

## KAUST INVENTION DISCLOSURE FORM

Date: \_\_\_\_\_

The purpose of this form is to facilitate the prompt disclosure by KAUST personnel of any intellectual property to which KAUST may assert ownership rights pursuant to the KAUST Intellectual Property [Policy](#).

Please fill out this form as best as you can, sign and send it to the Technology Transfer Office at the Innovation Cluster 3, 2<sup>nd</sup> Floor, or email it to [IP@kaust.edu.sa](mailto:IP@kaust.edu.sa).

**1. Title:** *(Brief Descriptive Title)*

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**2. Affiliations**

Physical Science and Engineering (PSE) Computer, Electrical and Mathematical Sciences and Engineering (CEMSE) Biological and Environmental Sciences and Engineering (BESE) Core Labs	Center:
	Academic Program

**3. Corresponding inventor**

<p><b>Corresponding inventor</b> <i>(with whom we should communicate on the invention)</i> Name:</p> <p>Email: _____</p> <p>Note: All inventors should be listed in Section 11- ACKNOWLEDGEMENT</p>
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4. Please describe your invention with technical detail sufficient to convey a clear understanding, to the extent currently known, of the nature, purpose, operation, and the physical, chemical, biological or electrical characteristics of the invention. Also describe how this invention is different from existing technologies. *(You can submit additional pages if necessary. Please append any existing drawings and/or written descriptions – including grant proposals, manuscripts, presentations, posters and/or any public disclosures.)*
5. What applications do you foresee the technology will have? How can it be used?
6. Did your work involve any non-KAUST collaborators such as a visiting student, University or Industry? ☐ Yes ☐ No If yes, please list all:
7. To the best of your knowledge, has there been a public or planned disclosure of this invention or disclosure to a third party? ☐ Yes ☐ No If yes, please specify:
8. If you are aware of any commercial entities that may be interested in your technology? ☐ Yes ☐ No If yes, please specify:
9. Was material used to develop this invention received under a Material Transfer Agreement (MTA) or grant? ☐ Yes ☐ No If yes, please list all
10. Please give details of any external funding used in this invention (even if provided in combination with KAUST funding).

## 11. ACKNOWLEDGEMENTS

Please provide below the legal names (as those appear in each person's passport or like document), employment details (such as collaborators) and addresses of all persons who are believed to have made significant contribution to the creation or discovery of the invention.

### **DETERMINATION OF INVENTORSHIP IS A LEGAL MATTER AND WILL BE DETERMINED BY LEGAL COUNSEL**

Pursuant to the KAUST IP Policy, I/We hereby assign all of my (our) right, title, and interest to the invention(s) described herein to KAUST and agree to execute all documents as requested AND further assign to KAUST all of my (our) rights to any patent application filed on this invention, and to cooperate in the protection of any associated Intellectual Property.

<b>First Name</b>	<b>Middle Name</b>	<b>Last Name</b>
<b>Inventor Contribution %</b>		<b>Job Title:</b>
<b>Address:</b>		<b>Telephone:</b>
<b>Citizenship:</b>		<b>E-mail:</b>
<b>Signature:</b>		<b>Date:</b>
<b>First Name</b>	<b>Middle Name</b>	<b>Last Name</b>
<b>Inventor Contribution %</b>		<b>Job Title:</b>
<b>Address:</b>		<b>Telephone:</b>
<b>Citizenship:</b>		<b>E-mail:</b>
<b>Signature:</b>		<b>Date:</b>
<b>First Name</b>	<b>Middle Name</b>	<b>Last Name</b>
<b>Inventor Contribution %</b>		<b>Job Title:</b>
<b>Address:</b>		<b>Telephone:</b>
<b>Citizenship:</b>		<b>E-mail:</b>
<b>Signature:</b>		<b>Date:</b>
<b>First Name</b>	<b>Middle Name</b>	<b>Last Name</b>
<b>Inventor Contribution %</b>		<b>Job Title:</b>
<b>Address:</b>		<b>Telephone:</b>
<b>Citizenship:</b>		<b>E-mail:</b>
<b>Signature:</b>		<b>Date:</b>

## INSTRUCTIONS

I. The Technology Transfer Office (TTO) reviews all KAUST IP Disclosure submissions as they are received from members of the KAUST community. Where appropriate, the TTO endeavors to license KAUST Intellectual Property to industry for further development and commercialization. Any royalties derived from any such license are shared with the inventor(s) and their departments according to KAUST's IP policy. This form notifies the OTT of your Intellectual Property and any relevant sponsorship, related agreement and publication history.

