

MORGAN STATE UNIVERSITY PROCEDURES ON PATENTS AND TECHNOLOGY TRANSFER

APPROVED BY THE PRESIDENT NOVEMBER 2, 2015

I. Introduction

The Morgan State University (hereinafter MSU or University) follows the Board of Regents Policy on Patents as approved and dated March 20, 1996. In order to encourage the disclosure of inventions and discoveries and to assist inventors, MSU has established the Office of Technology Transfer (OTT) within the Division of Research and Economic Development. OTT acts as a liaison between MSU researchers, the MSU Office of the General Counsel, patent attorneys, agents and corporations. OTT safeguards the interests of the University and its personnel in matters relating to intellectual property, and enforces the Board of Regents Policy.

II. Procedures

A. The Submission of the Intellectual Property Disclosure Form

When a new invention is identified, the first action taken is for the inventor, sometimes with the assistance of OTT, to prepare and submit to OTT an invention disclosure on a form entitled "Intellectual Property Disclosure Form." A sample form may be found in Attachment A.

B. Recording

When a completed disclosure form is received by OTT, it is date stamped and assigned an invention disclosure number, placed in a case file folder, and entered into the internal office computer system to establish the initial record of receiving to begin the application monitoring process. The system monitors the status of each disclosure and records marketing and licensing information. OTT produces invoices to send to licensees, and records the collection and distribution of licensing income collected.

C. The Disclosure Assessment Process

The OTT will assess the disclosure's technical and market potential, market need and level of market activity in relevant subject areas. The assessment of various types of technology is undertaken by OTT, including intellectual property (inventions, patentable and un-patentable), tangible research materials (e.g., monoclonal antibodies) and software (if patentable, or commercially licensable). A sample worksheet may be found in Attachment B. In addition, sample OTT procedures flowcharts may be found in Attachment C. OTT performs the following assessment tasks:

1. A search for similar inventions or existing patents is performed.
2. A literature search to establish potential need and uniqueness is conducted.
3. As needed for marketing purposes, an Executive Summary describing the disclosure's features and potential applications is prepared for review by the inventor, and utilized to market the invention to potential licensees.

4. In many cases, and to protect the patent rights of MSU, a provisional patent application will be prepared and filed with the US Patent and Trademark Office by the OTT, prior to marketing the invention.
5. In some cases, an approved outside patent firm, specializing in the particular technology area, is asked to do a patent search and opinion on patentability.
6. When a non-provisional patent is appropriate, OTT coordinates the preparation of the patent application and may seek the assistance of the Office of General Counsel or an approved outside patent firm to file the patent application.

D. Marketing

OTT staff will be active in targeting inventions and discoveries to companies interested in licensing new technology. The OTT performs the following marketing tasks:

1. Develop a list of companies with potential interest in licensing the invention.
2. Potentially interested companies are contacted to assess interest in licensing the invention.
3. When appropriate, companies that express interest will receive a confidentiality agreement prepared by OTT staff, and are contacted directly by OTT.
4. If needed, OTT, with inventor assistance, prepares a technical package for interested companies.

E. Licensing

As a result of successful technology marketing campaigns, OTT engages in licensing negotiations with one or more companies interested in further development, manufacturing and sale of products.

F. Costs

Costs associated with patenting, marketing, and licensing are paid by OTT. OTT may be reimbursed for these expenses according to Patent Policy.

G. Revenue Sharing

OTT assures that all revenue received from licensing activities is properly distributed to the inventors and their departments through the standard University practices, and according to the MSU Board of Regents Patent Policy.

Revenue includes: up-front payments; technology purchases; option fees; minimum annual licensing fees; technology transfer fees; technology development payments; and royalties.



