

## **Disclosing Your Invention**

### **What is “invention disclosure?”**

An invention is any new or useful process or discovery, art, method, technique, machine, device manufacture, software, composition of matter, or improvement thereof.

An “invention disclosure,” once completed and signed, is the first official record of the invention and is a legal document that notifies and describes the invention to the University.

### **Who should disclose?**

If you are a Marquette University faculty member or employee who conceives or develops something new and useful during the course of your employment, you have an affirmative duty to disclose.

### **Why should you disclose your invention?**

Disclosing your invention permits evaluation of your invention to determine whether the invention is patentable and whether commercial development is feasible. Failure to disclose may result in the loss of intellectual property protection of your invention.

If your work is funded by an outside sponsor, it is particularly important that you disclose as there are contractual obligations to external sponsors which provide such support. The University is under special reporting obligations when the invention results from federally funded projects.

### **When should you disclose your invention?**

An invention disclosure should be made when something new and useful has been conceived or developed, or when unusual, unexpected, or unobvious research results have been achieved and can be utilized. You are encouraged to disclose your inventions as soon as they have been reduced to practice.

Non-confidential disclosure of your invention (to people outside the University), which includes publishing, may constitute a bar to intellectual property protection. To ensure the possibility for worldwide protection, disclosures should be submitted for timely review no later than three months prior to any public disclosure.

### **How should you disclose your invention?**

The University’s Intellectual Property Policy requires you to disclose inventions conceived or developed in the course of your employment to the Contract Administrator using the attached Invention Disclosure Form.

### **What happens after you disclose your invention?**

The Contract Administrator and Intellectual Property Review Board determines whether the University should seek patent protection for the invention. That determination is based on availability of funds and an assessment of the invention’s commercial value.

### **How can an inventor help?**

There are several ways you can help the Contract Administrator and Intellectual Property Review Board accurately and quickly review the disclosure.

1. Contact the Contract Administrator as soon as you think you have an invention.
2. Fill out the disclosure form completely.
3. Be sure to list all companies and contacts you believe may be interested in the invention. You are the greatest resource for locating potential licensees because you are the expert in the field and are the most knowledgeable of companies in that market.
4. Be responsive to information requests. Although some of the requests may be frequent and time consuming, the better the information that is received from you, the more successful and faster the process will be.
5. Keep the Contract Administrator informed of upcoming publications or interactions with companies pertaining to the invention.
6. Call the Contract Administrator if you have any questions or concerns.



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## INVENTION DISCLOSURE FORM

The business of a university is the gathering and dissemination of knowledge. Making an invention and putting it to use in the service of the public is one mode of accomplishing this objective.

Accordingly, the University encourages the inventive process; and within the limits of financial practicality, can often provide assistance and advice in bringing inventions to the point of public use.

In the sense used here, an “invention” has a presumed commercial use and value. From this, certain caveats follow as a consequence.

1. Disclose first, publish later.  
Disclosing your invention by no means impedes subsequent publications. Publishing before submitting a disclosure can have disastrous consequences, both legal and tactical, on efforts to commercialize an invention.
2. Leave procedural questions to the specialists.  
What constitutes a patentable invention is sometimes a complex legal question. If you think you have made an invention, but you are not sure, then say so in your disclosure. Similarly, if you think, but are unsure, your invention may have commercial merit, simply say so on your disclosure.

Disclosure using this form is required by the University’s Intellectual Property Policy. **Once the form is completed, it should be sent to Sherri Kirsch, Contract Administrator, Office of Research & Sponsored Programs, Holthusen Hall, 341.**



4. POTENTIAL COMMERCIAL APPLICATIONS OF THE INVENTION / POTENTIAL LICENSEES: Have you been contacted by any party regarding the licensing of your invention? Are you aware of any companies in the field that may be interested in your invention? Are there current plans to use your idea commercially?
  
5. PUBLIC DISCLOSURE / PUBLICATION PLANS: Public disclosure includes abstracts and presentations at scientific meetings (including poster sessions), public seminars, shelving of theses, publications, disclosure to others outside the University who have not signed a confidentiality agreement, and use, sale, or offer of sale of the invention. Identify specific dates and circumstances of any such disclosures. Also, indicate your future disclosure or publication plans, and notify the Contract Administrator if the invention is publicly disclosed or published in the future (whether intentionally or inadvertently).
  
6. FINANCIAL SUPPORT / CONTRACT IDENTIFICATION: Identify the specific grant or external sponsors (governmental agencies, corporate sponsors, private agencies, or others) which provided support used to defray costs related to the research from which the invention resulted. This information is needed to determine whether this invention is subject to any commitments or restrictions arising from the terms of sponsorship.

