



UNIVERSITY OF THE PHILIPPINES
Quezon City

OFFICE OF THE PRESIDENT

MEMORANDUM NO. PAEP 15- 27

DATE : 15 May 2015

TO : The Chancellors
The Dean of UP Cebu

cc : Vice Presidents
University Secretary
Dr. Luis G. Sison, Director, TTBDQ

FROM: Alfredo E. Pascual
President

A handwritten signature in blue ink, appearing to read "Alfredo E. Pascual".

SUBJECT: **Guidelines on Invention Disclosure Incentive (IDI)**

Attached is a set of guidelines on the recently approved Invention Disclosure Incentive (IDI) program of the University for dissemination to all faculty and staff of your respective units.

The IDI was approved by the UP Board of Regents at its 1305th meeting held on 29 January 2015. The grant of financial incentive is meant to encourage inventors to disclose their inventions to the University. Invention disclosure is expected to help promote a pervasive culture of research and innovation and address the dismal situation of having an extremely low number of patents (applications and approvals) in the University.

The IDI is granted to inventors, researchers, faculty members, students, staff and visiting professors undertaking research pursuant to any program, project grant or contract under the auspices of the University. A total fixed amount of Forty Thousand Pesos (P40,000) is awarded per invention, in milestone-based tranches, to the inventor who goes through the invention disclosure process as described in the IDI guidelines.

The definition of an invention is found in the UP Intellectual Property Rights Policy of 2011 prepared by the UP System Technology Transfer and Business Development Office (TTBDO) and approved by the UP Board of Regents.

According to data from TTBDO, the University has managed to file only 57 patent applications for inventions in a span of 21 years. About 21 percent of these have been granted while the majority (65 percent) are still pending. Over ten percent of the applications have been abandoned or have lapsed.

Should you require further clarifications, please contact the TTBDO by phone at 9818500 local 2542 or email at techtransfer@up.edu.ph.

GUIDELINES ON INVENTION DISCLOSURE INCENTIVE

1. *Invention Disclosure Incentive (IDI)* - The IDI is an incentive program granted to inventors, researchers, faculty members, students, staff and visiting professors undertaking research and/or creative activities pursuant to any program, project grant or contract under the auspices of the University, who discloses the existence and assign patent rights and other related rights such as undisclosed information or know-how pertaining to the following inventions to the University in accordance with contractual stipulations, the UP Intellectual Property Rights Policy, the implementing rules and regulations of the Philippine Technology Transfer Act of 2009, other guidelines and the implementing rules that may be promulgated by the Office of the President.
2. *Objectives* – Under the Philippine Technology Transfer Act of 2009, the University shall accord their faculty members, researchers, students, staff, and visiting professors with incentives consistent with existing laws to sustain efforts in identifying valuable research outputs and IP, and in pursuing IP commercialization. The IDI shall be governed by the following objectives:
 - 2.1. Expand and enhance the patent portfolio and IP database of UP;
 - 2.2. Support disclosure and publication of innovation through the patent process, in addition to traditional publication channels;
 - 2.3. Reward diligence of the inventors through the lengthy and painstaking process from preparation of applications to granting of patents;
 - 2.4. Stimulate the creation of ground-breaking research and emergence of entrepreneurial ideas among inventors and researchers; and
 - 2.5. Encourage early disclosure of innovation, ideally prior to traditional publication channels, to protect the rights of the inventors, to facilitate technology transfer, and to increase the impact of the innovation by triggering the customer development process in parallel with the IP protection process.
3. *Incentive Scheme*
 - 3.1. A total fixed amount of P40,000.00 is awarded per invention, in milestone-based tranches, to the inventor who has completed the invention disclosure process as described in these guidelines. The incentive amount shall be released following the schedule below:
 - a. P15,000.00 for assessed and accepted disclosure as described in Section 4.2; and

- b. P25,000.00 for patent filed as described in Section 4.4.
- 3.2. The grant of incentive is applicable only to patent application filed in the Philippines. Patent applications filed in other territories are encouraged when deemed necessary by the Execomm. However, no additional incentive shall be granted for these applications.
- 3.3. If the invention is a result of collaboration between multiple inventors from the University and outside entity, the incentive shall be shared by the collaborating inventors in accordance with the determination of their participation or contribution in the authorship or invention.

4. *Invention Disclosure Process Flow*

- 4.1. Invention Disclosure Form (IDF) – Invention disclosure form is a confidential document that fulfills several functions: (i) it allows the Technology Transfer and Business Development Office (TTBDO) or its counterpart offices in the Constituent Units (CU-TTBDO) to assess the commercial potential of the invention or technology; (ii) it enables the TTBDO or CU-TTBDO to plan intellectual property (IP) protection and to advise on the best route to market; (iii) it serves as a useful document in determining patentability and for doing freedom-to-operate due diligence (i.e., whether commercial exploitation of your invention/technology would require licenses from other parties).
 - a. To signify his/her intent to disclose, the inventor shall submit a duly accomplished IDI Application Form to the respective CU-TTBDO for preliminary assessment.
 - b. Upon review and consideration, the inventor is requested to accomplish the complete IDF and submit it to the CU-TTBDO together with the following supporting documents, if any, such as but not limited to the following:
 - i. Proof-of-concept
 - ii. Preliminary prior art search
 - iii. Presentation and public communication materials
 - iv. Copy of relevant agreements, contracts, grants and similar documents
 - v. Relevant publications, related IP , advertisements
- 4.2. Assess – It refers to the review, validation and evaluation of the duly accomplished IDF and supporting documents by the CU-TTBDO.
 - a. The receiving Technology Transfer Office (TTO) shall assign an IDF reference number for proper documentation.