Date Received: _____
(For Office Use Only)

Case Number: _____
(For Office Use Only)

Completed forms should be sent by email or campus mail:
Mail: Office of Technology Transfer & Commercialization
1700 E. Cold Spring Ln, SEB 102, Baltimore MD 21251
Email: victor.mccrary@morgan.edu

Intellectual Property Disclosure Form

1. Type of Intellectual Property (*Please check*) Patent Copyright Software Trademark
2. Title of Invention: _____

3. Area(s) of Interest (i.e., Biological, Chemical, Engineering, etc.) _____

4. Inventor #1 (*Primary Inventor*):

Name: _____ Title: _____
Department: _____
University Address: _____
Email: _____ University Phone: _____ Fax: _____
Home Address: _____
Home Phone: _____
Citizenship: _____ Percentage of Contribution: _____

Inventor Signature: _____ **Date:** _____

Inventor #2:

Name: _____ Title: _____
Department: _____
University Address: _____
Email: _____ University Phone: _____ Fax: _____
Home Address: _____
Home Phone: _____
Citizenship: _____ Percentage of Contribution: _____

Inventor Signature: _____ **Date:** _____

Inventor #3:

Name: _____ Title: _____
Department: _____
University Address: _____
Email: _____ University Phone: _____ Fax: _____

Attachment A

Home Address: _____

Home Phone: _____

Citizenship: _____

Percentage of Contribution: _____

Inventor Signature: _____ **Date:** _____

Please check if there are additional inventors; attach additional sheets as needed.

5. **Detailed Description of Invention** (Please attach a complete detailed description of the technology. Please attach any available or relevant data including, but not limited to, drawings, sketches, diagrams, abstracts, pictures, figures, etc.).

Software

If the invention is software, please include all novel algorithms implemented in the software. Please attach a copy of the source code (hard copy and electronically).

6. **Date Invention Conceived:** _____

Is this date documented (i.e., in your lab records). Yes ___ No ___

Has the invention been reduced to practice? Yes ___ No ___

If yes, describe the demonstration(s) conducted that prove it works.

7. **Sponsorship:** *under Federal Law, Morgan State University is obligated to report any innovation resulting from federally funded research.*

Was the research that led to the invention sponsored?

Funding Source: ___ Federal government contract or grant ___ State non-federal contract or grant

___ University appropriated funds ___ Corporate ___ MIPS contract ___ Other

Grant Title _____

Grant Agency _____

Funding Amount _____

Principal Investigator _____

Award Date _____

Did you collaborate with a third party, institute, or organization?

If yes, please provide the name, affiliation, and involvement of the party.

8. **Publication**

(a) Submitted to a Journal: ___Yes ___No Date: _____

Journal Name: _____

(b) Published: ___Yes ___No Date: _____

Journal Name: _____

(c) Oral Disclosure: ___Yes ___No Date: _____

Location: _____ Handouts? ___Yes ___No

(d) Poster Presentation: ___Yes ___No Date: _____

Published Abstract: ___Yes ___No

(e) Thesis or Dissertation: ___Yes ___No Date: _____

(f) Other Disclosure: ___Yes ___No Date: _____

Describe: _____

*If the technology is scheduled for disclosure (conference/publication, including electronic disclosure), provide the anticipated date. _____

9. **Technology Significance** (choose one)

___ Modification to existing technology ___ Substantial advancement in the art ___ Major breakthrough

10. **Technology Stage** (choose one)

___ Concept ___ Design ___ Prototype ___ Modification ___ Production Model

___ Used in current work ___ Ready to license final product

Attachment A

11. **Future Research:** What additional research is needed to complete development and testing of the invention?

