

General Instructions for Completing the Confidential Invention Disclosure Assessment (“the Form”)

- Complete each section of the Form to the furthest extent possible. You will be able to complete some of the questions using the Invention Disclosure and the resources that are available in the OTC, through the library, and over the Internet. For other questions, however, you will need additional information from the inventor, which you can obtain during the inventor interview.
- As you complete the Form, keep track of the questions that you have for the inventor in Section 3.9(a) so that someone can ask them of the inventor during the inventor interview.
- Complete the sections of the Form that correspond to your respective position in the table below.

Section on the Confidential Invention Disclosure Assessment	Licensing Intern	Patent Analytics Intern	Licensing Specialist
1. Invention Overview	X		
2. Licensing Specialist Recommendation Summary			
2.1 Licensing Specialist Recommendation			X
2.2 Technology Analysis			X
2.3 Commercialization Pathway			X
3. Invention Assessment			
3.1 Background of the Invention and Technology	X		
3.2 Invention Description	X		
3.3 Potential Commercial Applications	X		
3.4 Stage of Development	X		
3.5 Market Overview and Potential	X		
3.6 Competitive Analysis	X		
3.7 Potential Licensees	X		
3.8 Commercialization/Licensing Pathway	X		
3.9 Questions, Concerns, and Future Actions	X	X	X
4. Patent Analytics Assessment			
4.1 Encumbrances		X	
4.2 Patent and Literature Search Results		X	

- The Patent Analytics Interns will initially complete Sections 4.1 and 4.2 in a separate document and after completing those Sections, will copy and paste the completed Sections into the Form.
- Comments in green, which are found throughout the Form, provide additional information about how to complete each section of the Form. When finalizing the Form, Interns should remove all directives in green.
- Try to use careful non-defining/proclaiming fact language, as the Form might be viewed by outside legal counsel and the inventors. Use language like “Our understanding is.....” “It appears this invention....” “The inventors indicate...” Refer to inventions as novel inventions...not new inventions.
- **If you have ANY questions about completing the Form, ask a Licensing Specialist for guidance.**

Specific Instructions for Completing Each Section of the Form

1. Invention Overview

- The Licensing Intern completes Section 1: Invention Overview of the Form.
- Complete the table in Section 1 by using information from the Invention Disclosure and the Licensing Specialist assigned to this technology.
- For the row entitled “Description of the Invention,” describe what the invention is without getting into the details of how it works. You will describe the invention in more detail in Section 3.2: Invention Description.

2. Licensing Specialist Recommendation Summary

2.1 Licensing Specialist Recommendation

- Licensing Specialist completes Section 2.1: Licensing Specialist Recommendation after the Interns have completed all of Sections 1 and 3.
- After reviewing the completed Form and conducting the inventor interview, make a recommendation as to whether or not the University should protect the intellectual property disclosed in the Invention Disclosure and, if so, how and to what extent.
- Once you have reviewed the completed Form and conducted the inventor interview, give the invention an overall rating of High, Medium/High, Medium/Low, or Low. The spirit of this rating is to provide a total score for the technology based on the accumulation of the information collected in the Form and through the inventor interview. Use the following guidelines when assigning an overall rating:
 - High: Use the rating of “High” if you have no doubt that UT and the OTC should use additional resources at this time to both protect the intellectual property and to further commercialize the disclosed invention.
 - Medium/High: Use the rating of “Medium/High” if you are certain that UT and the OTC should use additional resources to either protect the intellectual property or to conduct additional research on the commercial potential of the disclosed invention, but you are unsure that UT and the OTC should spend resources on both at this time.
 - Medium/Low: Use the rating of “Medium/Low” if you believe that UT and the OTC should use the minimal amount of resources necessary to protect the intellectual property but should not spend additional resources trying to otherwise commercialize the technology at this time.
 - Low: Use the rating of “Low” if you have no doubt that UT and the OTC should NOT use additional resources to protect the intellectual property or to further commercialize the disclosed invention.

