DISCLOSURE OF INVENTION Date:

Erfindungsmeldung.doc

An die

Medizinische Hochschule Hannover

Rechtsabteilung

OE 0400

|  |  |
| --- | --- |
| wird vom Institut ausgefüllt: | |
| eingegangen am: |  |
| schriftliche Eingangsbestätigung  verschickt am: |  |
| Mitteilung über Unvollständigkeit  am: |  |
| **Ablauf der 4-Monatsfrist zur**  **Inanspruchnahme am:** |  |
| Entscheidung über Freigabe oder  Inanspruchnahme erfolgte am: |  |

**Seal envelope and send separately !!**

**1. Title of the invention:**

|  |
| --- |
|  |

**2. Enclosures**

The following documents are enclosed:

|  |  |  |
| --- | --- | --- |
|  |  | .............. pages of description of the invention incl. .................. sketches/ drawings. |
|  |  |  |
|  |  | Statement of superior/head of department |
|  |  |  |
|  |  | Own research/publications in the field of the invention |
|  |  |  |
|  |  | Documents describing the state of the art (publications, brochures etc.) |
|  |  |  |
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|  |  |  |
|  |  |  |

!

**3. The following persons have contributed to the invention:**

Use a separate column for each inventor. Please also list inventors not employed at the MHH. Report additional inventors on a separate sheet and make a note under section 2. Only a person who made a distinct contribution to the invention can be considered as an inventor.

|  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- | --- |
|  | | | | I hereby disclose the invention specified in section 1 (please sign on page 4) | | | | | | | | | | | | | | |
| Yes | | | | | | Yes | | | | | | Yes | | |
| 1 Last name | | | |  | | | | | |  | | | | | |  | | |
| 2 First name | | | |  | | | | | |  | | | | | |  | | |
| 3 Title/academic degree | | | |  | | | | | |  | | | | | |  | | |
| 4 Nationality | | | |  | | | | | |  | | | | | |  | | |
| 5 **Home** | |  | |  | | | | | |  | | | | | |  | | |
|  | | - address: | |
| 6: | | -phone no.: | |  | | | | | |  | | | | | |  | | |
|  | | | **Occupation at the time of invention** | | | | | | | | | | | | | | | |
| 7 Profession | | | |  | | | | |  | | | | | |  | | | |
| 8 Institute / Department | | | |  | | | | |  | | | | | |  | | | |
| **9 Work** | | | |  | | | | |  | | | | | |  | | | |
| -address: | | | |
|  | | -phone no.: | |  | | | | |  | | | | | |  | | | |
| 10 | Official position  (Professor, assistant, scienctist, PhD student, technician etc.) | | |  | | | | |  | | | | | |  | | | |
| 11 | Type of contract  (research assistant, scientist,  work and service contract, lectureship,  etc.) | | |  | | | | |  | | | | | |  | | | |
| 12 | Current position relating to lines 7-11 (if your occupation has changed) | | |  | | | | |  | | | | | |  | | | |
|  | | | **4. Inventorship** | | | | | | | | | | | | | | | |
| 13 | Contribution to the invention | | | % | | | | % | | | | | % | | | | | |
| 14 | The invention results from my field of work. | | | Yes | | No | | Yes | | | | No | Yes | | | | No | |
| 15 | The task resulting in the invention was assigned to me (e.g. third party grant research project) | | | Yes | | No | | Yes | | | | No | Yes | | | | No | |
|  | | | **The invention was made as part of….** | | | | | | | | | | | | | | | |
| 16a | my bachelor or masters thesis | | | | Yes | | No | | Yes | | No | | | Yes | | | | No |
| 16b | my PhD thesis | | | | Yes | | No | | Yes | | No | | | Yes | | | | No |
| 16c | my employment contract | | | | Yes | | No | | Yes | | No | | | Yes | | | | No |

**4.1 How was the invention made ? By your own experience?** (only answer if you stated „no“ in lines 16a-c) – e.g.: suggestion by collaborator, personal experience, solution to a problem presenting itself in the context of your research project ... )

**4.2 Which experiences were already available at the institute before the invention was made?**

**4.3 Date of the invention?** When was the invention first conceived (month/year)?

**4.4 Was the research that led to the invention sponsored by the industry, or funded by a grant from the government (DFG, EU, BMBF,…)? Please specify.** If applicable: enclose grant proposal.