-
- (a) Is this research presently being undertaken? Yes No If yes, identify sponsor: _____
(b) Actively pursued by faculty/staff? Yes No If yes, identify faculty/staff: _____
(c) Actively pursued by corporate partner? Yes No If yes, identify corporate partner: _____
(d) Should corporate sponsorship be pursued, other than the corporate partner? Yes No
(e) Do you wish to form a “start-up” company based on this technology? Yes No

12. **Commercial Potential**

(a) List all products, processes and/or services you envision resulting from this invention and whether they can be developed in the near term (less than two years) or long term. _____

(b) Software inventions: If this is a modification or improvement to an existing work or incorporates elements that are not original to the creator(s), please identify that work and its creator(s). _____

13. **Competition and Potential Users and Manufacturers**

- (a) Describe alternate technology or products, processes and/or services currently on the market of which you are aware that accomplish the purpose of this invention.
(b) Please identify any related technologies or devices which are used for other purposes.
(c) List any companies you believe may be interested in this technology. Provide contact(s), address(es) and phone number(s) for each, if available. Please explain why this technology would be an asset to the company.

Completed Intellectual Property Disclosure Forms may be sent by email or campus mail to the Office of Technology Commercialization:

Campus Mail: Morgan State University, OTTC, 1700 E. Cold Spring Ln, Montebello D302, Baltimore MD 21251

Email: alethea.pounds@morgan.edu

MSU Provisional Patent Application Filing Worksheet

Intellectual Property Disclosure Number: _____ Inventor(s): _____

MSU Invention Disclosure Title: _____

Based on a preliminary assessment of the information provided by the inventor(s) in the Intellectual Property Disclosure (IPD) Form, the following Checklist applies for the filing of a provisional patent application:

- Invention reviewed for ownership under MSU Patent Policy and subject to MSU ownership rights
- Intellectual Property Disclosure Form reviewed for enabling description of the subject invention as necessary to meet USPTO provisional patent application criteria
- Invention meets US Patent requirement: a process, machine, article of manufacture, or composition of matter (includes software with functional applications)
- Invention appears novel: not known or used by others
- Invention appears useful: serves a useful purpose
- Invention appears not obvious: there's sufficient difference from what's been described/used before
- Patent Rights have not been compromised in the United States (an enabling description has not been publically disclosed more than 12 months ago)
- Invention has one or more identified commercial applications

Provisional Patent Application Filing Information and Related Dates

Date of first public disclosure of the invention: Indicate N/A _____ or Date _____

Pending date of public disclosure of the invention: Indicate N/A _____ or Date _____

Are international patent rights available under a provisional application? Yes _____ No _____

Provisional filing deadline date for US Patent rights: Indicate N/A _____ or Date _____

Date for submitting copy of Invention Disclosure to sponsor: Indicate N/A _____ or Date _____

Approved for Provisional Patent Application Filing

Not Approved for Provisional Patent Application Filing and Reasons:

