UNIVERSITY OF ILLINOIS

UNIVERSITY PATENT COMMITTEE
POLICY AND PROCEDURE

I. Policy

The basic University patent policy is set forth in the University of Illinois General Rules Concerning University Organization and Procedure, Section 17, and states in part: "Any discovery of invention (1) which is the result of research carried on by or under the direction of any employee of the University and having the costs thereof paid from University funds or from funds under the control of or administered by the University, or (2) which is made by any employee of the University as a direct result of his duties with the University, or (3) which has been developed in whole or in part by the utilization of University resources or facilities, belongs to the University and shall be used and controlled in ways to produce the greatest benefit to the University and to the public."

II. Procedure

Any discovery or invention meeting the above criteria must be disclosed to the University Patent Committee, a subcommittee of the University Research Board consisting of seven staff members appointed by the President. The Committee's purpose is to make recommendations to the President, via the Research Board, for the administration of such discoveries or inventions.

The inventor, after consulting with his department head, should submit the disclosure of invention in septuplicate to the Secretary of the Patent Committee. If technical drawings are included in the disclosure, only the narrative portion need be submitted in septuplicate; two sets of drawings should be submitted. A recommendation from the inventor and the department head, and other qualified personnel within the University, should accompany this material and should bear (a) the endorsement and comments of the dean, department head, or other administrative officer, as to commercial use and the desirability of patenting and (b) a recommendation as to whom the rights of the University should be assigned if it is the decision of the University not to file a patent application.

The Secretary of the Patent Committee, upon receipt of a disclosure, may circulate copies to other members of the Committee. The Secretary shall place consideration of the disclosure on the agenda for the next meeting of the Committee.

The Committee, after considering the public interest, as well as possible commercial value, will proceed to make a recommendation in accordance with the following principles.

A. When the nature of the invention is such that the issuance of a patent appears to be in the public interest, the University or the University of Illinois Foundation (hereafter referred to as the Foundation) should apply for a patent.

B. When it appears that the invention has commercial possibilities, the Committee may request that the Foundation or its subsidiary, University Patents, Inc. (hereafter referred to as UPI), study it, secure competent opinion from qualified sources, and report back to the Committee. If the decision of the Committee, after reviewing the report, is that the University or the Foundation should take steps to secure a patent or to negotiate with interests outside the University to develop the invention further and possibly to apply for a patent, with payment of royalties to go to the inventor and to the Foundation or to the University, such action, including the assignment of rights held by the University to the Foundation, will be recommended to the Chairman of the University Research Board and to the President. In those cases where the prompt filing of a patent application is considered necessary to protect the interests of the University and the inventor, the Committee may instruct the Foundation to proceed with the application and will report such action to the President. One of the responsibilities of UPI is to study and make recommendations to the Patent Committee on potentially patentable inventions of the University. It may also administer patents after issuance for the Foundation.

C. Contracts or grants with outside agencies (usually the United States Government) often provide that, if the University does not choose to apply for a patent, the rights must be released to the sponsoring agency. The Committee may so recommend, securing, when possible, the concurrence of the inventor, although the latter may have no legal rights to the invention. Many of the contracts, however, received from the United States Government specify that the rights to inventions belong to the Government or that the contracting officer may have the authority to decide the disposition of such inventions. However, if the invention results from a Government research contract which gives the Government the authority to require the assignment of any invention to the Government, the Secretary may take steps required to accomplish such assignment without referral to the President and the Board of Trustees (hereafter referred to as the Trustees.)

D. If it appears that there is a probability of income, the Patent Committee shall recommend to the President a plan for the distribution of such income that will recognize the interests and contributions of all involved, providing for the distribution of receipts from royalties and licenses. Upon approval, a report of interested parties will be made by the Secretary of the Trustees. This is applicable whether the rights are held by the University, by the Foundation, or by any outside corporation or agency.

E. Inventions made by persons in the employ of the University, in which the University specifically declines to exercise its rights, or in which it is determined by the Committee that the University has no rights, shall be assigned to the inventor, subject to all pertinent contractual obligations between the University and others.

