

**INITIAL CONFIDENTIAL DISCLOSURE TO PATENT ATTORNEY**

1. **CATEGORY:**       \_\_\_ Machine/Device (Mechanical)  
                          \_\_\_ Machine/Device (Electromechanical)  
                          \_\_\_ Software/Computer/Internet-based  
                          \_\_\_ Drug/Chemical Composition  
                          \_\_\_ Other: \_\_\_\_\_

2. **TITLE.** Please provide short descriptive title of the present invention and the purpose of the invention (do not include any “trademarks”):

3. **INVENTORS/CONTRIBUTORS:** Identify all persons that have been involved in the development of this invention (i.e., worked on the invention by conceiving or elaborating on the idea, designing experiments, evaluating experimental results, contributing features while building a device or performing a method, or otherwise directly contributing to the invention). Provide telephone numbers, residence addresses, citizenship, and employer at the time of conception of the idea). Inventorship will be determined after the invention’s claims are written - Each inventor must be able to look at the claims of the patent application and point to his or her contribution to one or more of the claims.

<u>Name</u>	<u>Address</u>	<u>Telephone/Email</u>	<u>Citizenship</u>	<u>Employer</u>
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4. **LEAD INVENTOR/CONTACT:** What individual is the most knowledgeable of this invention? (Provide this person’s name and telephone number and email address.)

Name:

Address:

Phone/Email:

5. **OWNERSHIP/ASSIGNMENT:** If the invention is to be owned by someone other than the inventor(s) (*e.g., employers often have rights to the inventions of their employees*), please list the owner (name, address, phone number, type of entity, state of incorporation) so that we may prepare and file the necessary assignment documents with the Patent Office. If the invention will be owned by more than one inventor/owner, please contact us regarding a Joint Owners Agreement.

Name:

Address:

Phone/Email:

State of Incorporation:

6. **BILLING CONTACT:** Who is the contact for billing purposes?

Name:

Address:

Phone/Email:

7. **FOREIGN FILING\*:** If you have an interest in foreign filing, please list any particular countries of interest. Because there are strict deadlines with respect to foreign filing, it is your responsibility to contact us immediately to discuss any potential bar dates.

Countries:

\*Foreign applications are published within 18 months of filing. If you do not wish to seek foreign protection, we generally request that your U.S. application not be published to maintain its confidentiality unless otherwise instructed by you.

8. **SEARCH:** If a prior art search has already been conducted (patent search, literature search, or products currently available from 3<sup>rd</sup> parties), please identify the results of the search and any comments or concerns you may have. If not, do you wish to commission a preliminary patentability search?

9. **DESCRIPTION OF INVENTION:** Please provide brief description of the present invention including, generally, how to make the invention and how to use the invention. Use sketches and drawings where necessary to understand the invention and refer to such in your description. For inventions directed to a particular method (e.g., computer-implemented inventions), also describe one complete example of how the process is used from start to finish. If software based, include screen shots, if available, and a description of a useful, concrete, tangible result(s) produced by the process: (*\*attach any drawings/flow charts necessary for an understanding of the invention and use additional sheets if needed*)

10. **MOST IMPORTANT FEATURES:** What specific aspects/features of the present invention do you believe to be new and not obvious, including advantages over what is currently available?

**11. CONCEPTION AND DEVELOPMENT**

(a) Date invention was conceived: \_\_\_\_\_

Do you have evidence to support this date? \_\_\_ Yes \_\_\_ No

If yes, what type of evidence (lab notebooks, other documentation, etc.)? \_\_\_\_\_

(b) Date the first drawing or sketch was made: \_\_\_\_\_

(c) Date first construction or model was made: \_\_\_\_\_

**12. DISCLOSURE**

(a) Has the invention been, or will it be disclosed or described in any manner (publication, abstracts, World Wide Web, oral presentation, etc.) or offered for sale or sold?  
\_\_\_ Yes \_\_\_ No;

If Yes, answer (b), (c) and (d), below

(b) Date invention was first disclosed to others: \_\_\_\_\_

(c) To whom was invention disclosed: \_\_\_\_\_

(d) Date of the first written disclosure (including Internet): \_\_\_\_\_

(e) Were the disclosures confidential? \_\_\_\_\_

Details: \_\_\_\_\_

13. **RELATED PATENTS:** Please identify any patents or applications you have filed that are related in any way to this invention, including provisional applications.

**Acknowledgement (please read and initial each paragraph)**

\_\_\_ I understand that an advance retainer will be required prior to undertaking any work. I understand that the firm does not undertake work on accounts that are past due or for which requested payments have not been made. All Patent Office fees must be paid by the client in advance. I understand that the firm's fee schedule is only an estimate. Fees are subject to change without notice.

\_\_\_ I understand that filing an application is no guarantee any patent will issue and a substantial number of applications are rejected. There are substantive and procedural requirements that must be satisfied before any invention can be patented. Moreover, if an idea is simply obvious or not novel, then it will not be patentable.

\_\_\_ I understand that a patentability search has limited scope and limited accuracy. For example, a searcher may miss relevant prior art or a patent may issue after the date of the search that may affect patentability. Even if the results appear to be favorable, there is no guarantee that a patent will issue.

\_\_\_ I understand that a patentability search is NOT an infringement search. It is possible to have an invention which is patentable but which also infringes one or more other patents (for example, an improvement patent).

\_\_\_ I understand that US patent law imposes a duty upon the patent applicant to disclose all known prior art references that would be material to patentability and that such information must be disclosed in an Information Disclosure Statement ("IDS"), usually within 3 months of the filing date. Results of patent searches must be disclosed. The duty to disclose is a continuous duty and a Supplemental IDS may be required upon discovery of new information.

\_\_\_ I understand that if foreign protection is desired, a patent application must be filed in each foreign country where protection is desired, typically at an initial filing cost of \$5000 - 10,000 per country. Moreover, such applications must be filed by a deadline set by each particular country and most countries will not allow a patent to be filed if the invention is publicly disclosed prior to filing in the foreign country. Certain foreign countries that are members of the "Paris Convention" will grant priority to a U.S. filing date if foreign filing is made within 1 year. Therefore, public disclosure after the U.S. filing date would not be a bar to foreign filing *if* foreign filing is accomplished by this 1-year deadline. Not all countries are members of the Paris Convention, most notably Taiwan. It is the client's responsibility to comply with any foreign filing deadlines.

\_\_\_ I understand that a provisional application will automatically go abandoned one year from its filing date. Therefore, in order to keep any subject matter in the provisional application pending before the Patent Office for examination, a non-provisional application must be filed in the Patent Office within the year at an additional cost.

\_\_\_ I understand that to maintain a patent in force, maintenance fees are due after the patent issues. The fees payable to the USPTO are the responsibility of the client. Reminders may be sent by our firm only as a courtesy.

Signature of Preparer: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

Phone: \_\_\_\_\_/Email: \_\_\_\_\_