

# Invention Reporting

**What Is It? And Why Should I Care?**

David Englert  
Office of Technology Transfer

Put simply, **Invention Reporting** is one of the steps in the **Technology Transfer** process.

Put simply, **Invention Reporting** is one of the steps in the **Technology Transfer** process.

But what is Technology Transfer?  
(And why should I care?)



# University of Rochester



# University of Rochester

- **Learn**



# University of Rochester

- **Learn**
- **Discover**



# University of Rochester

- **Learn**
- **Discover**
- **Heal**



# University of Rochester

- **Learn**
- **Discover**
- **Heal**
- **Create**



# University of Rochester

- **Learn**
- **Discover**
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## Research Cycle



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## Research Cycle



Grant Application



# University of Rochester

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- **Discover**
- **Heal**
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## Research Cycle



**Grant Application**

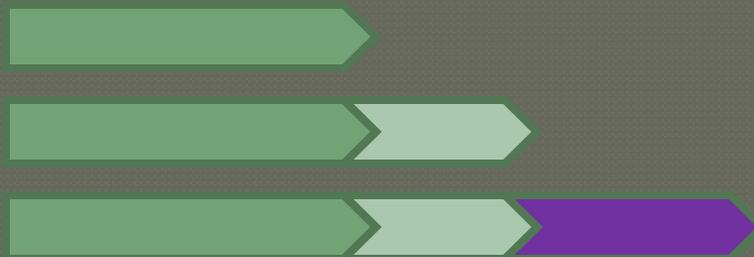
**Grant Award**



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## Research Cycle



Grant Application

Grant Award

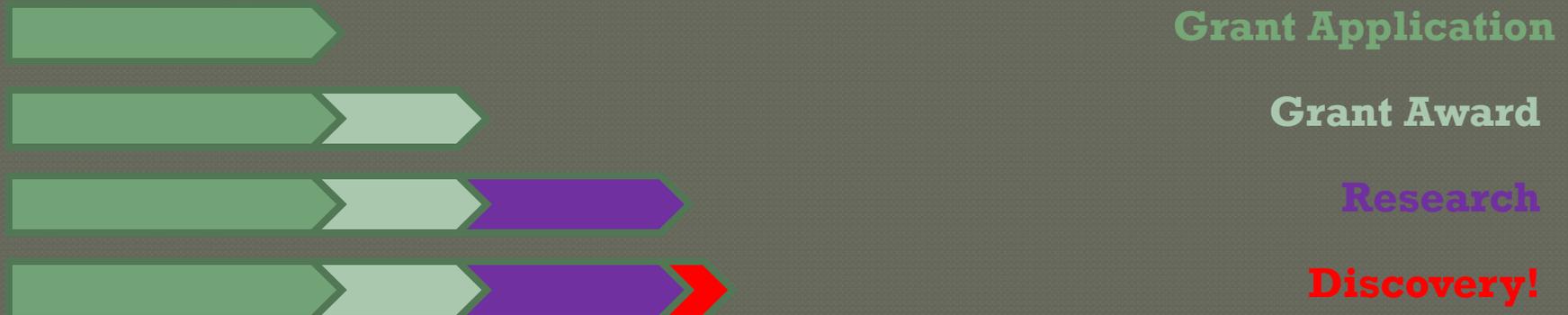
Research



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## Research Cycle

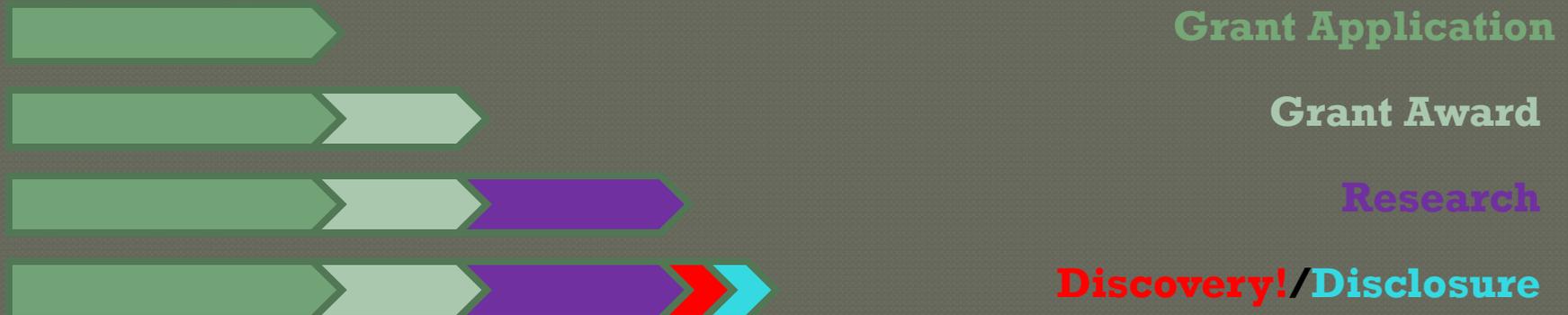




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## Research Cycle

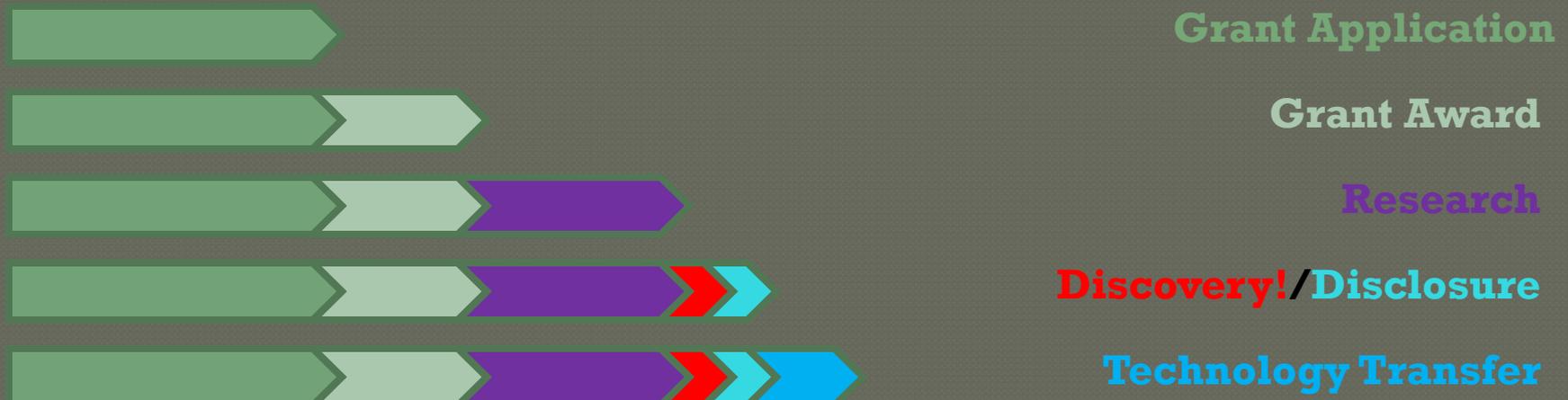




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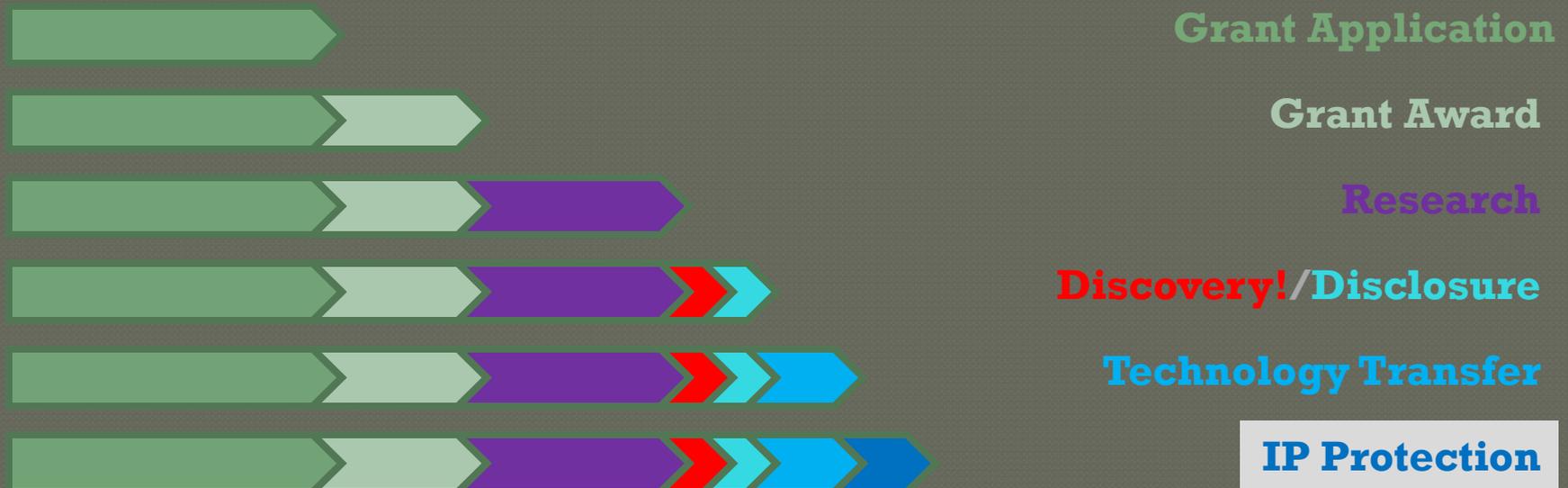




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- **Learn**
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## Research Cycle