**4.5 Aside from the inventors listed above, were there any other technicians or scientists contributing to development or realization of the invention? Please list.** (e.g. workshop technicians, students… without distinct contribution to the invention)

**4.5 Is the invention in the field of research of a different work group of the institute?**

**5. Description of the invention:** We are enclosing a description of the invention in which the invention is fully disclosed (see section 2)**.**

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| **NOTE:** It is important to fully and comprehensively disclose the invention, since a broadening of scope of the patent application is not possible after submission to the patent office. Only those parts of the invention that were disclosed to the institute can potentially be released to the inventors. The institute will keep all documents confidential. |

**Scope**

|  |  |
| --- | --- |
|  | ca. 4 pages (or more if needed) |
|  | Drawings, plans, sketches, research notes |
|  | if applicable: copies of publications describing the state of the art |
|  | if applicable: own publications in the field of the invention |
|  | if applicable: copy of the research grant application |

**Content**

|  |  |
| --- | --- |
|  | Technical problem: |
|  | What is the technical field of your invention? |
|  | What is the state of the art according to your knowledge? |
|  | What are the technical problems or disadvantages that are addressed by your invention? |
|  | Previous approaches to solve the problem? |
|  | What task was basis for your invention? |

**Technical solution**

|  |  |  |
| --- | --- | --- |
|  | How is the technical problem solved by your invention? | |
|  | | **>** Specification of technical means, description of the invention |
|  | | **>** Please enclose examples, sketches or data |
|  | What are the **novel aspects** of your invention? | |
|  | What are the advantages of your invention relative to state-of-the-art solutions? | |

**6. State of development**

Was the invention already tested? (Experiments, models, prototypes?) Or are you planning to test it in the near future? Please add schedule of experiments.

**7. Publication of parts of the invention: Was the invention already disclosed to the public in any way (orally or in writing: presentations at seminars, congresses, department tours, trade shows, exhibitions)**

The core of the invention, i.e. the inventive content, may not be published anywhere by anyone prior to submitting the patent application to the patent office (also not by you). Do not submit publications, distribute your thesis or give presentations! If applicable: enclose a draft manuscript of your publication.

**8a. Commercialization of the invention – Do you see applicability for your invention in the industry?**

Please specify: industry sector, companies? Existing contacts to the industry? Were parts of the invention already disclosed?

**8b. Are you aware of other parties interested in the invention? Which parties?**

Companies contacted, cooperation partners?

|  |
| --- |
| **I hereby attest** thataccording to my knowledge only the inventors listed under section 3 contributed to the invention, and that my description of the invention is complete and comprehensive.  **I am aware** that all publications of the invention and all communication to third parties who are not bound to secrecy can prevent the grant of a patent and thus are not permitted.  **I am also awar**e that the invention is not at my disposal until the institute releases it to me. |

Date , Signature Date , SignatureDate , Signature

**Statement of head of department/supervisor**

|  |  |  |  |
| --- | --- | --- | --- |
| Concerning **invention disclosure** dated |  | **titled** |  |
|  | (Date) |  | (short title) |
|  |  |  |  |

In order to enable us to evaluate the legal and contractual framework please answer the following questions:

1. Was the invention developed in the context of third-party funded projects? (e.g. SFB, DFG, BMBF, BITÖK, EG, cooperation with industry)

|  |  |
| --- | --- |
|  | No |
|  | Yes – Please specify: title of project or contract |

2. Will a proportion of the revenue generated from licensing need to be spent to reimburse third-party funding agencies for grants used for the research that led to the invention ? Third-party material or financial resources, which have been spent for the invention (e.g. prototype construction in the workshop, special purchases).

