Subject: Intellectual Property Procedures

Authority: U.S. Constitution, Article 1, Section 8, Clause 8; Bayh-Dole Act, Volume 37 of Code of Federal Regulations Part 401; Florida Statues, Sections 1004.23 and 1001.74; and Board of Governors Strategic Plan

Date: 07/25/05

Related References

Purpose: To establish procedures for the transfer of research results and other novel developments to commercial markets.

Signature of Approving Authority

Procedures Statement and Purpose:

Florida Agricultural and Mechanical University requires all employees and students to assign title of intellectual property to the institution. Therefore, each employee and student has the primary responsibility to ensure compliance with these procedures. In accordance with Florida Statues, Sections 1004.23 and 1001.74 and as stipulated in the Action Plan by Florida Agricultural & Mechanical University (herein after “FAMU” or “University”), strict adherence to these procedures is required.

These procedures guide faculty (including adjunct professors), researchers, staff, students, other persons employed by FAMU and other persons who utilize FAMU’s resources to assist with disclosure and protection of intellectual property. Whenever possible and feasible, FAMU will seek patent, copyright, trademark and trade secret protection for FAMU faculty, staff and students. The scope of these procedures includes collaborations with individuals, small businesses, corporations, non-profit organizations and government agencies.
I. Definitions:

A. The Bayh-Dole Act:
   The Bayh-Dole Act allows universities to elect to take title to inventions that emanate from projects funded by federal agencies.

B. Non-Disclosure Agreement (NDA):
   The NDA is a legal agreement where parties agree not to disclose confidential information. Once this form is completed by the receiving party, it should be sent to the Office of Technology Transfer, Licensing and Commercialization (hereafter known as TTLC) immediately for review, processing into the electronic database and execution by FAMU.

C. Docket Number:
   A number assigned to each invention disclosure that is submitted to the TTLC.

D. Intellectual Property:
   Intellectual property is property, other than personal or real, that has been created in the mind and is capable of being expressed in a tangible form.

E. Intellectual Property Review Committee (IPRC):
   The IPC is a five member committee responsible for objectively assessing the merits of all University employees’, students’ and external collaborating partners’ inventions.

F. Initial Meeting:
   The first meeting that the inventor has with the TTLC before presenting the invention to the IPRC is called the initial meeting.

G. Invention Disclosure Form (IDF):
   The IDF is an electronic form that all university employees, students and external collaborating inventors must complete and submit to the TTLC. The form allows for a description of the invention and provides pertinent information regarding the invention. The on-line form when completed will be automatically forwarded to TTLC.

H. Royalty Revenue:
   Royalty revenue is revenue generated from the sale or use of university inventions, trademarks, copyrights or other intellectual property.

I. Issue Fee:
   The issue fee is the amount assessed by the United States Patent and Trademark Office (hereafter referred to as USPTO) an invention is deemed patentable. The fee must be paid before the Patent Office will grant a U.S. Patent to an inventor.
J. **License:**
   A license gives the right to someone, other than the patent owner, to make, use, sell or offer to sell a patented invention in the United States.

K. **License Agreement:**
   A license agreement is a legally enforceable contract between a patent owner “licensor” and a third party “licensee” which sets forth the terms of the agreement.

L. **Maintenance Fee:**
   A maintenance fee is an amount assessed by the USPTO that must be paid three times during the life of a U.S. Patent. The first payment must be paid in the fourth year after the patent is issued. The second and third payments must be paid in 8th and 12th years after the patent is issued. Failure to pay maintenance fees timely will cause the patent to expire and become unenforceable in court.

M. **Net Income:**
   Net income is revenue generated by the assignment or license of university patents less all expenses or costs related to acquiring, protecting, licensing and marketing FAMU’s intellectual property.

N. **U.S. Patent:**
   A U.S. patent is a legally enforceable document that gives the patent owner the right to exclude others from using, making, selling or offering to sell the invention. It is valid for twenty years (20) from the date of filing a patent application.

O. **Non-Provisional Patent Application:**
   A non-provisional patent application is a legal document that requests the USPTO to grant a U.S. Patent that will be used to exclude others from using, making, selling, or offering to sell the invention.

