Government. Non-Government sponsors may also have intellectual property clauses and obligations attached to such sponsorship with which OTC must comply. Complete IDF Section 2 thoroughly and accurately so that the university can comply with its governmental and/or contractual reporting requirement.

3. **Title of the invention?**

This should be a non-enabling title and need not be the same as the title of the publication related to the invention.

**4. What are the responsibilities of the KSU contributors?**

The individual contributors certify that they are faculty, employees, staff, or students of Kent State University;

that each made a material contribution to the invention; and that each agrees to assign all right, title and interest to KSU pursuant to Ohio Revised Code 3345.14 (a separate assignment form will be provided to all KSU contributors prior to a patent application being filed). The individual(s) also agree to assist in the filing of patent applications and in the commercialization of the technology.

**5. What is the importance of % contribution of individual contributors and how does it relate to royalty income?**

Royalty income shall be distributed in accordance with the [KSU distribution of License and Royalty Income](https://www.kent.edu/research/technology-commercialization/ksu-distribution-license-and-royalty-income) (<https://www.kent.edu/research/technology-commercialization/ksu-distribution-license-and-royalty-income>). The % contribution determines the % of revenue share of royalty revenues. The revenues generated from the commercialization of the invention will be distributed to the contributors based on the % contribution. The % contribution will be the same as % revenue shared. If the blanks are not filled in, the contributors share of Net Royalty income, if any, will be divided equally among all KSU contributors to the invention. The university will honor the revenue sharing agreement among contributors set forth herein unless the contributors reach a different agreement, or as required by law. See KSU Policies:

<https://www.kent.edu/research/technology-commercialization/ksu-distribution-license-and-royalty-income>
<https://www.kent.edu/policyreg/university-policy-regarding-patents>
<https://www.kent.edu/policyreg/administrative-policy-regarding-patents>

**6. Are contributors same as inventors?**

Identification of a person as a Contributor in this Invention Disclosure does not assure that a contributor will

qualify as an “inventor” under applicable US patent law. Inventorship is defined and determined under U.S. patent law. An inventor is an individual or individuals who made contribution to the conception of an invention. Authorship in a publication doesn’t mean inventorship.

**7. Should visiting scientists or collaborators at other institutions be listed as inventors?**

All non-KSU individuals that may have contributed to the ideas leading to a discovery should be identified as a contributor under the non-KSU contributors section of the IDF. The University reserves the right to separately reach agreement concerning revenue sharing with any non-KSU contributor that it determines has an ownership interest.
<http://www.uspto.gov/web/offices/pac/mpep/s2137.html>

**8. How detailed should the description of the invention be?**

As detailed as possible. Without adequate information, OTC cannot perform a complete evaluation of the invention's licensing potential, nor can we obtain an accurate legal opinion as to whether it is patentable. Note that inventions supported by government sponsorship must be sufficiently complete in technical detail to convey a clear understanding to the extent known at the time of the disclosure, of the nature, purpose, operation, and physical, chemical, biological, or electrical characteristics of the invention.

**9. Why are the dates of conception and disclosure important?**

On March 16, 2013 the U.S. patent system has switched to a “fist-inventor-to-file”. The dates of disclosure are

important because in the U.S. an inventor has one year from the date of public disclosure (see Section 9 below) in which to file a patent application. Once a year from the time of disclosure has passed, the invention cannot be patented. Also, note that most foreign countries have an “absolute novelty” requirement. This means that in most foreign jurisdictions, patent rights are lost once an invention has been publicly disclosed. The university does not often file for foreign patents due to their prohibitively high costs, however, we strongly encourage inventors to submit and invention disclosure to OTC well before public disclosure so that we may keep this option open for a potential licensee.

**10. What is considered a public disclosure of an invention?**

Almost any disclosure without an obligation of secrecy may constitute a public disclosure. Public disclosure may include, but is not limited to, journal papers, conference abstracts/presentations, publications or descriptions on the World Wide Web, and dissertations indexed at the library, that describe the basic ideas of the invention in enough detail that someone else would be able to make and use the invention. Talking about these ideas may also constitute disclosure, as does selling or offering for sale a prototype of the invention.

**11. Should faculty & students refrain from publishing a paper or submitting an abstract/making an oral presentation of an invention before OTC has filed for a patent?**

The one-year grace period permits later patent filing for U.S. patents. However, inventors should disclose their invention well before the invention is publicly disclosed to preserve foreign patent rights.

**12. If the invention is disclosed either through a publication or an oral presentation before OTC files a patent application, are the patent rights lost?**

Not the U.S. rights but definitely foreign rights. In the U.S. we have one year from the date of first publication

(or public disclosure) in which to file for a patent.