2.2 Technology Analysis

- Licensing Specialist completes Section 2.2: Technology Analysis after the interns have completed all of Sections 1 and 3.
- After reviewing the completed Form and conducting the inventor interview, rate the disclosed invention on a scale of 1 to 3 for each of the four categories in the left column of this section, with 3 being the highest and 1 being the lowest rating.
- Use the following guidelines when assigning a rating to each category:
 - Competitive Position - The spirit of this rating is to evaluate where the technology fits into the existing competitive landscape. Consider factors such as the competitive advantage that the technology has over other current products or services in the market, including the current “gold standard,” the size of the advancement over the current technology available in the market, and how entrenched the competition is with the target customer base (*i.e.*, switching costs, etc.). (See Sections 3.2: Invention Description, 3.5: Market Overview and Potential, and 3.6 Competitive Analysis)
 - Development Status - The spirit of this rating is to evaluate the technology’s level of development. Consider factors such as the existence of a prototype and how much additional research/funding is needed before a potential licensee would consider it licensable. Judge the level of development based upon how ready the technology is to be licensed, not necessarily how close it is to being sold in the market. (See Section 3.4: Stage of Development)
 - Intellectual Property Strength - The spirit of this rating is to evaluate the overall strength of the University’s IP position. Consider factors such as the number of similar patents, barriers to patentability, and the likelihood of US and foreign patent protection based on statutory bar dates. (See Sections 4.1: Encumbrances and 4.2: Patents and Literature Search Results)
 - Other Considerations - The spirit of this rating is to evaluate the intangible factors that might hinder or help efforts to commercialize or license the technology. Consider factors such as the inventor’s interest in the commercialization process, the level of current and future funding, barriers to commercialization not covered by the above categories, etc. (See Sections 3.8: Commercialization/Licensing Pathway and 3.9: Questions, Concerns, and Future Actions.)
- For the table in the left-hand column that shows the relationship between “Market Size” and “Time to Market”, place an “X” in the square that best represents the convergence of the market size and time to market for the technology.
- Use the following guidelines when determining “Market Size” and “Time to Market”:
 - For “Market Size”:
 - Small = less than \$50 million;
 - Medium = greater than \$50 million and less than \$500 million; and
 - Large = greater than \$500 million.
 - For “Time to Market”:

- Now = within the next year;
 - Later = more than one year and less than five years; and
 - Much Later = more than five years.
- In the box entitled “Comments,” provide a brief explanation for your placement of the “X.”

2.3 Commercialization Pathway

- Licensing Specialist completes Section 2.3: Commercialization Pathway after the interns have completed all of Sections 1 and 3.
- After reviewing the completed Form and conducting the inventor interview, recommend the best pathway for commercializing this technology.
- If possible, provide a high-level overview of the strategy you will use to implement the recommended pathway and list any lead candidates that you have already identified.

3. Invention Assessment (INTERNS COMPLETE THIS ENTIRE SECTION)

3.1 Background of the Invention and Technology

- The Licensing Intern completes Section 3.1: Background of the Invention and Technology.
- To the extent possible, Section 3.1 should be completed before the inventor interview and before the Patent Analytics Intern begins Sections 4.1: Encumbrances and 4.2: Patent and Literature Search Results.
- Section 3.1 provides general information about the area of technology or field of research that is related to the disclosed invention. Give a broad overview of this area of technology and enough background information and context so that the Licensing Specialist or an Intern has enough information to understand the more detailed invention description in Section 3.2.
 - For example, if the invention is related to imaging and therapeutic applications that are used to diagnose and treat certain types of cancer, provide a general explanation of these types of applications and the types of cancer that they are generally used to treat. The goal is not to explain how the disclosed invention works but, rather, to provide a general understanding of the underlying area of technology or field of research.
- Start by reviewing Section 2: Description of the Invention and Section 3: Disclosures and Background Information of the Biological Sciences or Physical Sciences Invention Disclosure (Sections 4 through 8 of the Software Disclosure), then use Google, Web of Science, Knowledge Express, Inspec, and/or Academic Search Complete to identify articles, press releases, and other resources that contain general background information about this area of technology. You can access Web of Science, Inspec, and Academic Search Complete through UT’s Library at <http://www.lib.utexas.edu/indexes/titles.html?id=198> or by clicking on the hotlinks in the Word version of the Form.
- **Reminder:** Make a note in Section 3.9(a): Questions, Concerns, and Future Actions with regard to any additional questions that you think should be asked of the inventor at the inventor interview.

3.2 Invention Description

- The Licensing Intern completes Section 3.2: Invention Description.
- Complete as much of Section 3.2 as you can before the inventor interview and before the Patent Analytics Intern begins Sections 4.1: Encumbrances and 4.2: Patent and Literature Search Results.
- The purpose of Section 3.2 is to describe what the invention is made of, how it works, the problem that it solves, and how it is different and better than what is currently available to solve the same problem.
- Section 2: Description of the Invention of the Biological Sciences or Physical Sciences Invention Disclosure (Sections 4, 5, 7, and 8 of the Software Disclosure) will provide a starting point for most of the questions in Section 3.2 of the Form. Other resources include Google, Web of Science, Inspec, and Academic Search Complete, which can be accessed through UT's Library at <http://www.lib.utexas.edu/indexes/titles.html?id=198> or by clicking on the hotlinks in the Word version of the Form.
- **Reminder:** Make a note in Section 3.9(a): Questions, Concerns, and Future Actions with regard to any additional questions that you think should be asked of the inventor at the inventor interview.