P. **Provisional Patent Application:**
   A provisional patent application is a patent application that has no legally enforceable rights. It allows the inventor to file a legal adequate description of the invention in the USPTO in order to obtain an early filing date. Provisional patent applications allow inventors up to one year to seek funding before expending too many resources for an invention that cannot be patented or commercialized. These applications are relatively inexpensive.

Q. **Novelty:**
   Novelty is a basic requirement for patentability. All inventions must be new before the Patent Office will issue a U.S. Patent.
R. **Obviousness:**
Obviousness is a basic requirement for patentability. The USPTO will issue a U.S. Patent on inventions that are not completely new, but are innovative and have non-obvious improvements over existing technologies.

S. **Prior Art:**
Prior art is any printed publication or patent that pre-dates an invention.

T. **Copyright:**
A copyright is a means for protecting original works that are fixed in a tangible medium of expression. Protection is provided for documents such as technical reports, theses and dissertations. Copyright protection provides the original author with the right to exclude others from copying, distributing or creating derivative works.

U. **Trademark:**
A trademark is a name, logo or slogan that is used to add value and/or recognition to an item or business.

V. **Trade Secret:**
A trade secret is any formula, pattern, device, process, tool, mechanism or compound that is valuable to the developer but has not been protected by a patent and not generally known to others.

W. **University Research:**
University research is any research or development activity which is directly or immediately related to the duties or responsibilities for which a person is compensated by FAMU or one of its units or concluded with more than an insignificant use of facilities or equipment provided by FAMU or one of its units.

X. **Utility:**
Utility is one of three basic requirements for patentability. All inventions must be useful. In most cases, the USPTO will assume that an invention is useful for some purpose unless it clearly falls within the scope of those things that the Patent Office has deemed to lack utility such as: mathematical algorithms.

II. **Roles and Responsibilities:**

A. **The Office of Technology Transfer, Licensing and Commercialization:**
The Office of Technology Transfer, Commercialization and Licensing (hereinafter “TTLC”) has the primary responsibility for facilitating the commercialization and management of intellectual property, including published works, by faculty, staff, students and collaborating partners. Specifically, the office assists with the disclosure, evaluation and
protection of all inventions including, but not limited to, patents, copyrights, trademarks, service marks and trade secrets. A very important role of TTLC is identifying commercial partners to which FAMU technology will be licensed. The TTLC directs all patent and marketing activities and manages all license negotiations with entities outside of the University.

When an inventor thinks that an invention may have commercial potential, the TTLC should be contacted by telephone, e-mail or by visiting in person to discuss a disclosure. This should be done promptly particularly before submitting a manuscript for publication, presenting at meetings, conferences, seminars or symposia and prior to divulging the development by any other means to anyone. Failure to disclose development in a timely manner could jeopardize the inventor’s right to the invention. Developers of new or novel processes, products, strategies or services are strongly encouraged to contact TTLC to discuss a new or novel idea in the early stages of the invention that appears promising even if the development is not yet completely defined. Specific steps for disclosing may be found on page 11 of this Manual.

TTLC is responsible for reviewing all contracts, licenses, research and confidentiality agreements with all external entities regarding University discoveries and inventions. Because most agreements will include ownership clauses regarding intellectual property ownership, the TTLC and the Office of General Counsel must review each document to protect the interest of the University and the researcher.

III. Legal Authority:

A. The Bayh-Dole Act:
Volume 37 of Code of Federal Regulations Part 401 permits universities to retain ownership in all inventions and discoveries funded with federal funds.

B. Florida Statutes:
Section 1004.23 and 1001.74 of the Florida Statutes authorizes the University “to secure, protect, license and otherwise exploit letters of patent, copyrights, trademarks, and otherwise deal with the work product of University personnel.”

In addition, “University personnel who discover, invent, create or design a product, method or idea while associated with the University must cooperate with the University in defining and establishing the rights of such product, methods or idea. This obligation extends to any invention, creation or discovery, whether or not made on University time or with or without University facilities.”
C. University Authority:
The Vice-President for Research shall have the primary responsibility for the implementation of this policy on behalf of the University. All or a portion of the activities affected by this policy may be delegated by the Vice-President of Research to the Director of the TTLC.

IV. Scope of Policy:

This policy shall cover all inventions made by University employees, students and external collaborating partners during the course of their employment, enrollment or collaboration at the University. However, employees, students of the University and collaborating partners who may have created inventions on their own time and with their own resources may also wish to submit their inventions or ideas to the University.

