

# Intellectual Property and Commercialization (IPaC)

Disclosing Inventions Overview  
February 24, 2021



# IPaC



- ▶ Formally established when A&M System IP policy changed in May 2019
  - ▶ Prior to that, all Tech Transfer functions for the A&M System were in one central office, Texas A&M Technology Commercialization (TTC)
  - ▶ IPaC is the most experienced Tech Transfer Office in the A&M System
- ▶ Manages intellectual property (IP) resulting from research conducted by Texas A&M AgriLife agencies and Vet School research funded by AgriLife
- ▶ Staff:
  - ▶ Janie Hurley, Program Director [Janie.Hurley@ag.tamu.edu](mailto:Janie.Hurley@ag.tamu.edu)
  - ▶ Robert Brummett, Senior Licensing Manager [Robert.Brummett@ag.tamu.edu](mailto:Robert.Brummett@ag.tamu.edu)
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# IPaC Goal

- ▶ To help bring Texas A&M AgriLife's research results to the benefit of the public
  - ▶ Accomplished by commercially licensing rights in IP created to companies that will make, use, and sell products embodying those rights
    - ▶ In the course of getting to licensing, we may enter into confidentiality agreements, option agreements, or evaluation agreements with interested companies
- ▶ IP rights may take the form of patents, PVP certificates, copyright, or trademarks (trademarks are usually only in conjunction with another form of IP)
  - ▶ IP rights may be bound contractually and/or based on the provision of tangible material such as seed or cell lines
- ▶ We also work with AgriLife Administration, CERS, AgriLife Contracts, and SRS on IP-related topics and questions



# Today's Topic – Invention Disclosures in Brief

- ▶ One of the first things we need from inventors is a disclosure of the technology they've created
- ▶ Depending on the type of technology, stage of development, potential users, and other factors there are different types of disclosure forms
  - ▶ Invention Disclosure
  - ▶ Plant Variety/Germplasm Disclosure
  - ▶ Research Material Disclosure
  - ▶ Software Disclosure
- ▶ Today we will be focusing on some key aspects of the Disclosure of Invention form




# Disclosure of Invention

- ▶ The Disclosure of Invention form is used to disclose new inventions
  - ▶ Typically these types of technologies (inventions)\* are those that we would look at for patent protection consideration vs. software (copyrightable works), trademarks, or tangible materials
    - ▶ Generally speaking, subject matter for these types of technologies includes
      - ▶ Compositions of matter
      - ▶ Devices
      - ▶ Methods

\*You'll hear us use the term "technology" generically and interchangeably with "invention", "software", "plant variety", "research material", etc. as the case may be

# Disclosure of Invention Form



**TECHNOLOGY  
COMMERCIALIZATION**  
DISCLOSURE OF INVENTION

For TTC Office Use Only

Disclosure #:

Received:

Instructions: Complete all parts of the form based upon your knowledge and abilities. If a question does not apply, please enter "N/A."

When complete submit to [ttc-disclosures@tamus.edu](mailto:ttc-disclosures@tamus.edu).

*If you have a grant proposal, manuscript, or items requested under question number 4 that further detail your disclosed technology, please submit as separate attachments along with this form.*

Technology Description

1. Title of your invention (the "disclosed technology"):
2. List key words (e.g. key words or tags used for publication purposes) that correspond to the technology you are disclosing:
3. Summary of disclosed technology in lay terms:
4. If your disclosed technology is or includes:
  - (a) A device, attach a diagram/drawings of the device, labeling and detailing its principal components.
  - (b) A process, method, or algorithm, attach a flow chart detailing the steps of the process, method, or algorithm.
  - (c) A composition of matter, attach a detailed chemical description (i.e. structure, sequence, and/or formula) and the method of synthesis.
5. Does your disclosed technology include an algorithm or software?  
 Yes  No  
If Yes, please briefly describe (please note that if your disclosed technology is only software there is a separate disclosure form for software):
6. What problems does your disclosed technology solve or unmet needs does it provide?
7. Which unique features of your disclosed technology enable the solution to the problems or needs identified above, and how do these features solve the identified problems?
8. What current solutions exist to solve the problems or needs that you identified in question 6, and how do the unique features of your disclosed technology differ from the current solutions?

