**KING FAHD UNIVERSITY OF PETROLEUM & MINERALS**

# INVENTION DISCLOSURE FORM (IDF)

|  |  |  |
| --- | --- | --- |
|  | KFUPM ref. no.: |  |
|  | Docket no.: |  |
| **INSTRUCTIONS**  Please provide both soft and hard copy of this IDF   * SOFT COPY: Completely fill the form and email soft copy to iao-dtv@kfupm.edu.sa (without signatures) * HARD COPY: Print the filled form, **SIGN** and submit hard copy at following location:   *Innovation and Industrial Relation*  *Technology Transfer, Innovation and Entrepreneurship (TTIE)*  *Innovation Cluster Building, DTVC, Room 1148*  *Phone: 013 860 7811*  Further instructions to fill the form are made available in Appendix F | | |

## Title of Invention

|  |
| --- |
|  |
|

\*The term “Invention” herein includes any ideas and material that may qualify for patent, copyright or other intellectual property rights.

## Please submit Microsoft Word file of Invention Disclosure (written description of your invention) by email to iao-dtv@kfupm.edu.sa

## Contributor(s)

1. List below all persons who may have contributed to conception or creative reduction to practice of this invention (please carefully read Appendix E before filling this section; inventorship shall be subjected to legal review)

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| # | Title | Name(s) of Contributor(s) | Position | Department |
| 1. |  |  |  |  |
| 2. |  |  |  |  |
| 3. |  |  |  |  |
| 4. |  |  |  |  |
| 5. |  |  |  |  |

**If a KFUPM student is included as contributor, please fill and submit Appendix A**

1. Please nominate a contributor from above list who will serve as the principal contact for correspondence with Innovation and Industrial Relation:

|  |  |  |  |
| --- | --- | --- | --- |
| i. | Name | : |  |
| ii. | Email address | : |  |
|  |  |  |  |
| iii. | Phone | : | Office: |
|  |  | : | Mobile: |

*(Please note: The Innovation and Industrial Relation will communicate only with the principal contact specified above for all matters related to the invention disclosed herein)*

1. With reference to Section 3 (a), if you have listed a contributor who is not KFUPM employee or student, please indicate if there is a collaboration/contract research agreement in place between KFUPM and the non-KFUPM contributor’s employer. YES  / NO

* If YES, please provide a copy of agreement.
* If NO, arrange following forms to be submitted along with this Invention Disclosure Form:
  + Waiver Form(Appendix C)– to be filled and signed by non-KFUPM contributor
  + No Objection Letter (Appendix D) – to be filled and signed by employer of non-KFUPM contributor.

## **Was this invention developed with the use of any research grant/contract funds?** YES / NO

If YES, please provide the details below

|  |  |  |
| --- | --- | --- |
| Contract / Project / Grant no(s). | Sponsor(s) (for e.g. KACST, NSTIP, Saudi Aramco, KAUST, SABIC etc.) | Principal Investigator |
|  |  |  |

Please note that accurate and complete sponsorship information is necessary to fulfill KFUPM obligations under research grant and contracts. The information provided will be helpful to determine KFUPM’s Intellectual Property (IP) rights.

## Disclosures of the Invention

Were there any prior public disclosure(s) or are there any anticipated disclosure(s), either written or oral, of the Invention? YES  / NO

If YES, please select appropriate box(es) below:

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| PUBLIC DISCLOSURE | STATUS |  | WHERE | | DATE |
| Journal article\* | Submitted |  |  | | Click here to enter a date. |
|  | Accepted |  |  | | Click here to enter a date. |
|  | Published |  |  | | Click here to enter a date. |
| Conference\* | Submitted |  |  | | Click here to enter a date. |
|  | Accepted |  |  | | Click here to enter a date. |
|  | Presented |  |  | | Click here to enter a date. |
| Oral Presentation | Thesis/Dissertation defense | | |  | Click here to enter a date. |
|  | Seminar |  |  | | Click here to enter a date. |
|  | Other |  |  | | Click here to enter a date. |
| Poster Presentation | |  |  | | Click here to enter a date. |
| Disclosure to Industry\* | |  |  | | Click here to enter a date. |
| Grant Proposal\* | |  |  | | Click here to enter a date. |
| Other | |  |  | | Click here to enter a date. |

\*\*Please submit a soft copy of the disclosed material, for e.g. journal/conference article, thesis/dissertation copy etc, by email to: iao-dtv@kfupm.edu.sa.

