

## Description of the Patent Procedure

### Invention disclosures and patent registrations at the University of Münster

#### 1. General information

Patentable inventions or novel utility models created by University employees are subject to the Employee Invention Act [ArbNErfG]. University employees in this case are defined as all professors and instructors, staff members and civil servants who are in the employ of the University of Münster.

The new provision in §42 ArbNErfG, which took effect on 7 February 2002, fundamentally changed the legal framework conditions pertaining to invention disclosures and patenting procedures in the higher education sector. The former 'professorial privilege', which designated all employment-related inventions by university instructors as free inventions, was hereby nullified. As of the beginning of 2002, the general terms and requirements of ArbNErfG apply to the entire higher education sector.

#### 2. Invention disclosures

Every invention that university employees create or develop in connection with their official duties must be immediately reported in writing to the University of Münster in the form of an invention disclosure.

Inventors are to report their employment-related inventions by submitting the official 'Invention disclosure' form together with the necessary attachments to Dept. 6 of the University of Münster (Ms Katharina Steinberg), Schlossplatz 2.

Department 6.2 notifies the inventor that it received the disclosure and subsequently conducts an assessment to verify its completeness, whether an employment relationship exists between the inventor and the University, and possible third-party rights to the invention. The legally mandated period of four months during which the University must decide whether to waive or claim rights to the invention begins on the date the invention disclosure was received.

At the same time, Dept. 6 commissions PROvendis GmbH, the IP management agency for higher education institutions in North Rhine-Westphalia and subsidiary of the University of Münster, to conduct an evaluation of the disclosed invention.

PROvendis assigns a file number to the invention disclosure and carries out an assessment of the invention's proprietary, technological and commercial prospects. The following criteria are considered in the assessment:

- the state of the art
- the patent's possible scope of protection
- its strategic importance for the University
- the invention's stage of development
- the realistically expected market potential

PROvendis submits its opinion to the University regarding the above and its recommendation as to whether the University should claim or waive its rights to the invention.

Dept. 6 waives or claims the University's rights to the invention on behalf of the Rectorate and then notifies the inventor(s) of the decision. The decision must be made within four months as of the date the complete invention disclosure was received.

In the case of pending publications by researchers involved in the invention, Dept. 6 has made a special arrangement with PROvendis GmbH to review and assess the disclosures as fast as possible.

If you have any questions concerning the invention disclosure, Ms Katarina Kühn, patent advisor at the University of Münster, would be happy to assist you:

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### 3. Claim

The University is entitled to claim the rights to inventions arising from official duties within a period of four months from disclosure. The claim is considered declared if the employer has not explicitly waived its rights to the invention within four months after the receipt of the invention disclosure.

Should the University decide to claim rights to the invention, PROvendis GmbH – as the University's IP management agency – is then commissioned to oversee the patent registration through a patent attorney. Although the patent must be registered in Germany at the least, it does take into account the invention's corresponding commercial prospects. The University of Münster is responsible for all patent-related costs.

PROvendis GmbH is responsible for managing the continued copyright protection and marketing of the invention, whereby the (joint) inventor(s) are involved in the process if desired. PROvendis GmbH draws up a compelling technology offer which it actively extends to suitable companies and enters in various databases to ensure its effective commercialisation.

For inventions to which the University has claimed rights and subsequently commercialised the inventor(s) is/are paid an inventor's remuneration of 30% of the total revenues resulting from the invention's exploitation.

In the case of a strategic patent without concrete prospects of successful commercialisation, patent registration only takes place in Germany.

### 4. Waiver

In the case of a waiver, all rights to the invention revert to the (joint) inventor(s), who are then entitled to patent the invention at their own cost.

### 5. Secrecy

Because publicised inventions are no longer eligible for patent protection, the inventor is obliged to keep their employment-related invention secret until the University of Münster has chosen to either claim or waive its rights to the invention.