

# Invention-Patent Tech Transfer Procedure

## Invention Pre-Disclosure

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1. Inventor(s) notify Office of Technology Transfer (OTT) that they intend to disclose an invention.
2. Technology Transfer and Innovation Manager (TTM) holds a pre-disclosure meeting with inventor(s) to assess the readiness of the invention.
3. The TTM makes a go/no-go decision whether to proceed with the invention.
4. If the TTM decides to proceed with the invention, the inventor(s) will be invited to submit a disclosure form.
5. Inventors are requested to provide all relevant information to the best of their ability.
  - a. parties sponsoring the invention
  - b. parties who are sponsoring the further development of the invention
  - c. parties who have expressed interest in licensing the invention
  - d. the competitive/market landscape of the invention
  - e. fields of use of the invention
6. Inventor(s) and relevant parties (i.e. research assistants, graduate students) are advised to refrain from public disclosure (i.e. presentation, journal publication, word-of-mouth, etc.) of the invention without written consent from the TTM. Inventor(s) and relevant parties may be required to sign a non-disclosure agreement (NDA)

## Provisional Patent

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1. After the inventor(s) submits an invention disclosure form the TTM and The Office of General Counsel (OGC) will review the disclosure. The inventors may be instructed to make corrections or modifications.
  2. Once the disclosure is completed to the satisfaction the of TTM and OGC, a docket number will be assigned to the invention (i.e TNSTATEUNIV000000) and a Provisional Patent Application will be drafted.
  3. The TTM reports the invention in iEdison.
  4. The Provisional Patent Application is sent to the inventor(s) to provide final feedback regarding points of novelty, enabling descriptions, fields of use, etc.
  5. Once the application is written to the satisfaction of all parties, the application will be filed.
  6. The University will have 12 months from the filing date of the provisional patent to license the invention or file a full application. The default policy of the OTT is that the licensee will pay for the cost of the full application.
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## **Valuation and Licensing**

1. The TTM will assess the market and competitive landscape of the invention to identify prospective licensees and achieve a valuation of the invention.
  2. Marketing materials for the invention are developed and the invention is marketed through various channels.
  3. The OTT and OGC commence negotiations to arrive at a mutually beneficial agreement for the University and Licensee(s).
  4. Payments and royalties are distributed according to the revenue sharing clause of the TSU Intellectual Property Policy.
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## **Full Patent Application - Committee Review**

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1. If an invention has not been licensed 9 months following the filing of the Provisional Patent Application then the TTM will OTT will convene the intellectual property committee to vote to file a full application.
2. Inventors(s) are allowed to present or submit supporting justification for the full application. Inventor(s) are expected to support the cost of the full application (i.e. departmental funding, grant funding).
3. Cases where the University may elect to file a full application include
  - a. The invention has multiple fields of use and may be licensed to different parties
  - b. The invention is early-stage or relies on another invention still in development, and it has a high likelihood of being licensed in the near future (i.e <5 years)
  - c. The invention has significant revenue-generating potential
4. If the Intellectual Property Committee votes to file a full application, the TTM will elect title to the invention in iEdison.
5. If the Intellectual Property Committee votes against filing a full application, the invention will be retained by the university, or released to the inventor(s)