

DN 45 Invention Disclosure

OMB Control Number: 0693-0085

Expiration Date: 01/31/2026

Invention Disclosure Information

If you have questions about this form, please contact patents@nist.gov. If you have any questions regarding defining your invention, conception, reduction to practice, inventorship, or what is prior art, please contact the Office of the Chief Counsel at occpat@nist.gov

NIST requires the following information from you so that:

- The NIST Technology Partnerships Office (TPO) can prepare a recommendation for your management to 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 TPO can evaluate 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, potential 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). As inventorship is ultimately a legal determination, if you have any concerns about inventorship, please contact occpat@nist.gov.

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 the NIST invention disclosure portal.

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. As inventorship is ultimately a legal determination, if you have any concerns about inventorship, please contact occpat@nist.gov.

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 Potential Inventors:

Unless noted otherwise, the inventor order submitted here (down first column, then down second column, then third) will be used as the inventor order listed on any patent applications and patents.

NIST Employees*	Non-NIST Federal Employees*	Non-Federal Employees*

*At time of invention conception.

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. Invention Description:

a. Describe what the invention is, what is new, how it works, what problem it solves. 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.

9. 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

10. Possible Licensees or Collaborators:

List any companies that may be interested in licensing the invention or collaborating, and any contacts if known.

11. Potential Prior Art:

a. Was there 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.

☐ yes ☐ no

b. Identify any potential prior art (journal articles, patents, commercial products, etc. which are available to the public and disclose at least part of the subject matter of the invention) you know about. The purpose of this question is to identify potential prior art of which you are already aware. You are not required to perform a search to locate potential prior art.

Laboratory Director Comments:

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995 unless the information collection has a currently valid OMB Control Number. The approved OMB Control Number for this information collection is 0693-0085. Without this approval, we could not conduct this survey/information collection. Public reporting for this information collection is estimated to be approximately 3 hours per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. All responses to this information collection are voluntary. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to patents@nist.gov.

PRIVACY ACT STATEMENT

Pursuant to 5 U.S.C. § 552a(e)(3), this Privacy Act Statement serves to inform you of why the U.S. Department of Commerce (the Department), National Institute of Standards and Technology (NIST) is requesting the information on this form.

AUTHORITY:

The Department is authorized to collect the information on this form pursuant to 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:

This 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. NIST will use this information to track workflow, standardize processing, and provide data control in support of the Technology Transfer program.

ROUTINE USES:

The information solicited on this form may be made available as a “routine use” pursuant to 5 U.S.C. § 552a(a)(7) and (b)(3). The information may be made available to other federal agencies to assist the Department in connection with NIST’s management of the purposes stated above; or for other authorized routine uses.

A complete list of the routine uses can be found in the system of records notice associated with this form, “COMMERCE/DEPT-23: Information Collected Electronically in Connection with Department of Commerce Activities, Events, and Programs. This system of records notice can be found on the Department’s website at <https://www.commerce.gov/opog/system-records-notices-sorns>

CONSEQUENCES OF FAILURE TO PROVIDE INFORMATION:

Providing this information is voluntary. However, failure to provide the requested information may result in an inability for NIST to process, review, and/or act on such requests. In limited circumstances, NIST may authorize the submission of the requested information via paper forms pursuant to the requirements in 15 CFR 748.1(d).