



Guide to the UT Invention Disclosure Form

Version Dated May 3, 2011

General

An invention should be more than an idea, theorem or algorithm. In patent terms, it should be new, useful and not obvious. There should be a practical application, and the application must be shown to work in the laboratory. The Invention Disclosure should include data for preparation, fabrication or assembly of the invention, and results of its use. It should be narrowly defined so that it may be distinguished from other similar things that can be found in open or patent literature. The benefits and advantages of the invention should be stated in comparison to things that are already available.

1. Title of Invention:

Identify the invention, but to protect its patentability do not reveal its novel and useful properties in the title. The title must be unique from any other Invention Disclosures filed at UT as it is sometimes used as a unique identifier in our database. The title is reported confidentially to chairs, deans, the Innovations and Partnerships Office, and MaRS Innovation.

2a. University of Toronto Inventors:

An inventor is a creative and necessary contributor to the invention. A contributor who worked solely following the instructions of his supervisor without contributing novel input to the invention or who simply who tested or validated the invention does not qualify as an inventor. This definition is consistent with the Patent Act.

If the inventors were any of; faculty, staff, students or a visiting scientist who used UT facilities in creating the invention, they must be listed here. This definition complies with the Inventions Policy. Complete information (name, status and contact information) is needed to verify the inventor's status and allow us to contact them directly. Note that cross-appointed faculty or other personnel of UofT's affiliated hospitals, who invented at the hospital, are external inventors (see 2b below).

2b. External Inventors:

Name inventors off University premises, such as collaborators at affiliated or other hospitals, other universities, agencies, and companies. If none, write "none." This definition complies with the Inventions Policy and with the UofT-Hospitals Agreement, which stipulates that the location of the research, not the affiliation of the researcher, determines the institutional Policy governing ownership of intellectual property.

Their collaboration makes the invention jointly owned and subject to any prior agreements. It informs negotiations about ownership, patenting, and commercialization.

2c. Contributors

Persons who made useful and valuable contributions to the development of the invention, but did not otherwise qualify under the definition of inventor (2a) may be identified. Subject to the agreement of all the inventors, Contributors may receive a portion of revenues from commercialization of the invention, the relative amount to be specified in a Revenue Sharing Agreement.

3. Location of invention:

Specify the department(s) and building(s) at the University which were used in the creation of the invention. This allows the University to determine which departments are entitled to a percentage of revenue under the Inventions Policy. The location of the work determines distribution in cases where faculty are cross-appointed.

Also provide the contact information for any other locations, such as hospitals, companies, or universities where the inventive work was conducted. The University needs the information so we can properly inform other parties about the disclosure of the invention and for subsequent negotiation of inter-institutional or joint ownership agreements.

4. Description of invention:

Summarize the invention paying particular attention to identifying its novel and useful properties in light of publically available information. Attach a detailed description and as much data as is available showing that the invention works for its proposed purpose. If the invention is an improvement to a prior disclosure, state that fact and distinguish the new invention from it. This information is necessary to evaluate inventiveness, patentability, and potential for commercialization. Innovations and Partnership Office, Business Development and Commercialization Managers are available to answer questions if you require assistance.

5a. Funding:

Declare accurately and completely the funding received which directly supported the research which led to the invention. Please note that if the invention has not been reduced to practice there is limited opportunity to commercialize it. It is expected that there must be at least one source of funding associated with an invention. Funding includes support for salaries and research materials. The sponsor, project title, and RIS fund # are needed to locate the funding agreement and identify any legal encumbrances on the invention. If required, the University must report the invention to the funding sponsor. If you lack the records, please ask your administrator for assistance.

5b. Prior agreements:

INNOVATIONS & PARTNERSHIPS OFFICE

MaRS Centre, Heritage Building, 101 College Street, Suite 320, Toronto, Ontario M5G 1L7 Canada
Tel: +1 416 946-7342 • Fax: +1 416 978-6052 • innovations@utoronto.ca • www.research.utoronto.ca

State any agreement governing the research that is not declared under Funding at 5a. These include material transfer, software, non-disclosure/confidentiality, and non-funded collaboration agreements. The invention is also subject to the terms of these agreements

If this invention is an improvement or addition to a prior invention, declare any license or assignment that governs it. Specify the contractual party and the date so that the agreement can be located and that party notified of the new disclosure.

6. Patent and other IP applications:

Declare any patent or patent application already filed related to the disclosed invention. Specify the kind (US Provisional, Canadian, PCT), filing number, title, and date of filing. Attach a copy. Under the Inventions Policy, the University owns 50% of the invention until further assignment.

If a patent application was filed for a prior but related invention, check “no” but add that invention by name and RIS #. State the patent application by kind (US Provisional, Canadian, PCT), filing number, title, date, and status.

Warranty:

This guarantees the accuracy of the disclosure. If substantial changes are later made, e.g., to the inventors or sponsors, a revised disclosure will be necessary. If changes are made after the assignment of ownership has been executed by the Governing Council, an executed amendment to that assignment will be necessary.

Only University inventors sign and date. External inventors do not sign because they are not subject to UT Inventions Policy.

Review:

A draft of the disclosure should advisably be sent to the IP Officer for review before a final submission. Please attach a PDF to an e-mail addressed to: ip.officer@utoronto.ca

Submission:

One fully signed and dated original must be submitted to: IP Officer, Innovations and Partnerships Office, MaRS Heritage Building Suite 320, 101 College Street, Toronto M5G 1L7. Receipt will be acknowledged.