Sonia Kim, PhD
Manager, Marketing & Industry Partnerships

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Intellectual Property Associate
What is INVO?

Innovation and New Ventures Office

Prior to 2011, Tech Transfer Program (TTP)

What is Tech Transfer?
THIS IS NOT TECHNOLOGY TRANSFER.
Technology Transfer

Tech transfer activities focus on moving technology from the University to the public domain

- Grants received by University researchers from government agencies funded with taxpayer dollars

- Often, Universities do not have the financial resources to fully develop and commercialize technologies

- Licensing helps inventions reach commercial potential and returns them to the public domain to do good
What INVO does:

1. Evaluate inventions and assess the market opportunity
2. Protect inventions
3. Market inventions to industry
4. Negotiate licensing agreements
5. Provide commercialization resources for start-ups
Moving inventions toward commercial applications

**TRANSLATION**
- Center for Developmental Therapeutics (CDT)
- Center for Device Development (CD2)
- NU Clinical & Translational Sciences (NUCATS)
- NU Funding Opportunities

**TRANSACTION**
- Disclosures
- Intellectual Property
- Agreements
- Compliance

**COMMERCIALIZATION**
- License Inventions to Companies
- Partner with Companies, Investors & Advisors
- Start-up Companies
- Commercialization Clinics
DISCLOSURE
A record of an invention, the inventor(s) involved, sponsorships, and other public disclosures and publications

ONLINE VIDEO
- What?
- When?
- Where?
- Why?
- How?
INVO Forms

Invention Disclosure Form

Copyright Disclosure Form - Includes but not limited to literary and artistic works

Software Disclosure Form - Includes but not limited to source code

Research Tool Disclosure Form

Disclosure Assessment Form

Confidentiality Disclosure Agreement Forms (CDAs)

Student Petition to Release IP

Internship Petition to Release IP

Related Forms
# INVENTION DISCLOSURE FORM

**NU #:** _____________

**Date Received:** _____________

Please COMPLETE, SIGN and SEND with any relevant attachments by EMAIL to:

invodisclosure@northwestern.edu

## INVENTION TITLE

## INVENTOR(S)

- Please place an asterisk next to the principal investigator’s name.
- List all inventors, inside and outside Northwestern, and where they were employed at the time of invention and investigation.

<table>
<thead>
<tr>
<th>NAME (first, middle initial, last)</th>
<th>NU SCHOOL or Joint Institution</th>
<th>DEPT. OF APPOINTMENT (w/ Division if Medical)</th>
<th>POSITION</th>
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## SOURCES OF SUPPORT, RESEARCH SPONSORS AND GRANT NUMBERS

* All Funding Sources and Grant Numbers must be correct. If applicable, please include subcontract information corresponding to the funding listed. Please list all digits in funding sources and grant numbers, including zeros.

** Definition of Primary Agency: Federal agency that provided the greatest contribution to the invention, as initially determined by the grantee or contractor organization.

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**PLEASE CHECK THE WEBSITE FOR UPDATES USE MOST RECENT FORMS**
Common Issues that Slow Down Disclosure Processing

• Distinguishing between inventorship and authorship

• Accuracy of data for invention’s funding sources

• Thorough completion of inventor information
  (address, phone, email, NU ID number, citizenship)

• Signatures for all inventors
DISCLOSURE PROCESS

1. Invention Disclosure Submitted to INVO
2. Inventor Meeting to Discuss Disclosure
3. Patentability Assessment
4. Market Research & Commercialization Assessment
5. IP Protection Strategy & Commercialization Recommendations
INVO INVENTION MANAGEMENT TEAM:
• Oversees for invention from cradle to commercialization
• Provides technology, legal, and commercial expertise
• Decides whether to pursue patent or not
• Protects intellectual property

PATENT COSTS:
$25,000 to $35,000 over U.S. patent life*
• US Patent and Trademark Office (USPTO) fees
• Patent attorney/agent costs

*over $100,000 for foreign coverage
COMMERCIALIZATION
Plan to determine best path to bring the technology to the public domain

- License to an outside company or a start-up

INVENTION MANAGERS:
- Discuss with inventor
- Consult with industry experts and potential investors

TYPICAL CRITERIA FOR PLANS
- Risk Factors
- Technical Issues
- Market Area
- Financial Resources
- Regulatory Hurdles
- Management Capabilities
- Licensing Potential
LICENSING TO AN OUTSIDE COMPANY

- What companies are within this technology sector?
- What individuals at these companies does INVO have contact information for who would be able to evaluate for licensing opportunity?
- Market and promote technologies via INVO’s website, emails and company visits
LICENSING TO A START-UP

- Faculty interests and background in the commercial space
- Potential commercialization partners
- Match faculty with entrepreneurs and local organizations like Chicago Innovation Mentors (CIM)
- Offer resources for startup grants (SBIR, STTR)
MOST IMPORTANT TAKE-HOME:

Be sure you disclose to INVO as early as possible.

If you aren’t sure, please contact us.
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