## Which of the following categories apply to your invention (you may check more than one box, if applicable)?

|  |  |  |  |
| --- | --- | --- | --- |
|  | New Process |  | New Device |
|  | New Product |  | New Composition of Matter |
|  | New Use for an Existing Process/Product |  | Improvement to an Existing Process/Product |
|  | Other |  | |

## Please specify under which of the following strategic research areas of KFUPM and Kingdom of Saudi Arabia your invention can be categorized (you may check more than one box, if applicable)?

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
|  | Advanced Materials |  | Aerospace |  | Air Conditioning |
|  | Construction |  | Corrosion |  | Electrical Power |
|  | Electronics and Telecommunication |  | Energy |  | Environment Protection |
|  | Information Technology |  | Mathematics and Physics |  | Nanotechnology |
|  | Oil and gas |  | Petrochemicals |  | Renewables |
|  | Water |  | Other |  |  |

## Please also specify how your invention is relevant to the above selected research area?

|  |
| --- |
|  |

## Date of Conception

Has the date of conception of invention been documented in a laboratory notebook (or other documents)? YES  / NO

If YES, provide the date of conception: Click here to enter a date.

## With reference to Appendix E, please provide contribution of each contributor in the invention (only if more than two contributors were listed in Section 3 (a))

|  |  |  |  |
| --- | --- | --- | --- |
| 1 | Name | : |  |
|  | Please describe detailed contribution to the invention: | | |
| 2 | Name | : |  |
|  | Please describe detailed contribution to the invention: | | |
| 3 | Name | : |  |
|  | Please describe detailed contribution to the invention: | | |
| 4 | Name | : |  |
|  | Please describe detailed contribution to the invention: | | |
| 5 | Name | : |  |
|  | Please describe detailed contribution to the invention: | | |

## If your invention clearly recognizes a commercial problem to be solved and if a technology / method / process / product already exists in market (not just in literature) which solves the problem, please provide the advantages or unique feature(s) of your invention when compared to the existing solution(s). (e.g., what could it do to help a potential customer: lower expenses, increase productivity, efficiency or accuracy, minimize risk, simplify a process, overcome a defect, increase revenue etc.?)

|  |
| --- |
|  |

## Please identify and list the products or services where the proposed invention could be applied or implemented in practice

|  |
| --- |
|  |

## Please list names of commercial entities which you believe may be interested to license the invention in its present form. Also specify the reason why they would be interested (please note that end-user may not be interested in a concept, they are more interested in a final product, in such case a company providing the service or solution needed by the end-user may be the potential target for licensing your invention)

|  |
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|  |

## Declaration

I (We) hereby declare and sign that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

|  |
| --- |
| I (We) do hereby assign all rights, title and interest to this invention to KFUPM, and agree to execute all documents that are requested, assigning to KFUPM our rights in any patent application filed from this invention, and to cooperate with the KFUPM Innovation and Industrial Relation in the protection of this invention. KFUPM will share any royalty income derived from the invention with the contributor(s) according to its standard policies. |

|  |  |  |
| --- | --- | --- |
| 1. | Contributor’s name |  |
| Contributor’s signature |  |
| Date | Click here to enter a date. |
| KFUPM ID |  |
| Home Address |  |
| Country of Citizenship |  |
| 2. | Contributor’s name |  |
| Contributor’s signature |  |
| Date | Click here to enter a date. |
| KFUPM ID |  |
| Home Address |  |
| Country of Citizenship |  |
| 3. | Contributor’s name |  |
| Contributor’s signature |  |
| Date | Click here to enter a date. |
| KFUPM ID |  |
| Home Address |  |
| Country of Citizenship |  |
| 4. | Contributor’s name |  |
| Contributor’s signature |  |
| Date | Click here to enter a date. |
| KFUPM ID |  |
| Home Address |  |
| Country of Citizenship |  |
| 5. | Contributor’s name |  |
|  | Contributor’s signature |  |
|  | Date | Click here to enter a date. |
|  | KFUPM ID |  |
|  | Home Address |  |
|  | Country of Citizenship |  |

*Please note that the above information is required and that the absence of this information may hinder distribution of the contributor’s share of any royalties that may result from this technology.*

Director General, Innovation and Industrial Relation: Signature \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ Date\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Innovation and Industrial Relation (IIR), Technology Transfer, Innovation and Entrepreneurship (TTIE)