In order to protect all University inventions, all full-time faculty, researchers, staff and students must submit developments and receive prior approval from the Dean of the College and the TTLC before publishing or disclosing to any non-University source.

V. Duration of Policy:

The policy applies to all University employees, students and collaborating partners beginning with the date of employment, enrollment or involvement and is effective for all inventors. The obligations under this paragraph are effective without regard to an inventor’s status when an Invention Disclosure is completed or processed.

VI. Ownership:

FAMU owns all inventions developed or made utilizing University resources, including government or University sponsored research by faculty, staff, students and collaborating partners. University employees and students are required to assign their rights to their inventions and discoveries to the University. The same applies to collaborating partners unless the targeted technology was developed prior to the collaboration. All new employees and students must agree to assign their inventions developed during employment and/or enrollment to the University complete. All assignments must be executed prior to the University seeking legal protection. All other employees must execute assignment forms at the point of contract renewal. In any event, the Office of TTLC will not process or pursue legal protection for an invention prior to receiving an executed copy of the assignment form.

If the inventor believes that the University has no ownership interest in the invention, a determination must be made by the Dean of the College and the TTLC as to whether the University agrees with the determination of the inventor. In all cases where the University has no rights or waives its rights to
In the event that FAMU collaborates with corporations or certain other private entities regarding joint research projects conducted primarily at FAMU, the University will retain all rights to the inventions and discoveries. If, however, FAMU inventions are the results of sponsored research and the sponsor retains ownership in the inventions or discoveries, FAMU will negotiate a nonexclusive, royalty-fee license from the sponsor.

All FAMU employees who have obtained prior approval to engage in consulting work for external organizations must also seek a waiver from the University for inventions created during the course of the consulting agreement. FAMU retains an ownership interest in all inventions resulting from consulting activities where an employee failed to obtain prior approval from the University.

VII. Royalty Distribution:

In exchange for the rights of the inventors, the University will share a portion of the royalty proceeds with the inventors. The net income to the University from any royalty agreement or any agreement resulting from an invention shall be distributed as follows: 40% to the inventor(s) and 60% to FAMU (10% of the University's share will be distributed to the College and 10% to the Department where the development originated). For schools and colleges where there are no departments, 20% will be distributed to the unit.

If more than one inventor has contributed to the invention, those inventors shall be allocated equal amounts of the 40% inventors share unless otherwise agreed in writing. Any agreement modifying the distribution of income among the inventors must be approved by the TTLC, the Vice President for Research and the Office of General Counsel at the time the assignment is made, otherwise the distribution will be made in accordance with the above stated University policy.

Royalty payments will be paid to the inventor without regard to employment or enrollment status at the time of the distribution. If an inventor passes before the royalty period terminates, royalties due to the decedent shall be paid to the Inventor’s estate or other designee(s) for the royalty period.

VIII. Student Inventors:

Inventions created by students will remain the property of the students except when an invention is made in the course of employment at FAMU, or is made utilizing University Resources from work directly related to work performed under a grant or other sponsorship, or undertaken with other inventors who may have a duty to assign such work to FAMU. Any invention arising from a thesis or dissertation submitted as part of a requirement for a degree is
subject to this policy. In such case, when a student is obligated to assign rights to the University, the student will share in the distribution of royalties in the same manner as faculty unless otherwise stated in a written agreement.

When University employees, students or collaborating partners determine that an invention or other intellectual property has been developed on University time or with University resources, contact with the TTLC should begin by completing an Invention Disclosure Form and an Assignment Form.

IX. Intellectual Property Review Committee:

The Intellectual Property Review Committee (IPRC) is composed of five members from various Colleges and representatives from the TTLC. The IPC’s primary function is to objectively assess the merits of the invention and to determine whether the University has an interest in seeking some form of legal protection for the development. The Director of TTLC will attend all IPRC meetings, but will not participate in the vote unless there is a tie. In order to have a quorum, at least three of the five members must be present. A proper quorum is required before any decisions can be made regarding an invention. If certain members cannot be physically present, telephone or video conferences are acceptable provided that the absent members have all of the supporting documentation describing the invention at the time the vote is cast.

