

ATTACHMENT A

OHIO REVISED CODE SECTION CONCERNING STATE UNIVERSITY INVENTIONS

3345.14 Rights to discoveries or inventions to be University property; disposition of income therefrom

All rights to and interests in discoveries or inventions, including patents thereon, which result from research or investigation conducted in any experiment station, bureau, laboratory, or research facility of any state college or University shall be the sole property of such college or University. No person, firm, association, corporation, or governmental agency which uses the facilities of such college or University in connection with such research or investigation and no faculty member, employee, or student of such college or University participating in or making such discoveries or inventions, shall have any rights to or interests in such discoveries or inventions, including income therefrom, except as may, by determination of the board of trustees of such college or University, be assigned, licensed, transferred, or paid to such persons or entities.

As may be determined from time to time by the board of trustees of any state college or University, the college or University may retain, assign, license, transfer, sell, or otherwise dispose of, in whole or in part and upon such terms as the board of trustees may direct, any and all rights to, interests in, or income from any such discoveries, inventions, or patents which the college or University owns or may acquire. Such dispositions may be to any individual, firm, association, corporation, or governmental agency, or to any faculty member, employee, or student of the college or University as the board of trustees may direct. Any and all income or proceeds derived or retained from any such dispositions shall be applied to the general or special use of the college or University as determined by the board of trustees of such college or University.

Source: Ohio Revised Code Section 3345.14

Effective Date: 09-07-2000

Intellectual Property Policy, Attachment B

ATTACHMENT B

Invention Disclosure Form

Please complete this Invention Disclosure Form as completely as possible. It is important that you provide as much information as possible to facilitate the review, analysis and protection of your invention.

This is a confidential, proprietary, non-public document. Its contents may not be communicated in any way without the consent of University. This Form is to be submitted to the NEOMED Office of the General Counsel.

Description of Invention: Please provide as much information as possible. Additional attachments are welcome. The completeness and clarity of submission are directly related to our ability to act on your technology.

Inventors: List all university and non-university persons who have directly contributed in developing or conceiving the invention (including students, interns, post-doctoral candidates, scientists, and researchers, physicians, independent contractors and leased employees). **All individuals who have made any inventive contribution must be listed in order for a valid patent to be filed.**

Assignment: **University policy requires all employees of University, any independent contractors hired by University and any scientists, researchers or physicians who are leased to University, to assign their entire right, title and interest in and to all inventions to the University.** Each inventor is also expected to cooperate in the filing of patent applications and commercialization of the technology, including in communications with potentially interested companies.

Title of Invention	
Date of Invention (earliest conception date)	

INVENTOR(S) (* If there are more than 3 inventors, please list on a separate sheet)

	Inventor 1	Inventor 2	Inventor 3
Full Name			
Phone Work Home Cell			
Email Work Home			
University Department or Affiliation			
Signature			

For internal use Number: _____ By University	Date Received: _____	University File
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DESCRIPTION OF INVENTION

- (1) Please describe the invention in as much detail as possible (please be sure to attach any drawings, diagrams, photographs, lab book sheets, or other material that will help us understand the invention as its use). If a device or other product, describe the elements of the product; if a method, describe each step of the method. Please note any variants or different embodiments of the invention, so that we can seek broad protection. Please see a summary of questions we seek to answer during the initial processing of an invention in **Appendix A**.

(2) What are the key and novel features of the invention (how is it different from products or methods currently available)?

(3) What are the immediate and/or future applications of the invention?

(4) What are the advantages of the invention over other current/anticipated technologies?

TAXONOMY

Please characterize your invention by using key words for research area and research type(s).

Research Area

Invention Type

Device Diagnostic
Technique/Method Therapeutic
Other _____

DEVELOPMENT OF INVENTION

- (5) Please describe the current state of development of the technology. Has the invention been reduced to practice? **Does a prototype exist? Is there experimental data supporting the invention?**

- (6) Please describe developmental milestones that are expected to be reached within 18 months, and whether you have access to the necessary tooling, expertise or other needed resources.

- (7) Is there funding available for the next 18 months? If so, please identify the source of funding. If not, please estimate amount of funding needed, and what it would be used for.

THIRD-PARTY INVOLVEMENT

- (8) The University is required to report inventions made using government funds to the relevant government agency, including providing them with a confidential copy of the disclosure (please see **Appendix B** for an explanation of Investigators' and University's respective reporting obligations to the Federal Government). If an invention is made using industry or research grant funds, the university will be obligated to report such inventions to the sponsor, in accordance with the associated research grant/contract. **Please identify the sponsor of the invention, as well as the relevant grant/contract numbers.**

- (9) Please list any agreements that are in place or are being processed or drafted that might be related to the technology, such as Materials Transfer Agreements, Consulting Agreements, Confidentiality Agreements, Sponsored Research Agreements, and Fee-for-Service Agreements. Please include company/institution name and agreement date. **It is critical to identify any encumbrance on the technology as early as possible.**

MARKETABILITY

- (10) Please describe competing technologies or procedures (include names of products, software components, manufacturers, methods, etc.), as well as those making or selling such products.

