

Invention Disclosure

What Are Inventions?

Inventions are new and non-obvious solutions to technical problems. These may be material constructs or processes that facilitate novel and useful applications or these applications themselves, such as a new substance for cancer treatment, an innovative diagnostic test or a new indication of a known substance. An invention needs to be distinguished from a discovery which means that something is found that was there before and which is not patentable, such as a new signaling pathway.

An invention is considered patentable if it is new, i.e. if it has not been described before in written or oral form, non-obvious and capable of industrial application. Moreover, it needs to be sufficiently disclosed, clear and reproducible; a mere idea is often not enough to obtain patent protection.

When and to Whom Should You Report Your Invention?

At the DKFZ, the Office of Technology Transfer is responsible for all matters concerning inventions. Please do not hesitate to contact Technology Transfer at any time. In general, you are well-advised to contact Technology Transfer as early as possible and in any case, if you have made an invention or developed a new technology that stands out from previous knowledge and may have commercial potential. It is critical to contact Technology Transfer before publishing your results, since publication of inventions stands in the way of patenting. The term 'publication' in this context comprises not only publications in journals, but also lectures, diploma and doctoral theses, and talks with companies or external scientists. As soon as a patent application has been filed you can publish your invention. However, you are requested to do so in coordination with the Technology Transfer Office.

Why Do You Have to Disclose Your Inventions to the DKFZ?

According to the Employee Invention Act, you are obliged, as an employee of the DKFZ, to report any invention you make in writing and without delay to the DKFZ as your employer.

The law distinguishes between two categories of inventions that you have to disclose to the DKFZ:

- employee (service) inventions, i.e. inventions that have arisen from your work at the DKFZ or are based substantially on experience gained or work carried out at the DKFZ;
- free inventions.

To disclose your invention to the Office of Technology Transfer please use the designated forms.

The DKFZ cannot claim free inventions. In this case you are entitled to file a patent application at your own expense and commercially exploit the invention.

Under What Conditions Will a Patent Application for an Invention Be Filed by the DKFZ?

Whether or not the DKFZ will claim an invention and file a patent application depends primarily on the question whether it may lead to a commercial product or process or a usable application, not on the quality of your scientific achievement. An invention will be evaluated based solely on commercial criteria (see *Evaluation*). Patenting is frequently an important prerequisite for commercial exploitation, particularly in the pharmaceutical and biotech sector where, in view of the high costs and long times needed for product development, companies attach great importance to patent protection, which secures them a monopoly position.

How Is an Invention Claimed?

Within four months after receipt of the complete and signed invention disclosure form, the DKFZ needs to decide whether to release or to claim the disclosed invention. If no claim has been made four months after receipt of the invention disclosure, then the invention is automatically free. The inventors are now entitled to file their own patent application and to exploit their invention commercially.

Where to Find the Invention Disclosure Form

The invention disclosure form is found on DKFZ's website:

<http://www.dkfz.de/en/techtrans/researcherinfo/inventiondisclosure.html>

The next steps following disclosure of an invention are explained in the sections *Evaluation of Inventions* and *Patent Application*.

Frequently Asked Questions

My new ideas have recently been published in a journal. Can I still obtain patent protection?

In Germany, as in most countries, a patent is only granted for inventions that are “new” (novel), i.e. have not yet been published neither in written nor in oral form. A “novelty grace period” during which publications of the inventor are left out of consideration does not exist in Germany. Only in the case of utility patents a novelty grace period of six months is granted for the inventor’s own publications. In the US, there is a one-year novelty grace period for prior publications by the inventor in the case of a patent application. Filing a patent application outside the US is not possible.

I want to publish my research results as soon as possible. How much delay is caused by patenting?

The crucial date of a publication from a patent right point of view is the issue date of the journal or the date of publication on the Internet after a positive assessment, not the date of submission of your article. Considering that several months will usually pass between the date of submission of an article and its publication, it becomes obvious that a patent application will not necessarily delay publication.

However, to prevent information from becoming public during assessment, a patent application should first be lodged at the Patent Office *before* submitting the manuscript to a journal.

Please note that you are obliged to report to the DKFZ the publication of an invention if no patent application has been filed for it yet.

I have already explained the ideas for which a patent application is to be filed to my colleagues at the institute. Is that already public?

“Public” means that a group of persons that is no longer clearly delimited have access to relevant information. Colleagues who are working on the same project certainly do not belong to this group. However, you should always consider to what extent your colleagues have contributed to the invention and therefore should be named as inventors.

My invention has been described in detail in my diploma thesis which has been accessible to the public at the university library for several weeks. Is it still new?

Undergraduate, diploma and doctoral theses that are open to *public* inspection are prejudicial to novelty. The thesis in question must be kept locked up and any readers need to be committed to keep secrecy. However, in coordination with the faculty and/or university library, the bestowal of a doctoral degree will not normally be delayed.