Disclosing the Unexpected: The Invention Disclosure Process

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Office of Biotechnology and Business Development
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Experiments should explain observations
Results and data are valuable

Results and data provide:
• Answers to questions
• Ideas and direction for future investigations
• Tangible materials
• Unexpected outcomes

Have I invented something?
Will it be useful for others?
Is this of commercial value?

Invention Disclosure Form!!!
The Invention Disclosure Form is used to evaluate a technology

- Description of the invention
- Comparison to other relevant technologies
- Data showing how the invention works
- Information necessary for compliance obligations and for filing a patent
Invention description should be detailed

1. **Provide non-confidential descriptive title of the invention.** (brief title, preferably 20 words or less, that describes the invention and does not disclose confidential information)

   Antibodies for treatment of condition Y

2. **What is the invention?** (provide a brief description of the invention)
   - New molecule and its uses
   - Known molecule for a new use
   - Disruption of a known pathway and its effects on condition Y
   etc...

3. **How would you characterize the type or nature of the invention?**
   - therapeutic, □ diagnostic, □ vaccine, □ device, □ reagent, □ software program, □ mobile application, □ platform technology
   for Click or tap here to enter text., and/or □ other: Click or tap here to enter text.
The benefits of the invention should be clear

4. **What are the problems or needs the invention solves or addresses?**

5. **How does this invention differ from related technologies that have been published (including your own work) and/or are in clinical development and/or are on the market? And, how is this invention superior to those existing technologies?**

6. **What are the disadvantages, if any, of the invention and how might they be overcome?** (e.g., prohibitive cost, problematic side effects, and/or other concerns)
There should be potential for monetization

7. **What are the potential commercial uses of the invention?** What is the “end product” that will eventually be sold/licensed?

8. **What is the current stage of development of the invention and what additional work needs to be done before a company is likely to find the invention of interest?** (If there is more work to be done, please indicate the nature of the work to be done and how long it will take to complete, whether the necessary resources to do the work are available, and the milestone(s) that would trigger commercial interest.)

9. **What is the estimated market addressable by the invention?** (include potential number and type of end users/customers as well as potential annual sales)
Einstein monetizes technologies through out-licensing

- Patent applications for product development
- Tangible assets for internal research purposes
Einstein looks for the **right** commercial partner

10. **List companies that might have commercial interest in the invention and indicate why they might find it valuable.** (If there has already been contact with any of these companies, provide the relevant contact information, date(s) of the discussions, and indicate the nature of the discussions. Please note if these discussions were under the auspices of a previously executed confidentiality agreement.)

\[\text{Einstein} + \text{The Jackson Laboratory} + \text{AEROBLAZE} = \text{PETA} \]
Understanding the invention is critical

11. Attach a confidential “detailed description" of the invention. The description is limited to 4 pages of text and additional pages of data/figures. (Detailed description should clearly explain the essence of the invention so that it is easily understandable.) Description should convey significance, novelty and utility of invention. Feel free to cut and paste from relevant publications, manuscripts, research proposals, etc. If applicable, a self-contained manuscript/abstract/poster that fully describes and encompasses the invention may be attached as supplementary material; however, grant applications and/or multiple manuscripts that do not fully describe/support the invention cannot be accepted as supplementary material.

“It is my ambition to say in ten sentences what others say in a whole book”*
An idea is born on a specific date

12. Provide date the invention was conceived (an invention has been “conceived” when a definite and permanent idea about an operable invention has been formed, and when one of ordinary skill in the scientific field of the invention can make the invention without too much additional research or experimentation):

13. Provide date the invention was reduced to practice (for example, for a device, when a prototype or model of the invention was created; for a method, when the method was performed and results were confirmed; for a reagent, when the reagent was produced or synthesized):
Let us know *before* you announce to the world.

17. Please complete the following table to indicate the public disclosure status of the invention (past or in the near future):

<table>
<thead>
<tr>
<th>Status of abstract / presentation/ manuscript describing the invention (please provide copy of document if available)</th>
<th>Indicate yes or no</th>
<th>Date of submission and/or publication</th>
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<td>Has an abstract already been submitted for a conference or presentation?</td>
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Submit IDF now or forever lose your (foreign) piece

Next Seminar Series: The Patent Process

https://turbopatent.com/international-ip-protection-patent-mba-excerpt/pct-process/
Einstein has reporting obligations to different funding sources

18. Identify all sponsors whose support contributed, in whole or in part, to the conception, development, and/or reduction to practice of the invention. (If none, explicitly indicate NONE in the space below.)

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There is no such thing as a free lunch

16. Were any proprietary materials and/or special techniques received from third party(ies) (e.g., company, another academic institution, etc.) that were incorporated into the invention and/or used in the research that led to the invention? (If none, explicitly indicate NONE in the space below; otherwise, identify the source of the materials and/or techniques and confirm whether the transfer was covered by a Material Transfer Agreement and/or a Confidentiality Agreement.)
A person can contribute to an invention without being an inventor

19. **Who else was involved in the effort which led to the invention, whether or not such collaboration involved financial support?** For each listed collaborator, provide a short description of the contribution made by that collaborator(s). (If none, explicitly indicate NONE in the space below; otherwise, identify all other academic, research, or for-profit entities that were involved.)

   Click or tap here to enter text.

20. **Although the concepts were uniquely developed by the undersigned, identify persons, if any, with whom any collaborative work on the invention was shared.** Provide a description of the work shared with each person.
   a. Click or tap here to enter text.
   b. Click or tap here to enter text.
   c. Click or tap here to enter text.
   d. Click or tap here to enter text.
A person can contribute to an invention without being an inventor.
It should be clear what an inventor contributed to the invention

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<th>Name of Inventor:</th>
<th>% Contribution</th>
<th>Provide a description of the contribution of each named inventor to the conception and/or design of the invention</th>
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Inventors may come from multiple institutions

For each Inventor not employed by Einstein or Montefiore (at the time of the invention), please identify the appropriate technology transfer contact from that institution (name, phone, e-mail address).

Click or tap here to enter text. 
Inventor Name

Click or tap here to enter text. 
Technology Transfer Contact (name, phone, e-mail address)

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Inventor Name

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Technology Transfer Contact (name, phone, e-mail address)

Click or tap here to enter text. 
Inventor Name

Click or tap here to enter text. 
Technology Transfer Contact (name, phone, e-mail address)

But only one application can be filed.

If Einstein is the main institution, then the disclosure is reviewed according to the Patent Committee Process.
The Patent Committee reviews the invention disclosure

A Committee of Einstein and Montefiore Faculty review each invention disclosure to address the following points:

• Is the invention clearly described?
• Is more information needed from inventors?
• Is the invention useful, novel, and non-obvious?
• Is there commercial value?
• Does it make sense to pursue patent or copyright protection?

“Pursue to Patent” → The Patent Process → Stay Tuned!!
Summary

• The Invention Disclosure Form is used to evaluate a technology
• Description of the technology should be detailed and concise
• Disclose technologies to the OBBD sooner rather than later
• Einstein has a variety of obligations for reporting new technologies
• Patent Committee makes recommendation
• The Patent Process is an important upcoming topic of the IP and Coffee seminar series
Questions?

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