

## **Patent Advisory Committee**

### **Montclair State University**

**28 January 2013**

This committee is charged by the Provost to provide advice to the Provost regarding faculty, staff and student inventions on which the University may choose to file a patent application. The committee is also charged to furnish the Provost with advice on the potential value associated with a potential patent application. It is the responsibility of University Counsel to carry out due diligence activities prior to filing a patent application. The committee shall require the inventor(s) to complete the Invention Disclosure and review the information in it to prepare advice to the Provost.

The following link furnishes some basic information on key requirements for a patent: <http://www.ipwatchdog.com/2012/06/02/patentability-overview-when-can-an-invention-be-patented/id=23863/> This link includes examples and simple descriptions of key terms and concepts associated with the process. A wide variety of inventions can be the subject of a patent application including equipment, technology, chemical compounds, software and other non-natural items. Patent applications can be filed in the United States and/or worldwide and patents once issued must be maintained. There are fees associated with filing and maintenance. The costs associated with worldwide filing are greater than US only applications. A separate document provided by MSU legal counsel illustrates costs associated with patent filings. These fees are separate from those associated with legal services needed to write and submit a patent application.

Since the United States is now a “first to file” country the committee will be expected to act expeditiously on potential inventions submitted for consideration.

The following is the procedure:

The Dean of the college to which the inventor(s) belong will submit a completed invention disclosure form electronically to the committee chair. Within two business days, the chair will acknowledge receipt from the Dean and inform the inventor(s) that the committee will begin its evaluation. The disclosure and any subsequent information acquired during the evaluation process is considered confidential and cannot be shared or discussed with others outside the committee unless authorized in writing or by email by the inventor(s) and Committee Chair. Prior to disclosure to a party/parties outside the committee third party/parties will be required to enter a confidentiality agreement with the university with regard to the disclosure and associated information.

Within two business days after acknowledging receipt, the chair will evaluate the submission and will distribute the disclosure to the committee designating a member to serve as primary evaluator. During this period the chair may request information from the inventor(s) (and distribute this information to the committee) and/or seek advice from appropriate ad hoc Montclair State University personnel.

The primary evaluator considers the utility, novelty, obviousness, description and potential value of the invention. The primary evaluator may request information from the inventor(s) (and distribute this information to the committee) and/or seek advice from appropriate ad hoc Montclair State University personnel and will provide a preliminary recommendation by email to the committee within two weeks of receipt from the chair. "Value" will be described as high, low or not possible to estimate. The evaluation should not be exhaustive instead it should be based on general knowledge of the subject using readily available information. The primary evaluator's recommendation will be limited to whether the disclosure should or should not be filed as a provisional patent application, or if more discussion is needed.

Each member of the committee will advise the Committee Chair whether they agree or disagree with the primary evaluator's recommendations by email (no details beyond this) with the recommendation within two days of receipt of the summary. If the committee is unanimous in its recommendation to file or not to file, the chair will forward that recommendation to the Provost, appropriate Dean and inventor(s) within two business days. If the Committee is not unanimous, the Committee will discuss the submission and recommendation as soon as possible. The inventor(s) may be asked to attend to answer questions posed by the Committee and to offer additional information.

Following this meeting within two business days the chair will submit a final recommendation including a value judgment as described above to the Provost and appropriate Dean that includes a summary of the committee vote. To the extent possible, the committee should attempt to provide the Provost with potential commercialization opportunities as a part of the summary. The Provost's decision on the matter will be final and will be communicated by the Provost to the inventor.