Components of an Effective Invention Disclosure

Emory and GT both have very detailed ID forms to ensure that as much valuable information related to the invention is captured as possible. A strong ID requires significant detail; thus, it is important to be as thorough as possible and to not skip any sections, even if an input is not required to physically submit the form online.

General Information

a. Brief, descriptive title of the invention
b. Is the IP an invention, software, or copyright/trademark?
c. Summary (description) of the IP
    i. What is the invention and what are its uses?
d. Any documents that are relevant to the invention and convey a clear understanding of its purpose, operation, and characteristics
    i. grant proposals, publications, manuscripts, presentations, etc.
    ii. Diagrams, flows, processes, schematics, and other figures that may be **important and relevant for describing the invention in layman's terms.**

TIPS: The title should not be super fancy; its purpose is to broadly capture the material within the ID. It is also important that invention descriptions be thorough and comprehensive but written in a way that can be understood by someone in your field without being too highly technical. Remember, the people drafting and/or examining your patent application may not be experts in your field.

List of Inventors (Contributors)

TIPS: The list of inventors should be detailed and include full legal names of every person who made an intellectual contribution to the invention. Inventorship is a legal determination; it will be determined later in the process.

Relevance of IP to Previous Inventions

a. Is this invention related to any inventions that have been disclosed by you in the past? If so, include the titles of those ID's and/or patents.

Sources of Funding

a. Include all funding sources from which the IP resulted, including industry sponsorships and federal grants.

Invention History (Significant Dates)

a. When was the invention first conceived?
b. When was the first written description of the invention?
c. Has an enabling description of the invention been disclosed publicly?
d. Has there been an enabling public disclosure?
e. Are you intending on publicly disclosing IP in the future?

TIPS: (1) Dates are important because they establish a timeline of the invention; being as accurate and factual as possible can avoid pitfalls in the future during patent examination and, if necessary, litigation.
(2) Enabling means that the disclosure of the invention is of sufficient detail that anyone with an ordinary skill in that field can make use of the invention.
(3) Public disclosures before patenting do not necessarily void patentability in the US—as long as a patent is filed within 12 months of the public disclosure.
(4) Plan accordingly! Foreign countries do not offer this 12-month grace period. Patents will be considered ineligible if a public disclosure is made before filing.

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Prior art

a. Prior art includes any published material, including papers, patents, patent applications, websites, presentations, etc.
b. What are the differences and/or advantages of this invention over prior art?
c. Attach or provide links to prior art to expedite the assessment of the ID

TIPS:
(1) Remember, you are the expert on your invention and the technology area.
(2) Be thorough: include a list of any relevant prior art that aided in the development of the invention, including your own work. Links are import ant because they can expedite the discovery process for patent prosecu tors.
(3) Be able to explain what sets this particular invention apart from those in prior art.
- How is it different from the relevant prior art
- What are the technical advantages that your invention provides?
- If similar to prior art, what are the key components that make the invention novel?

Potential applications of the invention

a. Write a detailed technical description of the invention.
b. What are the advantages of your invention over the current state-of-the-art?
c. What are the current commercial applications of the invention?
d. Are there limitations of the invention that must be overcome before commercial applications?
e. Are there potential licensees of invention?
f. Has there been an assessment of the market size of technology? If so, provide any relevant data.

TIPS:
(1) The description of the invention in this part is more technical than the summary of the invention previously written. Be thorough and descriptive and use technical jargon that is common in your field but not specific to you and your lab.
(2) The technical description should also describe the physical structure (if applicable) of the invention and how one operates it.
(3) Explain any key terms that might not be universally known.
(4) Even if there are no licensees for technology, identifying any companies that might be of interest later on that can help the patent prosecutors draft a patent in such a way that it could be desirable to that company for licensing.
(5) Assessment of market size is important for commercialization purposes. Do a preliminary search to better under stand the market size for your technology. For help with this, see document on conducting a market assessment of a technology.