- (11) If the device is to be used for a clinical procedure, please estimate the current cost and volume (per month or per year) of the procedure. If there is a cost savings or increase in procedure volume (or similar benefit), please attempt to quantify here.

- (12) Please list any industry contact(s) that may be interested in licensing or sponsoring future research. (Include name, company/affiliation, title, phone/email information).

PUBLICATIONS AND PRIOR ART

(13) Please list the titles and dates of relevant publication(s) made by you or colleagues related to the invention **including publication on websites, or publication of abstracts or poster presentations, and presentations at conferences.** Please attach copies of published or submitted versions. **Valid patent protection depends on accurate dates of public disclosure.**

Publication(s):

Date:

(14) Please list dates of all disclosures you have made to individuals or entities NOT employed by University, and identify the recipients of such disclosures. Please include informal discussions either held on or off University premises. (Please indicate if a Confidentiality Agreement was in place or if an agreement is needed for upcoming discussions.)

Disclosure(s):

Date:

(15) Please list any literature and/or patent searches done by the inventors or other individuals or entities conducting research/development in the field related to this invention (patents can be searched at www.uspto.gov and ep.espacenet.com). **Please identify Key Words used for the searches.**

(16) Please list any publications of third parties that are similar to the invention, or disclose elements of the invention, and that therefore may be relevant prior art.

(17) Please list prominent individuals or researchers in this field (including any University employees):

REVENUE DISTRIBUTION

Individuals contributing to the invention should discuss and agree on the distribution of commercialization income before submitting an Invention Disclosure Form.

Established University policy provides that for any net revenue (as that term is defined in the University Intellectual Property Policy) derived from the commercialization of University Intellectual Property, the distribution shall be in accordance with that policy unless otherwise negated:

The following information will be used for patent applications and revenue distribution. **Please note that % Contribution indicates the percentage that each inventor should receive from the inventor share of the commercialization revenue. If unspecified on this document, all inventors will equally share all such revenue.**

	Inventor 1	Inventor 2	Inventor 3	Inventor 4	Inventor 5
Full Name					
Home Address					
County					
Citizenship					
% Contribution					

Send the completed, signed form and all attachments to: Maria R. Schimer, M.P.H., J.D., General Counsel (maria@neomed.edu)

Phone: (330) 325-6356

Please encrypt the file and send the password for the encrypted file in a separate email.

Inventor Signature

Date

ATTACHMENT C
LABORATORY NOTEBOOK GUIDELINES

Laboratory Notebooks are essential legal documents, necessary not only to assist in preparing the patent application, but also to defend in patent interferences and patent litigation. The importance of a properly kept notebook cannot be overemphasized. The notebooks may be used as evidence and may also be used to aid witnesses giving testimony.

Please use the following guidelines in keeping a laboratory notebook:

- (1) The notebook should have a permanent binding and the pages should be numbered.
- (2) Entries should be made in permanent ink, preferably black or blue.
- (3) The entries should be factual and timely.
- (4) The notebook should be assigned to one investigator.
- (5) Each page should be signed and dated by one of the investigators.
- (6) The pages disclosing the conception of the invention and the reduction to practice should be countersigned and dated by a co-worker or supervisor (not a co-inventor)... "witnessed and understood by..."
- (7) Vertical lines should be drawn through the unused portion of each page. Errors should be lined out with a single line and an explanation should be given.
- (8) Contemplated or planned experiments should be written out in detail as soon as conceived and results of experiments should be carefully recorded.
- (9) Potential benefits and uses of the invention should be recorded.
- (10) Charts, graphs, drawings, printouts and other data should be signed, dated and either attached to the notebook or referred to in it.
- (11) Six Critical Dates to be recorded in the notebook:
 - (a) The date the invention is conceived
(The idea should be communicated to someone other than a co-inventor who understands the idea. That witness should sign and date the entry in the notebook.)
 - (b) The date the invention is reduced to practice, e.g., the date the inventor first made the invention work.
(Again, this should be witnessed by someone other than a co-inventor who understands the invention and the entry should be signed and dated by that witness.)

Note: If an inventor can prove that "due diligence" was used from the date the idea was conceived until it was first reduced to practice, it is possible that patent rights may be granted back to the date the idea was first conceived.

- (c) The date the completed and operative invention is first used in public.
- (d) The date a detailed description of the invention or discovery is first published.
- (e) The date the invention is first offered for sale, whether or not the offer is accepted.

(f) The date the invention is first sold.

What to Expect Going Forward in the Disclosure Process

- (1) Email confirmation of receipt of Invention Disclosure Form
- (2) Review of Form by the Technology Transfer Officer and the Vice President for Research, using “Questions for Review When Processing a New Invention Disclosure” document
- (3) The General Counsel will conduct due diligence to assess the Invention in light of currently available technology, existing intellectual property and commercialization considerations.
- (4) Meetings with the General Counsel, General Counsel staff, outside consultants if necessary, and the Vice President for Research.
- (5) A written decision reached by the Technology Transfer Officer and the Vice President for Research regarding patentability and commercialization potential and follow up steps, if appropriate.