3.3 Potential Commercial Applications

- The Licensing Intern completes Section 3.3: Potential Commercial Applications.
- Complete as much of Section 3.3 as possible before the inventor interview and before the Patent Analytics Intern begins Sections 4.1: Encumbrances and 4.2: Patent and Literature Search Results.
- The purpose of Section 3.3 is to identify the near and long term applications of the invention.
- List the applications that can get this invention to market most quickly. Distinguish the primary application of the invention from the other possible applications.
- Rank the applications based on a combination of the following factors:
 - Nearest to prototype/commercialization
 - Market size
- When explaining these applications, write "inventor believes this technology could be used for....."
- When completing Section 3.3, start with Section 2.7 of the Biological Sciences or Physical Sciences Invention Disclosure (Section 5 of the Software Disclosure). Then use Google, Web of Science, Inspec, and Academic Search Complete to find ideas about additional applications. You can access these tools through the library at <http://www.lib.utexas.edu/indexes/titles.html?id=198> or by clicking on the hotlinks in the Word version of the Form.

- **Licensing Team Notification:** Once you have completed Sections 1, 3.1, 3.2, and 3.3, let the Patent Analytics Intern know that he or she can start on Sections 4.1 and 4.2. Send an e-mail to the Patent Analytics Intern and copy the Licensing Specialist. Continue working on Sections 3.4, 3.5, 3.6, 3.7, 3.8, and 3.9 of the Form.
- **Reminder:** If you are uncertain about a potential application, or if applications identified by the inventor are unclear, be sure to mention this in Section 3.9(a).

3.4 Stage of Development

- The Licensing Intern completes Section 3.4: Stage of Development.
- The point of Section 3.4 is to assess how close the invention is to being commercialized. When making this assessment, consider how close the invention is to being commercialized given that it is from a university. A technology can be ready to license before it is ready to be commercialized (pharmaceuticals are a great example). And when considering these questions, judge the level of development based upon how ready the technology is to being licensed, not just how ready it is to being sold as a product or service in the market.
- Start by reviewing Sections 2.1 through 2.8 and Sections 2.11 through 2.13 of the Biological Sciences or Physical Sciences Invention Disclosure.
- You might not be able to fully complete Section 3.4 until after you and/or the Licensing Specialist have conducted the inventor interview.
- **Reminder:** Make a note in Section 3.9(a) with regard to any additional questions that you have for the inventor.

3.5 Market Overview and Potential

- The Licensing Intern completes Section 3.5: Market Overview and Potential.
- The point of Section 3.5 is to provide an overview of the market(s) that the new invention might impact and to give an idea around the size of the market opportunity with regard to each potential application.
- You will need to complete each answer in Section 3.5 for each application that you listed in Section 3.3: Potential Commercial Applications. So if you listed 3 applications in Section 3.3, answer each question in Section 3.5 three times, once for each application.
 - For example, if the first application that you listed in Section 3.3 is “photothermal therapy,” write “Application 1: photothermal therapy” under each question in Section 3.5 and provide an answer related to that application. Do the same for the other two applications listed in Section 3.3.
- To conduct research for Section 3.5, use Knowledge Express and the resources available through UT Library’s Business Center. A list of these resources can be found at http://www.lib.utexas.edu/subject/business/databases_alpha.html.
 - **Factiva** is a database service available through the library that provides access to business news and press releases from around the world. It is an excellent resource for

finding out which companies are active in a particular technology area and for finding articles that discuss recent innovations and new technologies. Factiva is especially useful in providing articles about small and medium sized private companies that might otherwise be hard to find.

- **Gartner** allows users to access the executive summaries of Gartner's industry reports and provides market data and other statistics on companies and industries.
- **Mintel** provides market research reports for the US, Europe, and the UK over a broad range of sectors, but is mostly focused on consumer products.
- **NetAdvantage** contains company and industry profiles for a broad range of industries.
- **Business Monitor Online** provides industry and market reports for 175 countries for broad industry categories.
- **eMarketer** provides more in depth industry analysis and reports but only has industry information related to the IT, media, and telecommunications industries.
- **Business Source Complete** is a database that provides access to a very broad range of business articles and reports and includes both trade and scholarly business articles.
- Research and Markets is another good resource that can be accessed for free at <http://www.researchandmarkets.com/>.
- For question (h) of Section 3.5, use various association/societies' websites that are relevant to the technology you are researching, *e.g.*: American Cancer Society, American Diabetes Association, American Heart Association, etc. These resources will lead you to other associations, conferences, and conventions related to the technology. And check Ray's bookmarks P:\LA Toolkit\Future Intern Documents\New Intern Orientation\Ray bookmarks - Firefox.html for a list of websites that might be helpful.
- Be sure to document the source of your information so that it can be referenced later.
- **Reminder:** Make a note in Section 3.9(a): Questions, Concerns, and Future Actions with regard to any additional questions that you have for the inventor.

3.6 Competitive Analysis

- The Licensing Intern completes Section 3.6: Competitive Analysis.
- The point of Section 3.6 is to provide an overview of the competition, including the specific competing products and companies and a description of the competitive landscape.
- You can use the same resources that you used in Section 3.5: Market Overview and Potential for research in this section.
- **Reminder:** Make a note in Section 3.9(a) with regard to any additional questions that you have for the inventor.

