

Working With Innovators

Managing the Flow: From Inventor to TTO



UNIVERSIDAD NACIONAL DE LA PLATA
Dirección de Propiedad Intelectual



ORGANIZACIÓN MUNDIAL DE
LA PROPIEDAD INTELECTUAL

PIERCE  LAW
FRANKLIN PIERCE LAW CENTER

What Every Inventor Needs

- In the Lab:
 - **A Lab Notebook kept in permanent ink or some other permanent form**
 - **A Checklist for maintaining the Notebook**
 - o Daily record of every experiment with enough detail to permit one “skilled in the art” to understand what has been done
 - o Dates
 - o Protocols
 - o Data, drawings
 - o Thoughts about each experiment and results
 - o Witnessed on a regular basis by a person who is not a co-inventor
 - **Place for safe keeping (notebooks must be confidential)**
 - **For example of notebook keeping policy go to:**
www.cctec.cornell.edu/cctec/researchers/protocols/guidelines/index.cfm



What Every Inventor Needs

- And, every inventor also needs:
 - **A basic understanding of intellectual property law and the patent system**
Caution: IP errors can be irreversible.
- A copy of your organization's patent/IP policy
- How or who to contact in your technology commercialization office
- Your organization's invention disclosure form
- A basic guide to working with patent attorneys: What to expect



Optimizing the Role of the Inventor

- **Inventor tasks**
 - **Disclosure of invention**
 - **Meeting with patent attorney**
 - **Literature search**
 - **Providing background information as to why invention is needed; advantages**
 - **Providing drawings**
 - **Signing documents required for filing**
 - **Marketing**
 - **Going “on the road”**
 - **Investment participation if start-up**
 - **Consulting to licensee or assignee**



Managing the Innovation Flow

- Basic tool: The invention disclosure form
 - Title of Invention
 - Names of inventors
 - Overview of purpose of Invention
 - Detailed description of steps, processes followed to enable someone of “ordinary skill in the art” to reproduce and practice
 - Existing state of the art or relevant art (if known)



Managing the Innovation Flow

- Basic tool: The invention disclosure form
 - **Date of conception (enabling concept) and reduction to practice**
 - **Date of first disclosure to others and how disclosed**
 - **First sale or public use**
 - **Funding source**
 - **Witnesses (invention described and understood)**
- Include definitions for terms used



Managing the Innovation Flow

- New tool: Technology Scout
 - **Role:** “Walking the halls” to talk with researchers from early stages in research planning > reporting results.
 - **Skills needed:** A facilitator with science & new business background
- Administrative tool:
 - **Invention management database** – tracking from disclosure to license termination

