DN 45 Invention Disclosure

OMB Control Number: XXX-XXXX
Expiration Date: XX/XX/XXXX

Invention Disclosure Information

Detailed information on the invention disclosure process, NIST patent policies, and patent applications procedures are available on the NIST web site at: http://otp-i.nist.gov/intellectual-property-management/index.cfm. The site should answer many of the questions you may have regarding both this disclosure sheet and the process as a whole. If you have additional questions, please contact the Technology Partnerships Office on x3084.

NIST require the following information from you so that:

- Your management can make an informed judgment as to whether seeking patent protection for your invention is appropriate; and

- The Office of the Chief Counsel for NIST can perform an Employee Rights Determination to determine which organizations or individuals may have an ownership interest in the invention, and whether or not preferential licensing rights may exist; and

- The NIST Patent Committee can prepare a recommendation on how to best make the invention available to U.S. industry.

Other information you may be able to provide about the invention, such as the circumstances under which it took place, prior art of which you may be aware (publications, patents and the like), and potential uses/users is helpful and certainly welcome.

The attached information sheets use the term "inventor," and "invention" for convenience.

Have I created an "invention"?
Before completing the form, take a moment to consider whether your technology is sufficiently developed to be an "invention." A good test is whether you can describe the invention well enough that one with ordinary skill in the art (such as yourself) could take the description and reduce the invention to practice without "undue experimentation". In other words, you can describe with specificity each and every step required to practice the invention.

Am I an "Inventor"?
Inventorship is much more restrictive than authorship. A peer reviewed publication describing the invention and/or its use may have many co-authors that are not "inventors" under the patent laws. An inventor is one who contributes to the conception of the invention. That is, an inventor must contribute new concepts or new ideas which lead to the invention. Each inventor must be ultimately able to look at the claims of the patent application and point to his or her contribution to one or more of the claims. Someone who's only contribution of the invention is to carry out the instructions of the inventor(s) in the research leading to the invention or in reducing the invention to practice, is often critical to the overall process, but is not an inventor (unless they have also intellectually contributed new concepts to the invention).

Inventor Information
If there is more than one inventor, a NIST employee-inventor point-of-contact must be identified. The contact is responsible for completing the attached sheets, with the exception of the individual "Inventor Information Sheets." The contact should attach all relevant appendices to the invention disclosure sheet and submit them through his/her NIST management.

An Inventor Information sheet needs to be completed and attached for **each of the inventors**. Should your OU Director decide to have a patent application filed, it is very important that the U.S. Patent and Trademark Office be provided with accurate information on inventorship. Incorrect information on inventorship may affect the validity of a patent.

NIST Invention Disclosure

(To be completed by NIST point-of-contact inventor)

Instructions: Please insert your brief answers into the shaded fill boxes using Word. The boxes will expand as you enter information. Inventor Information forms (at the end of this document) must be completed for all inventors. Five Inventor forms are attached; please select the correct number of pages to print).

1. Invention Title:

2. Abstract: (Please provide a brief abstract, of approximately 100 words.)

3. List of Inventors:

NIST Employees	Non-NIST Federal Employees	Non-Federal Employees

4. Documentation of Invention Origin: (key creation dates)

a) Recorded in Lab Notebook # , page , on .
b) Date of Conception:
c) Reduced to Practice: from to

5. Brief description of continuing research/development activities, if any:

6. Disclosure: (List any publications, funding proposals, abstracts, or oral presentations outside of NIST that mention or define the invention. **Include date** of publications or oral disclosures. Include any manuscripts or presentations in preparation. Attach copies if available.)
Title and Date

7. Relevant External Collaborations/Funding: *(*Describe any external collaborations or funding relevant to the invention, including, but not limited to: informal collaborations, CRADAs, Material Transfer Agreements, Non-disclosure Agreements, Grants, Contracts, Cooperative Agreements, Guest Researcher Agreements. Attach copies of applicable documents.)

8. Relevance to NIST SBIR:

a. Is this invention the subject of a NIST SBIR subtopic?

☐ yes ☐ no

b. If yes, which one?

9. Invention Description:
a. Describe what the invention is, what is new, how it works, what problem it solves, what its limitations are. Please attach all relevant descriptions from papers or presentations.

b. Briefly describe how the invention would be commercially and/or technically superior to current practice.

c. Which of the following NIST criteria for seeking patent protection does the invention meet? More than one may be checked:
☐ **Doing so provides an incentive for commercialization of the technology in the U.S.**
☐ **It is likely that patent protection will have a positive impact on a new field of science or technology that falls within NIST's mission and will enhance the visibility and vitality of NIST.**
☐ **Doing so or would further the obligations or goals of a CRADA or other collaborative agreement.**
☐ **Doing so would further U.S. manufacturing, and/or**
☐ **Doing so is likely to lead to a commercialization license.**

If appropriate, briefly explain how.

10. Additional Work Required:
a. List any critical research and/or development to be done.

b. Is this best done by NIST, other parties (if so, who), or through a collaboration?

c. Are you interested and willing to collaborate on the further development of the invention?
☐ yes ☐ no

11. Prior Art:
a. List any non-NIST proprietary material or information, including that received under a Material Transfer Agreement or Non-Disclosure Agreement, used in the course of the invention.

b. Identify any prior art (journal articles, patents, commercial products, etc.) you know about.

Laboratory Director Comments:

This collection of information contains Paperwork Reduction Act (PRA) requirements approved by the Office of Management and Budget (OMB). Notwithstanding any other provisions of the law, no person is required to respond to, nor shall any person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the PRA unless that collection of information displays a currently valid OMB control number. Public reporting burden for this collection is estimated to be **30 minute per response**, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed and completing and reviewing the collection of information. Send comments regarding this burden estimate or any aspect of this collection of information, including suggestions for reducing this burden, to the National Institute of Standards and Technology, Attn: **Paul Zielinski, Paul.Zielinski@nist.gov, 100 Bureau Drive, Gaithersburg, MD 20889.**

Privacy Act Statement:

Authority: The National Institute of Standards and Technology Act, as amended, 15 U.S.C. 271 et seq. (which includes Title 15 U.S.C. 272) and section 12 of the Stevenson-Wydler Technology; Innovation Act of 1980, as amended,35 U.S.C. §200; 35 U.S.C. §207

Purpose: Information is collected for the National Institute of Standards and Technology (NIST), Technology Partnerships Office (TPO) to streamline the NIST invention disclosure and review processes and to make them scalable to a larger number of disclosed inventions.

Routine Uses: NIST will use this information to track work flow, standardize processing, and provide data control in support of the Technology Transfer program. Disclosure of this information is permitted under the Privacy Act of 1974 (5 U.S.C. Section 522a) to be shared among NIST staff for work-related purposes. Disclosure of this information is also subject to all the published routine uses as identified in the Privacy Act System of Records Notices: COMMERCE/DEPT-23: Information Collected Electronically in Connection with Department of Commerce Activities, Events, and Programs.

Disclosure: Furnishing this information is voluntary. When supplying the information, you are indicating your voluntary consent for NIST to use the information you submit for the purpose stated.