3. Should the invention be claimed by the institute? Rationale?

|  |  |
| --- | --- |
|  | Yes: The invention should be **claimed** , and **a patent application** should be **submitted** |
|  | **No** |

4. The statements in the invention disclosure form have been reviewed and appear to be correct.

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
|  | , |  |  |  |
| (Place) |  | (Date) | | (Signature) |

**IMPORTANT: Annotations to the disclosure of invention**

**You invented something**?

Please start thinking about patent protection for your invention and opportunities for commercial exploitation early on. The longer you wait, the greater the risk that others are faster. Don`t let your invention become public. The technology transfer office will advise you on all questions.

**The purpose of the invention disclosure form for inventors with employee or civil servant status at the research institute is to clarify who is entitled to the exploitation rights prior to submitting a patent application. This is regulated by the Law on Employee Inventions (LEI[[1]](#footnote-1)). If the invention results from an**

• **employment (contract, task)** at the institute or

• is essentially based on **experiences** or activities of the institute,

it is considered a **service invention** (Sec. 4), which can be claimed by the employer (Sec. 6), regardless of where or when (for example at the weekend) the invention was made. If the institute claims the invention ,a patent application must be submitted immediately (Sec. 13). If the invention is claimed the inventor is entitled to an adequate share of future profits (Sec. 9).

Every invention made during employment at the institute, must be reported to the employer **immediately, in writing and completly** (Sec. 5 respectively Sec. 18). The employer must immediately give the employee written confirmation of receipt of the disclosure of invention (Sec. 5).

The invention disclosure documentation should enable the employer (as a non-expert) to **determine**,whether it is really a service invention and, if that is the case, whether he wants to claim ownership of the invention. The employer has to make this decision **no later than 4 month after the receipt of the invention disclosure form** (important deadline!; Sec. 6). As of October 1st 2009 the invention is considered to be claimed, if it is not released to the inventor within 4 months after receipt of the invention disclosure form (Sec. 5, subsection 2, sentence 1 and 3).

The documentation describing the invention must be comprehensive in order to enable the institute (ie the employer) to make the decision as to whether or not to claim the service invention and file a patent application. If the disclosure of invention does not describe and explain the invention or its development precisely enough, the employer will inform the inventor within a period of two months and ask for a revised version (Sec. 5). If the employer **does not object** to the invention disclosure documentation within this period, it is considered complete .

In case of any objections the deadline for claiming the invention, (see above), will extend accordingly.

**Form "Disclosure of invention"**

**Aim and function of the form**

For the purpose of legal certainty, law specifically states that an invention should be disclosed in writing. However, many inventors are not familiar with the formal requirements for an invention disclosure statement. The invention disclosure form helps to overcome this problem by querying the inventor for the necessary information, thus reducing delaying queries and complaints by the administration of the institute to a minimum.

Furthermore the use of this form is advantageous for the administration of the institute: they receive a uniform, precise and comprehensive description of the invention. An additional (optional) form can be used to obtain a statement from the supervisor (as a rule from the group leader), unless the supervisor is the person reporting the invention. The inventor should present this form together with the invention disclosure form to his/her superior prior to submitting the documents to the management of the institute. The form thus helps to avoid misunderstandings between the parties concerned.

**Entries by the institute’s administration**

The table on the top of page 1 highlights important dates and deadlines regarding the invention. The necessity of a written acknowledgement and the possibility of an objection in case of incompleteness has been pointed out in chapter 1. Especially the important date of expiry of the claim deadline should be recorded. If the invention was fully disclosed this deadline cannot be extended.

**Enclosures**

Please list only data about personal details, the occurrence of the invention and about the legal and financial scope on the form "disclosure of invention". The comprehensive technical description and explanation( including schematics) of the invention should be added as enclosure and noted in section 2.

**Section 3: Inventorship (lines 1-16)**

If **more than one person** contributed to the invention it is sufficient to submit one single form. The form does take joint inventorship into account by asking the inventors to list their contribution to the invention in line 13 on page 2, in order to initiate discussion about the percentage of contribution in the course of the invention at an early stage.

