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UNIVERSITY OF ILLINOIS

POLICY AND PROCEDURE  
as administered by  
UNIVERSITY PATENT COMMITTEE

POLICY

The University Patent Committee, a subcommittee of the University Research Board, is appointed by the President. Its purposes are to consider inventions made by staff members during their period of service which, under its Statutes, belong to the University, and to make recommendations to the President via the Research Board for the disposition of such inventions. After considering the public interest, as well as possible commercial value, the Committee will proceed in conformity with the following principles, which appear to be the logical interpretation and implications of the Statutes of the University:

- A. When the invention appears to be in the public interest, the University or the University of Illinois Foundation should secure a patent.
- B. When it appears that the invention has commercial possibilities, the Committee may request the University of Illinois Foundation to study it, secure competent opinion, and report back to the Committee. If the decision of the Committee, after reviewing the report, is that the University or the Foundation should take steps to secure a patent, or to negotiate with interests outside of the University to secure a patent and develop the invention, with payments of royalties to the inventor and to the Foundation or to the University, it will be so recommended to the Research Board and to the President.
- C. Contracts with outside agencies (usually the Government) often provide that, if the University does not choose to exercise its rights to potentially patentable inventions, then such rights must be released to the sponsoring agency. The Committee may so recommend, securing, when possible, the concurrence of the inventor, although the latter may have no legal rights.
- D. Inventions made by persons in the employ of the University, in which the University specifically declines to exercise its rights, or where it is determined that the University has no rights, shall be released to the inventor, subject, however, to all pertinent contractual obligations between the University and others.

PROCEDURE

1. The inventor, after consulting with his department head, should submit a Disclosure of Invention (see sample attached) in septuplicate to the Secretary of the Patent Committee. If technical drawings are included in the Disclosure, only the narrative portion need be submitted in septuplicate. Two sets of drawings should be

submitted. Accompanying this material should be a recommendation from the inventor and department head, and/or other qualified personnel within the University, and bearing the endorsement and comments of the dean, department head, or other administrative officer, as to commercial use and/or the desirability of patenting.

2. The Secretary of the Patent Committee, upon receipt of a Disclosure, shall forward one copy to the Chairman of the Patent Committee and circulate copies to other members of the Committee. The Secretary shall place consideration of the Disclosure on the agenda for the next meeting of the Committee.

3. The Secretary shall make a Disclosure of the invention to the Government, if the contract so requires. This will be accomplished by transmitting a copy of the patent Disclosure to the sponsoring agency and stating that the University is considering the disposition of the invention and that the Government will be advised of the University's decision in the near future.

4. After consideration, the Patent Committee will advise the President, through the University Research Board, of its recommendations, in accordance with the Policy statement above, as to whether the invention should be patented or released.

5. The President, if he concurs, then may submit such recommendation to the Board of Trustees for a decision. If the invention grew out of a Government research contract which gives the Government the authority to require the release of any invention to the Government, the President may authorize such release without referral to the Board of Trustees.

6. After action by the Board, the Secretary of the Board should arrange for the notification of the Board's decision to the inventor, the department head and the Chairman of the Research Board, by requesting the Secretary of the Patent Committee to notify these and other interested parties.

7. If the decision is to file an application for a patent or make a patent search, the Patent Committee will recommend to the President that it be handled in one of the following ways:

- (a) If it appears to be in the public interest that the University shall, itself, hold the patent, the filing of an application shall be by the Board of Trustees.
- (b) If the invention appears to have commercial possibilities, it may be referred to the University of Illinois Foundation, which may take steps, itself, to secure the patent or negotiate with an outside agency in such a manner as to protect the interests of the University, the inventor, and the public.
- (c) Refer the patent to an agency or corporation outside the University in such a way that the interests of the University, the inventor, and the public will be protected.

8. If it appears that there is a possibility of income, the University Patent Committee, with the approval of the Legal Counsel, shall arrange contracts which will recognize interests of all involved and provide for the distribution of receipts from royalties and licenses. Such documents and terms will be submitted to the President and the Board of Trustees. Upon approval, a report to interested parties will be made by the Secretary of the Board, as provided in "6" above.

9. If, in accordance with the Statutes of the University, the sponsoring agency assumes the cost of securing the patent, a contract shall be worked out, as provided in "8" above, to protect the equities of the parties involved.

10. If the decision of the Board is not to file or make a patent search, the University rights shall be released to the inventor, unless there is a sponsoring agency involved, the contract with which requires that release be made to that agency. In the event that a release is made to the sponsoring agency, an attempt will be made to secure the approval of the inventor in every case, although this may be not legally required. It may be possible to negotiate with such agency for a royalty-free license from the inventor, in lieu of an outright release to the agency.

UNIVERSITY OF ILLINOIS  
DISCLOSURE OF INVENTION AND  
LETTER OF TRANSMITTAL

To the University of Illinois  
Patent Committee:

Date:

Entered herein and attached hereto is information concerning a potentially patentable invention, for your consideration.

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1. Descriptive Title of Invention

2. Inventor

Name:

Office Address and Telephone Number:

Rank and Department:

Permanent Address:

3. Name and Address of Co-inventor (if any)

4. Description of Invention

(In as simple and brief language as possible, describe invention, clearly pointing out what parts thereof are novel and which are old features, and which features were invented or suggested by colleagues. Attach two sets of drawings, sketches, photos and reports of invention, and any parts which will be used in the description, referring to by number, if necessary. Attach additional sheets, if needed.)

(a) Description:

(b) Earliest date and place invention was conceived.  
(Brief outline of circumstances.)

(c) Date and place of first sketch, drawing or photo.

(d) Date and place of first written description, if available.

5. Disclosure

(a) Disclosure of Invention to Others

Name, Title and Address	Form of Disclosure (including theses and other publications)	Date and Place of Disclosure	Was Signature Obtained (Yes - No)

(b) Date and place of completion of first operating model or full size device

(c) Present location of model

(d) Date, place, description and results of first test or operation

6. Support of University of Illinois

(Complete explanation, with dates, of University of Illinois facilities and support utilized, in whole or in part, in development of this invention.)

7. This invention was  was not  made while working on research sponsored by an agency outside the University. If so,

Name of sponsoring agency:

Description of contract: Number:

8. If decision of Patent Committee is to recommend release of interests of the University in this invention, the following is recommended:

Outright release to sponsoring agency, retaining no rights for inventor.

Release to inventor, with recognition of contractual obligations of the University to sponsoring agency.

Other

Respectfully submitted,

\_\_\_\_\_  
Inventor Date \_\_\_\_\_

\_\_\_\_\_  
Inventor Date \_\_\_\_\_

It is certified that the statements made herein are correct, to the best of my knowledge and belief.

\_\_\_\_\_  
Date \_\_\_\_\_  
Department Head, or other  
Administrative Officer

RECOMMENDATIONS

It is my/our opinion and recommendation(s) that the potentially patentable invention described herein:

Has little or no commercial value and should be released by the University to  inventor(s) or  sponsoring agency.

Definite possibility of commercial value and retention by the University or University of Illinois Foundation for development, with partial distribution of any net income to the inventor(s).

Other:

\_\_\_\_\_ Date \_\_\_\_\_  
Department Head or other  
Administrative Officer

\_\_\_\_\_ Date \_\_\_\_\_  
\_\_\_\_\_ Date \_\_\_\_\_  
Other Individuals who have  
knowledge of this Invention