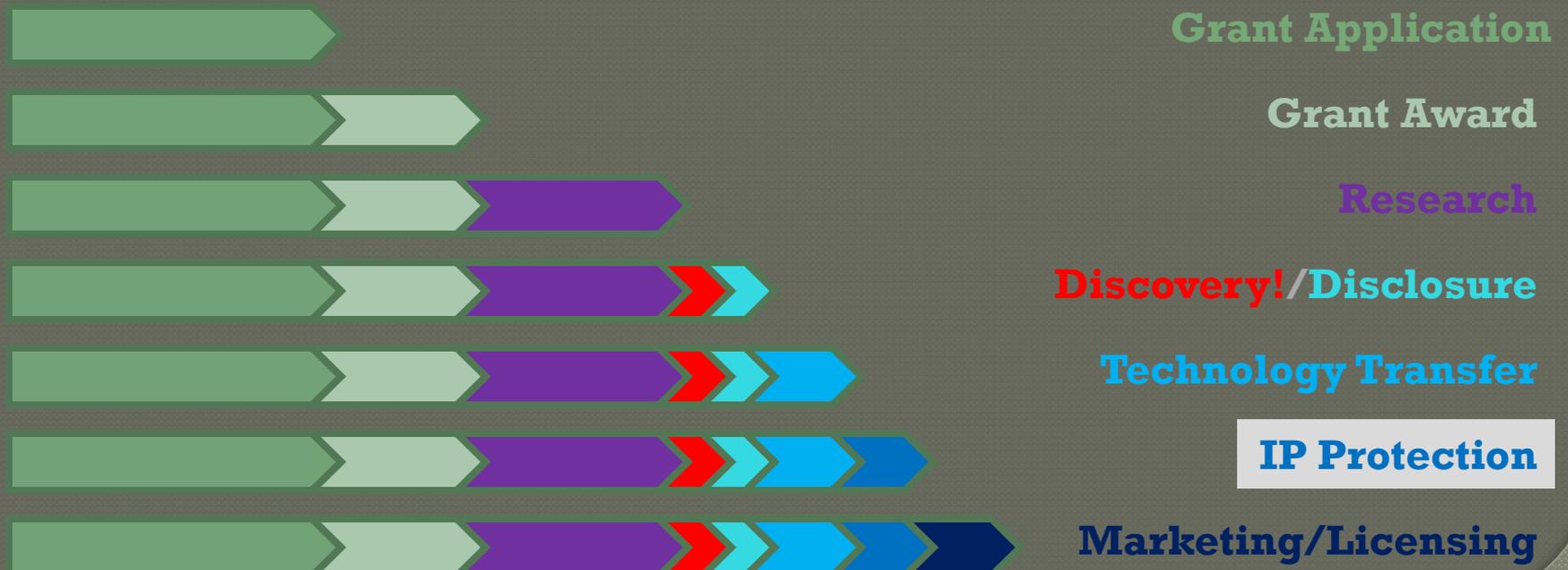




# University of Rochester

- **Learn**
- **Discover**
- **Heal**
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## Research Cycle





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## Research Cycle





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## Research Cycle



- **Disclosure**



# University of Rochester

- **Learn**
- **Discover**
- **Heal**
- **Create**

## Research Cycle



- **Disclosure**
- **Patenting**



# University of Rochester

- **Learn**
- **Discover**
- **Heal**
- **Create**

## Research Cycle



- **Disclosure**
- **Patenting**
- **Licensing**



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## Research Cycle



- **Disclosure**
- **Patenting**
- **Licensing**
- **Certain Outcomes**



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## Research Cycle



- **Disclosure**
- **Patenting**
- **Licensing**
- **Certain Outcomes**

So, **Invention Reporting** is simply alerting the federal funding agency when certain **technology transfer** milestones are met.