3.7 Potential Licensees

- The Licensing Intern completes Section 3.7: Potential Licensees.
- The point of Section 3.7 is to identify entities that might be interested in licensing the disclosed invention or partnering with the university to further the development of the technology. (For life sciences – 15-25 companies is the general goal.)
- Review Section 2.11 and 2.12 of the Biological Sciences or Physical Sciences Invention Disclosure (Section 13 of the Software Disclosure) to identify potential licensees.
- If possible, for each company listed, document where and how you found the company.
- BE SURE TO INCLUDE the REASON WHY the company would be interested in the technology and try to be specific as to what the company does. If possible, include where each company is in the value chain and whether it is a manufacturer, end user, etc.
- Searching a related conference or association is a good place to start because you might find a list of relevant companies.
- Here, as in Section 3.5, correlate companies to the applications listed in Section 3.3: Potential Commercial Applications. For example, if you listed applications A, B, and C in Section 3.3, indicate in the column entitled “Reason for Inclusion and Relevant Applications” that the company would likely be interested in applications A and C. Often, there will not be a perfect match, but asking a company that does something similar to application A for their partners in application B or C works well.

<i>Target Licensee</i>	<i>Reason for Inclusion and Relevant Applications</i>	<i>Website</i>	<i>Point of Contact with Phone and/or E-mail</i>
Abbott Labs	DNA Compounds, Apps A & B	www.abbott.com	Jim Wren - XXXXX

- If possible, list contact information for a person of interest at the company (business development, director of R&D, etc).
- Be sure to ask the inventor for the names of companies and potential licensees that have contacted him or her and include this information in the table.
- Before contacting a company, be sure that other interns have not contacted the same company to ensure that there is internal consistency and to keep us from bothering a company that we have already contacted. See: P:\LA Toolkit\Future Intern Documents\New Intern Orientation\A note about contacting companies.pdf. Be sure to check Salesforce as well.
- **Reminder:** Make a note in Section 3.9(a) with regard to any additional questions that you have for the inventor.

3.8 Commercialization/Licensing Pathway

- The Licensing Intern completes Section 3.8: Commercialization/Licensing Pathway.
- The point of Section 3.8 is to identify and assess the challenges that will be associated with commercializing and/or licensing the technology and to analyze the ease or difficulty with which the technology will be accepted into the marketplace.

- To the extent they are helpful; use the same resources that you used for Section 3.5.
- **Reminder:** Make a note in Section 3.9(a) with regard to any additional questions that you have for the inventor.

3.9 Concerns, Questions, and Future Actions

- The Licensing Intern will complete the majority of Section 3.9: Concerns, Questions, and Future Actions, but the Patent Analytics Intern and Licensing Specialist will also provide any information that he or she feels is relevant.
- The point of Section 3.9 is to identify questions or concerns that have not been raised in the answers to previous questions and that we need to ask the inventor during the inventor interview. Additionally, Section 3.9 provides a place to collect information about future actions that need to be taken with regard to this technology.
- If you have listed questions in Section 3.9 that need to be asked of an inventor, make sure that these questions are raised during the interview. And once these questions have been answered, remove the questions from this section and place the answer in the appropriate section of the Form.
- Document the answers to questions that inventor provide.

4. Patent Analytics Assessment

4.1 Encumbrances

- The Patent Analytics Intern completes Section 4.1: Encumbrances.
- This Section is located in a separate document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment.”
- Once Section 4.1 is completed, the Patent Analytics Intern will copy Section 4.1 from the document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment” and paste it into the document entitled “Confidential Invention Disclosure Assessment” for the relevant Tech ID#, which can be found in a subfolder named for the Tech ID# in the following folder: [P:\Licensing Supplemental Materials](#).
- The point of Section 4.1 is to identify any ownership issues that might impede the licensing/commercialization process.
- There are two main questions that need to be addressed to determine if there are any encumbrances: (1) Are all of the inventors from UT Austin? (2) Do any existing agreements give rights to a party other than UT Austin?
- **Inventors**
 - Start by reviewing Section 1: Scientific Contributor’s Information of the Biological Sciences or Physical Sciences Invention Disclosure (Sections 2 and 3 of the Software Disclosure).
 - Review Section 1.2 and 1.3 of the Biological Sciences or Physical Sciences Invention Disclosure (Section 2 of the Software Disclosure) and determine if any

contributors are not from UT Austin. If any are not currently employed by UT Austin, make a note in Section 3.9(a) of the Confidential Invention Disclosure Assessment to ask the inventor when the other contributors left UT Austin. Also make a note in Section 4.1(a) of the Form that one of the contributors is not currently at UT and state where they are from.