Phone: 860-7811, Innovation Cluster Building, DTVC, Room 1148

# APPENDIX A

**STUDENT FORM**

(Fill and submit along with Invention Disclosure Form, if applicable)

|  |  |  |
| --- | --- | --- |
| Name | : |  |

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| 1. **Please tick appropriate box** | | | | |
|  | I am currently a student at KFUPM | | | |
|  | I have graduated |  | Left the University | |
|  | |  | Full time employee at KFUPM | |
| *Provide current Staff or Faculty id* |  |

1. **Student details:**

(The students who have graduated also need to provide the following details)

|  |  |  |
| --- | --- | --- |
| 9 Digit Student ID | : |  |
| Staff / Faculty ID (if applicable) | : |  |
| Mobile Number | : |  |
| Personal E-mail (you always use) | : |  |

1. **Tick appropriate box(es)**

|  |  |  |  |
| --- | --- | --- | --- |
|  | Undergraduate Student |  |  |
|  | M.S. Student |  | Full-time Student |
|  |  |  | Part-time Student |
|  |  |  | Research Assistant (R.A.) |
|  |  |  | Graduate Assistant (G.A.) |
|  | PhD Student |  | Full-time Student |
|  |  |  | Part-time Student |
|  |  |  | Lecturer-A |
|  |  |  | Lecturer-B |
|  | Other |  |  |

# APPENDIX B

**TIMELINE REQUIREMENTS FOR INVENTORS**

(Fill, sign and submit along with Invention Disclosure Form)

|  |
| --- |
| Invention Disclosure Title: |

KFUPM and the Contributor(s) wish to provide for the efficient handling of all dealings during the Patent process (to include disclosure review, patent search, and patent application and office actions), and thus agree to the following:

KFUPM shall promptly send notice to Contributor(s) of any item pertaining to the Invention or Patent Application that requires input or other action from Contributor.

At each stage in the patent process the Contributor(s) shall respond according to the timeline below:

|  |  |
| --- | --- |
| **Stage in the Patent Process** | **Response Due to KFUPM Office** |
| Disclosure Review or Patent Search | Contributor(s) will respond with comments within 3 weeks |
| Patent Application – Questions from application writers | Contributor(s) will respond with answers within 2 weeks |
| Completed Draft of Patent Application | Contributor(s) will respond with comments, changes, or, if satisfied with the draft, signatures within 2 weeks |
| Office Action | Contributor(s) will respond with comments within 1 month |

|  |
| --- |
|  |
| Signature of Contributor\* |

*(\*To be signed by the contributor who would serve as principal contact with Innovation and Industrial Relation)*

# APPENDIX C

**WAIVER FORM**

**WAIVER OF ANY AND ALL INTEREST IN INTELLECTUAL PROPERTY**

[*Name of Collaborator*] (“Colleague”), of [*Name of Institution*], shall be working and/or collaborating with [*Name of KFUPM researcher*] (“KFUPM Researcher”), who is either employed by or a student of King Fahd University of Petroleum & Minerals (“KFUPM” or “University”).

The Colleague hereby acknowledges and agrees to the following.

1. Colleague acknowledges and agrees that as between Colleague and University, the University is the owner of all right, title and interest in and to all Intellectual Property as such term is defined below.
2. (A) “Intellectual Property” means any and all art, method, process, procedure, invention, idea, design, concept, technique, discovery, improvement or moral right, regardless of patentability, as well as any patents, patent applications, copyrights, trademarks, service marks, trade names, trade secrets, know-how or other intellectual property rights recognized in any country or jurisdiction in the world, which is developed by Colleague in association with and/or jointly with KFUPM Researcher including, but not limited to, that which is developed with the use of any University facilities, equipment and/or other University resources including, but not limited to, KFUPM Researcher.

(B) “Intellectual Property Protections” means the registration, application, filing, prosecution or maintenance of a patent, copyright, trademark or other protective measure for Intellectual Property.

