



BULLETIN

› **YOU THINK YOU
HAVE AN
INVENTION.
WHAT'S NEXT?**

› **WHEN AND
WHAT TO
DISCLOSE**

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When You Should Call the Technology Transfer Office About Your Invention

When an invention is disclosed to the TTO, a chain of events is set in motion to determine the best way to protect and commercialize the invention. This bulletin will help you determine whether you should submit your invention for this process, and when. (For forms, go to <http://www.cusys.edu/techtransfer/disclose/index.html>)

When does it make sense to submit an invention disclosure?

There are two situations when you should consider submitting your invention. The first is when you have some data and you would like to establish a date of inventorship. If your invention will likely have major commercial impact, or you know that others were working on the same invention, a disclosure can provide evidence that you are the first to invent. Note that you can also establish a date of inventorship by signing and dating your lab notebook and having a witness sign and date as well. See our Lab Notebook Bulletin at <https://www.cusys.edu/techtransfer/downloads/Bulletin-LaboratoryNotebooks.pdf>.

A second situation in which to consider submitting a disclosure is when you have a manuscript, presentation, abstract or thesis draft that is almost ready for submission to a publication or conference. Our office prefers to have at least two months to review the material prior to publication. To protect international patent rights, we will need to file a patent prior to the actual publication date. The review process at most journals and conferences are confidential, but some post abstracts on a website weeks in advance. The publication date is considered the first date that it is available, even if it is only an abstract that is posted on a website.

What kind of idea is worth disclosing as an "invention"?

First, to be patentable, an idea must be *novel* and *non-obvious*. For details about patent criteria, see our Patent Bulletin at <https://www.cusys.edu/techtransfer/downloads/Bulletin-USPatentProcess.pdf>

A rough guideline: If it is publishable, it could be patentable. However, not all patentable ideas are commercially viable. To be worth patenting, an idea must be useful. Do reviewers, colleagues, program managers, and students think that someone might be able to make money from your idea? If so, there's a good chance that the invention fills a market demand of some kind. In thinking about this, ask yourself the **Three Questions**:

•**What does your technology do?** What unique value does it create? What problems does it solve? Why will this invention make a difference to the industry and customers? You may not know these answers, but if you can provide the TTO with a "hunch," we can contact experts to validate it.

•**What other technical solutions are available?** There is almost always another way to address the need that your technology fulfills. Potential licensees will do the same analysis, so think about alternatives, merits and disadvantages, availability, cost, and any other factors that might make your invention a better solution.

•**How big is this opportunity?** Is the market for your invention a large one, with many potential customers, or a small niche market? Would your invention be of interest to everyone in the market, or only a small subset of potential customers? Is the market “hot” right now, or is it a mature market with a slow growth rate and entrenched companies? Information about this is very useful for us if you have it, but we don’t expect you to know these answers before you submit your disclosure.

How does the technology transfer office assess an invention?

The TTO looks at three basic criteria in deciding what to do with an invention: protectability, feasibility, and commercial potential.

•**Protectability**

Is it patentable? An invention must be novel, non-obvious, and useful; the TTO determines this by talking with you, the inventor, and by examination of scientific and patent literature.

Is there freedom to operate -- can a company practice this patent without infringing someone else’s patent? (For example, an invention disclosure may cover a new use for a patented pharmaceutical, but a pharmaceutical company may hold the patent on the drug itself.)

Can we enforce the patent? If someone infringes on the patent, will we be able to find out, and provide proof?

•**Feasibility**

Will it work? This depends on the maturation of the technology – a continuum from raw theoretical reduction to practice all the way to a market ready product.

What does the data say - a continuum of certainty from suggestive to proven in fact. Can it be validated and replicated in the context important for commercialization?

What is the product? How long will it take to develop and what that cost?

How complete is the technical asset? What is necessary in the production and product infrastructure so it can work? Can it be scaled to the size necessary for economic success?

What are the technical alternatives, and their intellectual property?

•**Commercial Potential**

How can a licensee make money from this invention? How much money can they make? Is the market big or small, broad or narrow, “hot” or mature?

What is the value proposition for the product – what does it replace and how can you estimate the value of it’s benefits? Some call this the “pain threshold” -- what pain will it solve for a user?

The TTO does a broad-aim analysis of commercial potential to determine if we want to patent and who might adopt the invention.

Why disclose?

Commercialization of an invention is an alternative way to have societal impact, beyond instruction and publication. The technology commercialization process is minimally intrusive into basic research and publication, and can be a source of funds that are not otherwise available for research, discretionary and personal support. Also, federal grant recipients are required by law to disclose any discovery made during the course of the project to their institution. For any questions about the disclosure process and timeline, feel free to call or email your campus TTO contacts found on the first page.

To download forms: <http://www.cusys.edu/techtransfer/disclose/index.html>