- Review Section 1.5 of the Biological Sciences or Physical Sciences Invention Disclosure (Section 3 of the Software Disclosure), which asks whether all inventors were acting in their capacity as employees of UT-Austin. If the answer is “No,” then indicate in Section 4.1(a) of the Form that there is “joint ownership between UT and another entity” and name the other inventors that contributed to the invention, including the name of their institution or company, if known.
- Review Section 1.7 of the Biological Sciences or Physical Sciences Invention Disclosure. If the answer is “Yes,” then indicate in Section 4.1(a) of the Form that there is “joint ownership between UT and another entity” and specify the name of the other entity.
- If the Invention Disclosure and/or the Licensing Specialist indicate that all of the inventors were UT employees at the time of the invention, write “100% UT owned and no encumbrances” in Section 4.1(a).
- If the Invention Disclosure and/or Licensing Specialist indicate that the IP is jointly owned, do the following:
 - Complete Section 4.1(b) of the Form.
 - Note in Section 3.9(d) of the Form that we will need an Inter Institutional Agreement (“IIA”) or a Patent Co-ownership Agreement (“PCA”).
 - If the IP is jointly owned with another institution or individual, note in Section 3.9(a) that the Licensing Specialist needs to discuss the percentage of ownership for each institution or individual involved at the inventor interview.
 - Note in Section 1: Invention Overview, in the row entitled “Non-UT Ownership Interests or Encumbrances,” that the IP is jointly owned with another party. If possible, name the other party.
- If any of the contributing inventors are from another university, note in Section 3.9(a) that the Licensing Specialist needs to ask the inventor whether the inventor is an adjunct or has a visiting scholar agreement.
- **Agreements**
 - Begin by reviewing the Invention Disclosure:
 - Start by reviewing Section 2.9: Materials Used of the Biological Sciences or Physical Sciences Invention Disclosure.
 - If the answer to 2.9 is “Yes,” indicated in Section 4.1(a) that materials used in development were obtained from the non-UT source indicated by the inventor.
 - Review Section 4.1 of the Biological Sciences or Physical Sciences Invention Disclosure (Section 19 of the Software Disclosure). If the answer to Section 4.1 is

“Yes,” list the following information for each sponsor in Section 4.1(c) of the Form:

- Name of Sponsor:
 - Title of Project:
 - UT Austin Acct#:
 - Grant#:
 - Whether UT is acting as a subcontractor:
- Review Section 4.2 of the Physical Sciences or Biological Sciences Invention Disclosure. If any agreements are described in Section 4.2, list the agreement, parties to the agreement, and a brief description of the agreement in Section 4.1(c) of the Form.
 - Review Section 4.3 of the Physical Sciences or Biological Sciences Invention Disclosure. If any other encumbrance is identified, describe the encumbrance in Section 4.1(a) of the Form.
 - Review Section 4.4 of the Physical Sciences or Biological Science Invention Disclosure. If the invention is the subject of a pending grant or contract proposal, list the pending grant or contract proposal in Section 4.1(c) of the Form.
- If the Invention Disclosure or Licensing Specialist indicates that there is a relevant agreement, try to find that agreement on the P: drive by going to the following folder and looking in the subfolder that is named for the sponsor or third party that is a party to the agreement: <P:\Licensees - Updated>. If you cannot locate the appropriate agreement in the P:\ drive, try to locate it in InTEAM. If you still cannot locate the agreement, send an email to the Admin Team, at administrativeteam@otc.utexas.edu, and request the documents from the Office of Sponsored Research. Copy the Licensing Specialist on this e-mail.
 - Once you have obtained the appropriate agreements, review the relevant agreements to determine whether or not the sponsor, or any other third party, has any rights to the IP or if there are any other limitations, encumbrances, or reporting requirements.
 - If the agreement contains any language that would give the sponsor or a third party licensing rights to any new inventions that were based on the research, cite the section of the agreement and quote the relevant language in Section 4.1(d) of the Form.
 - Note in Section 3.9(d) of the Confidential Invention Disclosure Assessment that we will need to include a special provisions clause in any Option or Patent License Agreement (PLA).
 - Once you have determined whether or not the agreements contain language that would give the sponsor or a third party licensing rights, do the following:
 - Note in Section 1: Invention Overview of the Confidential Invention Disclosure Assessment, in the row entitled “Non-UT Ownership Interests or Encumbrances,” that there is an encumbrance and briefly describe the encumbrance.

- Note in Section 1: Invention Overview of the Confidential Invention Disclosure Assessment, in the row entitled “Research Sponsors (public & private) include funding total,” that there are research sponsors, name the sponsor, indicate if they are public or private, and include the funding total.
- **Reminder:** After you complete Section 4.2, you will copy Sections 4.1 and 4.2 from the document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment” and paste it into the Confidential Invention Disclosure Assessment for the relevant Tech ID#. If you make a change to any part of Section 4.1 in the future, be sure to make the change in both documents.