Inventors who wish to report their invention/ their contribution to the invention using the form, are asked to indicate their inventorship by checking the boxes in the table on page 2. The inventors need to sign the form on page 4. This does not apply to co-inventors without distinct contribution to the invention, who should be listed by the reporting person in the table on page 2 only as a formality.

With their statement on page 4 the inventors confirm that apart from the persons listed on the form, nobody else contributed to the invention. This information is needed for correctly stating the names of the inventors on the patent application. (Sec. 37 PatG[[2]](#footnote-2)). It is also relevant for the institute to know about contributing free inventors or employees of other institutes for reasons of joint commercial exploitation of the patent at a later time.

Only those persons are to be mentioned as **inventors**, who made an essential, inventive and distinct contribution to the invention ("flash of inspiration")!!

**Details on employment (lines 7-12)**

Please enter the employment status at the time of the invention. In academia inventions are often made towards the end of undergraduate or graduate work, so please give an address under which the inventors can be reached after graduation (line 12).

**Section 4: Inventorship (lines 13-16a-c)**

Section 4 clarifies whether the invention is an "order"- or "experience"-invention (lines 14-16, top of page 3).

The question concerning research projects is intended to clarify the obligation of the institute towards funding institutions. This question is asked again in the form "statement of superior/head of department", because from experience usually only the superior or the head of research can provide all details.

If the invention is in the area of work of another institute or workgroup of the same institute, applicability of the invention in this field should be evaluated.

**Section 5: Description of the invention**

An extensive and complete description of the invention is to be added to the invention disclosure form. The content should be structured in technical *task* and technical *solution*, which are also part of every patent application. The inventor is to communicate his knowledge about the state-of-art extensively and to enclose known citations (annotation in chapter 2). This facilitates the (patent) search to be performed by the technology transfer office. Inventors are encouraged to perform their own searches, because their results can be enclosed or cited.

The inventors should focus mainly on **the essential innovative aspects** of their invention. Please specify why the invention solves a technical problem and which advantages their invention has over previous research. Inconclusive preliminary tests as well as illustration of scientific basics can be given as minor constituent of the disclosure of invention. Both are not the core of the patent application, but can contribute to the explanation of the invention.

**Please note: You as the inventor are the "above-average specialist". So please address your disclosure of invention to an "only-avarage specialist"! For example, please refrain from adding page-filling mathematical derivations., do not explainin great detail WHY something works, but focus on WHAT has to be done so that it works.!**

**Section 7: Publication of parts of the invention**

For evaluation of the patentability of an invention it is important to know whether parts of the invention have been made accessible to the public orally or in writing (Sec. 3PatG[[3]](#footnote-3)); inventors from academia are often not aware of this. By signing the form the inventors commit themselves to secrecy until release of the invention by the institute or until submission of a patent application.

**Section 8: Industrial applicability of the invention**

As patent applications are costly, technical feasibility (cf. chapter 6 on page 4) and the market opportunities of the invention (cf. chapter 8 on page 4) have to be assessed at an early stage. In each phase of the technical development and the employees invention and patent covenant-procedure the inventors should look out for potential licensees without revealing content or the essence of the invention.

**Form "Statement of head of department/supervisor"**

The inventor should present the form along with the invention disclosure form and supporting documents to his direct supervisor or head of department. As this form is not mandatory, it is listed as “optional” in section 2. However,,past experience showed that the agreement of the supervisor is essential.

Section 1.: PhD- and Diploma-students are often not aware of third party funded projects and their financing.

Section 2.: Third-party *Special* material or financial resources usedfor the invention (e.g. prototype construction in the workshops), could consitute grounds for reimbursement claims to the inventor.

Section 3.: For inventors lacking complete insight into the particular field of research it is especially important to get their superior’s opinion on the options for claim of the invention by the employer or release of the invention to the inventor.

Section 4.: The supervisor is asked to confirm that the information on the invention disclosure form is correct and complete.

1. **If not specified otherwise, the sections refer to the Law on Employee Inventions.** [↑](#footnote-ref-1)
2. [↑](#footnote-ref-2)
3. [↑](#footnote-ref-3)