

## *Frequently Asked Questions*

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If a specific question is not addressed, please contact [Colleen Michael](#) at 631-344 -4919.

## **What is Technology Transfer?**

Technology Transfer is the process of developing practical applications for the results of scientific research. For instance, a research result may be of scientific and commercial interest, but patents are normally only issued for practical processes, and so someone -- not necessarily the researchers -- must come up with a specific practical process. Another consideration is commercial value.

The process to commercially exploit research varies widely. It can involve licensing agreements or setting up joint ventures and partnerships to share both the risks and rewards of bringing new technologies to market. Other corporate vehicles, e.g. spin-outs, are used where the host organization does not have the necessary will, resources or skills to develop a new technology. Often these approaches are associated with the raising of venture capital (VC) as a means of funding the development process.

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## **What is a patent?**

A patent is essentially a grant by the federal government to an inventor of the right to exclude others from making, using, or selling his or her invention. Patents are necessary for successful commercial developments of inventions. While there are several types of patents, generally the one of interest to you will be a utility patent. Utility Patents are granted for machines, articles of manufacture, compositions of matter, and processes (or any useful improvement of these) that are novel, useful, and non-obvious. Patent protection is governed exclusively by the scope of the claims of the issued patent. Patent protection is only effective in the country in which the patent has issued.

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## What are the requirements for a patent?

The three most important characteristics of a patentable invention are novelty, non-obviousness, and usefulness. Generally speaking, an invention is **useful** if it has a functional purpose, is operable, and is of some benefit to society. A **novel** invention is one that is not known to the public. In general, an invention will **NOT** meet the novelty requirement if:

- It was known to the public.
- It was described in a publication.
- It was used publicly, or offered for sale prior to the application filing date.

In addition, the invention must be **non-obvious**. This means that the invention must not be obvious to one of ordinary skill and creativity in the art and is a determination made by the U.S. Patent and Trademark Office by comparing the invention to the “Prior Art”(such as publications in the field of the invention, including your own). To help meet this requirement, make sure the patent attorney or agent working on the application has a good understanding of the invention and provide him or her with any prior art you know. This will allow them to draft the patent application so that the invention is clearly distinguishable from prior art.

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## **What is a copyright?**

A copyright is a form of intellectual property that grants its holder the sole legal right to copy their works of original expression; such as a literary work, movie, musical work or sound recording, painting, computer program, or industrial design. It is possible to protect software that you have developed by getting a copyright or releasing it under an Open Source Software License. To obtain a copyright registration or to release software under an Open Source Software License, you must first contact the Dorene Price at extension 4153.

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## **What is a disclosure?**

Disclosure of an invention is any public announcement or discussion, which includes written abstracts; talks, presentations, seminars, posters; publications (including electronic publications and postings); news releases; emails; and use of the invention in public. Disclosure will limit the right to obtain a patent. Until a patent application has been filed, you have to be very careful what you say, send in an e-mail, present in public, post on the Internet, or publish regarding the invention. There should be no public disclosure of an invention until a patent application is filed. Even if you have filed a Record of Invention, contact the TCP prior to giving seminars, providing copies of papers, abstracts, overheads, or making any public disclosure.

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## What is a Record of Invention?

A Record of Invention (ROI) is an important legal document that starts the patent process by identifying various aspects of the invention proposed to be patented. This document briefly describes the invention and its achieved advantages, date of conception, and novel features. A record of invention also includes (but is not limited to) design sketches, funding source, related or referenced publications or patents, laboratory notebook entries, information on the contributing collaborators, and public disclosure information. The ROI is very important because it officially starts the process of expert review of the invention to determine whether patent protection will be sought. Please let us know we can assist you in the submission process. The ROI helps to start the patent process, the sooner it is submitted, the better.

For ROI Form and Guidelines, go to: <http://www.bnl.gov/tcp/forms.asp>

**Note: ROI is NOT a patent application.**

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## **Can I publish my work before the invention is patented?**

This is a common and complicated question to answer, so one should read this answer carefully. The simple answer to this question is yes, you can publish your work before an invention is patented. An inventor is permitted to obtain a patent if the patent application is filed within one year of the date of publication which first disclosed the invention. A major distinction must be made between a patent and a patent application. These two distinct terms should not be used interchangeably because they convey separate meanings. A patent application does not carry the same protection provided by a patent because a patent excludes others from making, using, or selling an invention. In order to “patent” an invention, an inventor must file a patent application. This is a document filed to the United States Patent & Trademark office which fully and publicly discloses the information of the invention (if there are questions about the meaning or examples of **public disclosure** please refer to question 5). When a patent application is filed, it does NOT mean that you have a patent. Be aware that the patent process can take months or even years to finalize, but also know that once a patent application is filed then an inventor can publicly disclose the information of an invention in a publication.

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## **What are the policies for keeping a laboratory notebook?**

From the moment you think you have a new invention until the filing of the patent application; it is important to follow the proper procedures. The first step is maintaining accurate research records, which is a critical step in the patent process. Below is just a short list of guidelines for maintaining research notes that must be followed:

- Notebooks must have sewn bindings and sequentially numbered pages.
  - Make sure all entries are original, handwritten in ink, and do not skip any pages.
  - Make corrections by drawing a line through the incorrect material so that it is still legible.
  - Sign and date each page upon completion. Have a witness read, sign, and date each experiment upon completion.
  - Record everything you do, as you do it, including small calculations, changes to procedure, and results.
  - Record your hypotheses as they form the basis of the conception of an invention.
  - Avoid disparaging commentary or other characterizations of the data in your notebooks.
- Patent Licensing Responsibilities, Benefits and Guidelines for Laboratory Notebooks can be found at:

- <https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d331.htm>
- <https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d421.htm>

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## **What does the Office of Technology Commercialization and Partnership do?**

Part of the mission of the Department of Energy (DOE) is the transfer and commercialization of technology. TCP's role is to fulfill this DOE mission by finding industrial partners possessing the capability, interest and resources to develop BNL technologies from the stage of infancy into maturity as useful products. This model is used at the University level and is now emulated by federal laboratories.

The licensing wing of TCP evaluates the Record of Inventions (ROI) submitted by inventors for commercial potential and makes recommendations of whether or not to retain title for the inventions. TCP markets BNL inventions to industry, negotiates and administers license agreements. In addition, it records income and disbursements, and prepares yearly reports to the DOE. Other functions include assisting IPLG with material transfer agreements (MTAs) and non-disclosure agreements (NDAs).

The partnership wing of TCP provides the means for BNL to obtain the necessary authorizations and funding to perform research and development services for non-DOE federal agencies and non-federal entities which includes Centers for Advanced Technology (CAT)), or New York State Energy Research and Development Authority (NYSERDA). This section of TCP drafts and negotiates CRADAs and Work for Others Agreements with commercial entities. In addition, it authorizes interagency agreements (proprietary or non-proprietary) or grants, which can be beneficial and appropriate in important research areas of other Federal agencies that simultaneously advance the goals of BNL.

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### **How do I contact the Office of Technology Commercialization and Partnerships?**

The TCP is located in Building 490 C within Brookhaven National Laboratory. Please direct your questions to [Colleen Michael](#) at (631)-344-7134.

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