

West Virginia University Research Corporation
Office of Technology Transfer (OTT)

DISCLOSURE OF INTELLECTUAL PROPERTY
Confidential Statement

This form must be completed including all signatures prior to the initiation of an intellectual property evaluation by the OTT.

Foreword to the Inventor/Creator: You are the expert in the field of your intellectual property (I.P.). Your input on this form and your involvement in the technology transfer process are integral in the process of securing rights for your I.P. This disclosure form was designed to facilitate this effort. Please note sections 6(d) and 7 are optional. Should you have questions please contact the OTT at (304) 293-7539, TechnologyTransfer@mail.wvu.edu or refer to the WVU Intellectual Property Policy available at <http://www.wvu.edu/~research/techtransfer/>

Responses can be typed within this document or submitted separately.

1. Descriptive Title of the Intellectual Property: (Title should be descriptive enough to identify the I.P., yet not descriptive enough to reveal any unique and unpublished details. This title may later be changed).

TITLE:

2. Contributor Information: Please list the following information pertaining to each contributor/creator/inventor of the I.P. If there are non WVU contributors, please include their information in the table. Attach extra sheets if necessary. Note: this information is required by some governmental forms.

<u>Information</u>	<u>Inventor/Creator</u>	<u>Inventor/Creator</u>	<u>Inventor/Creator</u>	<u>Inventor/Creator</u>
Name/Title				
Citizenship				
Email				
College or External Affiliation				
Department				
Work Phone				
Work Address				
Home Address (No P.O. Box)				
Home Phone				

3. Establishment of Discovery History

a. **Conception:** When, where and with whom was the idea for the I.P. first conceived?

b. Public Disclosure:

Has the I.P. been disclosed in a publicly available form?

(Such as abstract, paper, thesis, dissertation, talk, news story, website or any other)

If yes, please identify the medium of disclosure and to whom it was disclosed.

c. Future Disclosure:

Is a publication or other public disclosure pertaining to your I.P. planned in the next four (4) months or beyond?

If yes, Please indicate the type of disclosure (presentation, proposal, thesis, etc.) and the predicted date of disclosure along with any prepared drafts or abstracts.

d. **Reduction to Practice:** Have you reduced the I.P. to practice? Is there a working prototype? When was or when will it be completed?

4. Sponsorship (Required by the Federal Government)

Indicate any past, present, or contemplated sponsorship of the invention either internal, governmental or private. These sponsors could include: WVU, the Federal Government, Corporations, HHMI, Private Foundations, etc. If funded by multiple sources indicate the percentile of sponsorship from each agency.

Check here if there is **no** current sponsorship of this invention.

Sponsor: _____ P.I. _____

Federal Grant #: _____

WVU Grant ID#: _____

WVU Office of Sponsored Programs Number (OSP#): _____

Short Title: _____

Research Period - Beginning Date: _____ Ending Date: _____

Percentage of Sponsorship: _____

Sponsor: _____ P.I. _____

Federal Grant #: _____

WVU Grant ID#: _____

WVU Office of Sponsored Programs Number (OSP#): _____

Short Title: _____

Research Period - Beginning Date: _____ Ending Date: _____

Percentage of Sponsorship: _____

5. Description of Intellectual Property

a. Nature of the Work:

Is the I.P. a new process, composition of matter, device or product?

Is it an improvement to an existing product or process?

What are the improvements or advantages over existing methods, devices or materials? What features are believed to be new?

Is it a literary work, photograph or musical composition?

Is the I.P. considered software?

If it is software, have the proper copyright markings been utilized?

b. Steps Involved:

If the I.P. is a composition of matter, device, or product, how is it made?

If the I.P. is a process, a method, or software, what are the steps involved?

c. State of Development:

Describe the state of development of the I.P. (unspecified, discovery, preclinical, prototype, phase I, II, III, or NCE.)

Is the work on the I.P. continuing?

If a patent is desired, are there any major complications to overcome before the I.P. is ready to be filed as a patent application?

d. Utility:

What are the possible uses for the I.P.?

Does it solve an existing problem?

How is the I.P. used to achieve its purpose?

Are there any other uses that could be realized in the future?

e. Limitations:

Does the I.P. possess any disadvantages or limitations?

Can they be overcome?

If so, how? Are there competing ways to solve the same problem(s)?

f. **Variations:**

Discuss possible variations and modifications that can be envisioned with regards to your I.P. (example- pictures can be taken using conventional film or via a digital camera, the end result is essentially the same but the processes are different.)

g. **Technical description:**

If a patent is desired, please give a detailed technical description to serve as a source of information for the patent attorney/agent while preparing a patent application. Include with the description any pertinent notebook entries, photographs, reports, drawings, publications, references and writings.

