

When completed submit to:

# Emory Intellectual Property Disclosure Statement Form

Office of Technology Transfer  
1599 Clifton Rd., NE, 4<sup>th</sup> Floor  
Atlanta, Georgia 30322  
(404) 727-2211

The purpose of this form is to facilitate the prompt disclosure by Emory Personnel of any Intellectual Property to which Emory may assert ownership rights pursuant to Section I of the Emory University Intellectual Property Policy effective March 15, 2011. Please review the attached instructions and guidelines.

**1. Title of Intellectual Property**

**2. Type of Intellectual Property**

- |   |   |   |
|---|---|---|
| <input type="checkbox"/> Diagnostics            | <input type="checkbox"/> Drug Discovery   | <input type="checkbox"/> Medical Device |
| <input type="checkbox"/> Micro & Nanotechnology | <input type="checkbox"/> Non-Therapeutics | <input type="checkbox"/> Research Tools |
| <input type="checkbox"/> Software               | <input type="checkbox"/> Therapeutics     | <input type="checkbox"/> Vaccine        |

3. Please **attach a description** with technical detail sufficient to convey a clear understanding, to the extent currently known, of the nature, purpose, operation, and the physical, chemical, biological or electrical characteristics of the invention.

4. <u>Legal Name</u> of Contributor (No Nicknames)		Position	Department	Emory Employee ID <small>Please <b>do not</b> provide SSN</small>	% Contribution	VA	CHOA	GA Tech	Other Institution (name)
Last Name	First Name								
					___%	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	
					___%	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	
					___%	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	
					___%	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	

*Please list all persons who are believed to have made significant contributions to the Intellectual Property including Emory Personnel as well as other Contributors at other institutions. Determination of inventorship is a legal matter and will be determined by legal counsel.*

**5. What funds were used to develop this intellectual property? Please check all that apply**

- Government Grant? Grant No(s) \_\_\_\_\_ Agency \_\_\_\_\_ PI \_\_\_\_\_
- Foundation Grant? Sponsor(s) \_\_\_\_\_ OSP # \_\_\_\_\_
- Industry Sponsor? Sponsor(s) \_\_\_\_\_ OSP # \_\_\_\_\_
- Discretionary or department funds? \_\_\_\_\_
- Other? \_\_\_\_\_

**6. a) Was any material used to develop this intellectual property received under a Material Transfer Agreement?**

Yes     No

If yes, please describe \_\_\_\_\_

**b) Are you aware of any other agreement that relates to this intellectual property (other than those listed in section 5)?**

Yes     No

If yes, please describe \_\_\_\_\_

7. <b>Public Disclosure</b> (accurate data is essential as prior disclosure may affect the possibility of obtaining patent rights)	Date	References/Comments Please include names of periodicals/journals (use separate sheet if necessary)
A. First publication containing sufficient description to enable a person skilled in this field to understand and to make or use the Intellectual Property (Please include the date submitted or publication date, if published)		
B. First public oral disclosure of Intellectual Property sufficient to enable a person skilled in this field to understand and to make or use the invention (include slides and/or presentation materials)		
C. If this Intellectual Property is unpublished and undisclosed, provide the anticipated publication or oral disclosure date and any submissions made for potential publication.		
D. Other publications and/or public oral disclosures that provide background information to this Intellectual Property		
E. First sale or public use of Intellectual Property		

8. Has the Intellectual Property been reduced to practice?  Yes  No

9. Please attach list of any commercial entities that may be interested in this Intellectual Property (provide as much detail as possible)

10. This Intellectual Property was disclosed to and understood by:

Signature of Non-Inventor Personnel **Witness** \_\_\_\_\_ Date \_\_\_\_\_

Name and Title of **Witness** (please type or print) \_\_\_\_\_

**I (we) hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true.**

**Pursuant to the Emory University Intellectual Property Policy, I (We) hereby confirm the assignment of all of my (our) right, title and interest to this Intellectual Property to Emory University and agree to execute all documents as requested, to assign to Emory University all of my (our) rights to any patent application filed on this Intellectual Property, and to cooperate with the Emory University Office of Technology Transfer in the protection of this Intellectual Property. Emory University will share income derived from the Intellectual Property with the inventor(s) according to its standard policies.**

_____ Contributor's Signature (Emory Personnel) <span style="float: right;">Date</span>	_____ Contributor's Signature (Emory Personnel) <span style="float: right;">Date</span>
_____ Campus Address	_____ Campus Address
_____ Campus Phone <span style="float: right;">Campus Email Address</span>	_____ Campus Phone <span style="float: right;">Campus Email Address</span>
_____ Home Address <span style="float: right;">City, State, Zip</span>	_____ Home Address <span style="float: right;">City, State, Zip</span>
_____ Country of Citizenship	_____ Country of Citizenship



