

Disclosing the Unexpected: The Invention Disclosure Process

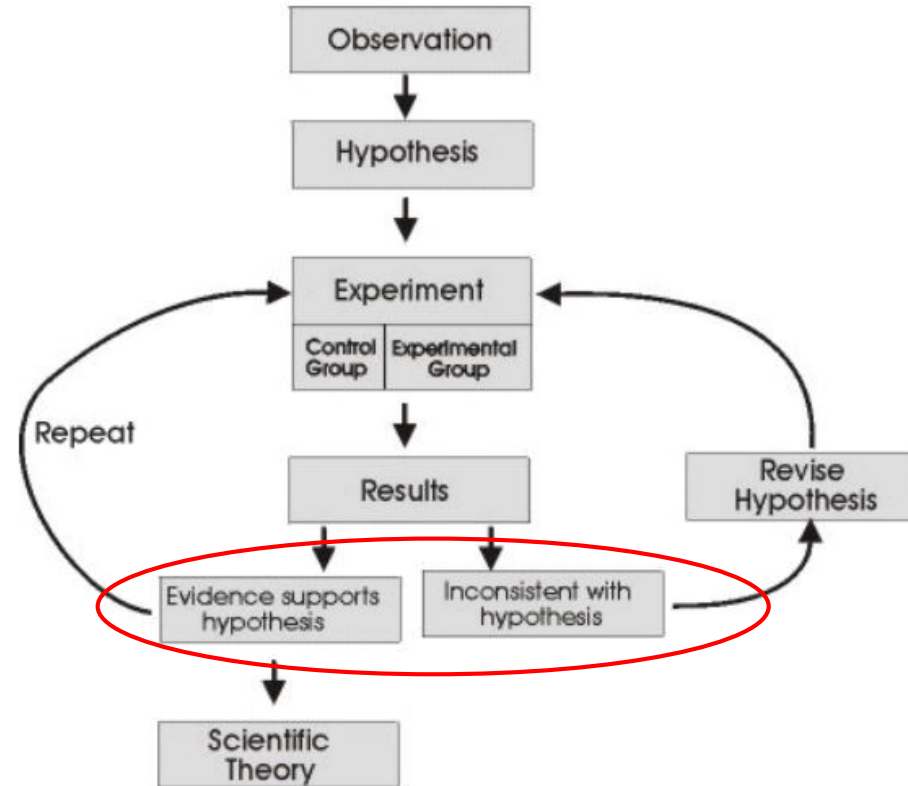
Benjy Neymotin, Ph.D.

Assistant Director

Office of Biotechnology and Business Development

August 21, 2019

Experiments should explain observations



Results and data are valuable

Results and data provide:

- Answers to questions
- Ideas and direction for future investigations
- Tangible materials
- Unexpected outcomes

Have I invented something?
Will it be useful for others?
Is this of commercial value?

Invention Disclosure Form!!!

The Invention Disclosure Form is used to evaluate a technology



For Office Use Only
Date of Receipt: Click or tap here to enter text.
Invention Disclosure No.: Click or tap here to enter text.
Upcoming Publication? Click or tap here to enter text.
Anticipated Date? Click or tap to enter a date.

Invention Disclosure Form

[For Inventors: An Invention Disclosure should be made when something new and useful has been conceived or developed or when unusual, unexpected, or non-obvious research results have been achieved that may have commercial value. The purpose of the Invention Disclosure Form is to permit evaluation of an invention to determine whether commercial development is feasible and whether the invention is patentable. The invention should be as clearly described as possible. Information that helps evaluators appreciate the invention will increase its ultimate chances for successful licensing and commercialization.]

The timing of an invention's public disclosure is a controlling factor in determining the invention's patentability. It is crucial not to publicly disclose any invention-related information to a person who is not under any duty to keep the invention a secret. Public disclosure includes, but is not limited to, a printed publication in any media form (e.g., a paper copy or an electronic copy on the internet), a demonstration or presentation to any third party, and a sale or an offer for sale.]

Where was the work supporting this invention conducted (please check all that apply)?

☒ Albert Einstein College of Medicine ☐ Montefiore Medical Center ☐ Other: Click or tap here to enter text.

