

THOMAS JEFFERSON UNIVERSITY
INVENTION DISCLOSURE PROCEDURE GUIDE

I. INTRODUCTION:

The Office of Technology Business Development (“OTBD”) is a service department of the Innovation Pillar of Thomas Jefferson University, Thomas Jefferson University Hospitals and all controlled affiliates, collectively referred to as “Jefferson”. The OTBD has responsibility of protecting both patentable and unpatentable technology developed by personnel of Jefferson and assisting such technology to the marketplace.

Upon joining Jefferson, all faculty or staff members, fellows, students, or unpaid volunteers, become subject to Jefferson's Patent Policies requiring the assignment to Jefferson of intellectual property which emerges from any research, development or other activity sponsored by Jefferson or developed with the use of University funds, equipment, facilities or other personnel of Jefferson. All Jefferson personnel are required to sign an Assignment of Inventions Agreement as a condition of joining Jefferson. A copy of the Assignment of Inventions Agreement is attached here as Exhibit A of Invention Disclosure form.

This form is designed to assist Jefferson personnel to report their patentable inventions. It is impossible to give a precise definition of what constitutes a patentable invention, since the answer depends upon many factors and, in the last analysis, is a unique decision made by the U.S. Patent and Trademark Office. In general, there are three criteria for a patentable invention: novelty, utility, and being non-obvious to one skilled in the art. Jefferson encourages employees to contact OTBD to disclose their ideas for any new device or instrument, diagnostic assay or marker, therapeutic composition of matter such as a lead compound or a set of compounds, biological research material. OTBD will work with the inventor candidate group to evaluate the invention, consider the feasibility of patent protection, and determine the appropriate commercialization path for the intellectual property. On occasion, OTBD also engages industry experts as consultants to provide commercial feedback.

II. EVIDENCE OF CONCEPTION

"Conception" of an idea relates to the time of an invention's formulation and must be provable by legally sufficient evidence. "Legally sufficient evidence" requires objective proof of the date of conception and its subsequent development. Carefully maintained laboratory notebooks and a timely and well written invention disclosure are, therefore, very important. “Reduction to practice” relates to the enablement of an invention after conducting experiments and obtaining supporting data to show the invention works. Such information is very important for marketing the invention to potential commercial licensees and attracting investment interest. .

III. HOW TO PREPARE AN INVENTION DISCLOSURE

It is important in preparing an Invention Disclosure, to document the earliest date of the original concept of the invention. This may be as simple as a single, dated entry in a notebook. The inventor candidate should not wait for the final or ideal form of the idea to be developed, but should

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document the concept as soon as he/she has the first hazy outline of his/her invention. The inventor should not hesitate to contact the Innovation Pillar and submit an Invention Disclosure form. Addenda can be added as details are worked out. To secure the fullest protection possible for new ideas, laboratory records concerning such developments should be dated and signed, and kept in an orderly manner.

- A.** The Report of Invention should be written as soon as possible after you believe that you have made an invention.
- B.** The Report of Invention should be as complete as it can be at the time when it is written. Remember - it can be updated - and probably will be as your research progresses.
- C.** The first sketches or drawings and the first written description of each part of the invention, no matter how crude, are important legal records, particularly when they are signed, dated and witnessed at the time when they are made.
- D.** If the subject matter of the invention has or will be publicly disclosed or commercialized, the date of first public disclosure must be mentioned in the Report of Invention so that the patent attorney will be on notice to be mindful of any deadlines for seeking patent rights. At the time of a public disclosure, the ability to seek patent rights in most European countries is lost. A few countries have a grace period—in Japan, six months from the public disclosure date, in the US and Canada, one year from the public disclosure date—to file a patent application. It is important to keep us continually apprised of any pending public disclosure, such as the upcoming publication of a meeting abstract, journal article, or a to-be-funded grant. It is very important to notify us about any information provided by the editors regarding online publication, because this may occur before the print journal issues. While the review of a submitted abstract or manuscript is considered confidential, once they are accepted, they could be published at any time. Some journals even publish the galley proofs before they have been reviewed by the authors. The review of grant applications is considered confidential, although applicants should mark “Confidential” on the confidential parts of the proposal. Once the grant has been approved for funding, the abstract will publish when the grant is awarded. Any proprietary information in the abstract will be considered a public disclosure. Therefore, we request that copies of manuscripts, abstracts, grant application abstracts and proposals, etc. related to previously disclosed or soon to be disclosed inventions be provided to the Office of Technology Business Development prior to submission to the funding agency, journal or conference, if possible. Your cooperation in this respect is greatly appreciated!

IV. TRANSMITTAL:

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- The completed Report of Invention should be transmitted directly to the OTBD, with a copy to your Chairperson or Supervisor. **You will not receive a confirmation notification until your signed, completed Report of Invention and Exhibit A are received.**

V. ACKNOWLEDGEMENT:

The OTBD will acknowledge receipt of your Invention Disclosure by assigning a case number and it is requested that all subsequent correspondence reference the assigned case number.

If you have any questions, do not hesitate to contact:

Bob DeHaven
901 Walnut Street
11th Floor
Philadelphia, PA 19107
Phone (215) 955-6862
robert.dehaven@jefferson.edu