

## **Guide for Preparation of Intellectual Property Disclosure Form**

(Please see faculty handbook for detailed Intellectual Property policy)

1. Disclose only one creation per form. Use a separate form for each creation. This form is to be used for all potentially patentable and copyrighted intellectual property as well as trade secrets and items for trademark protection.
2. Make your disclosure complete. If the intellectual property is an invention, the disclosure is adequate for patent purposes only if it enables a person skilled in the art to understand the creation.
3. Items to be considered in preparation of a complete disclosure:
  - ❖ All essential elements of the intellectual property, their relationship to one another, and their mode of operation.
  - ❖ Equivalents that can be substituted for any elements.
  - ❖ List of features believed to be new.
  - ❖ Advantages this intellectual property has over the prior art.
  - ❖ Has the intellectual property been built and/or tested?
4. Please include any drawings, figures, and/or sketches (no jpeg please).
5. Prior knowledge and information should be identified such as pertinent publications, patents, or previous devices, and related research or activities.
6. Witnesses should be persons other than the inventors or co-inventors that have read and understand the process of the creation.
7. The “Inventor Assignment” document at the end of this form **MUST BE** filled out and signed by each inventor at the time of disclosure.
8. An electronic version of the all parts to the disclosure **MUST BE** submitted in MS Word or pdf (no jpeg please) by email to [Rmahurin@montana.edu](mailto:Rmahurin@montana.edu) and hard copy must be signed by all pertinent parties and submitted to the Technology Transfer Office in room 304 of Montana Hall.
9. Please verify whether or not the creation was funded by outside sources and if so please list GRANT NUMBERS.
10. Failure to follow all these guidelines will increase evaluation time and may prevent patent prosecution.

Please call the Technology Transfer Office at 994-7868 with any questions.

Montana State University - Bozeman  
**Intellectual Property Disclosure Form**  
Cover Sheet

- ✚ Please fill in the following forms electronically and attach it to an email along with an electronic version of the intellectual property including any figures/drawings and email to: [Rmahurin@montana.edu](mailto:Rmahurin@montana.edu). MS Word or pdf files only.
- ✚ Please submit a hard copy of all materials with the appropriate signatures to the Technology Transfer Office MT Hall 304.
- ✚ Please follow the submission instructions carefully. Failure to do so will greatly increase the evaluation time.

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***CREATOR(S)***

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Name (please print/type clearly)	Signature & Date
1. _____	_____
2. _____	_____
3. _____	_____
4. _____	_____
5. _____	_____

Title of invention/discovery:

Name(s) and contact information of others that could evaluate the invention/discovery:

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***DEPARTMENT HEAD***

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Name : \_\_\_\_\_

What is your opinion of the creation? \_\_\_\_\_

Recommendations: \_\_\_\_\_

Signature and Date: \_\_\_\_\_

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***WITNESSES***

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Names and signatures of two (2) witnesses that are not inventors and understand the technical aspects of this creation:

1. \_\_\_\_\_
2. \_\_\_\_\_

Montana State University  
**Intellectual Property Disclosure Form**

This form is provided to permit evaluation of the patent potential of inventions/discoveries, and to facilitate preparation of patent applications when warranted. Please fill in the answers as completely as possible, and use additional sheets when necessary. Please call 406.994.7868 with any questions.

1. State the title of the creation: \_\_\_\_\_
  
2. Describe the creation. Use additional sheets if necessary. Attach descriptive materials such as drawings, sketches, photographs, etc. which may help illustrate the creation. Delineate new and important features. Make sure to include both the preferred embodiment as presently identified, and alternative constructions, procedures, or equivalent components which can accomplish the same result as the preferred embodiment.
  
3. Key Words:
  
4. State the primary purpose of the creation, including the need satisfied or problem solved by the creation.
  
5. Please list what you feel is prior art. Please include references, articles, talks, abstracts, patents, etc. which are relevant to either the state of the prior art or to the creation. Please include dates and provide copies whenever possible.
  
6. Compare new and important features of the creation with the prior art, explaining why and how the new creation is better.
  
7. Are there any publications, abstracts, submitted manuscripts, talks, etc. on the new creation (either already done or in the works)? Please provide details and dates or projected dates if not yet submitted.
  
8. Please name any sources of funding used in facilitating this creation. **Include grant number(s).**
  
9. Are you aware of any other person or entity that is making or is likely to make any claim to this creation? If so, please identify and explain.