6. Prior Art

a. **Current State of Technology:**

Describe the current state of research in the field of technology pertaining to your I.P.

b. **Unmet Need/Purpose of Creation:**

What unmet need does your I.P. fill within the current field of relevant technology?
What lead you to create your I.P.?

c. **Relevant Patents/Publications:**

Please identify any publications or patents relevant to your I.P. that are known to you or any other co-inventor/creator.

d. **(Optional) Patent Search:** Have you conducted a patent search? This is usually helpful and we have expert staff to assist you. Go to: <http://www.uspto.gov/> or contact our expert patent librarian:

Ms. Marian Armour-Gemmen, Patent Librarian
Evansdale Library, West Virginia University
Phone: (304)-293-4696 Ext. 5106, Fax: (304)-293-7730,
Marian.Armour-Gemmen@mail.wvu.edu

Attach related patents from your search, if any, to the back of this form.

7. Reviewers (Optional)

We may need to have experts review this technology to give us input on technical, business or intellectual property aspects of your I.P. Please suggest the names and give contact information of any experts you know. All reviews, unless otherwise indicated, are done in complete confidentiality so as to ensure honest responses. You will not know who we select as the final reviewers and all information about this invention will remain completely confidential.

Name of Reviewer(s)	Reviewer's Affiliation	Phone Number	Email Address

8. Commercialization and Sales Potential

(Please provide complete and detailed answers to lessen the time required for I.P. evaluation)

a. Sales:

List any past, present or future offers for sale of your I.P. performed by yourself or anyone else. (Note: a “sale” includes any legally binding agreement for the purchase of your product, even if an exchange of payment/goods has not yet occurred.)

If a sale or an offer for sale has occurred, please provide the date(s) on which this occurred.

b. Preparation for Sale:

Have you or anyone else taken any actions to prepare for the sale of your I.P.? (Have you started producing units for sale, devising a sales campaign, or preparing a means of purchase for consumers?)

Have you conducted any market research to determine the marketability of your I.P.?
If so, when?

c. Potential Consumer:

Describe who is or might be a potential customer for the final product. Would there be a potential consumer market outside the U.S.?

d. Company Interest:

Name any companies that may be interested in buying your I.P. as it is. If you have spoken with any representatives of these companies in regards to the purchase of your I.P., please provide their names and contact information.

e. Competing Products:

Do you know of any other products or material either on the market or in development that could compete with your I.P.? Please describe.

9. External Inventing

It is understood that with the involvement of more than one university/college/department and in other situations, the revenues shared by the universities/college/departments shall be subject to negotiation between the affected universities, colleges and departments and the Office of Technology Transfer.

- a. Was any of the work for the creation of this I.P. completed at any other institution by either you or any of your co inventors/creators? If so, please specify where.

- b. Even if the work for the creation was performed at WVU, did you or any other co inventor/creator use proprietary materials owned by another organization to make this I.P.? Examples of proprietary materials may include: confidential information, biological materials, chemical compounds, and software code. If such materials were used please attach a copy of the material transfer agreement.

10. Inventorship/Creatorship

Please allocate the percentage of contribution made by each inventor/creator to the conception of the I.P. By signing below, each inventor/creator agrees that the information presented herein is accurate to the best of his/her knowledge and that the percentage of contribution to the conception of the IP is as shown. The percentage contribution will be used to determine the allocation of any distribution among the inventors/creators. Attach additional sheets if necessary.

Name of Inventor/Creator	% Contribution	Signature of Creator	Date

11. Department/College Information

- a. The Department Chairperson for each inventor/creator should sign to confirm the university contribution, contract and grant support for the I.P.

Department Chairperson's Name	Department Chairperson's Signature	Date	Email address

- b. The Dean for each inventor/creator should sign to confirm the university contribution, contract support and grant support for the I.P.

Dean's Name	Dean's Signature	Date	Email address

Return this complete form along with the completed Record of Assignment to:

**Office of Technology Transfer
West Virginia University Research Corporation
Chestnut Ridge Research Building
P.O. Box 6224
Morgantown, WV 26506-6224**

West Virginia University Research Corporation
Office of Technology Transfer

RECORD OF ASSIGNMENT
to
WEST VIRGINIA UNIVERSITY

Form may be separately completed by each inventor/creator

WHEREAS,

Name of Inventor/Creator

Residence Address (No P.O. Box)

1. _____	_____
2. _____	_____
3. _____	_____
4. _____	_____

(“Assignor(s)”) has/have invented/created certain new and useful intellectual property with a working title of:

TITLE OF INTELLECTUAL PROPERTY

which may become the subject of a United States or foreign patent application or any other type of intellectual property protection.

