For Inventors

Working with the Office of Industrial Liaison

NYU’s Office of Industrial Liaison seeks to promote the commercial development of NYU technologies. Below, you will find information on securing intellectual property protection and how OIL works with scientists and inventors to help protect and promote their discoveries and inventions.

***Where do I start?***

You should notify OIL as soon as possible after you come up with an invention or discovery that may have commercial potential. In order to avoid loss of certain patent rights, patent applications must be filed on inventions before public disclosure (e.g., publishing or presenting to non-NYU individuals). OIL will work with you to accommodate your publication schedule while filing these patent applications, and is available to advise on the consequences of specific public disclosures on patentability.  To enable OIL to determine the invention’s patentability and commercial potential, certain information is needed. To help prepare this information, a form for the confidential disclosure of invention has been prepared. *[Add link to Form*]

If you are unsure of whether an idea or discovery is appropriate for a patent application, we encourage you to contact us so that we can get together and discuss this.

The confidential disclosure will include:

* A summary describing exactly what the invention is—Is it a compound, process, machine, manufacture, composition; a new use for, or an improvement of, a known item or process?
* A description of the benefit or use of the invention—What problem does it solve?  What advantage does it have over existing or imminent solutions (cost, convenience, safety, performance)?
* A list of pertinent literature, including patents—If there is no pertinent literature, list the closest known. Copies of all listed literature (called “references” in patent language) should be included, along with a brief explanation of the difference between each reference and the invention, describing the advantages of the invention over the references.
* Other research collaborators and funding sources—If you were collaborating with other scientists (whether from NYU or from other institutions) or if your research project has been funded by an agency, foundation, or another source, or if you used materials obtained under a material transfer agreement (MTA), include all details, so that we can comply with any obligations to the government or other parties.
* Any pending public disclosures (e.g., presentations or publications).

**Response** — OIL will acknowledge receipt of a confidential disclosure. Next, it will evaluate the invention for patentability and marketability in consultation with the inventors to determine whether or not to seek patent protection.

If the decision is to proceed with patent protection, OIL will cover all patenting costs, and coordinate the application process, relying on the inventors’ participation and engaging the services of an outside patent attorney. The inventors assign rights to the University, and receive 42.5% of any net income resulting from the commercialization of the invention, one of the most generous royalty-sharing policies of any university.

It is important to know that the patenting process has certain timeframes and windows of opportunity for filing patent applications. The US government recently passed the America Invents Acts, which moves the US from a “first-to-invent” to a “first-file” system, making the timely filing of patent applications even more important. The initial application filed may be either a regular application, which will be examined by the US Patent & Trademark Office (USPTO) or a “provisional” patent application, which establishes a filing date for priority purposes and can be supplemented with additional data for one year.

A patent application in some ways looks like a manuscript, describing what you have done, and teaching others how to use your invention. It also contains “claims” at the end which describe the scope of your invention, which the patent attorney will draft with your input. Once a regular patent application has been submitted, it may take 2-4 years for the USPTO to review it. The USPTO may initially reject certain claims as too broad or as “obvious” in light of prior work. The patent attorney will work with you to respond to these rejections, in some cases amending the claims to gain allowance. Once a patent issues, it provides protection for 20 years from the date of filing.

Once a patent application is filed, OIL will begin to seek commercial partners, which could include existing companies or entrepreneurs and investors to help form a new start-up company. Existing companies can offer the necessary infrastructure such as channels to market, sector knowledge, facilities, commercial management, and an existing network in place, while start-ups may offer greater commitment to the technology and have the potential to contribute to local economic development. The start-up route also ensures that the entrepreneur’s commitment and energy drive the development of the technology and that changing corporate priorities do not affect the development of the technology. In some instances, a start-up may further develop the technology to demonstrate proof-of-concept, such as prototype development or early clinical trials, and then partner with or be acquired by a larger company, with greater resources to take the product to market. OIL will work in consultation with you to determine the best path forward.

Once there is agreement between NYU and a commercial partner on a desire to move forward, OIL will negotiate a license agreement, which grants the company rights to the NYU technology. OIL looks to be flexible in negotiating win-win agreements, which meet the needs of industry, while preserving core university values such as the right to publish, and providing a fair return to both parties. Following the license, inventors often have close ongoing collaborations with the company in their efforts to develop the inventor’s technology, through relationships such as sponsored research, consulting, and serving on scientific advisory boards.