If you checked **Albert Einstein College of Medicine**, submit your disclosure to the following address/email:

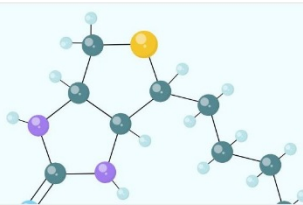
Secretary of the Patent Committee
Office of Biotechnology and Business Development
Albert Einstein College of Medicine
Jack and Pearl Resnick Campus
1300 Morris Park Avenue — Belfer 908
Bronx, NY 10461
biotech@einstein.yu.edu

If you checked **Montefiore Medical Center**, submit your disclosure to the following address:

Office of Research and Sponsored Programs
Montefiore Medical Center
3308 Rochambeau Avenue
Bronx, NY 10467

*If you checked both **Albert Einstein College of Medicine** and **Montefiore Medical Center**, please submit your disclosure to both offices.*

- Description of the invention
- Comparison to other relevant technologies
- Data showing how the invention works
- Information necessary for compliance obligations and for filing a patent



Invention description should be detailed

1. **Provide non-confidential descriptive title of the invention.** (brief title, preferably 20 words or less, that describes the invention and does not disclose confidential information)

Antibodies for treatment of condition Y

2. **What is the invention?** (provide a brief description of the invention)

New molecule and its uses

Known molecule for a new use

Disruption of a known pathway and its effects on condition Y

etc...

3. **How would you characterize the type or nature of the invention?**

☐ therapeutic, ☐ diagnostic, ☐ vaccine, ☐ device, ☐ reagent, ☐ software program, ☐ mobile application, ☐ platform technology for [Click or tap here to enter text.](#), and/or ☐ other: [Click or tap here to enter text.](#)

The benefits of the invention should be clear

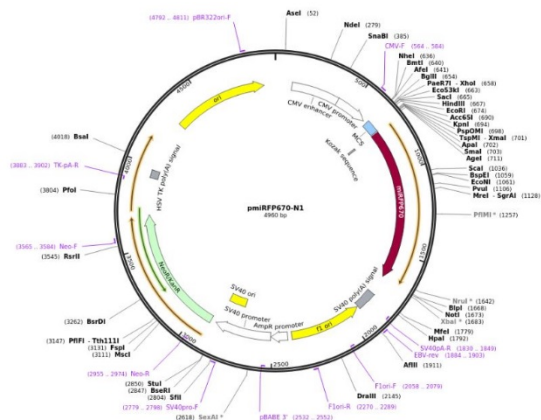
4. **What are the problems or needs the invention solves or addresses?**
5. **How does this invention differ from related technologies that have been published (including your own work) and/or are in clinical development and/or are on the market? And, how is this invention superior to those existing technologies?**
6. **What are the disadvantages, if any, of the invention and how might they be overcome? (e.g., prohibitive cost, problematic side effects, and/or other concerns)**

There should be potential for monetization

7. **What are the potential commercial uses of the invention? What is the “end product” that will eventually be sold/licensed?**
8. **What is the current stage of development of the invention and what additional work needs to be done before a company is likely to find the invention of interest?** (If there is more work to be done, please indicate the nature of the work to be done and how long it will take to complete, whether the necessary resources to do the work are available, and the milestone(s) that would trigger commercial interest.)
9. **What is the estimated market addressable by the invention?** (include potential number and type of end users/customers as well as potential annual sales)

Einstein monetizes technologies through out-licensing

- Patent applications for product development
- Tangible assets for internal research purposes



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Organization
International Bureau



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(81) Designated States (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BN, BR, BW, BY, BZ, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IR, IS, JP, KE, KG, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PA, PE, PG, PH, PL, PT, QA, RO, RS, RU, RW, SA, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TH, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW.

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Published:

— with international search report (Art. 21(3))

— with sequence listing part of description (Rule 5.2(a))

(88) Date of publication of the international search report:

25 February 2016



Einstein looks for the right commercial partner

10. **List companies that might have commercial interest in the invention and indicate why they might find it valuable.** (If there has already been contact with any of these companies, provide the relevant contact information, date(s) of the discussions, and indicate the nature of the discussions. Please note if these discussions were under the auspices of a previously executed confidentiality agreement.)