The IPRC shall also review and render an opinion on whether or not the unit should copyright published works submitted by employees, students and collaborating partners.

X. Decision of the Intellectual Property Review Committee:

All decisions made by the IPRC will be in writing and sent directly to the inventor and the Dean of the College within two weeks after the IPC meeting. The Director of TTLC will summarize the Committee’s decision and any recommendations for moving forward with the process. Each Committee member’s vote is confidential and will not be included in its written decision.

The IPRC can make one of three recommendations:

1) TTLC move forward and patent the invention;

2) The invention is not ready for patenting and suggest that the inventor(s) continue the research and come back before the Committee within a stated period of time for reconsideration; or

3) The University may waive its rights to the invention and permit the inventor to pursue the invention without University funding. In the event that the Dean of the College or the Inventor is dissatisfied with the decision of the IPRC, an appeal for reconsideration may be
submitted, in writing, to the Director of TTLC within two weeks of the written decision by the IPRC. An inventor has the right to seek reconsideration by the IPRC no more than two (2) times following the original decision.

If the IPRC votes to pursue patent protection for the invention, a provisional patent application will be filed with the USPTO as soon as practicable. Within one year of filing the provisional patent application, the TTLC (or an external legal entity) will file a non-provisional patent application with the USPTO. If the patent is allowed, the University will pay the issue fee and all maintenance fees to keep the patent in force for the entire patent term.

In the event that the University decides to abandon the invention, the University will notify all parties with an interest in the invention, within a reasonable time, before taking such action. The University may opt to waive all of its rights in the invention or some of its rights. If a partial waiver is appropriate, the University will negotiate a written agreement with the inventor regarding the University’s interest in the invention.

XI. The Protection Process:
The intellectual property protections process involves ten very important and distinct steps. All University developments will be subject to the following procedures:

1) The inventor must arrange a preliminary meeting with the staff of the TTLC (The purpose of this meeting is to discuss the idea with the TTLC staff).

2) The next step is the beginning of the assessment phase of the invention. Before the University expends substantial resources on certain inventions, the staff, in collaboration with the Intellectual Property Review Committee (IPRC), must objectively determine whether the University will support the development.

3) Once the docket number has been assigned, the TTLC staff will schedule an initial meeting with the inventor to outline and explain the protection process including how the inventor will be expected to interact with the TTLC during the disclosure process. The purpose of this meeting is to prepare the inventor for the meeting with the IPRC.

4) The Director of TTLC will outline the assessment, patent and licensing phases of the process for the inventor. If the inventor attached evidence of prior art to the form, a discussion regarding the technical aspects of the patent or publication will be necessary.

5) These steps are called the Disclosure phase. During this phase, the inventor is expected to share any and all relevant information with the TTLC staff.
6) If the TTLC staff reviews the submission and makes the decision to pursue protection for the development, the inventor must complete an Invention Disclosure Form. The inventor is expected to actively participate in this phase. The disclosure process begins when a University employee or student submits an Invention Disclosure Form to the Office of TTLC. The form should be as complete as possible and all supporting documentation must be attached. This is a very important aspect of the process because it clearly documents the period which an invention was conceived or made. All forms may be picked up from the Office of TTLC or downloaded from the website (www.research.famu.edu/tt/).

7) The TTLC staff will assign a docket number once a complete disclosure form is received and the supporting documentation is attached.

8) The inventor must participate in the assignment phase by presenting or completing an assignment form.

9) At this point, the inventor stays fully engages in the protection phase and works closely with the TTLC staff to pursue a patent, copyright, trademark and or trade secret protection for the invention.

10) After the protection phase the Office of TTLC will begin to develop a marketing and licensing Strategy for approaching entities external to the University.

XII. Processing a Patent Application:

Once the disclosure form is received, the supporting documentation is attached and the docket number has been assigned, the TTLC staff will schedule a meeting with the inventor to outline and explain the patent process including how the inventor will be expected to interact with the Office of TTLC during the application process. The purpose of the initial meeting is to prepare the inventor for the discussion meeting with the IPRC. The Director of Office of TTLC will review and discuss the information contained on the Information Disclosure Form.

The inventor will be given sufficient time to prepare for the meeting with the IPRC. This committee will decide whether patent protection is appropriate following a presentation made by the inventor before the Committee. If the IPRC determines that a patent is the best mechanism for protecting the University’s interest in the invention, the patent application process will begin.