## Instructions

- I. The Office of Technology Transfer (OTT) reviews all Emory IP Disclosure Statement Forms as they are received from members of the Emory community. Where appropriate, the OTT endeavors to license Emory Intellectual Property to industry for further development and commercialization. Any royalties derived from any such license are shared with the inventor(s) and their departments according to Emory policy. This form notifies the OTT of your Intellectual Property and any relevant sponsorship, related agreement and publication history.
- II. The following instructions apply to the correspondingly numbered sections in the Form:
  1. Use a brief descriptive title to aid in identifying the Intellectual Property.
  2. Check the appropriate technology box.
  3. In describing the Intellectual Property, attach material which covers the following points:
    - i. General purpose
    - ii. Technical description, including a list of key words
    - iii. Advantages, unusual features and improvements over existing methods, devices or materials. How does the Intellectual Property differ from the present technology? What problems does it solve or what advantages does it possess?
    - iv. Attach sketches, drawings, photographs, or other material that help illustrate the description, if appropriate.
    - v. Commercial applications (economic potential, potential uses, indirectly related uses, etc.)
    - vi. Please list (and attach) any additional related patents or publications which may be important background reference material in reviewing the Intellectual Property. If appropriate, please attach an initial patent search related to the Intellectual Property obtained from searching the USPTO's website: <http://www.uspto.gov/web/menu/search.html>.
  4. Include the names of any potential co-inventors including any potential co-inventors at another institution. A co-inventor is an individual who has conceived or contributed an essential element of the invention, either independently or jointly with others, during the evolution of the technology concept or reduction to practice. Include the percent contribution to the invention for each Contributor as mutually agreed upon by all of the Contributors. Mark each check box for any Contributors who also have an appointment with or are employed by the Department of Veterans Affairs ("VA"), Children's Healthcare of Atlanta ("CHOA") or the Georgia Institute of Technology ("Ga. Tech."). For the VA check box, include any Contributor who (i) has a dual appointment with the VA, i.e., is employed/salaried by both the VA and Emory; or (ii) has executed a VA-WOC Appointee Intellectual Property Agreement with the VA in order to conduct research using VA facilities and/or resources. Name any other institution (university, research institute, company, etc.) the Contributor is affiliated with under "Other Institution".
  5. List all sources of funding that relate to the creation/development of the Intellectual Property by providing the applicable contract or grant number(s), the OSP UPN numbers, and the principal investigator on the project(s), including departmental, governmental, industrial and/or foundation support (e.g., NIH, departmental, Georgia Tech/Emory Center for the Engineering of Living Tissues, other external sponsors).
  6. List all MTAs and other agreements whose Material and/or terms relate to the Intellectual Property.
  7. In the United States, a patent application must be filed no later than one year after public availability of a printed publication disclosing the invention in detail (use of overheads or blackboards may be considered written disclosures). In other countries, filing must take place before either oral or printed publication is made available to the public; however, where there has been a U.S. filing before any oral or printed publication, generally a one year grace period is granted for foreign filing. Complete all parts of section 6 in view of the following:
    - i. Conception, in the patent-law sense, involves the formulation, in the mind of the inventor, of the complete means for solving a problem. The mere recognition of a desirable result, or of a problem, or of a general approach to solving the same, without the formulation of the physical structure to accomplish that result or to solve the problem, will not suffice to constitute conception.
    - ii. The term "first publication" means the first time any member of the general public (those outside the Emory community), without restriction of confidentiality, would have been able to legally gain access to your written or printed enabling description of the invention.
    - iii. "First public oral disclosure" means the same as 7ii, but only as to oral presentation to the general public (those presented to individuals outside the Emory community).
    - iv. The anticipated date of publication, (as described in 7ii above), should be entered here, as well as the date any documentation was submitted for review for possible publication.
  8. Reduction to practice, according to patent law, involved actual and complete use of the invention for its intended purpose. Such reduction to practice generally involves physical construction of the invention and testing the physical embodiment to determine whether it performs as contemplated, but this is not always necessary if the invention can be fully described.
  9. A list of commercial entities that may be interested in the invention will assist the OTT in identifying potential licenses for the technology. Please include names and addresses of specific contacts if known.
  10. Your lab books and/or other records relating to this Intellectual Property should be witnessed by a person who has read and understood your disclosure. It is recommended that this form also be witnessed. If the principal investigator is not an inventor/author, he or she is often the best witness.

### III. What is a utility patent?

A utility patent is a grant issued by the United States (or other foreign countries) which gives the owner of the patent the right to exclude others from making, using, or selling the invention claimed in the patent within the jurisdiction of the country for the term of the patent (typically 20 years from the date the utility patent application is filed). A patent document typically includes a specification, drawings, and claims. The claims are an important component of a patent because they describe the scope of the patent holder's exclusionary rights. The purpose of the specification and drawings is to fully disclose and enable the invention to the public upon issuance of the patent. US Patent applications are filed with the U.S. Patent and Trademark Office (USPTO), which office assigns applications to different "art units." The patent examiner, who is assigned to each application, reviews the application to determine if the invention meets the legal criteria for patentability. The time and effort required for the prosecution of a patent application depends on the nature of the art claimed in the application and the complexity of the invention. In general, it is more difficult and time consuming to obtain patents in the chemical and biotechnology arts than in the mechanical arts. Also, more data is typically required to support patent applications in the chemical or biotechnology arts.

### IV. Criteria For Patentability (in addition to full disclosure and enablement of the invention)

1. Novelty: The invention must be different from the prior art. It cannot be described in a single reference, such as a patent or article which, for US applications, was published more than one year from the filing date of the patent application. In addition, the invention cannot have been publicly used or offered for sale more than one year from the filing date of the application. It should be noted that any publication of an invention bars patentability in most foreign countries. In accordance with provisions of the Patent Cooperation Treaty (PCT), an applicant is entitled to claim priority to their U.S. filing date in foreign applications. So long as a U.S. application is on file prior to publication, foreign patent rights may be preserved by filing a PCT application within one year of the U.S. application.
2. Non-Obvious: The invention cannot be obvious to a person of ordinary skill in the art. A patent examiner may combine several references in attempting to establish that the claimed invention is obvious and therefore not entitled to patent protection.
3. Utility: The invention must be useful.