1. The Colleague hereby acknowledges and agrees that the University is the owner of all right, title and interest in and to the Intellectual Property. Moreover, to the extent any such Intellectual Property is deemed by any party to reside with Colleague, Colleague hereby assigns to University all of its rights and interests in and to the Intellectual Property. Further, Colleague shall promptly disclose any Intellectual Property developed by Colleague that Colleague is aware of and shall use all reasonable efforts, at University’s request and at no cost to University, to cooperate fully with University to transfer any such Intellectual Property to University. To the extent any payment is due Colleague with respect to University’s use or exploitation of such Intellectual Property, such payment shall be from net royalties accrued by the University in accordance with University policies and regulations.
2. The University may, in its sole discretion, file for and maintain Intellectual Property Protections anywhere in the world for any and all Intellectual Property. Such right to maintain Intellectual Property Protections shall reside solely with the University and its authorized agents, representatives and designees. To the extent, Licensor, or its authorized agents, representatives and designees, require the assistance of Colleague in conjunction with the filing, prosecution and/or maintenance of its Intellectual Property Protections and any and all related enhancements, discoveries and inventions, Colleague shall cooperate with University and its authorized agents, representatives and designees.
3. Colleague understands that the University is free to publish materials (including, but not limited to, reports and papers of research and other activities related to the Intellectual Property and/or its development). Any such reports or papers may refer to the fact that the Intellectual Property was developed with Colleague’s participation and may, further, acknowledge Colleague’s role therein, it being understood that such reference shall be made in the University’s sole discretion. Colleague hereby grants University the right to use Colleague’s name only in conjunction with any such publication as described herein.
4. Colleague hereby represents and warrants that his/her waiver and/or assignment of Intellectual Property rights as specified herein does not conflict with nor violate any other obligations, terms or conditions he/she may have pursuant to any other contract(s), policy(ies) and/or regulation(s) with any third party(ies).

The undersigned Colleague has caused this Waiver of any and all Intellectual Property to be duly executed.

|  |  |  |  |  |
| --- | --- | --- | --- | --- |
| DATE: | Click here to enter a date. | Name | : |  |
|  | Title | : |  |
|  |  | Signature | : |  |

# APPENDIX D

**NO OBJECTION LETTER**

To,

Director General - Innovation and Industrial Relation,

Technology Transfer, Innovation and Entrepreneurship,

King Fahd University of Petroleum and Minerals,

Dhahran, Saudi Arabia.

Re: Proposed Collaboration between *Name of collaborators*

As an authorized representative of *Name of university/organization*, this letter confirms our awareness of the collaboration on *Title of Disclosure*, between our employee(s) *Name(s) of non-KFUPM contributor(s)* and *Name(s) of KFUPM researcher(s)*, who is either employed by or a student of King Fahd University of Petroleum & Minerals (“KFUPM”).

Our university/organization is aware that this employee has executed a document titled “Waiver Form” reflecting that KFUPM is the owner of all Intellectual Property rights resulting from the collaboration, and that the employee has waived any claim of such rights and agreed to assign all associated Intellectual Property rights to KFUPM.

Our university/organization does not object to this waiver and assignment of Intellectual Property rights, and does not claim any rights itself in the Intellectual Property resulting from the collaboration. Our university/organization acknowledges that it has no interest in any licensing or other revenues resulting from the collaboration or Intellectual Property rights resulting from it.

KFUPM is hereby authorized to solely prosecute and file patent applications which include this employee as a co-inventor, and to have any and all patents issued solely to KFUPM as owner.

|  |  |  |
| --- | --- | --- |
| Sincerely, |  |  |
| Name | : |  |
| Title | : |  |
| Signature | : |  |
| Date | : | Click here to enter a date. |

# APPENDIX E

**AUTHORSHIP vs INVENTORSHIP**

Scientific research organizations and academic institution tend to publish research results as quickly as possible through journal articles that often have multiple co-authors in addition to the primary researcher(s).

Some of the reasons for adding persons as co-authors include:

1. The primary researcher will employ students to perform routine assay and testing, e.g., sequencing genes and other routine laboratory work; it is customary to add the students as co-authors.
2. The co-author may be a colleague who has been asked to proofread the article before publication.
3. The co-author may be listed because he is the primary researcher’s supervisor or faculty advisor, although supervision may have merely been general.
4. All of the members of a research team may be listed as co-authors, even though the project was entirely designed by and managed by the primary researcher.
5. When the publication is a summary or condensed version of a doctoral dissertation, a faculty advisor may be listed as co-author because the advisor suggested the topic or problem that is the subject of the dissertation.
6. The co-author may have contributed to the journal article by updating the general state of current research, or by providing a theoretical explanation, including equations, for why the solution put forth in the article works or represents an advance in the art.