In the unlikely event that the inventor has already disclosed the invention, the Director will expedite the meeting with the IPRC.
XIII. Assessment:
At this point a meeting with the IPRC will be scheduled to discuss the technical merits of the invention and all potential commercial aspects of the invention that may be relevant. During the meeting, the inventor will be expected to answer questions regarding the patentability of the invention. The inventor is expected to have at least conducted a literature search on the invention and possibly a preliminary patent search prior to completing the disclosure form. The literature and patent searches are necessary for objectively evaluating the novelty of the invention before expending University resources on a development that might not warrant protection. While a cursory search may not be definitive on the issue of novelty, it can assist in assessing the commercial value of the invention if protection is warranted. A more in depth prior art search will be conducted by the Office of TTLC through an external search firm.

The USPTO will assess the patentability of a development by answering three basic questions regarding the invention according to 35 U.S.C. §§ 101-103. The first question is whether the invention is useful. The invention must have some utility before a patent can be granted. Utility is generally assumed because most inventions are useful for something. The second question is whether the invention is novel. Novelty can be easily determined by reviewing other patents and publications related to the invention. Thirdly, the Patent Office determines whether the invention is obvious by reviewing patents and publications. If the inventor satisfies these basic requirements for patentability, the Patent Office will generally issue a patent as long as other minor provisions are also satisfied.

XIV. The Patent Process:
Making an application for a patent is a critical step for all parties involved. The patent process is very time consuming and very expensive. Once the invention moves into this aspect of the process, the University will begin committing resources for the patenting and licensing of the invention. To begin the process, the Office of the TTLC will need to engage the services of a patent attorney to draft the patent application.

There are two types of patent applications that can be filed. One is the provisional patent application and the other is a non-provisional patent application. In most cases, the University will first file a provisional patent application with the United States Patent & Trademark Office. The provisional patent application is very simple and often easy to file which allows the University to begin seeking out potential commercial partners to assist in exploiting the invention. The provisional application expires after one year. If the University fails to file a non-provisional application, the invention is abandoned.
The inventor is expected to assist the patent attorney with preparing the patent application. The inventors are required to contact TTLC prior to contacting the patent attorney directly. All correspondence will be sent directly to the TTLC and then forwarded to the inventor(s).

The second type of patent application is the non-provisional application. After this application is filed, it will be examined in the USPTO to determine the patentability of the invention. During the prosecution of the patent, the Patent Office will send several pieces of correspondence to the patent attorney. The most important piece of correspondence is called an **Office Action**. An Office Action is a document stating whether or not the inventor is entitled to a patent. If the invention is not patentable, the Office Action will clearly set forth the reasons for the rejection. Generally, several rejections will be outlined in the Office Action. Once the patent attorney receives an Office Action containing rejections, the Director of the Office of TTLC and the inventor will be contacted to discuss the merits of the rejection. If feasible and convenient, a meeting will be scheduled at the TTLC with the inventor and patent attorney to discuss responding appropriately to the Office Action. The Patent Office will send all correspondence regarding the invention to the patent attorney. The patent attorney will contact the TTLC to discuss the invention. If necessary, the patent attorney will contact the inventor directly to assist with preparing a response to the Office Action. The patent process is lengthy and can take up to two years before a patent is issued or longer if an appeal is filed.

**XV. Record Keeping:**

Each inventor should keep detailed records, preferably in bound notebooks, of the progress of the research and development of any project, which is worked upon. The records are evidence that may be needed later to **prove inventorship**. Ideally the most significant records should be witnessed (i.e. read, signed and dated) by someone who is familiar with the research, but is **NOT** a co-inventor.

**XVI. Licensing and Marketing Strategy:**

If the IPC has decided that the invention will be patented and after a patent application has been filed, the Licensing and Marketing personnel will begin efforts to seek commercial partners. The TTLC staff will develop a comprehensive strategy designed to generate and establish commercial interest in the University invention. If a company has expressed an interest in the basic invention, a confidential disclosure form must be completed and returned to the TTLC. All commercialization agreements must be reviewed by the Office of General Counsel before forwarding to the President of the University for approval.
XVII. FAMU-FSU College of Engineering:

The following statement sets forth guidelines for the ownership and assignment of intellectual property for all faculty, students and employees of the FAMU-FSU College of Engineering (CoE).

