



A RESEARCHER'S POCKET GUIDE

INVENTION DISCLOSURE AND PATENT PROCESS



Research

Academic research often generates knowledge that leads to new discoveries and inventions.

Inventions that satisfy the requirements of novelty, inventiveness, and industrial applicability may be protected by patent laws and enjoy an exclusive patent right for up to 20 years.

At HKU, the Technology Transfer Office (TTO) manages staff-generated inventions and intellectual property rights belonging to the University and assists inventors to achieve academic recognition and financial rewards via protection and commercialization of the invented technologies.



Invention Disclosure

The technology transfer process begins with staff submitting an Invention Disclosure Form (IDF), notifying TTO of a potentially patentable invention that they have made. The duty to report and disclose the inventions generated during the staff's course of employment is obligatory.

The TTO Patent Evaluation Committee then reviews the invention and makes recommendations on the appropriate methods of protection.

As the IDF records the conception of the invention and provides a basis for the analysis of its patentability, commercial value, and ownership and any contractual obligations, it should be prepared with due care.

Quick Tips on Invention Disclosure



Any public disclosure renders an invention unpatentable. Therefore, before a patent application is filed **DO NOT:**

- Present the invention at any event
- Provide an abstract for any meeting
- Post any information online
- Publish in any journal
- Speak with any media or press outlets
- Make any advertisements, sales, or demonstrations
- Discuss with any third party without a signed non-disclosure agreement (NDA)



Good practice in IDF preparation

- Before preparation, consult the Guidelines for Completing the IDF annexed to the disclosure form
- Submit the IDF at least 3 months before any planned future disclosure to allow sufficient time for evaluation and patent drafting
- On the IDF, only list as inventors persons who intellectually contributed to the invention, and do not list those who merely carried out instructions or provided non-technical advice
- Explain the invention in a clear and detailed manner, and identify at least one way in which it could be made and used
- Perform a preliminary patent search and explain the invention's distinguishing technical features by comparing it point-by-point with existing technologies (prior art)

Patent Evaluation and Filing Processes

Submission of completed IDF

- 1 The inventor submits a completed IDF to the Intellectual Property Management team of TTO.
- 2 TTO confirms receipt and arranges evaluation in 4 to 6 weeks.

First committee evaluation

- 3 TTO conducts a multi-factored assessment having regard to the patentability and commercial value of the invention, and the opinions of the inventor.
- 4 If filing is recommended, the inventor is notified of the filing strategy. If not, the inventor is notified of the reasons for refusal and may request re-assignment of IP rights for disposition at the inventor's own cost.

Patent drafting and filing

- 5 TTO instructs an external patent attorney skilled in the technology area to prepare the patent claims and specification. This typically takes 4 to 8 weeks.
- 6 The inventor is invited to provide comments and/or revisions on the draft.
- 7 TTO arranges patent filing and execution of the legal documents, and attends to requests and challenges from patent examiners.

Second committee evaluation

- 8 When provisional / PCT (international) application is due for conversion to regular / national patent application (if applicable), TTO conducts further evaluation to determine the appropriate filing strategies having regard to the opinions of patent examiners and attorneys, new developments on the invention (if any), and other relevant factors.

Further down the road

- 9 TTO continues to handle patent prosecution, responses to office actions, appeals, and proceedings, until final rejection or issuance.
- 10 Getting a patent granted typically takes 3 to 10 years of continuous work. Also, maintenance work is required to keep a registered patent alive.
- 11 In the event that TTO considers it no longer practicable to continue pursuing a pending application or maintaining a granted patent, the inventor is notified of the reasons and may request re-assignment of IP rights for disposition at the inventor's own cost.

Patent Budgeting

Where funding is secured for patent costs, patent filing is generally approved more expeditiously. Researchers are therefore encouraged to request a patent budget (recommended amount: HK\$250k) in their research grant applications.

For more information, please refer to the 'Useful Materials' on the back cover.

Useful Materials



HKU IPR POLICY

<http://www.rss.hku.hk/contracts/ipr>



HKU INVENTOR'S GUIDE

<https://www.tto.hku.hk/booklet>



INVENTION DISCLOSURE FORM

<https://www.tto.hku.hk/for-researchers/forms-agreements-and-other-templates/invention-disclosure-form>



RESEARCH RELATED AGREEMENT TEMPLATES

<http://www.rss.hku.hk/contracts/contract-research/templates>

IPR Enquiries

Intellectual Property Management Team, Technology Transfer Office

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2299-0133 (Invention Disclosure & Patent Procedures)
2299-0108 (Science & Engineering Inventions)
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