

SECTION 1: INSTRUCTIONS

This Evaluation is intended to provide technology developers at SIU with an opinion of protectability/marketability for a technology. After reading through this document, SECTIONS 3 and 5, and SECTION 4 if applicable, must be filled out. The document must be signed by all developers/inventors and returned to the Office of Technology Transfer (OTT) via hard copy to 913 N. Rutledge Street/MC 9631, or electronically via email to techtransfer@siumed.edu. The OTT should receive this document back within 2 weeks of its receipt by the developers/inventors. **TECHNOLOGY DEVELOPERS/INVENTORS ARE NOT PERMITTED TO MAKE OR RETAIN COPIES OF THIS DOCUMENT, BUT MAY REQUEST ACCESS TO THE DOCUMENT FROM TIME TO TIME THROUGH THE OTT FOR PERIODS OF UP TO 1 WEEK.**

SECTION 2: EVALUATION

FILE NUMBER:

TITLE:

DEVELOPER(S):

Name
Title
Department/Unit
SIU Campus/Outside Organization

Name
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Department/Unit
SIU Campus/Outside Organization

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Name
Title
Department/Unit
SIU Campus/Outside Organization

DISCUSSION AND TECHNOLOGY DESCRIPTION:

New technologies are generally reviewed for patentability based on four criteria: enablement, usefulness, novelty, and non-obviousness. By considering these criteria, along with the best interest of the public and the University, the OTT can then make a recommendation as to whether a technology should be pursued by SIU.

Provide a brief abstract (2-3 sentences) of the disclosed technology.

ENABLEMENT EVALUATION:

Under 35 U.S.C. § 112, first paragraph, an invention must be adequately enabled to be patentable. To satisfy this requirement, one of ordinary skill in the field must be able to construct or perform the invention without undue testing or experimentation. This requirement does not require the invention to be reduced to practice or to be mechanistically proven; however, sufficient evidence or data may be required to support certain claim limitations that are necessary to clearly define the invention.

Discuss whether the developers have disclosed enough information so that someone skilled in the art can replicate the technology.

USEFULNESS AND SUBJECT MATTER EVALUATION:

Under 35 U.S.C. § 101, an invention must be considered useful or serve some useful purpose to be patentable. A patent must claim a process, machine, manufacture or composition of matter to be deemed to have patentable subject matter. Patent eligible subject matter excludes abstract ideas, physical phenomena, and laws of nature. Regardless of these exclusions, "methods and products employing abstract ideas, physical phenomena, and laws of nature to perform a real-world function may well be [patentable]." - MPEP Chapter 2106 Patent Subject Matter Eligibility

Provide a brief description (2-3 sentences) on whether the technology contains utility and patentable subject matter.

NOVELTY EVALUATION:

Under 35 U.S.C. § 102, an invention must be novel to be patentable. An invention is generally considered novel unless all aspects of the technology are described in a single patent or publication (collectively known as "prior art").

Provide a brief discussion of whether the technology would be considered novel in view of any single prior art reference.

NON-OBVIOUS EVALUATION:

Under 35 U.S.C. § 103, an invention must be non-obvious to be patentable. An invention is generally considered non-obvious unless there is some combination of patents, publications, and/or other prior art that provide a teaching, suggestion, or motivation of the invention. Furthermore, few alternatives and market forces can influence a finding of obviousness. However, commercial success, long felt but unsolved needs, and failure of others are just a few factors that can influence a finding of non-obviousness.

Provide a detailed discussion of how combinations of prior art references may impact the obviousness of the technology.

NON-PATENT PROTECTION EVALUATION:

New technologies are primarily reviewed for patentability, but other forms of intellectual property protection (copyrights, trademarks, trade secrets, know-how) may be appropriate instead of, or in addition to, patent protection. The suitability of non-patent protection is also factored into the recommendation of whether a technology should be pursued by SIU.

Provide a brief discussion of what types of non-patent protection may be recommended for the technology, if any.

EXPORT CONTROL STATUS:

United States export control laws regulate the flow of certain types or classifications of information, technologies, and products outside the US. Export control laws include, but are not limited to, the U.S. Department of Commerce's Export Administration Regulations and the regulations administered by the Office of Foreign Assets Control. Please check the appropriate box below and provide details.

- Tier 1: The disclosed technology does not appear to comprise export controlled or dual-use subject matter. No further export control action is recommended.
- Tier 2: The disclosed technology does not appear to comprise export controlled subject matter, and any dual-use capability is non-enabling and/or incidental (e.g. a technology that improves operation of a generic computer, where generic computers are often incorporated in security and defense systems). The Developers are encouraged to update the OTT of any further developments that may impact the export controls status of the disclosed technology.
- Tier 3: The disclosed technology appears to comprise export controlled subject matter or may have enabling dual-use potential. SIU's Export Controls staff has been consulted for considerations relating to the technology disposition contained in this document. Additional export controls considerations related to the disclosed technology are described below, if applicable.

Detail any specific export control applications, including dual-use, categories, or countries of concern.

FEDERAL FUNDING/INVENTION REPORTING STATUS:

The Bayh-Dole Act mandates reporting activities for patentable inventions made with federal funding. Such activities include timely submission of the disclosure, filing of a patent application, granting of a confirmatory license to the government, and pre-approval of invention release to a third party, including an inventor.