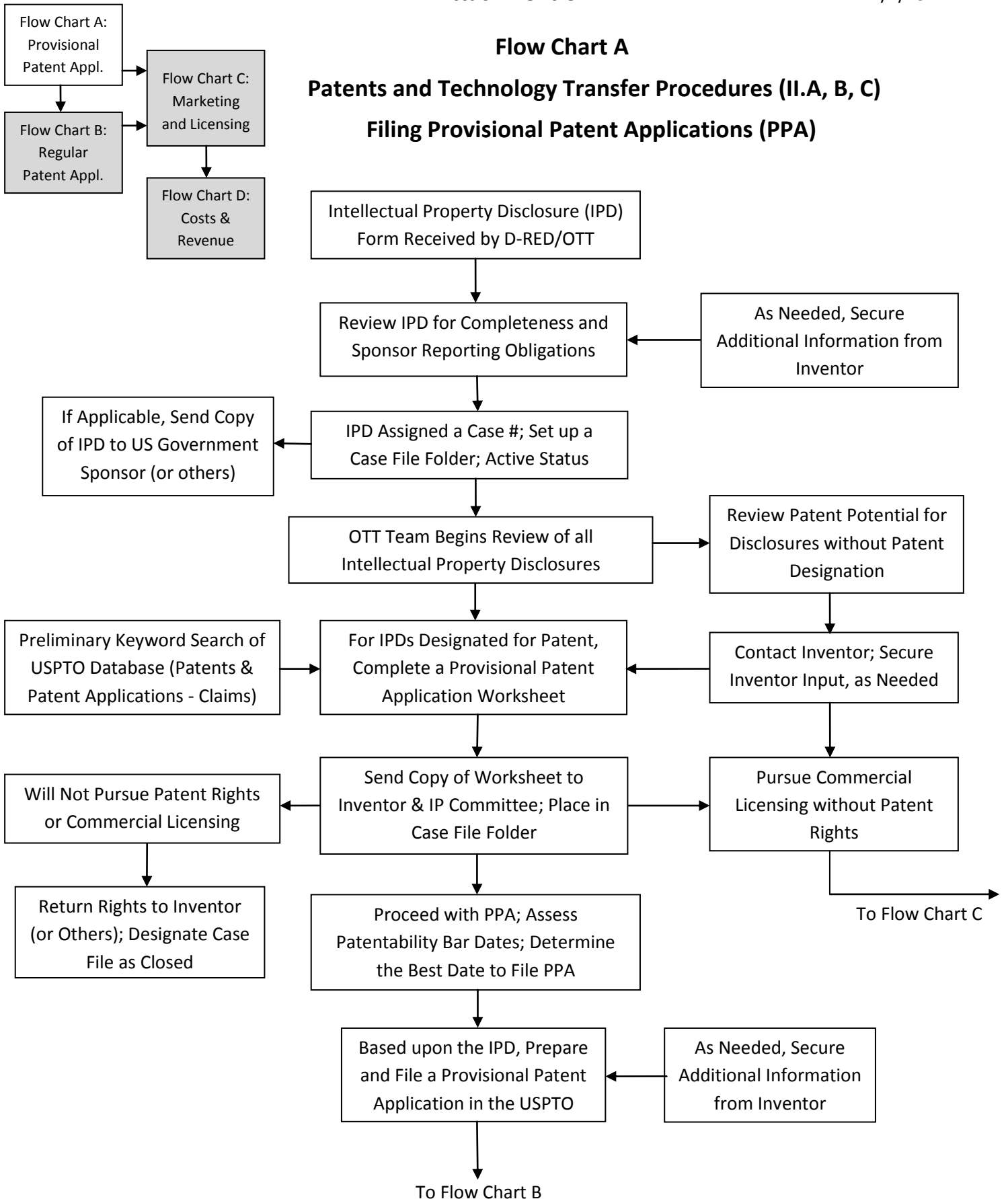
- Patent Rights are not available to MSU - per unchecked item(s) above
- Additional information is needed from inventor(s) prior to completing preliminary assessment
- Pursue commercialization of the invention without pursuing patent rights
- Return invention rights:
 - to inventor
 - to other entity, as provided under contract or funding agreement _____

