

IP process guide

Inventions

At a university, inventions may emerge for various reasons and in various settings. **Employee inventions** can arise both in the context of work duties during working hours and outside of working hours – for example, in the course of secondary employment (‘experience invention’). In addition, employee inventions may also be **contractual inventions** developed in collaboration with industry or other research institutions, and governed by the respective agreement.

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 forward, inventors are required to submit an invention disclosure to the Ulm University’s IP Management.

Invention disclosure and assessment

To report an invention to the Ulm University’s IP Management, the **invention disclosure form** ([link to the form](#)) must be fully completed. 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 contractual inventions, the information and decision-making processes defined in the respective agreement shall apply. These may replace certain parts of 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.

Generally, a patent application must be filed with the patent office no later than 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 filing the patent application, a disclosure no longer jeopardises the grant of the patent.

Furthermore, it is possible to deliberately omit the core of the invention from posters, abstracts or lectures. The handling of a possible disclosure – including, where appropriate, the consideration of a non-disclosure agreement - must be discussed with the Ulm University's IP Management. We are confident that we will find a solution together.

First application / priority application

Ulm University's IP Management commissions a patent law firm to draft the patent application and organise a kick-off meeting with the inventors. The expert knowledge of the inventors and their cooperation is necessary for a successful patent procedure and commercialisation.

The patent is filed by the patent law firm with the selected patent office in the name of Ulm University. The inventors are named as such on the patent application.

Formal examination procedure

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.

Based on the results of the search report, discussions with the inventors, and commercialisation potential, a foreign extension (i.e. subsequent application) of the patent may be considered.

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.

Granting of the patent

An official **decision to grant a patent** is issued once the patent office has completed its examination and determined that all legal and formal requirements for patentability are fulfilled. If these requirements are not met, a decision of rejection will be issued. If no opposition is filed within the prescribed period, the patent will be granted and entered into the official patent register.

Caution! Upon publication of the patent application, provisional protection against unauthorized use takes effect. Once the patent is granted, it provides full legal protection against infringement.

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 application is filed.

inventor's compensation

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

Patent commercialisation

The **term of patent protection** begins on the filing date with the patent office and lasts for a maximum of 20 years. IP Management is responsible for coordinating the administration, maintenance, and enforcement of the patent, including the payment of patent fees and inventor 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.

Where possible, Ulm University's IP Management engages with relevant industrial contacts provided by the inventors to support commercialization of the patent. 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.