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# Disclosure of Invention Form

- Disclosure of Inventor Forms and extra Inventor Data Sheets can be downloaded at:

<https://techtransfer.tamus.edu/ForInventors/FormsForInventors.shtml>

The screenshot shows the TAMU Technology Commercialization website. The header features the TAMU logo and the text "TECHNOLOGY COMMERCIALIZATION". The navigation menu includes: HOME, AVAILABLE TECHNOLOGIES, FOR INDUSTRY, NEW VENTURES, ABOUT US, FOR INVENTORS, and RESOURCES. The main content area is titled "Forms for Inventors" and contains the following text:

The disclosure form documents the circumstances under which your invention occurred or the details of the completion of your copyrightable work and provides the information necessary to evaluate patentability, inventor/authorship issues, commercial potential, and any obligations to research sponsors. It also begins the process that may lead to the commercialization of your discovery.

The disclosure forms are available in Microsoft Word format.

Pick the appropriate form to begin filling out your disclosure. Once you submit a completed disclosure a member of the TTC will be in contact with you.

Please call our office if you have any questions regarding the forms.

The "Documents" list on the right side of the page includes:

- Invention Disclosure Form with Inventor Data Sheet
- Inventor Data Sheet
- Plant Variety/Germplasm Disclosure Form
- Breeder/Contributor Data Sheet
- Software Disclosure Form with Author Data Sheet
- Author Data Sheet



# Disclosure of Invention -Completing the Form

- ▶ The Disclosure of Invention form includes 21 questions
  - ▶ These include providing a title and keywords, describing the invention, telling us what you envision its use being, what its stage of development is, who the inventors are, where the funding came from, what outside materials were used in the development, and if there are any outside agreements that may affect what we can do with the disclosed technology
    - ▶ This is just a brief summary, see the disclosure form for more detail
  - ▶ The inventors are also required to complete and submit an inventor data sheet (for each inventor), and sign both the Disclosure Signature Page and Agreement for Distribution

\*You'll hear us use the term "technology" generically and interchangeably with "invention", "software", "plant variety", "research material", etc. as the case may be





# Common Issues on Submitted Disclosures

- ▶ We won't touch on every question on the form, but will review the following sections that sometimes are not complete or that we often get questions about:
  - ▶ Q3. Summary of disclosed technology in lay terms.
  - ▶ Q12. Have you disclosed, or do you plan to disclose, the unique feature(s) described above to any party external to A&M System (e.g. company, university, conference abstract/presentation/poster, seminar journal publication, etc.)?
  - ▶ Q20. Identify all funding sources you believe were used to conceive of or develop the technology you are disclosing.
  - ▶ Q21. Identify any materials/information used in the conception or development of the technology you are disclosing that were obtained from a non-A&M System entity under a Materials Transfer Agreement, Nondisclosure Agreement, or other contracts.
  - ▶ The Inventor Data Sheet
  - ▶ Signatures on the Disclosure and Inventor Distribution Agreement



## Q3. Summary of disclosed technology

- ▶ We don't restrict or dictate how you may choose to describe your technology, however we need a brief overview that succinctly describes what you've created, what its purpose is, and what it does
  - ▶ You can think of this similar to an abstract for a conference or for a manuscript
- ▶ Additional questions are asked in the disclosure form that we've designed to help get to the heart of what the technology is
- ▶ In total (all questions answered), the disclosure form provides a description of your technology sufficient to describe what it is, how it works, and what it does
- ▶ We will follow up with any questions we need answered to clarify to better inform us of your technology, but having a good description on the form is necessary for our review and often for reporting to research sponsors



## Q12. Have you disclosed...

- ▶ In this context, “disclosed” means having told an outside party about your invention
- ▶ The reason for this question is that if we consider patent protection, a disclosure to outside parties may affect if or how we can patent a technology
- ▶ It is also important to know what these are because of sponsor reporting obligations
- ▶ IPaC can't, and won't, tell you not to make these types of disclosures, but we need to be aware of any you have made or will make as we evaluate the technology and commercialization opportunities
  - ▶ Please keep in mind reporting and other obligations that may be required by a Sponsored Research Agreement can affect your ability to make these types of disclosures



## Q20. Identify all funding sources...

- ▶ Funding source is a key factor in determining which Tech Transfer Office in the A&M System your disclosure is assigned to
- ▶ Sponsored research usually requires reporting of inventions to the sponsor
  - ▶ IPaC and TTC will do this reporting, but be sure to also include reference to your Disclosure of Invention in your reports if required to do so
- ▶ Sponsors, especially corporate sponsors, often have the first right to negotiate for a license to inventions created using their funding
- ▶ Ideally, we'd want to see the M##### number used by SRS to be able to easily pull the funding agreement to review for these types of obligations
  - ▶ We may ask you for clarification and for copies of research agreements that we do not have access to

## Q20. Identify all funding sources...

20. Identify any and all funding sources you believe were used to conceive of or develop the technology you are disclosing.