AND WHEREAS WEST VIRGINIA UNIVERSITY, a state institution of higher education existing under the laws of the State of West Virginia (hereinafter called “Assignee”), is desirous of acquiring the entire worldwide right, title, and interest in, to and under said invention/creation and in, to and under Letters Patent or similar legal protection including any intellectual property protections to be obtained therefore in the United States, its territorial possessions, and in any and all foreign countries.

NOW, THEREFORE, in consideration of One (\$1.00) Dollar, the Intellectual Property Policy of West Virginia University and/or other good and valuable consideration paid to Assignor(s) by said Assignee, the receipt and sufficiency of all of which Assignor(s) hereby acknowledge(s), Assignor(s) do/does hereby assign, sell, transfer, and set over unto said Assignee, the entire right, title, interest in said intellectual property and improvements for the United States and its territorial possessions and all foreign countries and all divisions, reissues,

continuations, continuations-in-part, renewals, and/or extensions thereof including all priority rights under the International Convention associated therewith for each country and the Union, said Assignee to have and to hold the interests herein assigned to the full ends of the terms of said Letters Patent and an and all divisions, reissues, continuations, continuations-in-part, substitutes, renewals, and/or extensions thereof, respectively, as fully and entirely as the same would have been held and enjoyed by Assignor(s) had this assignment not been made.

The Commissioner of Patents and Trademarks is requested to issue such Letters Patent in accordance herewith. Assignor(s) covenant that Assignor(s) is/are the lawful owner(s) of the inventions and improvements disclosed in said invention, that the same are unencumbered, that no license has been granted to make, use, offer for sale, sell or import said inventions or improvements of any of them, and that Assignor(s) has/have the full right to make this assignment.

Assignor(s) hereby covenant(s) with said Assignee, its successors, assigns and legal representatives that I/we have made to others no assignment, grant, mortgage, license, sale or agreement affecting the rights and property conveyed and that we have the full right to convey the same as herein expressed.

And for the consideration aforesaid, Assignor(s) agree(s) jointly and individually that Assignor(s) will communicate to said Assignee or the representatives thereof any facts known to Assignor(s) respecting said inventions and improvements, and will, upon request, but without expense to Assignor(s), testify in any legal proceeding, sign all lawful papers, execute all divisional, reissue, continuation, continuations-in-part, substitutes, renewal, and/or all other patent applications, execute all rightful oaths, and generally do all other and further lawful acts, deemed necessary or expedient by said Assignee or by counsel for said Assignee, to assist or enable said Assignee to obtain and enforce full benefits from the rights and interests herein assigned. This assignment shall be binding upon Assignor(s) heirs, executors, administrators, successors, and/or assigns, and shall inure to the benefit of the heirs, executors, administrative successors and/or assigns, as the case may be, of said Assignee

DATE EXECUTED _____, 20__

INVENTOR/CREATOR 1 (printed name)

INVENTOR/CREATOR 1 (signature)

State of _____ County of _____

The forgoing instrument was acknowledged before me this _____, 20__
by _____ (inventor/creator name).

My commission expires _____, 20__

Notary Public (signature)

Seal/Stamp

DATE EXECUTED _____, 20__

INVENTOR/CREATOR 2 (printed name)

INVENTOR/CREATOR 2 (signature)

State of _____ County of _____

The forgoing instrument was acknowledged before me this _____, 20__
by _____ (inventor/creator name).

My commission expires _____, 20__

Notary Public (signature)

Seal/Stamp

DATE EXECUTED _____, 20__

INVENTOR/CREATOR 3 (printed name)

INVENTOR/CREATOR 3 (signature)

State of _____ County of _____

The forgoing instrument was acknowledged before me this _____, 20__
by _____ (inventor/creator name).

My commission expires _____, 20__

Notary Public (signature)

Seal/Stamp

DATE EXECUTED _____, 20__

INVENTOR/CREATOR 4 (printed name)

INVENTOR/CREATOR 4 (signature)

State of _____ County of _____

The forgoing instrument was acknowledged before me this _____, 20__
by _____ (inventor/creator name).

My commission expires _____, 20__

Notary Public (signature)

Seal/Stamp