

IP process guide

Inventions

At a university, inventions may arise for various reasons and in different constellations. **Employee inventions** can arise both in the context of work tasks during working hours, but also outside of working hours, e.g. during a secondary employment (experience invention). Furthermore, employee inventions may also be **contractual inventions** that are developed in collaboration with industry or other research institutions.

Caution! An invention has already been created as soon as an idea can be described in a technically plausible manner – a prototype or functional model is not required. From this point in time, inventors are obliged to submit an invention disclosure to the IP Management of Ulm University.

Invention disclosure and assessment

To report an invention to the IP Management of Ulm University, the **invention disclosure form** (link to the form) must be completed in full. Receipt of the invention disclosure will be confirmed by e-mail to the named inventors.

IP Management first checks the completeness of the invention disclosure and the employment status of the inventors as well as whether the invention is subject to a third party contract or not. In the case of a contractual invention, the information and decision-making processes agreed in the contract must be observed; they partially replace the procedure described below.

The inventors will be notified no later than 4 months after receipt of the invention disclosure whether Ulm University wishes to **claim or release** the invention. The decision is based on whether the invention would be **protectable** and thus patentable. According to the Patent Act, it must be determined whether the invention is new, involves an inventive step and is industrially applicable (§1 PatG). In addition, the development status and user potential of the invention as well as its chances of commercialisation are determined.

By claiming the invention, Ulm University decides to utilise the rights to the invention for a patent application and commercialisation. IP Management takes care of the subsequent processes, which are briefly summarised below.

Caution! The novelty of an invention is a mandatory requirement for patenting. However, it can only be maintained as long as there is no disclosure. This disclosure can also occur, for example, through lectures, conference contributions or through communication with collaboration partners, such as another higher education institution or a company.

As a rule, a patent application can be filed with the patent office four months after receipt of a complete invention disclosure. In justified individual cases, a patent

application can be filed with the patent office as early as two months after the invention disclosure by submitting a complete invention disclosure and proper notification of an intention to publish. From the time of the patent application, a disclosure no longer jeopardises the grant of the patent.

Furthermore, it is possible to omit the core of the invention from posters, abstracts or lectures. The handling of a possible disclosure, if necessary also the use of a non-disclosure agreement, must be discussed with the IP Management of Ulm University. We will certainly find a solution together.

First application / priority application

IP Management at Ulm University commissions a patent law firm to draft the patent specification and liaises with the inventors for technical coordination. The expert knowledge of the inventors and their cooperation supports a successful patent procedure and successful commercialisation.

The patent is applied for by the patent law firm at the relevant patent office in the name of Ulm University. The inventors are named as such on the patent specification.

Formal examination procedure

The patent office issues a **first publication** 18 months after the first application for the invention at the patent office, whereby the patent application becomes part of the state of the art and is accessible to everyone. This first publication is independent of whether the patent is granted or not.

After filing the first application with the patent office, a formal examination is carried out there and the prior art is searched. The IP management or the commissioned patent law firm will answer the prior art search report in technical consultation with the inventors.

Granting of the patent

An official **decision to grant a patent** is issued as soon as the patent office is able to grant a patent for a completed patent application. Otherwise, a decision of rejection will be sent. The patent office will obtain the grant and official entry in the patent register if the official decision to grant is not objected to within the admissible opposition period.

Caution! From the time the patent is granted, the patent is protected against imitators.

Subsequent application

A subsequent application abroad as a **European patent (EP) or international patent (PCT)** can be filed with the relevant patent office no later than 12 months after the initial application. Ulm University decides on the subsequent application in consultation with the inventors. The decisive factor here is the expected commercialisation proceeds in relation to the costs

incurred. Separate patent application costs are incurred for each country in which the patent is to be applied for.

Invention premium / inventor's remuneration

As the applicant, Ulm University has the rights to exploit the invention. The inventors are remunerated in accordance with the **Employee Inventions Act (§42 No.4 ArbEG)**.

Patent commercialisation

The **term and thus the protection of the patent**, starting from the date of application to the patent office, is a maximum of 20 years. IP Management coordinates the administration, maintenance and defence of the patent and therefore also the payment of patent costs and inventor's remuneration.

The **maintenance of a patent** is regularly reassessed. Patent costs and commercialisation opportunities are taken into account, if necessary with support from industry or the inventor.

In the best case scenario, the IP Management of Ulm University speaks with suitable industrial contacts of the inventors to enable the patent to be utilised. If necessary, a patent commercialisation agency is commissioned for this purpose. Negotiations on the terms of further development, licensing or sale are conducted by IP Management.