A. Invention Disclosure and Ownership for Inventors from the Same University

1) Faculty members in the FAMU/FSU COE are required to disclose their inventions to the Technology Transfer Office at the University that is responsible for administering funding for the research. The intellectual property will be owned by the university where the invention is disclosed.

2) If there are no external funds, disclosure will be made at the University where the faculty member is employed. The intellectual property will be owned by the University where the invention was disclosed.

B. Invention Disclosure and Ownership for Inventors from the Different Universities:

3) (a) Where there are two or more inventors representing different Universities, an Invention Disclosure Form will be filed at the institution responsible for administering the external research funds. The same University shall be responsible for obtaining protection, negotiating any agreement for the commercialization of the technology or intellectual property and distributing proceeds to the non-prosecuting university. However, Federal and State laws will govern joint ownership. Absent any prior agreement between the universities regarding the distribution of funds, all proceeds shall be divided equally between the universities.

   (b) Where there are two or more inventors representing different Universities and there are no external research funds for the project, an Invention Disclosure Form will be filed at both institutions. In this case, Federal and State laws will govern joint ownership of the intellectual property. Subsequently, the Directors of Technology Transfer will meet to determine which University will file and prosecute the patent application and agree upon the distribution of proceeds. Absent any prior agreement between the universities regarding the distribution of funds, all proceeds shall be divided equally between the universities.

C. Reporting Requirements:

4) Each institution will provide:
   (a) An annual report of intellectual property activities and costs;

   (b) A copy of every Invention Disclosure Form received from faculty employed by the College of Engineering must be shared with the non-
receiving University. The Disclosure Form must be sent to the non-receiving University within three business days after disclosure is made to the University; and

(c) Each institution is required to report to the other institution the number of disclosures submitted by the COE faculty.

D. Patent and Licensing Fees:
  5) Each institution will be required to submit an assessment of patent related costs to the non-prosecuting technology transfer office within 90 days after the end of the fiscal year. All outstanding fees related to the protection of discoveries/inventions are due within 90 days after the end of the fiscal year.

E. Royalty Distribution:
  6) Each University will make royalty and or other cash distributions annually. All payments will be sent directly to the Technology Transfer Office within 90 days after the end of the fiscal year.

F. Prior Intellectual Property Agreements:
  7) This Agreement does not change the rights or obligations of either University regarding invention disclosures made anytime prior to the effective date of this Agreement.

XVIII. Trademark Protection:
A trademark can be a name, symbol, color or combination of words in connection with a product that is used or will be used in commerce. Trademark protection lasts as long as the mark is used.

XIX. Trade Secret Protection:
It is within the sole discretion of the University to keep certain discoveries and inventions as a trade secret and not seek patent protection. When appropriate, the Office of TTLC will maintain a legally sufficient description of the invention. The Office of TTLC will take whatever means necessary to ensure the confidentiality of the invention including obtaining non-disclosure agreements from all parties with knowledge of the secret.

XX. Copyright Protection:
Absent a federal law, state law, contractual agreement or written employment obligation prohibiting ownership of copyright materials, all copyrights obtained by University employees and students remain the property of the creator unless the work was created as work for hire.

In the event that a work is considered patentable and copyrightable, the author/inventor of the work will be governed by the patent policy as outlined.
XXI. Forms:

A. Confidential Disclosure Form (CDA)

B. Invention Disclosure Form

C. University Assignment Form (with Notary Forms)

D. Intellectual Property Review Committee Assessment Form

E. University Waiver Form
A. CONFIDENTIAL DISCLOSURE FORM (CDA)

Subject Matter: _____________________________

Date of Disclosure: __________________________

The undersigned acknowledges and agrees, individually and on behalf of their respective companies or employers, that all disclosures, discussions, demonstrations and exchanges of information taking place between the undersigned and the representatives of Florida Agricultural and Mechanical University on this day and all subsequent disclosures, discussions, demonstrations and exchanges of information relating to the above subject shall be confidential; that the information is proprietary to Florida Agricultural and Mechanical University and _____________________ , the developer of the__________________________ ; and, that the information shall not be disclosed or duplicated in any way, except upon prior written consent of Florida Agricultural and Mechanical University and _________________________

