Invention Disclosures

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Invention Disclosures

- **What is a disclosure?**
  - A written description of an invention or copyrighted work
Invention Disclosures

• Why disclose your inventions?
  – It’s the only way to ensure that the results of your invention will be used
  – It’s University Policy
  – Extramural sponsors require it

Gold Sheet Language:
“I agree to be bound by the terms and conditions of the outside grant or contract which supports this proposed activity and in consideration of the information and facilities made available to me by the University or the outside sponsor, to assign copyright and patent rights to the Iowa State University Research Foundation, Inc. in accordance with terms and conditions stated in the Faculty Handbook.”
Invention Disclosures

• When to disclose?
  – Before you make a public disclosure
  – When you have an invention you think is novel
  – When you have evidence that it will work

NOTE:
• More than 90% of patents filed are improvements on existing technology
• Your invention does not have to be a breakthrough to be of value
Invention Disclosures

• How to disclose your inventions:
  – Iowa State University Intellectual Property Disclosure and Record Form (IPDR)
    • Located at: www.techtransfer.iastate.edu
    • Purpose: To provide information that the Office of Intellectual Property and Technology Transfer (OIPTT) and the Iowa State University Research Foundation (ISURF) need to evaluate your invention.
Disclosures Received by ISURF

![Bar chart showing disclosures by ISURF from FY94 to FY03 for different categories: Biological Sciences, Chem/Related Eng., Consumer Products, Phys Sci/Related Eng., and Seed/Germplasm. The chart illustrates the trend over the years.]
Benefits of Protecting Intellectual Property

• Incentives:
  – Companies will invest in technical and market development to get a product to market
  – Recognition for inventor/author and university
  – Placement of graduate students in rewarding jobs
  – Income for company, inventor/author and university
  – Stewardship of technology and funding source obligations
Benefits of Protecting Intellectual Property

• IP protection preserves the rights of the inventors and the university to control the technology:
  – Prevents inappropriate use of the technology
  – Ensures use for public good
Benefits of Protecting Intellectual Property

• Formation of relationships between company and inventor/author/university:
  – Research support
  – Consulting arrangements and other opportunities for collaboration
Benefits of Protecting Intellectual Property

- Grants, Research Support and Royalty Sharing from ISURF for FY99-FY03

<table>
<thead>
<tr>
<th>Category</th>
<th>Amount</th>
</tr>
</thead>
<tbody>
<tr>
<td>Royalty Sharing to Academic Units</td>
<td>$ 2,666,542</td>
</tr>
<tr>
<td>Royalty Sharing to ISU Inventors</td>
<td>$ 4,025,229</td>
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<tr>
<td>Agreement Leveraged Research</td>
<td>$ 1,982,588</td>
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<tr>
<td>ISURF Funding*</td>
<td>$ 5,336,301</td>
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<td><strong>TOTAL</strong></td>
<td><strong>$14,010,660</strong></td>
</tr>
</tbody>
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* Includes funding for applied research projects, grants to the VPR office and support of OIPTT.

**NOTE:** As of FY04, OIPTT receives no State funding and is supported totally by ISURF which has always been financially independent.
Some Patented and Licensed Inventions

- **Biological Sciences**
  - Genetic Markers for Pig Quality
  - *Salmonella choleraesuis* Vaccine

- **Chemistry**
  - Multiplexed Capillary Electrophoresis System
  - Superbase

- **Physical Sciences**
  - Instrumented Tap Test & Local Stiffness Imaging System and Software
  - Lead Free Solder Alloy Based on Tin-Silver-Copper
  - Central Vacuum Cleaner Muffler

- **Consumer Products**
  - Preemergence Weed Control using Corn Gluten Meal
Funding Requirements and Our Obligations

• Federal Agencies (37 CFR Part 401):
  – The university is obligated to have written agreements with its faculty and technical staff requiring disclosure and assignment of inventions
  – The university has an obligation to disclose each new invention to the federal funding agency within two months of receiving the invention disclosure
  – Decision on whether or not to retain title to the invention must be made within two years of invention disclosure to the agency
Funding Requirements and Our Obligations

- **Federal Agencies (37 CFR Part 401)**
  - Upon election of title, the university must file a patent application within one year (or earlier if there is a patent bar date)
  - The university must submit periodic reports to the agency regarding the utilization of the invention as requested by the funding agency
  - The universities must share with the inventors a portion of the royalties received from licensing their invention

**NOTE**: Federal agencies have the authority to audit grantees and contractors for compliance with these regulations.
Funding Requirements and Our Obligations

• Corporations:
  – Generally, the company funding the research has an option to acquire a royalty-bearing license to the resulting IP
  – Under the terms of the funding agreement, periodic progress reports will typically be required
  – Prompt disclosure of IP to ISURF is necessary to enter into license negotiations with the company in a timely manner and to protect the intellectual property