Comments: _____

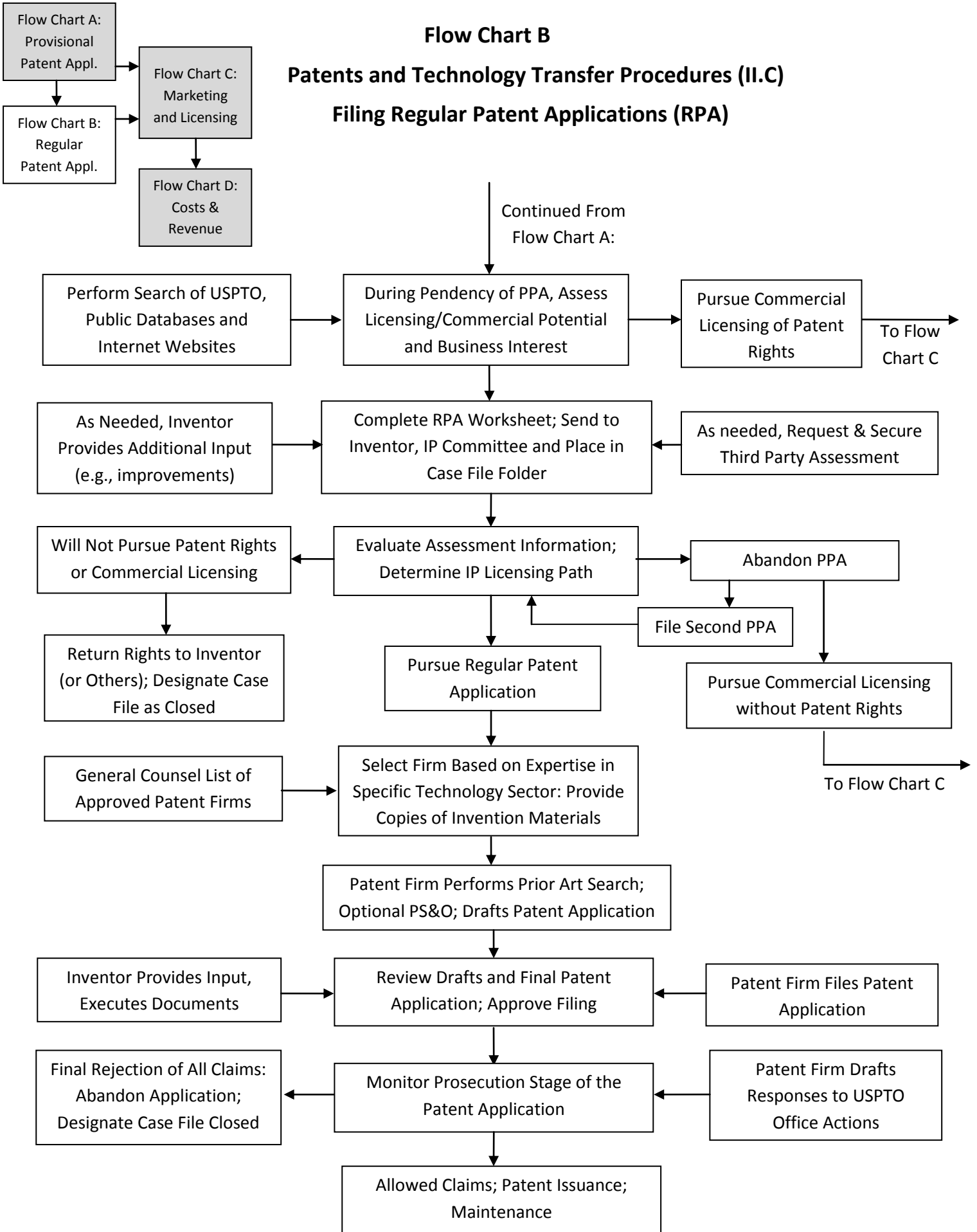
Reviewer Name: _____ Completion Date: _____

Within 10 workdays of Completion Date, D-RED/OTT will send an electronic copy to the inventor(s) and MSU Intellectual Property Committee Members; and place in the IPD Case File with associated IPD documentation.