- b. The CU-TTBDO shall review the disclosure materials and note which part needs additional disclosure information. In any event, the CU-TTBDO may always attempt to have at least one meeting with the inventor/s either in person or by telephone to verify that they have a complete understanding of the invention including technical, legal and commercially-significant aspects.
- c. Submitted IDFs shall be assessed and ranked by the CU TTBDO according to its novelty, inventive step and industrial application, taking into account the stage/ maturity of development, priority areas and potential commercialization, for review and approval of the UP System TTBDO Executive Committee (Execomm).

It is suggested that CU TTBDO must conduct a preliminary review of prior art (stage 1 prior art search) – patent documents and scholarly articles among others – before endorsing the IDF to the Execomm.

- d. Only duly accomplished IDF, reviewed and approved by the Execomm shall qualify for the incentive in the amount of Fifteen Thousand Pesos (P15,000.00).
- e. Inability to complete the IDF and supporting documents within the required response time of the TTBDO or its counterpart office in the CU shall delay the completion of invention disclosure process as well as the grant of incentive for qualified invention disclosure.

4.3. Claims Drafting – It refers to the preparation of claims for the invention by the assigned Patent Agent (PA) as first step in patent application.

- a. The PA shall draft the claims to define the scope of protection in terms of technical, structural and/ or functional features of the invention, sought by the inventor.
- b. Upon completion of the claims draft, the PA may send a copy thereof to the inventor for review. In any event, they may have at least one meeting prior to filing of Request for Grant of a Philippine Patent to certify that the claims draft is accurate.

4.4. Prior Art Search – It refers to organized review of prior art contained in public documents such as but not limited to patents, technical publications, published articles, conference papers, marketing materials and public demonstrations related to the disclosed invention. In all cases, searches are conducted using different patent databases to see if there is any evidence that the invention or technology has been done before.

- a. The PA will conduct stage 2 prior art search based on the claims drafted as described in Section 4.3.

- b. Completed prior art search will be presented to the IP committee (IPC) designated by the CU TTBD0 for further evaluation and recommendation for patent filing.
 - c. In the event that the invention is not patentable, the IPC may assist the inventor in considering possible alternative embodiments for the invention and may recommend a different approach of IP protection.
 - d. Duly accomplished and filed Request for Grant of a Philippine Patent with the Intellectual Property Office (IPOPHL), including required documents set by the IPOPHL, grants the inventor the incentive in the amount of Twenty Five Thousand Pesos (P25,000.00).
- 4.5. Publication and Substantive Examination – It refers to the publication of patent application in the IPO Gazette together with the search document that reflect prior art established by the PA or on behalf of UP, and the process by which the IPOPHL examine whether the patent application satisfies the patentability requirements of IPOPHL under a given time.

5. *Obligations of the Inventor*

- 5.1. The inventor shall disclose the existence and assign patent rights and other related rights such as undisclosed information, know-how pertaining to the following inventions to the University in accordance with the UP IPR Policy, implementing rules and regulations of the Philippine Technology Transfer Act and other related laws and policies.
- 5.2. The inventor shall coordinate with the CU-TTBD0 prior to any form of public disclosure or enter into contracts such as but not limited to research agreements, IP agreements and commercial contracts with third parties to avoid risking the scope of IP protection and possibly hindering the opportunity to market the invention.
- 5.3. The inventor shall closely coordinate, respond to requests and maintain contact with the TTBD0 or CU-TTBD0 until the completion of the disclosure and technology transfer process.

6. *Disbursement of the Incentive*

- 6.1. Notification of incentive is released within 30 days upon review and approval of final documents by the Excomm, pursuant to Section 3.1.
- 6.2. The incentive shall be formalized with an issuance of check from the TTBD0 to the inventor or main inventor, in case of collaboration work, as determined on the IDF and signing of the payment acknowledgement receipt.

7. *General Guidelines*

- 7.1. A maximum of ten (10) IDFs shall be endorsed by the Excomm for grant of incentive on a monthly basis. IDFs that are not approved for grant of incentive due to maximum reach per month shall be automatically included for consideration in the following month.
- 7.2. IDF, patent claims, records and all supporting documents shall remain confidential. Likewise, the parties involved in the invention disclosure process shall obtain Confidentiality and Non-Disclosure Agreement (CNDA).
- 7.3. All disputes, controversies or claims arising out of or relating to these guidelines, or about its termination or invalidity shall be settled through negotiation and/or mediation facilitated by the Office of the Vice President for Academic Affairs, within sixty (60) days from the receipt of a notice by the other party from the party injured.
- 7.4. Invention disclosure, IP ownership and Grant of Philippine Patent are subject to the provisions of the UP IPR Policy, Philippine Technology Transfer Act, IP Code of the Philippines and such other related laws, rules and regulations.
8. *Effectivity* – These guidelines shall take effect upon approval of the UP Board of Regents on the proposal to provide financial incentive for filing an invention disclosure during its 1305th Meeting held on 29 January 2015. Invention disclosure submitted prior to this date shall not be eligible for the IDI program.

Annex "A" – IDI Application Form

Annex "B" – Complete IDF

Annex "C" – Invention Disclosure Process Flow