If the discovery or invention is a result of sponsored research, the Secretary shall make a disclosure of the invention to the sponsoring agency if required. This may be accomplished by transmitting a copy of the disclosure to that agency and stating that the University is studying the disposition of the invention and that the sponsor will be promptly advised of the University's decision. In recent years contracts and grants from the Federal Government have become much more strict as to the reporting of patentable inventions. Accordingly, disclosures of patentable inventions made under such contracts and grants must be filed promptly with the Patent Committee, in no case more than ninety days after the date of conception.

After consideration, the Patent Committee will advise the President, through the Chairman of the University Research Board, of its recommendation as to whether the invention should be patented, with the possible use of the services of the Foundation, or assigned to the sponsoring agency or the inventor.

The President, if he concurs, may submit such recommendation to the Board of Trustees for a decision.

The statutes of the University provide that a sponsoring agency may be granted preferential treatment in administering any patentable inventions that may develop from the sponsored work. Such preferential treatment may take the form of granting to the agency the first opportunity to negotiate the method of developing the invention. If the sponsoring agency agrees to bear the cost of such development, including the application for a patent, with the approval of the Trustees or the Board of Directors of the Foundation, the sponsoring agency may be granted a nonexclusive or an exclusive license to use a resulting patent with the payment of standard fees and royalties to the University or the Foundation. If such negotiations with the sponsoring agency are not successful, the University or the Foundation may negotiate with others. Final terms in such event must be approved by the Trustees or the Board of Directors of the Foundation.

III. Form of Disclosure

To the inventor: When making a disclosure, follow the form outlined below. The disclosure must be filed with the Patent Committee within ninety days after conception or first reduction to practice, whichever is first.

UNIVERSITY OF ILLINOIS
DISCLOSURE OF INVENTION

Date

To the University of Illinois Patent Committee:

As required by the statutes of the University, for your consideration there follows and is attached hereto information concerning a potentially patentable invention which I conceived or brought into practice during the period of my employment by the University:

1. Descriptive Title of Invention:

2. Inventor:

   a. Name:

   b. Rank and department:

   c. Office address and telephone number:

   d. Permanent address:

3. Co-inventor(s): (Same as for inventor.)

4. Invention:

   a. Description: (In as simple and brief language as possible, describe invention, clearly pointing out those parts which are novel, and those which were invented or suggested by colleagues. Attach two sets of drawings, sketches, photos, reports of invention, and parts that will be used in the description, referring to them by number, if necessary.)

b. Earliest date and place of conception:

c. Date and place of first sketch, drawing, or photo:

d. Date and place of first written description:

5. Disclosure of Invention to Others:

a. Names, titles, and addresses of others involved with invention:

b. Form of disclosure: (Include these and other publications.)

c. Dates and places of disclosure:

d. Were signatures obtained from persons to whom disclosure was made? (Answer yes or no.)

e. Date and place of completion of first operating model or full-size device:

f. Present location of model:

g. Date, place, description, and results of first test or operation:

6. Support of University of Illinois: (Complete explanation, with dates, use of University of Illinois facilities, and financial or other types of support utilized, in whole or in part, in development of this invention.)

7. Support of Others:

a. Name of sponsoring agency:

b. Number of contract or grant:

c. Description of contract:

8. Recommendation, if application for a patent is not filed:

a. ☐ Assignment to sponsoring agency.

b. ☐ Assignment to inventor(s), with recognition of contractual obligations of the University to sponsoring agency.

c. ☐ Other:

Signature of Inventor - Date

9. Certification by Department Head: It is certified that the statements made herein are true and correct, to the best of my knowledge and belief.

Signature of Department Head (or other administrative officer) - Date

10. Recommendations by Department Head, other Administrative Officer, and other qualified personnel within the University:

It is my opinion and recommendation that the potentially patentable invention described herein be disposed of as follows:

a. ☐ Assigned by the University to ☐ the inventor(s) or to ☐ the sponsoring agency because of little or no commercial value.

b. ☐ Retained by the University or the University of Illinois Foundation for development because of possibility of commercial value with partial distribution of any net income to the inventor(s).

c. ☐ Other:

Signature of Department Head (or other administrative officer) - Date

(If other University administrative officers of staff members have knowledge of the invention, they may make a recommendation such as the above.)

March 1967