

San José State University Research Foundation

Invention Disclosure

Part A – Identifying Information

1. Names of Inventor(s): Inventors are those who contributed intellectually to the invention and made a significant contribution. Please provide the names of other inventors on an attached page.

Name: _____ Department: _____

Campus Address: _____ Home Address: _____

Office Phone #: _____ Home Phone #: _____

Fax #: _____ Social Security #: _____ Email: _____

Name: _____ Department: _____

Campus Address: _____ Home Address: _____

Office Phone #: _____ Home Phone #: _____

Fax #: _____ Social Security #: _____ Email: _____

2. Title of Invention: Inventions include new processes, products, apparatuses, and compositions of matter, living organisms - or improvements to existing technology in those categories. Keep in mind that a "catchy" title sometimes helps to get initial attention from potential licensees, and try to keep a broad focus for its potential applications.

Part B – Signature(s)

By signing, I (We) understand that in accordance with the San José State University Intellectual Property Policy, all inventions which I (we) conceive or develop while employed SJSU shall be examined by the university to determine rights and equities therein. I (We) hereby agree to promptly furnish the university with any additional information necessary to this determination. In the event that the university decides to exercise its rights to the invention disclosed herein, I (we) agree to assign all right, title and interest to this invention to San José State University under the terms of the Intellectual Property Agreement between the Inventor(s) and the San José State University Research Foundation and to fully cooperate with the university or its designee in securing appropriate protection for the intellectual property embodied in this invention.

Date: _____

Date: _____

Date: _____

Date: _____

Please return this form to:

Natisha Holloway, Risk Management & Compliance Analyst
San José State University Research Foundation
210 North Fourth Street, 4th Floor, San José, CA 95172-0130
Email: Natisha.Holloway@sjsu.edu
Phone: 408-924-1451

With Copy to:

Dr. Michael Muthig, Director
Office of Innovation, San José State University
Email: OfficeofInnovation@sjsu.edu
Phone: 408-924-3811

Part C – Invention Information

Please attach a separate narrative that responds to each of the items below.

1. Description of the Invention. [How would you describe your invention to intelligent people not in your field?]

2. Evidence for Patent. [The criteria for a U.S. Patent are novelty, utility, and non-obviousness.] Please describe in "bulleted" format, evidence you have for each criterion or evidence others might cite against any of the criteria.

- a. *Novelty*: An invention is novel if nothing identical previously existed. How does your invention differ from what already exists? In what ways might it not be unique?
- b. *Utility*: Who might find your invention useful, and why? What companies might be interested in making or selling it, and why? Is there other technology that currently provides similar utility? If so, what is the unique advantage of your invention?
- c. *Non-obviousness*: Non-obviousness measures the degree to which an invention could not have been anticipated from the totality of previous knowledge. At the time it was conceived, why might your invention not have been obvious to people reasonably skilled in the field? Are there ways in which it might be part of an evolutionary trend?

3. Stage of Development. The more resources that companies must invest in a technology to bring it to market, the less initial value they place on the technology. To what extent has your invention been realized in practice so that at least the general principles are demonstrable? Are you working toward a prototype or demonstration of principle? Has the invention been reduced to practice?

4. Expert Opinions. The university has finite funds with which to protect inventions, and its strategy is to patent those inventions most likely to be licensed to a company and provide future commercialization. To make the highest quality decision on individual inventions, SJSU often seeks the opinion of experts familiar with the field but unrelated to the inventors, especially experts familiar with the commercial potential. Can you suggest experts who can give a confidential opinion on your invention? Please provide a phone number or address. (Assume we will contact anyone you name.)

5. Publication, Sale, or Public Use. Publishing an "enabling" disclosure and applying for patent protection are not mutually exclusive; they can be done simultaneously under the proper circumstances. U.S. patent laws allow one to apply for a patent no later than one year after a public disclosure, such as a published paper, a widely available abstract, or an offer of public sale. However, the moment a public disclosure or publication is made, rights to foreign patents are lost unless a U.S. filing has been made within the preceding twelve months. Foreign protection is important to many international licensees, so inventors are urged to use discretion, take advantage of Confidential Disclosure Agreements available from this office, and file invention disclosures with the university well in advance of presentations or publications.

- a. Has your invention been disclosed in an abstract, paper, talk, news story, thesis, or public conversation?
If yes, please indicate the type and date of each public disclosure (please enclose copies, if available).
- b. Is a publication or other disclosure planned in the next six months? If yes, please indicate the type and date of each planned disclosure (please enclose drafts, abstracts, or preprints).
- c. Are you aware of publications or patents by others that describe anything similar to your invention, even if in a different field? If yes, please give citations and enclose copies of relevant publications or patents if possible.
- d. Have you sold or offered for sale any products that embody your invention? Have you allowed others outside the university to use your invention? If so, please describe the circumstances and give dates.

- e. The San José State University Research Foundation may publish a "non-enabling abstract" each year to publicize new inventions that are available to license. Are there reasons why your non-enabling abstract cannot be included in such a brochure? If yes, please specify.

6. Sponsorship. Sponsoring agencies sometimes require the university to disclose inventions that arise from work they fund. If the research that led to your invention was sponsored, please give details. Please include name(s) of government, industry, university, foundation or other sponsor(s), the SJSU Research Foundation account numbers and effective date(s), if known. If your invention has been disclosed to government or industry sponsors, please provide details including names of organizations and their representatives.

7. Addendum. The United States grants patents to those who are first to file their invention. Some inventors document the date of their invention by keeping bound notebooks, with each page dated and signed in ink by witnesses. *If you have not done this, please go back now and sign and date each page of this disclosure form.*

Please include any other information you think relevant to your invention, such as reports, preprints, excerpts from grant applications, drawings or diagrams, etc. Tabular information showing quantitative or other objective advantages of your invention over existing technology are especially useful.

Part D. – Declaration of Institutional Support

Please attach a completed **Declaration of Institutional Support (Inventions)** form and obtain the signatures of your department chair and college dean.

This form is available on the [San José State University Research Foundation's Forms](#) web page.