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Understanding the invention is critical

11. **Attach a confidential “detailed description” of the invention. The description is limited to 4 pages of text and additional pages of data/figures.** (Detailed description should clearly explain the essence of the invention so that it is easily understandable. Description should convey significance, novelty and utility of invention. Feel free to cut and paste from relevant publications, manuscripts, research proposals, etc. *If applicable, a self-contained manuscript/abstract/poster that fully describes and encompasses the invention may be attached as supplementary material; however, grant applications and/or multiple manuscripts that do not fully describe/support the invention cannot be accepted as supplementary material*)

“It is my ambition to say in ten sentences what others say in a whole book”*

An idea is born on a specific date

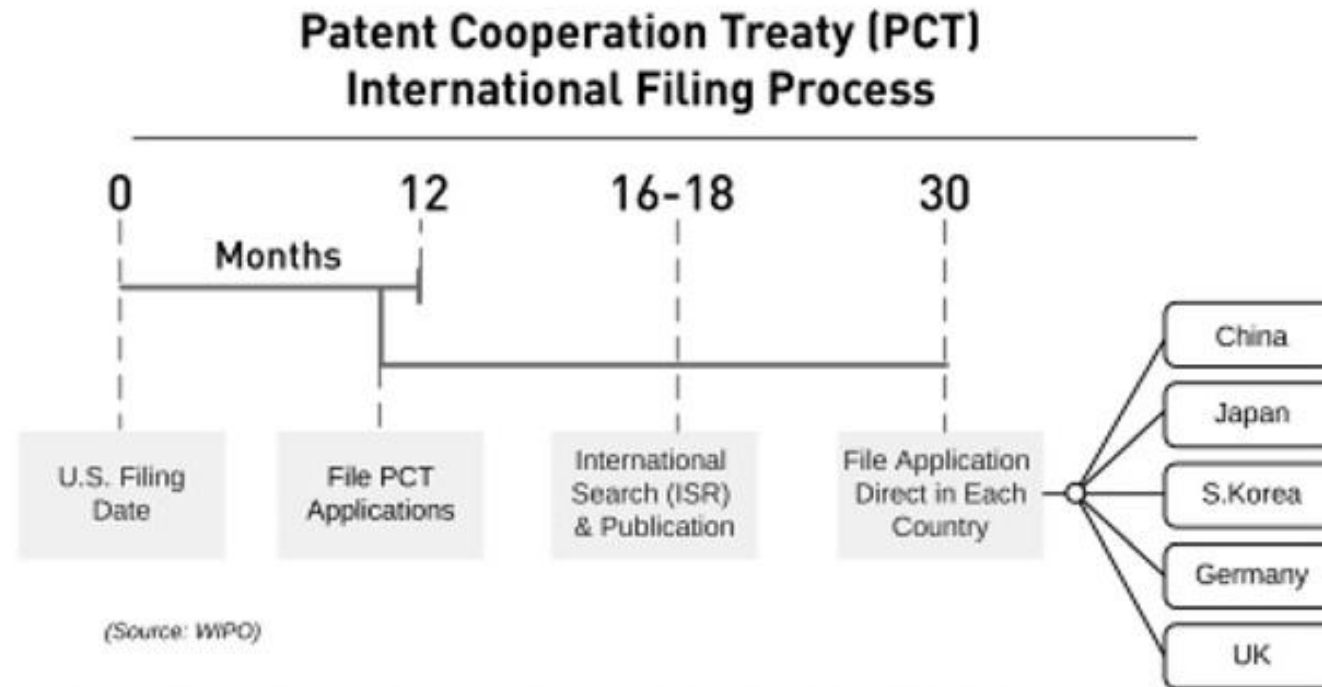
12. Provide date the invention was **conceived** (an invention has been “conceived” when a definite and permanent idea about an operable invention has been formed, and when one of ordinary skill in the scientific field of the invention can make the invention without too much additional research or experimentation):
13. Provide date the invention was **reduced to practice** (for example, for a device, when a prototype or model of the invention was created; for a method, when the method was performed and results were confirmed; for a reagent, when the reagent was produced or synthesized):

Let us know *before* you announce to the world

17. Please complete the following table to indicate **the public disclosure status of the invention (past or in the near future)**.

Status of abstract / presentation/ manuscript describing the invention (please provide copy of document if available)	Indicate yes or no	Date of submission and/or publication
Has an abstract already been submitted for a conference or presentation?	Choose an item.	Click or tap to enter a date.
Will an abstract be submitted for a conference or presentation in the next three months?	Choose an item.	Click or tap to enter a date.
Has a public presentation been given?	Choose an item.	Click or tap to enter a date.
Has an abstract or manuscript been submitted or posted on any websites?	Choose an item.	Click or tap to enter a date.
Has a manuscript been accepted for publication?	Choose an item.	Click or tap to enter a date.
Has a manuscript been published? Indicate online AND in-print dates.	Choose an item.	Click or tap to enter a date.
If you are submitting a manuscript with this disclosure, when do you intend to submit the manuscript for publication?	Choose an item.	Click or tap to enter a date.