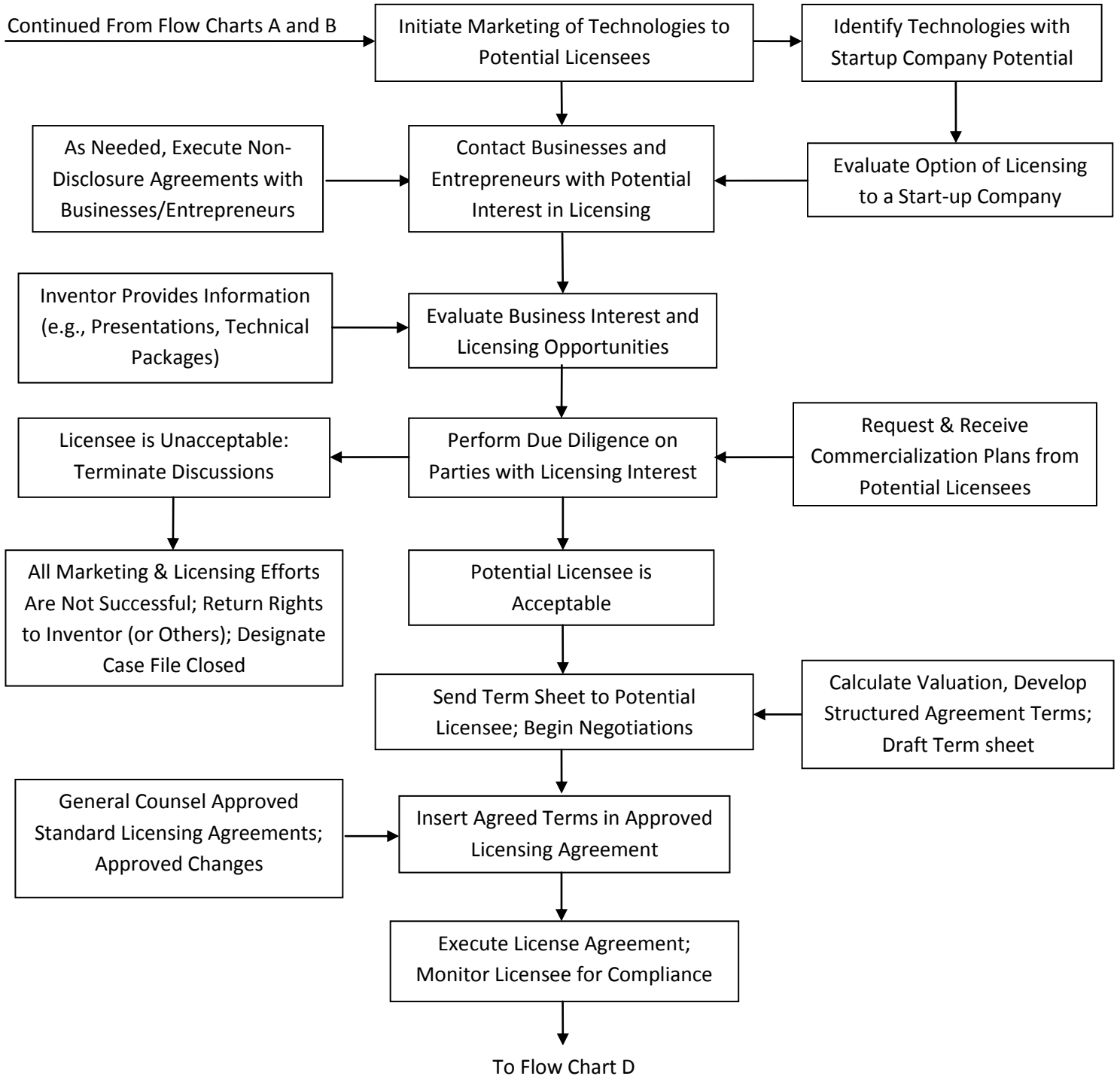
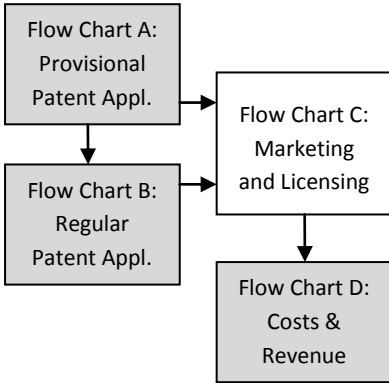
Flow Chart A
Patents and Technology Transfer Procedures (II.A, B, C)
Filing Provisional Patent Applications (PPA)



Flow Chart B
Patents and Technology Transfer Procedures (II.C)
Filing Regular Patent Applications (RPA)



Flow Chart C Patents and Technology Transfer Procedures (II.D, E) Marketing and Licensing



Flow Chart D
Patents and Technology Transfer Procedures (II.F, G)
Expenses and Revenue Sharing