# Invention Reporting: A Brief History

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1940s

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1940s



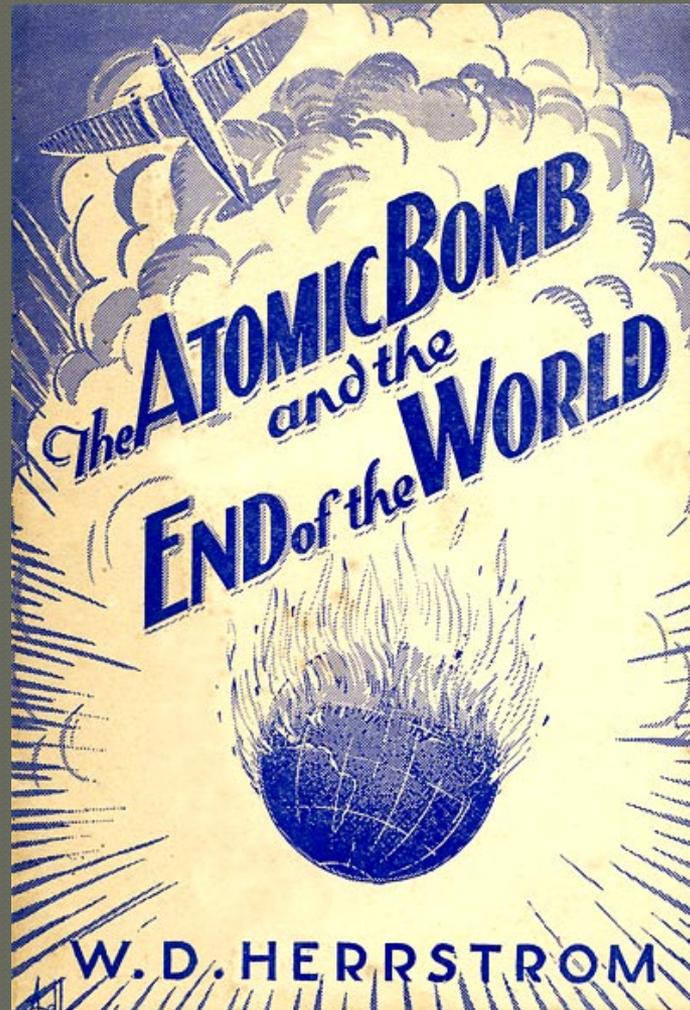
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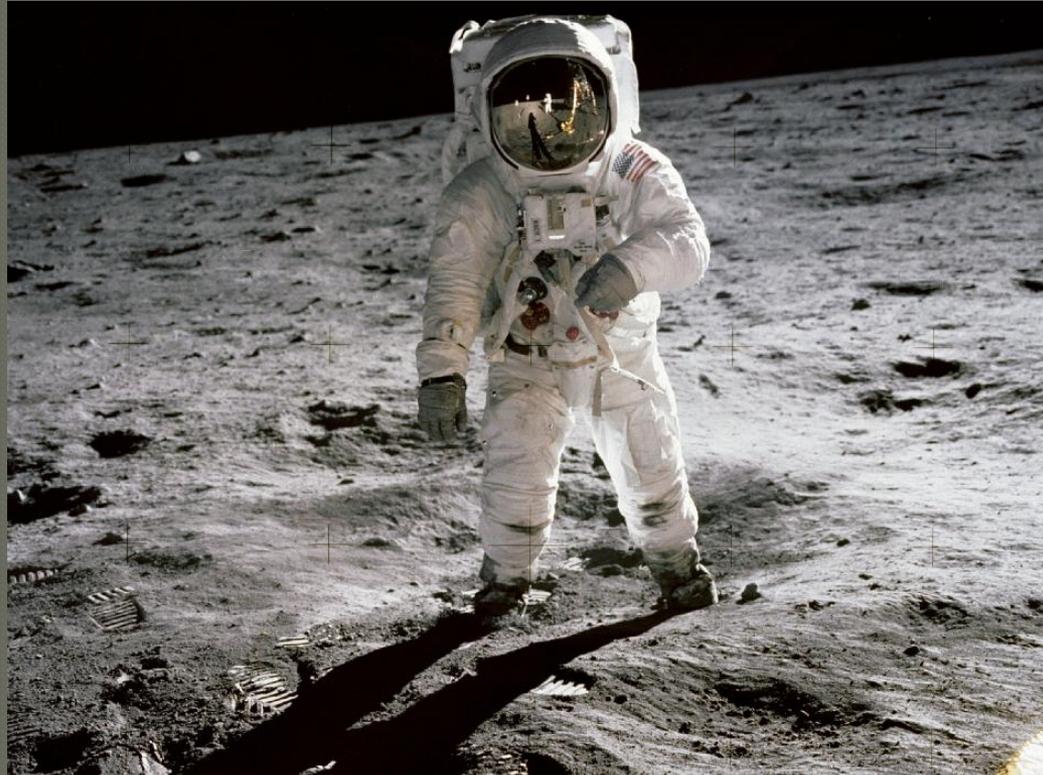
1960s

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# Invention Reporting: A Brief History

1940s

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1960s

1970s

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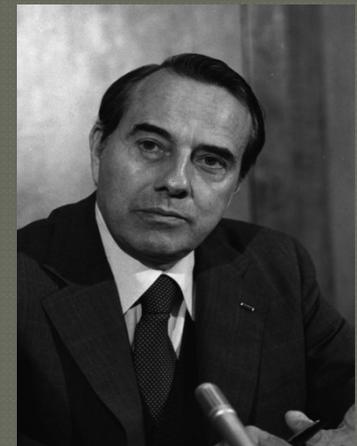
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Birch Bayh (D) U.S. Senator from Indiana (1963 – 1981).

Bob Dole (R) U.S. Senator from Kansas (1968 – 1996).



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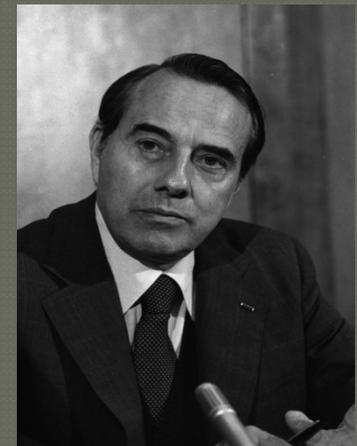
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**Bayh-Dole Act (35 USC §§ 200 – 212)**

12 December 1980

# Invention Reporting: A Brief History

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# Invention Reporting: A Brief History

## Bayh-Dole Act

1940s

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1960s

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“Possibly the most inspired piece of legislation to be enacted in America over the past half-century...”\*

\*Source: *The Economist*, 2002.

