

SMITH HOPEN

U.S. REGISTERED PATENT ATTORNEYS

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Invention Disclosure

Date Submitted: _____

Client Name: _____
(Company Name)

Phone: _____

Person Submitting Disclosure: _____

Fax: _____

Email: _____ Website: _____

Address: _____ City: _____ State: _____ Zip: _____

Technical Invention Title: _____

Brand name / Trademark Name of Technology (if exists): _____
(e.g., Teflon, Pentium, etc..)

Inventorship

1) Please list all individuals that materially contributed to the conception and completion of the invention.*

INVENTOR #1: Name: _____ Citizenship: _____

City of Residence: _____ State of Residence: _____ Zip: _____

Email: _____

INVENTOR #2: Name: _____ Citizenship: _____

City of Residence: _____ State of Residence: _____ Zip: _____

Email: _____

INVENTOR #3: Name: _____ Citizenship: _____

City of Residence: _____ State of Residence: _____ Zip: _____

Email: _____

INVENTOR #4: Name: _____ Citizenship: _____

City of Residence: _____ State of Residence: _____ Zip: _____

Email: _____

Government Support

2) Was this invention supported by government funds? Yes No

If "Yes": Agency: _____ Grant No.: _____
(i.e., DARPA, NIH, DOD, etc..)

* If there are more than four (4) inventors please attach an addendum to this document.

Public Disclosures / Commercialization

3) Have you disclosed the invention to third-parties or commercialized the invention yet? Yes No

If "Yes" was selected above, date of disclosure: _____
(date)

Describe the circumstances of the disclosure/commercialization: _____
(e.g., seminar, trade show, etc..)

4) If "No" was selected in Question 3, when do you plan to disclosure or commercialize? _____
(date or unknown)

Foreign Patent Protection

5) It is possible foreign patent protection will be sought on this invention? Yes No

If "Yes" note countries or regions desired: _____
(e.g., Europe, Japan, Canada, Australia, etc...)

Invention Disclosure

6) Describe the general field of this invention:

(e.g. "this invention relates to solar energy, in particular high-efficiency organic photovoltaic cells")

7) What problems or drawbacks in the current state of the art served as motivation for the current invention?

8) Briefly describe the invention in the form of an abstract:

9) What are the primary objectives of this invention?

10) What is the closest existing technology to the invention?

11) How does the invention improve upon the technology noted above?

12) Have any patents been filed on related inventions? Yes No

If "Yes" please identify patents: _____

13) Please outline a detailed description of the invention below. Attach any additional pages required including illustrations.



14) _____ additional pages are attached to this disclosure.

Acknowledgement

- 15) The duty of candor is acknowledged herein (see Attachment A).
- 16) The best mode requirement is acknowledged herein (see Attachment B).
- 17) The criteria for determining inventorship is acknowledged here (see Attachment C).

CLIENT: _____ E-SIGNATURE: / _____ / DATE: _____

Please email this document to staff@smithhopen.com. Additional documentation may be scanned and emailed to staff@smithhopen.com or faxed to (727) 507-8668.

ATTACHMENT A

Duty to Disclose

Everyone who is involved in any substantive way in the preparation or prosecution of an application for a patent before the United States Patent and Trademark Office (the "subject application"), including all inventors, all attorneys, all company executives or other agents of the inventors or of any assignee or licensee, and who participates in the application process, by 37 C.F.R. § 1.56 owes a duty of candor and good faith to the PTO and to the public. The scope of this duty is set forth in the following paragraphs.

The extent of this duty is commensurate with the degree of involvement of the individual in the preparation or prosecution of the subject application. All such individuals have a duty to disclose to the PTO information they are aware of which is material to the examination of the subject application. Such information is material where there is a substantial likelihood that a reasonable Examiner at the PTO would consider it important in deciding whether to allow the subject application to issue as a patent.

Examples of information material to the subject application include (but are not limited to):

- A description of the invention, or a material portion of it, in a patent or printed publication in the United States or any foreign country which occurred before the applicant's invention, or more than one year before the subject application was filed;
- An public use or sale, or offer for sale, of the invention, or a material portion of it, in the United States more than one year before the subject application was filed;
- Abandonment of the invention at any time; Information showing or tending to show that the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country on an application for patent or inventor's certificate filed more than twelve months before the filing of the subject application in the United States;
- Information showing or tending to show that the invention was described in a patent granted on an & application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another before the invention;
- Information showing or tending to show that a named inventor did not himself invent the subject matter sought to be patented; Information showing or tending to show that before the applicant's invention thereof, the invention was made in this country by another who had not abandoned, suppressed, or concealed it.
- In evaluating the novelty of an invention, it is important to consider not only evidence disclosing or teaching the entire invention, but also evidence showing or tending to show that the differences between what is sought to be patented by the subject application and the prior art are such that the invention as a whole would have been obvious at the time it was made to a person having ordinary skill in the art to which such invention pertains.

In view of the foregoing, we rely on you to fully inform us concerning such information, to supply us with true and complete copies of all documents relevant to such information, and to monitor our communications with the PTO to ensure that such information is fully and accurately disclosed in a timely manner.