4.2 Patent and Literature Search Results

- The Patent Analytics Intern completes Section 4.2: Patent and Literature Search Results.
- This Section is located in a separate document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment.”
- Once Section 4.2 is completed, the Patent Analytics Intern will copy Sections 4.1 and 4.2 from the document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment” and paste it into Section 4 of the Confidential Invention Disclosure Assessment for the relevant Tech ID#.
- The purpose of Section 4.2 is to identify public disclosures, including literature, patents, presentations, abstracts, posters, etc., that describe or anticipate the key elements or features of the disclosed invention.
- The point of Section 4.2 is NOT to make legal determinations, or to give legal opinions, with regard to the patentability of the invention. Do not write your answers to any of these questions in a way that suggests you are making a legal determination or giving a legal opinion.
- Be aware that Section 4.2 is usually passed on to outside legal counsel.
- Begin by reading the following sections from the Confidential Invention Disclosure Assessment: Sections 3.1: Background of the Invention and Technology, 3.2: Invention Description, and 3.3: Potential Commercial Applications, which the Licensing Intern has already completed and can be found in the subfolder named for the Tech ID# in the following folder: [P:\Licensing Supplemental Materials](#).
- Review the Invention Disclosure.
- To answer Section 4.2(a) of the Form, review Section 3.1: Prior Disclosures and Section 3.2: Pending/Expecting Disclosures of the Biological Sciences or Physical Sciences Invention Disclosure and list any prior or pending public disclosures mentioned by the inventor. Then, do a search on the Internet using the inventor’s name or the name of his or her research group to determine if there have been additional public disclosures that are not listed in the Invention Disclosure. (A good place to start is the inventor’s own website, which will usually list all publications and presentations.)
- Likely sources of disclosure include grant applications (NIH, NSF), theses, presentations, and conference abstracts.

- If you identify a potential public disclosure, describe the disclosure, note the date of the disclosure, and indicate that it was not listed by the inventor in the Invention Disclosure.
 - If you are not sure if a disclosure contains confidential or enabling information, make a note to that effect in Section 4.2(a) and underline your comment.
 - Make a note in Section 3.9(a): Questions, Concerns, and Future Actions to ask the inventor about the disclosure and, if possible, save a copy of the document or link that contains the disclosure in the folder associated with the Tech ID on the P:\ drive.
- **Patent Applications and Issued Patents Identified in the Invention Disclosure.** To complete the table under Section 4.2(b).1 for issued patents and patent applications identified in the Invention Disclosure, do the following:
 - List any issued patents or patent applications mentioned in Section 3.4 of the Biological Sciences or Physical Sciences Invention Disclosure in the table under Section 4.2 (b).1.
 - In the “Relevant Portion and Explanation of Relevance” column of the table, identify the relevant portions of the patent application or issued patent by listing the column and line numbers for the pertinent language and, in a few words, explain why the cited language is relevant.
 - In the column entitled “Patent Title and a Hyperlink to a PDF of Patent,” include a link to a PDF of the cited patent from Google Patents.
 - To determine the Assignee, go to the USPTO’s assignment website at <http://assignments.uspto.gov/assignments/?db=pat>. At this site, you can determine who owns any issued patent or published patent application.
 - To determine who owns an issued patent, place the patent number in the “Patent Number” search field and click search. The results page will show the previous and current owner of the issued patent. An “Assignor” is the person who previously owned the patent and sold or gifted the patent to the new owner, the “Assignee.”
 - To determine who owns a patent application, place the publication number in the “Publication Number” search field and click search. The results page will show the previous and current owner of the patent application.
 - **Note:** The USPTO assignment website only contains assignee information for published patent applications. If the inventor listed a patent application in the Invention Disclosure that has not yet been published, you will not be able to identify the current owner.
- **Searches for Additional Issued Patents.** To complete the table under Sections 4.2(b).2 for issued patents, do the following:
 - Before you start searching for patents, you need to understand the underlying technology and have a set of relevant keywords that you will use to search. Read Section 2 of the Biological Sciences or Physical Sciences Invention Disclosure to get a better understanding of the technology and an idea of relevant keywords. Also read Sections 3.1 and 3.2 of the Confidential Invention Disclosure Assessment, if these

sections have already been completed by the Licensing Intern. You may also want to read articles identified by the inventor in Section 3.5 of the Physical Sciences or Biological Sciences Invention Disclosure.

- Identify keywords that you believe will produce relevant results.
- Once you have identified some keywords, go to <http://patft.uspto.gov/> and use the advanced search in “Issued Patents.” Use multiple keywords at the same time: “Keyword1” and “Keyword2” and “Keyword3,” etc. The use of four keywords, versus two, will yield fewer results and, likely, results that are more relevant to the disclosed invention.
- If you can use four keywords at one time, you should get a fairly focused set of results. However, do not make your search so narrow that you exclude relevant patents.
- You may also use classifications to narrow your search results. (You should have received training on using the U.S. classification system.)
- If you do not find relevant results, try synonyms of the keywords that you have already used or keywords that are related to unique components of the invention.
- Review the issued patents in your search results by reading the Abstract, Background of the Invention, Summary of the Invention, and Detailed Description of the Invention sections of the patent.
- Do not analyze the claims of the patent.
- If a search produces relevant issued patents, do the following:
 - In the table under Section 4.2(b).2, identify the database that you searched and the keywords and/or classifications that you used to conduct the search. In that same table, cite the issued patents that describe inventions similar to the disclosed invention and complete the other columns of the table.
 - In the column entitled “Patent Title and a Hyperlink to a PDF of Patent,” include a link to a PDF of the cited patent from Google Patents.
 - In the “Relevant Portion and Explanation of Relevance” column of the table, identify the relevant portions of the issued patents by listing the column and line numbers for the pertinent language and, in a few words, explain why the cited language is relevant.
 - To determine the Assignee for an issued patent, go to the USPTO’s assignment website at <http://assignments.uspto.gov/assignments/?db=pat>.
 - Place the patent number in the “Patent Number” search field and click search. The results page will show the previous and current owner of the issued patent.
 - If an issued patent is assigned to a related company, be sure to list that company in Section 3.7: Potential Licensees.
- Do not cite more than 10 issued patents in total, in addition to the issued patents mentioned in Section 3.4 of the Biological Sciences or Physical Sciences Invention Disclosure.