Name_____________________________________
Company and/or Employer:________________________
Title Held:_____________________________________
Date:____________________________
B. INVENTION DISCLOSURE FORM
FLORIDA AGRICULTURAL AND MECHANICAL UNIVERSITY
OFFICE OF TECHNOLOGY TRANSFER, LICENSING AND COMMERCIALIZATION

1. Title of Invention

2. Inventors
   Name
   Department
   Home
   Home address
   City
   State
   Zip Code
   Citizenship
   Work phone
   Fax
   Home phone
   Email

   Name
   Department
   Home address
   City
   State
   Zip Code
   Citizenship
   Work phone
   Fax
   Home phone
   Email

(if more than two inventors please use additional sheets)

3. Brief Description of the Invention
   (Attach the Detailed Description of the Invention)
4. **Date of Invention**  
(Attach copies of any document that illustrates the date of invention such as lab notebooks or dated photos).

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5. **Date Reduced to Practice (Has the invention been made?)**  
Is test data available? **Yes/ No**  
If so, please attach copies

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6. **Purpose of the Invention**

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7. **What work remains to complete development?**

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8. **Has the invention been published?**  
If so, when?  
Name of publication(s)  
Attach copies of article or abstract.

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9. **Has the invention been disclosed to anyone other than a FAMU employee?**  
(Oral Presentation, Poster or other)  
Date of Disclosure  
Name of Disclosing Party  
Provide contact information for each person that has knowledge of the invention  
(If more than one, please attach additional sheet).

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10. List all relevant prior art publications

11. List all relevant patent numbers

12. **Source of Funding** (If more than one, please attach others)
   - Government
   - Agency/ Company/ Foundation
   - Contract/ Grant #
   - Contact Person
   - Address
   - City
   - State
   - Zip Code

13. **Licensing Opportunities:** Do you know of any organizations or companies that would be interested in licensing the invention? Yes/ No
   If so, provide the following information.
   - Name
   - Company/University
   - Address
   - City
   - State
   - Zip Code

14. **Signatures**
   - Inventor
   - Date
   - Inventor
   - Date
15. **Approved by:**

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| Dean                  |  
| Date                  |  

C. UNIVERSITY ASSIGNMENT AGREEMENT (with Notary Forms)

This agreement is entered into as of this ____ day of _________, ______ by and between Florida Agricultural and Mechanical University (FAMU), acting for and on behalf of the FAMU Board of Trustees an educational institutional public body corporate, existing under the laws of the State of Florida and having offices at Tallahassee, FL (hereinafter called “University) and __________________, Inventor of the College/Institute of ______________ at Florida Agricultural and Mechanical University hereinafter referred to as “Inventor”.

WITNESSETH:
WHEREAS, Sections 1001.74(26) and 1004.23, Florida Statutes (2003) empowers the University to consider contributions by employees in the development of inventions and patents and enter into a written contract with such personnel establishing the interests of the personnel and University in the invention and patent;

WHEREAS, the inventor is a faculty member in the College/Institute of ___________________ at this University and has developed a _____________________ with potential commercial value, while employed by the University; (The said product is described in the Statement of Disclosure, attached as Exhibit A, and incorporated fully into this document by this reference); and

WHEREAS, the research undertaken by the inventor that lead to the development of the unique product was conducted using the facilities within the College of ________________.

NOW THEREFORE, the University and Inventor in consideration of the mutual benefits to be attained by the parties do hereby covenant and agree as follows:

(1) Definitions as used in this agreement:

(a) “Inventions” mean discoveries, concepts, and ideas whether patentable or not, relating to any present or prospective activities of the University regarding the New and Improved Drug including but not limited to processes, methods, techniques, and any improvements thereof, and

(b) “Net Profits” for purposes for this agreement, shall mean revenue received by the University from the manufacture, use, license, lease or sale of the invention, less all University expenses, including overhead, related to the invention.

(2) The inventor agrees to assign to the University all rights, title, and interest in the above identified product.
(3) The University agrees to seek patent protection of the New and Improved development in the name of the University, through its authorized representative.

(4) The University and Inventor agree to divide the net profits a on 60/40 (University/Inventor) basis including but not limited to financial proceeds from licenses, leases, assignments or any other written document executed by the University and any person (s), firms, or corporations for the manufacture, use lease, license, or sale of the product.

