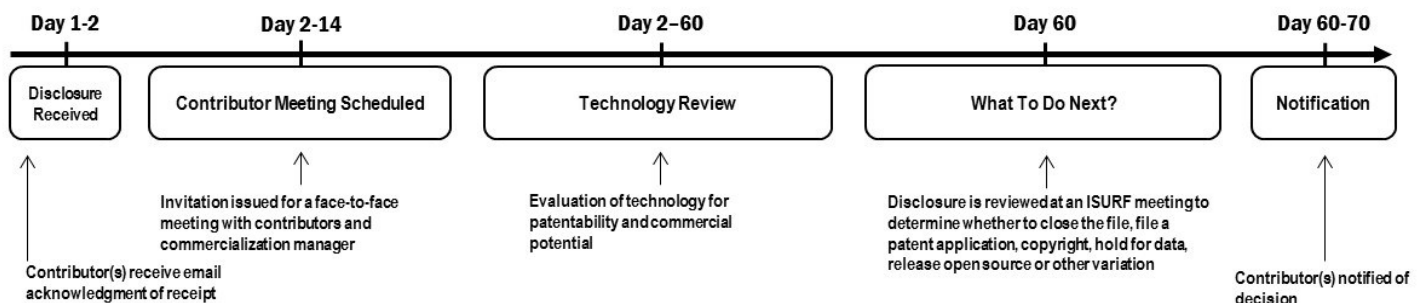




Software Invention Disclosure – what to expect . . .

The receipt of a software invention disclosure, via an Intellectual Property Disclosure and Record (IPDR) form and the Copyright form, is the start of the commercialization process. The software is carefully evaluated for patentability or other options for protection, and commercial potential. Included in the patentability assessment is a review of the prior art (examples: publications, presentations, patent applications, existing patents, and non-confidential communications) and an evaluation of whether the idea is novel and non-obvious patentable subject matter (requirements for a patent). Copyright is a form of protection provided by U.S. law and protection is secured automatically when the work is created. Your work does not have to be published to be protected by copyright. Registration with the Copyright Office is not required to secure protection, but is recommended in some circumstances (e.g., establishes a public record of the copyright claims, a necessary step before an infringement suit may be filed). The commercial evaluation includes an assessment of the current and future market potential (examples: cost, effectiveness, industry's interest and ability to adopt, and overall impact) and a comparison to competitive technologies. Third party agreements and obligations, including funding agreements and any third-party open-source software used in the development, is reviewed to make sure Iowa State is meeting its obligations. Here is what you can expect after you submit an IPDR and Copyright form:



ISURF Cost

There are usually not any out-of-pocket expenses related to reviewing the software invention disclosure. If the disclosure is outside of ISURF's areas of expertise or we have a large number of disclosures under evaluation, we will utilize outside sources to provide information such as the prior art review or market assessment. The cost of using outside sources can be up to \$3,000.

Timeline (Days)



Day 2-14: Initial Meeting

Commercialization Managers will meet with the contributor(s) to discuss the software and disclosure documentation. This is to ensure a complete understanding of the software, and to gather any information missing from the IPDR and Copyright forms, such as funding sources, public disclosures, contributors, collaborators, usage of third-party software, a more thorough description, assignment of copyright, etc.



Day 2-60: Technology Evaluation

- Patentability Assessment. Review of prior art and an evaluation of whether the idea is novel and non-obvious patentable subject matter (requirements for a patent).
- Copyright Protection. Copyright protection exists when the software is created. A review of the software is conducted to determine authorship and whether registration should be pursued with the Copyright Office.
- Commercial Review. An assessment of the current and future market potential and a comparison to competitive technologies.
- Third Party Obligations & Rights.
 - Funding sources are reviewed to make sure Iowa State is meeting its obligations to third parties under funding agreements. Collaborators and co-owners are also considered.
 - Third-party open-source and commercial software is reviewed to understand the obligations in the license agreement (e.g. open source license agreement or End User License Agreement (EULA)).
- ISURF internal technology evaluation meeting to determine next steps.



Day 60+: Activities following the decision made from technology evaluation meeting

Decision – Consult with Third Party

- If a third party has rights under a funding agreement or collaboration, ISURF will consult with that party to determine their interest in pursuing a patent application or other protection.

Decision – Protect as Copyright

- Copyright protection is automatic when the work is created and does not require any action from the contributor or ISURF.
- ISURF may elect to register the software with the Copyright Office.
- ISURF will market the technology.
- ISURF will retain a copy of the source code and executable. Updates should be provided to ISURF at regular intervals.

Decision – Release Open Source

- If ISURF decides or the contributors' request, to release the software as open-source and all funding and third-party obligations have been met, ISURF can assist in this process.
- The determination of an appropriate open-source license (GPL, LGPL, BSD, etc.) and the web site location of the released software (GitHub, Mercurial, other) will be decided on a case-by-case basis.

Decision – File Provisional or Utility Patent Application (rare)

- ISURF will retain a patent attorney and an initial consultation between the patent attorney and contributor(s) will occur.
- A non-confidential marketing brief will be placed on ISURF's website and marketing will be initiated.
- See Provisional, or Utility Patent Application – what to expect, Just In Time series handout for more details.

Decision – Hold for Data and/or Code

- If the code/software is not complete or other additional data is needed to make a decision and no public disclosure is planned, ISURF will keep the IPDR file open. ISURF will inquire about progress approximately every six months. This can continue until there has been a public disclosure, enough information is obtained to make a decision, or a deadline is reached.
- The contributor(s) should contact ISURF to share all new data, presentations, publications and/or public disclosure plans.

Contact Information

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