- If you find them more useful, feel free to use Patent Lens¹ instead of the USPTO for patent searches. Both of these resources are free.
- **Searches for Additional Patent Applications.** To complete the table under Sections 4.2(b).2 for patent applications, do the following:
 - To search for additional patent applications, go to <http://patft.uspto.gov/> and use the advanced search in “Patent Applications.” Start with the same keywords that you used to identify issued patents in your search above.
 - If you do not find relevant results, try synonyms of the keywords that you have already used or keywords that are related to unique components of the invention.
 - Once you have a set of search results, review the patent applications by reading the Abstract, Background of the Invention, Summary of the Invention, and Detailed Description of the Invention sections of the patent application.
 - Do not analyze the claims of the patent.
 - If a search produces relevant patent applications, do the following:
 - In the table under Section 4.2(b).2, identify the database that you searched and the keywords and/or classifications that you used to conduct the search. In that same table, cite the patent applications that describe inventions similar to the disclosed invention and complete the other columns of the table.
 - In the column entitled “Patent Title and a Hyperlink to a PDF of Patent,” include a link to a PDF of the cited patent application from Google Patents.
 - In the “Relevant Portion and Explanation of Relevance” column of the table, identify the relevant portions of the patent application by listing the column and line numbers for the pertinent language and, in a few words, explain why the cited language is relevant.
 - To determine the Assignee for each patent application that you list, go to the USPTO’s assignment website at <http://assignments.uspto.gov/assignments/?db=pat>.
 - To determine who owns a patent application, place the publication number in the “Publication Number” search field and click search. The results page will show the previous and current owner of the patent application.
 - If a patent application is assigned to a related company, be sure to list that company in Section 3.7: Potential Licensees.
 - Do not cite more than 10 patent applications in total, in addition to the patent applications mentioned in Section 3.4 of the Biological Sciences or Physical Sciences Invention Disclosure.
- If you find them more useful, feel free to use Patent Lens² instead of the USPTO for patent searches. Both of these resources are free.

¹ www.patentlens.net/daisy/patentlens/patentlens.html

² www.patentlens.net/daisy/patentlens/patentlens.html

- **Literature Identified in the Invention Disclosure:** To complete the table under Section 4.2(c).1 for literature identified in Section 3.5 of the Biological Sciences or Physical Sciences Invention Disclosure, do the following:
 - In the table under Section 4.2(c).1, list literature, articles, abstracts, posters, etc. mentioned in Section 3.5 of the Biological Sciences or Physical Sciences Invention Disclosure and complete as much of the table as possible.
 - In the “Relevant Portion and Explanation of Relevance” column of the table, identify the relevant portions by listing the page numbers and paragraphs that are pertinent and, in a few words, explain the relevance.
 - If possible, in the column entitled “Publication/Journal and Hyperlink” provide a hyperlink to the article, abstract, poster, etc.
- **Searches for Additional Literature:** To complete the table under Sections 4.2(c).2 for Literature, do the following:
 - To search for additional literature, you can either use Google Scholar or the resources available through the UT Library. To access the resources available through the UT Library, go to <http://www.lib.utexas.edu/indexes/titles.html?id=198> and double-click on “Inspec.” Once you are on the Inspec homepage, click on “Choose Databases” in the top left-hand corner. When the “Choose Databases” window opens, put a check next to “Academic Source Complete” and “Business Source Complete” and then click on “Ok.” Once you are back on the main search page, enter the relevant keywords in the search boxes and conduct a search for relevant articles.
 - Use the same or similar keywords that you used when searching for patent applications and issued patents.
 - If you do not find relevant results, try synonyms of the keywords that you have already used or keywords that are related to unique components of the invention.
 - If you identify relevant results, do the following:
 - In the table under Section 4.2(c).2, cite any literature, articles, abstracts, posters, etc. that appear to describe an invention or technology that is similar to the disclosed invention and complete as much of the table as possible.
 - In the “Relevant Portion and Explanation of Relevance” column of the table, identify the relevant portions by listing the page numbers and paragraphs that are pertinent and, in a few words, explain the relevance.
 - If possible, in the column entitled “Publication/Journal and Hyperlink” provide a hyperlink to the article, abstract, poster, etc.
 - Additionally, if you can, download a copy of the article, abstract, poster, etc. Go to P:\Licensing Supplemental Materials and find the folder that corresponds to the Tech ID for the technology. Go into the folder and create a new folder entitled “(TECH ID) Literature Search Results.” Save a copy of the article, abstract, poster, etc. and indicate that you have saved a copy by writing “Saved to P: Drive” in the column entitled “Publication/Journal and Hyperlink.”

