

THE CHINESE UNIVERSITY OF HONG KONG
Office of Research and Knowledge Transfer Services

Patent Application Fund (PAF)

GUIDELINES

I. Background

- 1) University develops various types of technology in the form of invention or innovation outputs. Securing intellectual property (IP) rights for these inventions and innovations through patent application is a key strategy to enhance the chance for the commercialization of such technology.
- 2) The purposes of the PAF are to enhance the awareness of the strategic importance and benefits of IP protection, and to encourage and motivate CUHK faculty members to pursue IP protection of their research achievements.
- 3) The PAF may support various types of Applications in different countries for different benefits and situations, including Provisional and Non-Provisional (Regular) Patent Applications to the US Patent and Trademark Office (USPTO). For instance, at a relatively lower cost, a Provisional Patent filed with USPTO helps the Inventor(s) to secure an early filing date for novelty determination and allows the Inventor(s) to more safely make disclosures of the Invention (e.g., publication of the inventive subject matter) before making any substantial investment in the formal application.

II. Application

- 4) All CUHK staff are eligible to apply.
- 5) Applications are open all year round until the budget is fully utilized.
- 6) Application should be made on Invention that has not been disclosed before. Such disclosure includes publications and those disclosed/described in a public setting like a poster session, seminar, and conference.
- 7) To apply, Inventor should complete the **Invention Disclosure Form**, which is available for download on the Office of Research and Knowledge Transfer Services website <http://www.orkts.cuhk.edu.hk/intellectual-property-licensing/download-forms>, and forward the signed Form with all necessary supporting information to:

Director,
Office of Research and Knowledge Transfer Services
Room 301, Pi Ch'iu Building, CUHK

III. Vetting and Approval

- 8) All applications will initially be processed on a first-come-first-served basis by the ORKTS.
- 9) For Provisional Patent Application:
 - (a) Applications will be reviewed by the Patent Committee (PC), which approval is required for applications to be funded by PAF.
 - (b) Generally 1-2 months are required for the process.
 - (c) The Provisional Patent filed will lapse if the Inventor does not file a Non-Provisional (Regular) Patent Application within 12 months. Therefore, once funded for the Provisional Application, the Inventor should make further pursuits during the 12 months to enhance and prepare the Provisional Patent for either (i) a Non-Provisional (Regular) Patent Application which is to be approved by the Patent Committee if PAF is sought; and/or (ii) commercialization opportunities. During this and further process for technology development, the Inventor is expected to be actively engaged with the support of ORKTS where appropriate and necessary.
 - (d) If the Inventor wishes to apply for a Non-Provisional (Regular) Patent with the support of PAF after the Provisional filing, a fund request with necessary supporting information such as new data generated should be submitted to ORKTS within 8 months after the Provisional filing, for evaluation by the Patent Committee.
- 10) Non-Provisional (Regular) Patent Application:
 - (a) If the Inventor wishes to apply for a Non-Provisional (Regular) Patent from start, viz., going straight for a Non-Provisional Patent in the US, or a patent in other jurisdictions (e.g. in China), and wishes to seek the support of PAF; please use the same Invention Disclosure Form. Vetting and approval by the Patent Committee is required for the filing.
 - (b) Generally 3-4 months are required for the process.
- 11) In order to help the PC determine the merit of an invention disclosure, the Inventor will be invited to give a 10-15 minutes short presentation via teleconference (e.g. Zoom) to introduce the invention to the PC members. The presentation shall highlight the invention's competitive edge, market leads/potential, advantage over existing technologies, or any question the members may have raised before the interview. A 5-10 minutes O&A will follow the presentation for the inventor to address further questions from the members.
- 12) Once the evaluation by PC is completed, ORKTS will inform the Inventor of the result by email.

- 13) All patent applications, including those for Provisional and Non-Provisional (Regular) Patents, and all patents to be filed with or without the support of PAF, must be filed through ORKTS using law firms appointed by the University. Inventors who have other sources of fund for the patent filing are also required to send the request for filing to ORKTS using the same Invention Disclosure Form.
- 14) To allow sufficient time for the evaluation and to expedite the process, the Inventor is encouraged to discuss with ORKTS his/her initial ideas such as those pertaining to patenting strategies, and are required to submit the Invention Disclosure Form with all necessary information including prior art search results and market estimation.
- 15) As resolved in the 38th Patent Committee Meeting, a PAF Review Panel (PRP) has been established on 21 May 2019, the PRP members will assist the PC members to review PAF applications when necessary.

IV. Inventor Contribution to Patent Application

- 16) The applicant can choose to make a reimbursable “Inventor Contribution” (the Contribution) using funding from personal source to demonstrate the commitment to the patent application and subsequent IP commercialization. Such commitment, if so wished, had to be indicated in the Invention Disclosure Form at the beginning of the PAF application for the consideration of the PC.
- 17) The Contribution will be reimbursed to the inventor when there is income generated from the invention and being sufficient for the reimbursement.
- 18) Such Contribution will not affect the share of income attributable to Inventors as per University policy.
- 19) When PAF is sought for a Provisional Patent Application:
 - (a) The Applicant may consider making the Contribution of HK\$5,000 for each application.
 - (b) Upon the payment of the Contribution, the Provisional Patent will be filed by ORKTS without going through vetting by the PC.
- 20) When PAF is sought for other types of patent including PCT:
 - (a) The applicant can choose to make the Contribution of HK\$20,000 for EACH jurisdiction pursued, up to 5 selected jurisdictions. The maximum Contribution is thus capped at HK\$100,000. Requests for filing in additional jurisdictions will require the approval of the PC.
 - (b) The PAF application will still have to go through the vetting and approval process of the PC.

V. Enquiries

For questions and further information, please contact:

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