# Invention Reporting: A Brief History

## **Bayh-Dole Act**

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➤ **Disclosed Inventions**

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- **Decisions to discontinue process**

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**and...**

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The recipient institution may retain rights to inventions arising from federally-sponsored research, **providing that the recipient institution acknowledges the government's right to a royalty-free license to the invention when deemed in the interest of the United States (march-in rights).**

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The recipient institution may retain rights to inventions arising from federally-sponsored research, **providing that the recipient institution shares the financial benefits of licensing the discovery with the discovering scientist.**

# Invention Reporting: A Quick Overview

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# Invention Reporting: A Quick Overview

✓ Pre-Disclosure (IPA)

➤ At Invention Disclosure

Page: 3 of 4 Automatic Zoom

(Enclose drafts, abstracts, pre-prints)

**11. Public Use or Sale:** Has there been any public use or sale of products embodying the invention?

If "Yes," describe, giving dates: \_\_\_\_\_

**12. Related Developments:** Are you aware of related developments by others? If "yes", please give citations. Copies of any relevant patents or publications would be appreciated.

\_\_\_\_\_

**13. Sponsorship:** If the research that led to the invention was supported by extramural funding, such as a grant from the National Institutes of Health, or involves the use of tangible research material provided by another university or company, please provide the information below.

Sponsor Name: _____	Grant/Agreement Number or Date: _____
Sponsor Name: _____	Grant/Agreement Number or Date: _____
Sponsor Name: _____	Grant/Agreement Number or Date: _____
Provider Name: _____	MTA/Agreement Number or Date: _____
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# Invention Reporting: A Quick Overview

- ✓ Pre-Disclosure (IPA)
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- ✓ Pre-Disclosure (IPA)
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- **At patent filing (non-provisional)**
  - Government Clause**

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- **At patent issuance**

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- **When product becomes publicly available**
  - **And every year thereafter (Utilization Report)**

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- **Whenever we cease moving the technology forward**

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- ✓ At patent issuance
- ✓ At technology licensing
- ✓ When **product becomes publicly available**
  - ✓ And every year thereafter (Utilization Report)
- ✓ Whenever we cease moving the technology forward
- **Other (sub-licensing, 3<sup>rd</sup> Parties, etc.)**

# Invention Reporting: A Quick Overview

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**Who does all of this?**



The Bridge from Science to Success  
**Technology Transfer**

**We do!**

So . . .

# Invention Reporting

# Invention Reporting

**What Is It?**

# Invention Reporting

**What Is It? And Why Should I Care?**

# Invention Reporting

**What Is It? And Why Should I Care?**

**When it is time to close out a grant, YOU will be asked to provide information related to Invention Reporting.**

# Invention Reporting

**The funding agency will want to know if**

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**The funding agency will want to know if**

- **Any discoveries (inventions) arose from the research**

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- **Details, details, details**

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**If you contact us, we can provide **ALL** of the requested information in a matter of minutes.**

# Invention Reporting

**The funding agency will want to know if**

- ✓ Any discoveries (inventions) arose from the research
- ✓ Any patents were filed on the discoveries
- ✓ Details, details, details

**If you contact us, we can provide **ALL** of the requested information in a matter of minutes... assuming proper procedures have been followed all along.**

# Invention Reporting

# Meliora!

# Invention Reporting

## Additional Resources:

- Office of Technology Transfer 585.276.6600
- [OTT Web site](#)
- [General Invention Reporting Information](#)
- [Invention Reporting Timeline](#)
- [20 Questions About Invention Reporting](#)
- [Bayh-Dole Act \(37 CFR 401\)](#)