(5) The University would receive sixty (60%) of the proceeds in (4) above. Twenty (20) percent of its allocation will be set aside for the College/Institute or Department and forty percent (40%) of the net profit, after expenses, will be distributed to the Inventor(s).

(6) No compensation will be paid to the Inventor from the profits until the University has been reimbursed for its costs including, but not limited to, attorney fees incurred while seeking the trademark, copyright, patent or other protection. However, this is subject to the rights, if any, of the State of Florida and any Federal agencies which may be derived from sponsored research in the development or use of the “____________________”.

(7) The Inventor agrees to communicate to said University or its representatives (s) any facts known to them with respect to the development and to testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and re-issue application, and related documents; make all rightful oaths; and generally do anything necessary to [said] University in obtaining and enforcing proper protection of said development.

(8) The Inventor agrees to communicate and assist the University or its designees in obtaining, defending and enforcing patents, copyrights, or trademarks on a national and international basis, which are based upon or related to the invention.

(9) The Inventor shall not at any time, except as properly required, in the conduct of the normal business of the University or except as authorized in writing by the University, publish, disclose or use any information relating to any aspects of this invention.

(10) The Inventor, upon termination of employment with the University, shall promptly return to the University, all documents, records, notebooks, computer discs, and similar repositories containing any information related to the invention, including copies thereof within his possession, whether prepared by him/her or others. If at any time after the termination of employment, the Inventor determines that he/she has any information in his/her possession or control, regarding the invention, he/she shall immediately return to the University all of this information, including all copies and portions thereof.
(11) This agreement shall be binding upon the parties hereto and upon their respective heirs, executors, administrators, legal representatives, successors and assigns.

(12) This agreement is governed by the laws of the State of Florida. If any court of competent jurisdiction shall hold any provision of this agreement invalid or not enforceable, such holdings shall not invalidate or render unenforceable any other provision hereof.

(13) This agreement is effective on the undersigned date and can only be amended or terminated by mutual written agreement between the parties.

Entered into on this _______ day of _________________ _______ 20___ by Inventor and the undersigned representatives of Florida Agricultural and Mechanical University

_________________________  __________________________
Date       Inventor

_________________________  __________________________
Date       Inventor
NOTARIZED STATEMENT FOR PROFESSOR

I hereby certify that on this day before me, a Notary public duly authorized in the State of Florida and Leon County to take acknowledgements, Inventor personally appeared, known as the Professor of ______________ at Florida Agricultural and Mechanical University who executed the foregoing instrument for the uses and purposes therein expressed, and acknowledged before me that he/she executed this statement willingly and without undue influence.

Witness my hand and official seal in Leon County, Florida above on this day of __________, 20___

__________________________
Notary Public

My Commission expires:
NOTARIZED STATEMENT FOR THE PRESIDENT

I hereby certify that on this day before me, a Notary public duly authorized in the State of Florida and Leon County to take acknowledgements, __________________ personally appeared, known as the President of Florida Agricultural and Mechanical University, or her/his Designee who executed the foregoing instrument for the uses and purposes therein expressed, and acknowledged before me that the agreement was executed in the name of Florida Agricultural and Mechanical University, and that __________________ or her/his designee has statutory authority to bind said University.

Witness my hand and official seal in the Leon County, Florida on this day of ___________________________, 20____

________________________
Notary Public

My Commission expires:
D. Intellectual Property Committee Assessment Form

Name of Inventor(s):________________________________________

Title of the Invention________________________________________

_________________________________________________________

Docket Number____________________________________________

Assessment Criteria:

1. Is there sufficient information to evaluate the invention?

2. Is the invention substantially complete?

3. Based on the literature provided by the inventor, do you think the invention is novel? If not, please explain.

4. Based on the patents provided by the inventor and the TTLC, is the invention different from what is known? If so, explain.

5. Does the invention solve a particular problem or enhance an existing technology?

6. What is the commercial potential for this invention?

7. Have the results of the research been documented and substantiated by others in the department or industry?

8. How would you assess the licensing potential of the invention?

9. What is the Committee’s recommendation?

_____ TTLC should seek patent protection.

_____ Inventor should continue the research and return at a later date for reconsideration

_____ University should execute a waiver form relinquishing rights to inventor