Submit IDF now or forever lose your (foreign) piece



This timeline displays the process of global patent filing via the Patent Cooperation Treaty (PCT).

Next Seminar Series: The Patent Process

Einstein has reporting obligations to different funding sources

18. Identify all sponsors whose support contributed, in whole or in part, to the conception, development, and/or reduction to practice of the invention. (If none, explicitly indicate NONE in the space below.)

Federal Grants and Contracts		
Sponsor	Award Number	Time Period
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Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.
Foundations		
Sponsor	Award Number	Time Period
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Industry-Sponsored		
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Other		
Sponsor	Award Number	Time Period
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There is no such thing as a free lunch

16. **Were any proprietary materials and/or special techniques received from third party(ies) (e.g., company, another academic institution, etc.) that were incorporated into the invention and/or used in the research that led to the invention?** (If none, explicitly indicate NONE in the space below; otherwise, identify the source of the materials and/or techniques and confirm whether the transfer was covered by a Material Transfer Agreement and/or a Confidentiality Agreement.)

A person can contribute to an invention without being an inventor

19. **Who else was involved in the effort which led to the invention, whether or not such collaboration involved financial support?** For each listed collaborator, provide a short description of the contribution made by that collaborator(s). (If none, explicitly indicate NONE in the space below; otherwise, identify all other academic, research, or for-profit entities that were involved.)

[Click or tap here to enter text.](#)

20. **Although the concepts were uniquely developed by the undersigned, identify persons, if any, with whom any collaborative work on the invention was shared.** Provide a description of the work shared with each person.
- a. [Click or tap here to enter text.](#)
 - b. [Click or tap here to enter text.](#)
 - c. [Click or tap here to enter text.](#)
 - d. [Click or tap here to enter text.](#)

A person can contribute to an invention without being an inventor

*See “Authorship vs. Inventorship”
@ www.Einstein.yu.edu/biotech

The screenshot displays the website of the Albert Einstein College of Medicine. At the top, the Einstein logo and the tagline "Science at the heart of medicine" are visible. Navigation links for "Education", "Research", and "Health" are in the top right. Below the header, a search bar and an "Intranet" button are present. A left sidebar contains links: "Overview", "Faculty & Inventors", "Industry & Commercial Partners", "Presentations, News & Publications", and "About Us". The main content area features a section titled "IP & Coffee Seminar Series" with a video player. The video is titled "The 'Muddy Metaphysics' of Patent Inventorship" by Janet M. MacLeod, Ph.D., dated July 17, 2019. The video player shows a Fox Rothschild LLP logo and a play button. A small inset image shows a person in a lab coat working with equipment. The video progress bar at the bottom indicates a duration of 17:07.

It should be clear what an inventor contributed to the invention

Name of Inventor:	% Contribution	Provide a description of the contribution of each named inventor to the conception and/or design of the invention	Signature:	Date:
1. Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	.
2. Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	.
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4. Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	Click or tap here to enter text.	.

Inventors may come from multiple institutions

For each Inventor not employed by Einstein or Montefiore (at the time of the invention), please identify the appropriate technology transfer contact from that institution (name, phone, e-mail address).

Click or tap here to enter text. Click or tap here to enter text.

Inventor Name

Technology Transfer Contact (name, phone, e-mail address)

Click or tap here to enter text. Click or tap here to enter text.

Inventor Name

Technology Transfer Contact (name, phone, e-mail address)

Click or tap here to enter text. Click or tap here to enter text.

Inventor Name

Technology Transfer Contact (name, phone, e-mail address)

But only one application can be filed.

If Einstein is the main institution, then the disclosure is reviewed according to the Patent Committee Process

The Patent Committee reviews the invention disclosure

A Committee of Einstein and Montefiore Faculty review each invention disclosure to address the following points:

- Is the invention clearly described?
- Is more information needed from inventors?
- Is the invention useful, novel, and non-obvious?
- Is there commercial value?
- Does it make sense to pursue patent or copyright protection?

“Pursue to Patent” → The Patent Process →



Stay Tuned!!

Summary

- The Invention Disclosure Form is used to evaluate a technology
- Description of the technology should be detailed and concise
- Disclose technologies to the OBBD sooner rather than later
- Einstein has a variety of obligations for reporting new technologies
- Patent Committee makes recommendation
- The Patent Process is an important upcoming topic of the IP and Coffee seminar series

Questions?

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