All of these may be valid reasons for naming persons as co-authors, and may be in accordance with the customary practice in the research field of institutional practice, but none of these reasons is sufficient for naming the co-author as an inventor in a U.S. patent application.

A U.S. patent application must name the inventors of the invention being claimed, which may be for a new and useful process, machine, manufacture, or composition of matter. The “invention” is defined by the claims in the patent application. Typically, the claims will include one or more independent claims, which will include a combination of steps (for a process or method), or a combination of elements (for a machine, manufacture, or composition of matter). The application may also include a series of dependent claims, each of which adds at least one additional step or element to the combination in the independent claim, or that places some limitation or qualification on a step or element already recited in the independent claim. An inventor is a person who contributes to adding a step, an element, or a limitation to at least one claim in the patent application.

Invention is usually said to require (1) conception; and (2) reduction to practice. “Conception” is the process of coming up with the idea for the invention that is complete enough that one of ordinary skill in the art can make and use the invention without undue experimentation. “Reduction to practice” may be an actual reduction to practice, e.g., making a model or prototype, or a constructive reduction to practice by filing a patent application that describes how one of ordinary skill in the art can make and use the invention without undue experimentation. A person who makes the model or prototype based solely on the instructions of the primary researcher is not an inventor. If, however, the person making the prototype must engage in nonroutine experimentation or solve an unexpected technical problem to make the invention work as described, then he may be a co-inventor, particularly if the solution to the problem is not known in the art. There may be joint inventorship. Usually joint inventorship will require communication between the joint inventors to come up with the complete conception of the invention, but not always.

# APPENDIX F

**INSTRUCTIONS TO FILL INVENTION DISCLOSURE FORM**

1. Fill the title of invention.
2. Send your invention disclosure in a ‘Microsoft Word file’ by email to [iao-dtv@kfupm.edu.sa](mailto:iao-dtv@kfupm.edu.sa).
3. Contributor(s)
4. After reading the *Inventorship vs. Authorship* document (Appendix-E) thoroughly, fill the name, position and department of each contributor. Please note that, Inventorship will be evaluated based on ‘contribution of each contributor’ in the invention, as provided by the contributors on page 3 and 4 of the form.
5. Nominate a contributor who will serve as principal contact with Innovation and Industrial Relation. The Innovation and Industrial Relation will interact only with the nominated principal contact for all matters related to this disclosure. **It is the responsibility of principal contact to communicate information to all other contributors. We suggest the principal contact is resident here so that he may be available for personal meetings if needed. Innovation and Industrial Relation should be notified of any change of address.**
6. If you have listed contributor(s) who is(are) not affiliated to KFUPM, please indicate if there is a collaboration agreement in place which establishes the terms of the joint work between KFUPM and other university/organization. If no agreement exists, the person from other university/organization needs to fill and sign the ‘Waiver Form’, and get the ‘No Objection Letter’ filled and signed by his/her employer. It is to be noted that, clearly and neatly scanned soft copies of these two executed documents are acceptable and can be sent to Innovation and Industrial Relation by email.

*Please note: Processing of disclosures which include contributors from other university/organization will start only after the signed ‘Waiver Form’ and ‘No Objection Letter’ are received.*

1. If the invention was developed using research grants/funds, please provide complete sponsorship information.
2. Check applicable boxes and provide necessary information.
3. Check all boxes that apply to the category of this invention.
4. Check all boxes that apply to the category of this invention.
5. Provide detailed information as to how your invention is related to the checked Strategic Area.
6. Provide date of conception of invention. If you do not remember the exact date, provide at least month and year.
7. If more than two contributors are listed, provide contribution of each contributor in the invention. This information is essential in determining true inventors.
8. The question is to understand the commercial potential of your claimed invention. Technical abstracts may not be helpful. Please use layman’s terms in providing information which may help us understand how your claimed invention overcomes the shortcomings of technologies/products already existing in market and what advantages does the invention provide?
9. List the products/services that might benefit from your invention. Provide all possible fields of commercial application of your invention.
10. List the names of commercial entities that might be interested in your invention to either license it at its present state or partner with KFUPM in technology development for commercialization.
11. Fill all applicable details and sign at the corresponding location. If any contributor is not resident in Saudi and thus unable to sign in personal, he may print the filled document, sign at the appropriate place, neatly scan the signed page and send it to the contributor who is principal contact. The hard copy of this form when submitted to Innovation and Industrial Relation should have at least one signature in original.