ATTACHMENT B

Best Mode Requirement

Applicants for patents are required to describe their invention, and the manner and process of making and using it, "in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

These two related requirements are at times referred to as the preferred embodiment requirement or the best mode requirement. Since patents have been invalidated for failure of the applicant to adequately present or describe the invention, it is important that we be sure to include in the application a sufficient description to permit one skilled in the field to which the invention pertains to make and use not only some form of the invention, but the best form of the invention known to us at the time the application is filed.

For example, if we know that the preferred form of the invention requires use of a particular material, or processing of a particular sort, we must fully disclose this in the application. Put differently, if we decide that some aspect of the invention is really proprietary and a trade secret and therefore do not disclose this aspect in the application even though it relates to the preferred embodiment of the invention, not only will any resulting patent likely be invalid, we also may be held liable for significant damages occasioned by others who have been sued for infringement of the patent, or who have improperly paid royalties thinking the patent to be valid, or who have had to change what they were doing, or were investing monies to design around what they thought to be a valid patent.

Only you know what the preferred embodiment of the invention is. Only you know what the best mode for your system or process is. Thus, only you can determine if the application as prepared fully sets forth the preferred embodiment of the invention, and the best mode, in sufficient detail to make sure that others skilled in this field can make and use the invention to achieve all of the advantages we think presently flow from the invention. When the inventor or inventors execute the application, they must have no reservation in their minds about whether or not it adequately sets forth the preferred embodiment of the invention, and the best mode contemplated for practicing the invention. They must be able to candidly and truthfully answer questions posed by someone, even years later after the invention has undergone further refinements, that when they signed the application it indeed set forth what was the preferred embodiment of the invention and its best mode as well.

Should you have any questions about the foregoing, please discuss them with us before we put the application in final form so that we can be sure that the application complies with these requirements. We do not mean to suggest by the foregoing that the best mode and preferred embodiment of the invention presented in the application must be what you finally use or market. It is certainly understandable that after the application is signed and filed with the Patent and Trademark Office, you and others may continue to work on and develop the invention it describes, such that subsequently you may elect to introduce and market a form of the invention that is somewhat different from the form set forth in the application.

However, at the time the inventors sign the patent application, it must set forth the then preferred embodiment and best mode of the invention. Once the application is filed with the PTO, it is not possible to add variations or improvements without filing a new application, termed a "continuation-in-part" application. But it is possible, even after the application has been filed, to make sure that the claims cover not only the form of the invention set forth in the application, but also variations and elaborations which you subsequently develop or decide to employ in connection with the invention. For this reason, please keep us advised of such developments so that we can make sure that the application includes claims of appropriate scope to cover not only what is set forth in the application but also what you are marketing and what others might decide to offer in competition with you. Again, it is best to discuss any questions you have concerning these matters with us; we welcome such discussions at any time.

ATTACHMENT C

Determining Inventorship

It is important to accurately determine the inventor or inventors of an invention set forth in an application for patent. The act of inventing is, basically, the act of bringing an idea to fruition. It begins with conception of the idea. After it is conceived, the invention is reduced to practice by making and testing the invented object or process under conditions that it will typically encounter.

Just as often, the "reduction to practice" is effected, insofar as patent law is concerned, by filing a patent application. Thus, to determine inventorship, it is important to focus upon the conception or conceptions involved. These conceptions, technically speaking, are the conceptions set forth in the claims, the numbered paragraphs that conclude the patent application. The claims will certainly reflect the preferred and described embodiment of the invention, but they may focus on certain elements of the preferred embodiment and omit others. For that reason, when determining inventorship, it is necessary to examine the claims of the application.

The conception of an invention may have occurred in the mind of a single person, or may have occurred during joint efforts by two or more people. It is not necessary for these people to physically work together, or to work on the invention at the same time, or to make the same type or amount of contribution, or to each contribute to the subject matter of each claim of the application. Instead, two or more people may be joint inventors as a result of their joint efforts concerning the invention as defined by the various claims of the application. When each contributed important aspects of the claimed invention to the joint effort, then each properly should be named as a joint inventor. On the other hand, the invention may have come into being as a result of a conception by one person. In such a case, even though others may have suggested variations or elaborations on the invention, if those variations or elaborations would have been obvious to one skilled in the field of the invention, then the invention would be the product of the single, initial person.

Whether or not an invention was conceived by one or more people, it can be owned by any entity or combination of entities. The inventors can assign the invention, for example, to their employer, or one inventor can assign his interest in the invention to another inventor, or joint inventors can assign the invention to a third party. Accordingly, ownership of an invention is a question completely separate and different from the fact of inventorship itself. Inventorship depends upon conception. The original inventor or inventors own the invention until its assignment. While errors in determination of inventorship may be corrected, provided they arose without any deceptive intention, still it is important to accurately determine inventorship. This determination should be based upon and reflect the early records of the invention. Put differently, willfully naming someone as an inventor who is known not to be an inventor constitutes grounds for invalidating any patent based on the invention. Accordingly, the person or group of people named in an application as the inventor of the invention should only include those who significantly contributed to the invention, and not those who are named, for example, solely because they were the supervisors of the actual inventors.

Should you have any questions concerning determination of inventorship, please discuss them with us.