10. Please list known competitors or alternate technologies which solve the same problem.

11. Are there commercial products you envision? If so, please describe.

12. What do you feel are the immediate research plans or steps to be taken in order to commercialize?

13. What do you feel are the longer term research plans or steps to be taken in order to commercialize?

14. Please identify whom you believe to be potential licensee(s) or purchaser(s) of this creation and why. If known list specific names and contact info.

15. Has anyone made contact or communication with any of the above from question 13 relative to this creation? If so, please specify the nature of the correspondence.

16. Contact information for each creator.

Name	Mailing Address	Department & Room #	Citizenship	Phone

17. **IMPORTANT:** Please fill out the following Inventor Assignment to MSU form. The following form must be complete and accompany the Intellectual Property Disclosure Form.

This form submitted by:

Submitted by Signature \_\_\_\_\_ Date \_\_\_\_\_

## Inventor Assignment to Montana State University

*(If more than one (1) inventor, please call 994-7868 and request multiple inventor version of this document)*

This Agreement is entered into by \_\_\_\_\_ (INVENTOR) and Montana State University (MSU), to assign inventions/discoveries as described in the attached Intellectual Property Disclosure entitled: “\_\_\_\_\_”.

INVENTOR acknowledges the inventions/discoveries were conceived and/or reduced to practice while INVENTOR was employed by MSU and INVENTOR is bound by the Patent Policy of the Montana University System and Montana State University. Under these policies, MSU is entitled to obtain a formal assignment from the INVENTOR of his/her entire right, title, and interest in and to the inventions/discoveries and related technology created by INVENTOR during his/her employment by MSU.

1. The INVENTOR assigns and transfers to MSU all right, title, and interest in and to:
  - a. the inventions/discoveries described in the Intellectual Property Disclosure Form and/or related Patent Application(s);
  - b. any technical information, know-how, trade secret, process, procedure, composition, biological materials, device, method, formula, protocol, technique, software design, tradename, trademark, copyright, copyrightable material, drawing, or data which is related to the inventions/discoveries;
  - c. any related Patent Application(s), including all provisionals, divisionals, continuations, continuations-in-part, reissues, continuing patent applications, substitutions, renewals, extensions filed, and all patent(s) issued thereon in the United States and all other countries; and
  - d. all improvements to the inventions/discoveries made or invented by the INVENTOR during employment with the University.

For purposes of this Agreement, paragraph 1(a)(b)(c)(d) will be collectively referred to as “INVENTIONS”:

2. INVENTOR is authorized to use the INVENTION for MSU educational and research purposes.
3. INVENTOR agrees to cooperate fully with MSU and its Licensee(s) in all respects, including the preparation of patent applications and execution of related documents as may be necessary to fully exercise the assignment rights granted in this Agreement. INVENTOR also agrees to take all actions that may be necessary to enable MSU to obtain, defend, and enforce the intellectual property rights in the INVENTION(s), including executing documents, cooperating with retained counsel, and testifying in all legal proceedings.

4. INVENTOR acknowledges that MSU is solely responsible for negotiating and contracting with third parties for the patenting, licensing, sale, and/or transfer of INVENTION(s) and agrees not to negotiate or contract with third parties or interfere with MSU's exercise of its rights to do so.
5. In exchange for the assignment of rights under this agreement, INVENTOR will receive fifty percent (50%) of net royalties and other commercialization income (which does not include payments for sponsored research) received by MSU from commercialization of the INVENTION(s) as outlined under MSU Patent Policy.
6. INVENTOR hereby warrants that he/she is INVENTOR of the INVENTION(s) and that no assignment, sale, agreement, or encumbrance has been made or will be made or entered into by INVENTOR which would conflict with this Assignment.
7. INVENTOR further agrees to supply MSU, upon request, access to all lab notebooks and any other material, which contain information about the INVENTION(s).
8. MSU will provide the INVENTOR with an annual statement showing the total royalties and other commercialization income received by MSU and all expenses incurred within forty-five (45) days of the close of MSU's fiscal year. If there are any net royalties, MSU shall distribute the INVENTOR's share with the annual statement.

This Agreement shall be binding upon and inure to the benefit of the INVENTOR, INVENTOR's successors and heirs.

INVENTOR

Name \_\_\_\_\_

Signature \_\_\_\_\_

Date \_\_\_\_\_

SS# \_\_\_\_\_

Address \_\_\_\_\_

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Received and accepted by:

\_\_\_\_\_  
Rebecca W. Mahurin, Ph.D.  
Director, Technology Transfer Office

\_\_\_\_\_  
Date