- Do not cite more than 10 articles, abstracts, posters, etc. in total, in addition to those mentioned in Section 3.5 of the Biological Sciences or Physical Sciences Invention Disclosure.
- How to complete Section 4.2(d), regarding inventors:
 - List any inventors that appear to have done a significant amount of work in this area. For example, if an inventor is listed on three of the cited patents and has written two articles on the relevant technology, list that inventor.
- How to complete Section 4.2(e), regarding research groups and companies:
 - Try to identify companies and research groups that are doing research on, and/or filing patents for, similar types of technology.
 - When searching through patents and literature, document the companies and research groups that could be potential licensees.
 - Start by researching the inventors that you have listed in your answer to Section 4.2(d) to determine the companies and research groups with which they are affiliated.
 - Another resource is the assignees to the patents and patent applications that you listed in your answers to Section 4.2(b).
 - You can also do a quick search on the Internet to try and find research groups and companies that are active in this space.
- In answering Section 4.2(f), use your own judgment to evaluate the patent landscape and how the applications, issued patents, other literature, and prior disclosures that you identified through your research will affect the current invention. If the inventor has made comments about the patent landscape in the Invention Disclosure, only incorporate the information that you think is accurate.
- **Reminder:** Copy Section 4.2 from the document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment” and paste it into the Form for the relevant Tech ID#. If you make a change to any part of Section 4.2 in the future, be sure to make the change in both documents.
- After you have copied Sections 4.1 and 4.2 into the Form for the relevant Tech ID#, create a new subfolder on the P: drive in the folder assigned to that Tech ID# that is entitled “Patent Analysis for Outside Counsel.” Move the document entitled “Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment” into this folder. Make sure that the document title contains the Tech ID#, for example “5655 HEL Patent Analytics – Sections 4.1 and 4.2 of the Confidential Invention Disclosure Assessment.”
- **Reminder:** When you copy and paste Section 4.2 into the Form, do not forget to make the necessary notes in Section 1: Invention Overview, Section 3.7: Potential Licensees, and Section 3.9: Questions, Concerns, and Future Actions of the **Confidential Invention Disclosure Assessment**, which might include some or all of the following:
 - If there were additional contributors to the invention that are no longer at UT-Austin, make a note in Section 3.9 to ask the inventor when the additional contributors left UT-Austin;

- If the IP is jointly owned, make a note in Section 3.9 that we will need an Inter Institutional Agreement (“IIA”) or a Patent Co-ownership Agreement (“PCA”);
 - If there are co-inventors at another institution, make a note in Section 3.9 that the Licensing Specialist needs to discuss the percentage of ownership for each institution or individual involved at the inventor interview;
 - If the IP is owned jointly with another institution, Note in Section 1, in the row entitled “Non-UT Ownership Interests or Encumbrances,” that the IP is jointly owned with another institution and name the institution;
 - If any of the contributing inventors are from another institution, note in Section 3.9 that the Licensing Specialist needs to ask the inventor whether the inventor is an adjunct or has a visiting scholar agreement;
 - If there is a sponsored research agreement, or any other agreement, that gives a third party licensing rights to the invention, make a note in Section 3.9 that we will need to include a special provisions clause in any Option or Patent License Agreement (PLA). Also note in Section 1 in the row entitled “Non-UT Ownership Interests or Encumbrances,” that there is an encumbrance and briefly describe it. And in the row entitled “Research Sponsors (public & private) include the funding total,” note that there is a research sponsor, name the sponsor, indicate whether it is public or private, and include the funding total, if known;
 - If you identified a public disclosure that might contain confidential or enabling information, make a note in Section 3.9 that the Licensing Specialist needs to ask the inventor about the disclosure; and
 - If you identified a relevant patent application or issued patent that is assigned to a company that is a potential licensee, list the company in Section 3.7: Potential Licensees of the Confidential Invention Disclosure Assessment.
- **Once you have completed Sections 4.1 and 4.2 of the Form, send an e-mail to the Licensing Intern and the Licensing Specialist letting them know that you are done with these sections and that you have copied and pasted both sections into the Form. Schedule a meeting with the Licensing Specialist to review your research. In the meeting, make sure to discuss the following items with the Licensing Specialist:**
 - Verify with the Licensing Specialist to make sure that he or she does not have any additional information about contributors/inventors. (After the interview, be sure to note in Section 4.1(a) which Licensing Specialist you spoke with, that you verified the inventor status, and the date of the verification.)