(a) Describe the internal resources that were used in the development of the technology you are disclosing:

█

(b) Which A&M System member(s) funds were used in the creation of the technology you are disclosing (e.g. AgriLife, TAMU, TEES, etc.):

█

(c) Identify all external sources of funding used in the conception and development of the technology you are disclosing; include grant numbers or other unique, assigned identifiers for each in the table below:

Name of Funding Agency/Entity	Federal Grant/Agreement/Contract/Other Type of Award No.	MAESTRO Project ID No. (M#####) (other Internal Acct. or Reference No. if no MAESTRO Project ID)	Office managing award (AgriLife, TAMU, SRS, TEES, etc.)
█	█	█	█
█	█	█	█
█	█	█	█



## Q21. Identify any materials/information...

- ▶ Materials obtained from an outside party (even originally obtained from an outside party) may have obligations or restrictions on what we may do with inventions created using them
- ▶ Please also identify purchased materials as this may help us in the searches we do when evaluating your disclosure
- ▶ Disclosures are sent to AgriLife's Risk and Compliance Office for Export Control restriction review, and they may need to know this information as well



# The Inventor Data Sheet

- ▶ This provides information we'll need to document
  - ▶ What the individual inventor contributed to the invention
    - ▶ Important for patenting
  - ▶ The inventor's contact information
    - ▶ So we can contact inventors and make sure records in our system are up to date
  - ▶ The inventor's department, college, and center affiliations
    - ▶ So that we can inform the appropriate administration of your disclosure
    - ▶ Also used in determining which TTO within the A&M System will manage, or at least be made aware of, your disclosure
  - ▶ Outside (non-A&M System employees) inventors need to have an Inventor Data Sheet submitted with the disclosure, but do not have to sign the disclosure signature page and cannot sign the distribution agreement



# Signatures

- ▶ All inventors, except outside inventors described above, must sign and date the Disclosure of Invention Signature Page and identify a percent contribution to the invention
  - ▶ The Witness Signature is optional
  - ▶ Inventors in different locations may sign identical copies of this form (same inventors and percentages identified) and TTC will file these separate pages together
  - ▶ All signatures must be signed by hand, not a scanned copy of your signature\*\*

\*\*DocuSign is an acceptable alternative for signatures required with the disclosure form



# Signatures

## COMMERCIALIZATION DISCLOSURE OF INVENTION SIGNATURE PAGE

Each named inventor/author ("creator") must sign and date this page, **except that non-TAMUS creator signatures are optional, but still must be named on this page.** Identify each creator's percentage of contribution to the disclosed technology<sup>2</sup>. Percentages must total 100%.

Title of Disclosed Invention:

### **Creator Signatures**

I/We certify that the information in this Disclosure of Invention is complete and accurate.

_____	% Contribution	Date
Printed Name: <input type="text"/>		
_____	% Contribution	Date
Printed Name: <input type="text"/>		
_____	% Contribution	Date
Printed Name: <input type="text"/>		
_____	% Contribution	Date
Printed Name: <input type="text"/>		
_____	% Contribution	Date
Printed Name: <input type="text"/>		
_____	% Contribution	Date
Printed Name: <input type="text"/>		

### **Witness Signature (optional)**

Disclosed to and understood by me on this  day of  Month, Year

Signature: \_\_\_\_\_  
Printed Name:





# Submitting the Disclosure and Signatures

- ▶ Completed Disclosures of Invention, including Inventor Data Sheets for each inventor, Disclosure Signature Page signed and dated, and Distribution Agreement signed and dated, need to be submitted to:  
[ttc-disclosures@tamus.edu](mailto:ttc-disclosures@tamus.edu)
- ▶ If you have a manuscript, poster, or abstract, (even in draft form) submit those with your Disclosure paperwork



# Wrapping Up

- ▶ See our website for more information
  - ▶ <https://ipc.agrilife.org>
    - ▶ For Inventors: <https://ipc.agrilife.org/for-inventors/>
    - ▶ Commercialization Overview: <https://ipc.agrilife.org/for-inventors/commercialize/>
    - ▶ More Information on Disclosing: <https://ipc.agrilife.org/for-inventors/disclose/>
- ▶ Contact Janie or Robert about any questions or for additional information
  - ▶ Janie Hurley: <https://ipc.agrilife.org/people/hurley-mba-janie/>
  - ▶ Robert Brummett: <https://ipc.agrilife.org/people/brummett-robert/>

## Questions?