

# MedStar Inventor Services: How It Will Work For You



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Director, MedStar Inventor Services

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MedStar Inventor Forums

# Invention Disclosure Form – The First Step

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<http://mi2.org/inventors>

  
**MedStar Health**

**EXHIBIT 3**  
**INVENTION DISCLOSURE FORM**  
**INSTRUCTIONS PAGE**

**Please complete all Sections (I-VIII). The signature page must be signed by all inventors. Management of inventions is governed by the MedStar Health Intellectual Property Policy (\_\_\_\_ date \_\_\_\_\_), which is available at <http://starport.medstar.net>.**

**In addition, attach a detailed specification of the invention, including any relevant manuscripts by the inventors and citations of relevant publications. This specification will form the basis for a potential patent application and should be “enabled,” meaning that it provides detailed guidance on how to make and use the invention. The specification should include working examples and experimental data in support of your invention; support will reduce the likelihood of a rejection patent application based on lack of enablement.**

**When drafting your specification, keep in mind the tests for patentability (below).**

TESTS FOR PATENTABILITY
<ul style="list-style-type: none"><li>• <b>New or Novel:</b> an invention must be clearly and demonstrably different from any “prior art.” (Prior art refers to any publicly available information such as existing technology, processes, methods, or products).</li><li>• <b>Useful:</b> an invention must represent a new application or method or an improvement over existing products or techniques.</li><li>• <b>Non-Obvious:</b> an invention must go beyond any known equivalents, so that it is not “obvious to one skilled in the art.” This is a frequent cause for rejection of a patent application. Identifying and carefully considering close equivalents will greatly assist the patent application process and improve the chances of successfully prosecuting a patent application.</li></ul>

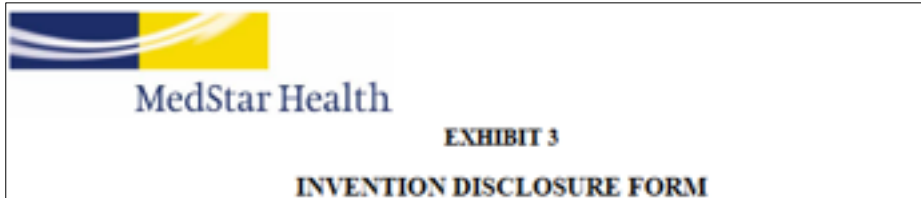
**Your specification should state what your invention is and how it is different (or superior to) the current state-of-the-art. Please list and briefly describe the closest equivalents to your discovery. Internet search engines (such as Google and PubMed) should be used to identify similar and/or related technologies. Such technologies (patented or not) may limit the “novelty” of your invention, thus causing a rejection of the claims in the patent application.**

To [Disclosure@MI2.org](mailto:Disclosure@MI2.org)  
cc  
bcc  
Subject **Invention Disclosure Form**



# Ownership defaults to MedStar (but we're not trying to own your minds)

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## Ownership Determination MedStar Inventor Services

- MI2
- MHRI
- MedStar Legal
- Associate Rep

### What's considered?

- (a) the extent to which MedStar Health Resources were used
- (b) whether the Project was conducted on the inventor's own time
- (c) the location at which the Project was conducted
- (d) whether the development of the Invention is included in the inventor's job description or scope of duties
- (e) whether the invention is a result of sponsored research

# What Next?

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- MedStar-owned
  - Proceed through MedStar Inventor Services commercialization process
- Inventor-owned
  - Yours to develop and commercialize; no MedStar support
  - Option to proceed through MedStar Inventor Services commercialization process; requires assignment of ownership to MedStar
- Why voluntarily assign ownership to MedStar??
  - \$\$\$\$\$ Investment
  - Time
  - Expertise
    - See “Commercialization Primer” at [MI2.org/inventors](http://MI2.org/inventors)

# Questions That Demand Answers & The Resources Required to Answer Them

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## Questions

- Is the science sound?
- Does it work as it's supposed to (and is it safe)?
- Is something similar out there and, if so, how is your invention different?
- Is meaningful intellectual property protection available?
- Will others lay claim to inventorship or ownership of the intellectual property?

## Resources

- Clinical Luminaries
- Leading Scientists
- Technical / Subject Matter Experts
- Prototyping Engineers
- Regulatory Consultants
- Patentability Assessment Databases and Firms
- Patent Attorneys

# Questions That Demand Answers & The Resources Required to Answer Them

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## Questions

- Will it sell?
- Is it ready to be sold?
- How large (and how accessible) is the market for your invention?
- Is it manufacturable?
- Is it reimbursable?
- What will be the commercialization strategy – license, new company

## Resources

- Network of Industry Contacts
- Angel Investors
- Venture Capitalists
- Reimbursement Analysts
- Technology Licensing Officers
- New Business Development Experts


# Net Revenue Distribution

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- For those inventions that are owned by MedStar and for those inventions where Inventor chooses to assign ownership to MedStar
  - First dollar goes to paying back direct costs of commercialization
    - Patenting
    - Development and prototyping
    - Other MedStar investment *directly* related to your invention
  - Net revenue splits down the middle
    - 50% to Inventor
      - No cap (i.e., \$10M total net revenues? Inventor gets \$5M)
    - 50% to MedStar
- We encourage you to compare our deal with any other similar organization
  - It's among the best, and the most INVENTOR-FRIENDLY in the business
- Proviso: IP Policy under revision, get your IDF's in now!

# Thank You


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 <http://mi2.org/inventors>

- Questions?
  - [Disclosure@MI2.org](mailto:Disclosure@MI2.org)
  - [MI2.org/inventors](http://MI2.org/inventors)



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# THANK YOU

Questions and Answers