II. The following instructions apply to the correspondingly numbered sections in the Form:

1. Use a brief descriptive title to aid in identifying the Intellectual Property.
2. Check the appropriate division box to which this technology is associated.
3. List the inventor to whom all TTO communications should be directed.
4. In describing the Intellectual Property, attach material which covers the following points:
  - i. General purpose
  - ii. Technical description, including a list of key words.
  - iii. Advantages, unusual features and improvements over existing methods, devices or materials. How does the Intellectual Property differ from the present technology? What problems does it solve or what advantages does it possess?
  - iv. Attach sketches, drawings, photographs, or other material that help illustrate the description, if appropriate.
  - v. Commercial applications (economic potential, potential uses, indirectly related uses, etc.).
  - vi. Please list (and attach) any additional related patents or publications which may be important background reference material in reviewing the Intellectual Property. If appropriate, please attach an initial patent search related to the invention obtained from searching the USPTO's website: <http://www.uspto.gov/web/menu/search.html>.
5. Explain how this invention is of value (industrial application).
6. Name any other institution (university, research institute, company, etc.) the Contributor(s)/collaborator(s) is/are affiliated with.
7. In the United States, a patent application must be filed no later than one year after public availability of a printed publication disclosing the invention in detail (use of overheads or blackboards may be considered written disclosures). In other countries, filing must take place before either oral or printed publication is made available to the public: however, where there has been a U.S. filing before any oral or printed publication, generally a one year grace period is granted for foreign filing. Complete all parts of section 7 in view of the following:
  - i. From a legal perspective, Conception is "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice." In addition, "Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill or faculty." So, the mere recognition of a desirable result, or of a problem, or of a general approach to solving the same, without the formulation of the physical structure to accomplish that result or to solve the problem, will not suffice to constitute conception.,.
  - ii. The term "first publication" means the first time any member of the general public (those outside the KAUST community), without restriction of confidentiality, would have been able to legally gain access to your written or printed enabling description of the invention.
  - iii. "First public oral disclosure" means the same as 7ii, but only as to oral presentation to the general public (those presented to individuals outside the KAUST community).
  - iv. The anticipated date of publication, (as described in 7ii above), should be entered here, as well as the date any documentation was submitted for review for possible publication.
8. A list of commercial entities that may be interested in the invention will assist the TTO in identifying potential licenses for the technology. Please include names and addresses of specific contacts if known.
9. List all MTAs and other agreements whose Material and/or terms relate to the Intellectual Property.
10. List all sources of funding that relate to the creation/development of the Intellectual Property by providing the applicable reference numbers, and, if applicable, the principal investigator on the project(s).
11. Include the names of any potential co-inventors including any potential co-inventors at another institution. A co-inventor is an individual who has conceived or contributed an essential element of the invention, either independently or jointly with others, during the evolution of the technology concept or reduction to practice.

### III: Related Patent Terminology

**Reduction to practice**, according to patent law, involved actual and complete use of the invention for its intended purpose. Such reduction to practice generally involves physical construction of the invention and testing the physical embodiment to determine whether it performs as contemplated, but this is not always necessary if the invention can be fully described. A person contributing only to the reduction to practice of an invention is not an inventor.

**What is a patent?** A patent is a grant issued by the United States (or other foreign countries) giving the owner of the patent the right to exclude others from making, using, or selling the invention claimed within the jurisdiction of the country for the term of the patent (typically 20 years from the date the patent application is filed). A patent document typically includes a specification, drawings, and claims. The claims are an important component of a patent because they describe the scope of the patent holder's exclusionary rights. The patent fully discloses the enablement of the invention to the public upon issuance of the patent.