Indicate whether the technology is associated with any federal funding that may trigger Bayh-Dole reporting requirements.

ADDITIONAL CONSIDERATIONS:

Provide additional discussion regarding topics not described above, such as cost of manufacture, market size, profit margin, freedom to operate, and any other relevant concerns.

RECOMMENDATIONS:

Compile all information into a recommendation on how to proceed. Include discussion of whether trade secrets, design patents, trademarks, or other non-patent forms of protection may be appropriate, especially if protection is warranted by market size.

REFERENCES:

DISCLOSURE DATE:

EVALUATION DATE:

SECTION 3: DISPOSITION FORM (REQUIRED)

Choose **ONLY ONE** disposition preference below. If you have questions on the options or the information in this Evaluation Form, please contact the OTT before choosing a disposition preference below. If **OPTION 1** or **OPTION 2** is selected, proceed to **SECTION 5** (skip **SECTION 4**). If **OPTION 3** is selected, fill out both **SECTIONS 4** and **5**. Regardless of what option is selected below, the Senior Research Administrator holds the final disposition authority of the IP.

- OPTION 1:** I/We wish to temporarily halt the technology protection process until the technology can be further developed to a more protectable state. I/We will contact the OTT to discuss our development strategy.
- OPTION 2:** I/We wish to abandon this technology. I/We do not wish for the OTT/SIU to pursue this technology.
- OPTION 3:** I/We wish to attempt to advance this technology into a protectable state/invention to be supported by the university according to the recommendation of the OTT. If university support for the technology is approved, the protection strategy may include one or more types of intellectual property, including patents, copyrights, trademarks, trade secrets, and know-how. The protection strategy will be determined by the university.

Note: If **OPTION 3** above is selected, a recommendation for the disposition of the technology will be made to the Senior Research Administrator specified in Southern Illinois University-System Intellectual Property Policy, which may include a committee review. The developer(s) will be notified of this decision. The intellectual property rights may be released to the developers only if the Senior Research Administrator declines university support for this technology. If the Senior Research Administrator declines support, or if the developer(s)/inventor(s) have not received notification of the decision within the time specified by the Southern Illinois University-System Intellectual Property Policy, they may petition the OTT for release of the intellectual property rights to the technology.

SECTION 4: INVENTION DISCLOSURE ELECTION (OPTIONAL- DEPENDING ON SECTION 3)

Fill out only if **OPTION 3** in **SECTION 3** above is selected. By filling out this section and signing this document, each person certifies that he/she is an official inventor and agrees to the royalty distribution provisions contained within. Multiple inventors are responsible for determining the split of their share among themselves and supplying that information in Question 2 below.

1. Has the state of development or any other information about the technology (other than inventorship) changed since the corresponding Evaluation Request Form was submitted? If yes, attach a brief page or other documents as needed to the end of this document indicating those changes.

Yes

No

2. Fill in the following information for all new inventors who were not previously listed as developers in the corresponding Evaluation Request Form. Use additional sheets as necessary.

Name:

Title:

SIU Department or Outside Company/Organization:

Work/Alternate Phone Number: _____ | Email Address: _____

Home Address (Street, City, State, and Zip Code): _____

Role/Contribution: _____ | Country of Residence: _____ | Citizenship/Permanent Residency: _____

Name: _____ | Title: _____

SIU Department or Outside Company/Organization: _____

Work/Alternate Phone Number: _____ | Email Address: _____

Home Address (Street, City, State, and Zip Code): _____

Role/Contribution: _____ | Country of Residence: _____ | Citizenship/Permanent Residency: _____

Name: _____ | Title: _____

SIU Department or Outside Company/Organization: _____

Work/Alternate Phone Number: _____ | Email Address: _____

Home Address (Street, City, State, and Zip Code): _____

Role/Contribution: _____ | Country of Residence: _____ | Citizenship/Permanent Residency: _____

SECTION 5: SIGNATURES (REQUIRED)

Complete for all previously listed developers in the associated Evaluation Request Form AND any newly listed inventors from SECTION 4 above (if applicable).

By signing below, each developer/inventor obligated to assign his/her intellectual property ownership rights to the Board of Trustees of Southern Illinois University as defined by the Southern Illinois University- System Intellectual Property Policy hereby assigns his/her ownership rights in the subject matter described in this Evaluation/Disposition Form (along with any attached updated material and the associated Evaluation Request Form) to the Board of Trustees of Southern Illinois University.

Signature: _____ | Date: _____

Printed Name: _____

% of Inventors' Royalties (complete only if technology is being advanced to an invention): _____

Signature: _____ | Date: _____

Printed Name: _____

% of Inventors' Royalties (complete only if technology is being advanced to an invention): _____

Signature: _____ | Date: _____

Printed Name: _____

% of Inventors' Royalties (complete only if technology is being advanced to an invention): _____

Signature: _____ | Date: _____

Printed Name: _____

% of Inventors' Royalties (complete only if technology is being advanced to an invention): _____

Signature: _____ | Date: _____

Printed Name:

% of Inventors' Royalties (complete only if technology is being advanced to an invention):

Signature:

Date:

Printed Name:

% of Inventors' Royalties (complete only if technology is being advanced to an invention):

SECTION 6: INSTITUTIONAL ACKNOWLEDGEMENT (FOR OTT USE ONLY)

OTT File Identifier:

Date Received by OTT:

Signature, OTT Director:

Date: