Invention Guide

What You Need to Know About Recognising, Protecting and Commercialising an Invention

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## Contents

1. Purpose of the guide................................................................. 3  
   - What constitute research findings?........................................ 4  
   - How do I recognise an invention?......................................... 4  
   - What should I do upon realising I have made an invention?........ 4  
   - How can research findings be protected?................................. 5  
   - Where can I find more information?...................................... 5  

2 What do the terms idea, invention and innovation refer to? ............... 5  

3 Act on the Right in Inventions made at Higher Education Institutions in Finland.......................................... 6  
   3.1 Purpose of the Act.............................................................. 6  
   3.2 To whom does the Act apply?............................................. 6  
   3.3 Under what circumstances was the invention made?.................. 6  
   3.4 Decisions and obligation to notify....................................... 7  
   3.5 Why should I submit the invention disclosure?....................... 8  

4 Practices of the universities..................................................... 9  
   4.1 Intellectual property rights and invention regulations .................. 9  
   4.2 Transfer of rights agreement.............................................. 10  
   4.3 General terms and conditions for commissioned research............ 10  
   4.4 Public research funding in Finland and Europe....................... 10  
   4.5 Inventor compensation..................................................... 11  
   4.6 What should I do when I make an invention?........................... 11  
   4.7 Preparing an invention disclosure...................................... 12  
   4.8 Invention disclosure process in more detail:.......................... 13  

5 Protecting the invention.................................................................. 14  
   5.1 Patenting in some more detail............................................. 14  
   5.2 Patent application............................................................. 15  
   5.3 Patenting process in general............................................... 16  
   5.4. International aspects....................................................... 16  
   5.5 Views on patenting costs................................................... 17  
   5.6 Patent claims have an important role................................... 18  
   5.7 Patenting is a strategic decision......................................... 19  
   5.8 Utility model................................................................. 19  
   5.9 Other possible methods of protection.................................... 20
Introduction

1. Purpose of the guide

This guide was written for the personnel of the university community to assist them in issues relating
to recognising, protecting and utilising inventions. One of the university’s missions is to promote and facilitate the utilisation of intellectual property rights that relate to inventions created at the university. This guide outlines the practices that relate to inventions made at the university. One of the university’s goals is to utilise research findings and thereby carry out the university’s assigned task of interacting with society. Research findings are utilised through students who complete their degrees, research cooperation, two-way exchange of personnel, scientific publications, inventions, new services and business ideas, among other things.

Together with business life and the public sector, universities and the teaching and research work they conduct form an important part of the national innovation system and a source of many innovations that are utilised internationally. The utilisation of research findings supports the research activities of the university in a number of ways. The scientific publication of the research also contributes to the success of the possible commercialisation.

The guide starts with a brief overview of the Act on the Right in Inventions made at Higher Education Institutions. The guide also discusses the practices of the universities in the Pirkanmaa region and briefly addresses matters that relate to protecting and commercialising inventions. See the end of this guide for a list of entities that provide assistance.

In addition to this general guide, institutions of higher education also have their own rules that regulate the implementation of innovations and innovation activities. If the institutions of higher education have joint units, these may be subject to procedures and rules that are separately agreed upon. Innovation Services always provide confidential assistance in actions related to inventions, the commercialisation of research, and interpretation of up-to-date guidelines. The purpose of this guide is to review the basic facts that researchers should keep in mind when planning background material for their research activities or a new research project, but first and foremost during the research project. The guide will help you with the following questions, among others:

- **What constitute research findings?**

  Research findings refers to new information, ideas, methods, solution models, devices, substances, inventions, computer software, etc. that are achieved in a project, regardless of whether the related intellectual property rights can be or are protected. Research findings are most often measured against peer reviewed top-level international scientific publications and presentations. **Before publication**, researchers should consider whether the research findings can also be protected or utilised in another way in the public or the private sector. This guide takes the perspective of utilisation into account. Some of the terminology related to the topic is defined at the end of this guide.

- **How do I recognise an invention?**

  The recognition of a problem or need may lead to the creation of an idea. The idea is sometimes processed into an invention once a solution is developed to the problem or need. Once the solution (product, process or method) is utilised by way of commercialisation or by the public sector, for example, this solution is referred to as an innovation. An invention refers to a new product, method, device or the new use of something old. An invention that can be patented is a **technical solution** to a problem. For more information on recognising and protecting an invention, see chapter 2, 4 and 5.

- **What should I do upon realising I have made an invention?**

  The first and most important thing you should do is contact your educational institution’s Innovation
Services. The employees there will advise you on matters relating to the invention. Evaluating the need to protect the invention and the utilisation options takes time, which is why you should contact Innovation Services six months prior to the estimated time of publication and for your part take care that the matter remains a secret. For more information on the preparation and processing of an invention disclosure, visit the intranet webpage for Innovation Services. The birth moment for invention is the submission date of the invention disclosure if not otherwise confirmed in writing.

How can research findings be protected?

A typical way of protecting research findings is to seek a patent for them. You should also utilise the information on patenting when you plan research projects and focus areas for your research. Other ways of protecting research findings as part of business operations include confidentiality, a trademark and a utility model, among other things.

For more detailed information on protecting research findings, patent databases and commercialisation opportunities, see chapter 5 and onwards.

Where can I find more information?

Innovation Services provide assistance in matters relating to inventions and utilising them; the basic facts can also be found on the intranet page of each school. A list of websites that provide more information on issues relating to inventions can be found at the end of this guide.

2 What do the terms idea, invention and innovation refer to?

An idea is described as a conception without a method of implementation. It is created as a result of the recognition of a problem or need. An invention is a solution to a problem or need (method of implementation). An invention may be a new product, device, method or a new use for something old. According to the current definition, an invention must meet the general requirements for patenting: novelty, an inventive step, and industrial applicability. However, an invention does not necessarily have to be directly patentable. An invention is a new and innovative solution to a problem. The greater the effect the invention has on the development in the field, the greater its importance. An invention may also be created by accident, which is why you should evaluate your research findings and write them down in a research diary or laboratory record book.

· Novelty refers to the invention not being known anywhere prior to its creation. Examples of obstacles to this include an existing invention or patent, a thesis, a conference publication (oral presentation or poster), or a presentation for a project meeting. According to the laws of Finland, any type of public disclosure constitutes an obstacle to patenting. You can, however, tell others about the invention in confidence, for example in internal project meetings where everyone is bound to confidentiality by NDA.

· An inventive step refers to the invention being substantially different from other known solutions and not obvious to others skilled in the same field.

· Industrial applicability refers to the invention being of a technical nature, functional and reproducible.

The definition of invention is also mentioned in the Act on the Right in Inventions made at Higher Education Institutions, the main points of which every researcher ought to know. This Act is explained in more detail in the following section.

In short, an innovation is an invention with a broader utility. When an innovation achieves commercial success or otherwise reaches a wide range of users, we can refer to it as an innovation. An innovation is a new or significantly improved commodity (product, technology or service) introduced
to the market, a new or significantly improved adopted process, a new method adopted by a company, or a new organisational method in business practices, the work organisation or external relations. The developer of the innovation may be an individual, a company, a group of companies, or public organisations. Similarly, a service innovation is something new that brings productivity and efficiency to the operating environment of the public sector or companies with a customer-oriented service concept. Standards can also promote the creation and spread of innovations.

3 Act on the Right in Inventions made at Higher Education Institutions in Finland

3.1 Purpose of the Act

All inventions which are made by individuals employed by Finnish institutions of higher education during their employment and which can be patented in Finland are regulated by the Act on the Right in Inventions made at Higher Education Institutions, hereafter referred to as “the HEI Invention Act” in this document. The Act determines the ownership of the intellectual property rights related to an invention in different situations. The law came into force on 1 January 2007. The purpose of the HEI Invention Act is to make it easier to recognise, protect, utilise and commercialise inventions and standardise the rights of the employees of all institutions of higher education to the inventions they make during their employment. The HEI Invention Act also provides instructions for compensating inventors (Section 9) and the public disclosure of research findings (Section 11). When carrying out international collaborations, note that the HEI Invention Act only applies in Finland.

3.2 To whom does the Act apply?

The Act applies to individuals employed by institutions of higher education. In practice, the Act therefore applies to individuals whose salary is paid by an institution of higher education, regardless of the original source of the money. The HEI Invention Act also applies to inventions made by academy professors and academy research fellows of the Academy of Finland. The Act also applies to students of doctoral schools who are in an employment relationship with an institution of higher education. The HEI Invention Act does not apply to students (such as unpaid course work, Bachelor's theses, etc.) or grant researchers, who receive their grant directly from a foundation. The Act also does not apply to employees of external companies who work in the premises of an institution of higher education, but who receive their salary from elsewhere. The Act does not affect copyright or design rights, and only applies to patentable inventions.

3.3 Under what circumstances was the invention made?

The Act divides inventions made in institutions of higher education into three types (Section 3):

1. inventions made in open research,
2. collaborative research, and
3. under other circumstances.

The ownership rights to an invention depend on the type of research in which the invention was made. The institution of higher education and the sponsoring party may also make a separate agreement regarding the ownership of the intellectual property rights in all events. If separately agreed upon in writing, an inventor can also voluntarily surrender the rights to his/her invention to the institution of higher education, as part of preparations for a new project, for example. Similarly, if separately agreed upon, the rights to an invention that are claimed in collaborative research may
later be returned to the inventor if the primary utilisation path is not carried out for some reason.

**In open research**, the inventor(s) retain all rights. However, the institution of higher education retains a secondary right to claim the rights to the invention if the inventor him/herself does not intend to utilise them. Also typically a secondary limited right related only to education and research use is discussed. In practice, open research is carried out:

- with basic funding provided by the institution of higher education or a grant provided by charitable foundations that is paid through the institution; or
- as research funded by endowment funds.

**Collaborative research** involves external sponsors. The Act does not determine what percentage of the funding must come from outside the institution of higher education. The funding may also be provided by several sources. In collaborative research, the rights to an invention primarily belong to the university. The university agrees upon the transfer of rights with the sponsor, taking the background material into account. If not otherwise agreed with collaboration parties and the institution of higher education decides not to utilise the invention, the rights may be returned to the inventor after the project or related research program is ended. Examples of collaborative research include:

- research funded in full by an external company/consortium, i.e. **commissioned research**
- Tekes projects, projects under the EU Framework Programme for Research, and projects funded by the Academy of Finland

Inventions made **under other circumstances** refer to inventions made by individuals who do not directly participate in the research, or inventions that do not directly relate to the research. The rights to any inventions made under other circumstances belong to the inventor. Examples of inventions made under other circumstances include:

- inventions made by laboratory engineers or administrative personnel.
- research carried out and inventions made with a personal grant paid directly to the researcher.

If you study in a **doctoral/postgraduate school** and make an invention, please contact your institution’s Innovation Services. The employees there will help you determine whether the invention was made in open or collaborative research.

### 3.4 Decisions and obligation to notify

Employees are **obligated by law to notify** the institution of higher education of any new inventions. **According to Section 5 of the HEI Invention Act, inventors must submit an invention disclosure without delay in writing to the institution of higher education, regardless of the type of research in which the invention was made.** The institution of higher education must respond to the invention disclosure with a written counter-notification within two months of the day the invention disclosure was submitted. In the counter-notification, the institution must provide its own view of the type of research the invention was made in. If asked by the institution the inventors are obligated to provide clarification how the invention shares are defined. In case of this request it is handy to have notes or other relevant documentation available.

The notifications and decisions required by the institution’s invention regulations (counter-notification
within two months, decision within six months, possible patenting decisions in relation to the publication of the invention), and decisions regarding the protection and utilisation of the invention, such as licensing and sale, are primarily prepared by **Innovation Services** according to the direction of the director of the inventors’ own department or school. If necessary, the inventors, cooperation partners and external experts concerned are consulted. The rector of the institution of higher education makes the final decisions based on proposals prepared by Innovation Services.

### 3.5 Why should I submit the invention disclosure?

In practice, an invention disclosure should be submitted due to the fact that doing so ensures that the parties involved in making the invention can be determined from the beginning. The invention disclosure also indicates when the invention was made. This helps in the preparation of research projects, for example. An invention can thus be defined as background material for research, which can play an important role in measures aimed at utilisation. If an invention is not defined as background material, it can be seen as having been made in the project, in which case it can be defined as a research finding. The rights to the invention may then be transferred to the sponsors of the research due to the terms and conditions of the research agreement.

It is also important to be aware of invention-related matters as they relate to computer software, business models (such as new services) and algorithms (contacting Innovation Services or submitting a notification of an important idea before submitting an invention disclosure), and, when necessary, request a statement from the university regarding these matters by preparing an invention disclosure.

Keep in mind, that something that is only at the level of an idea without any concrete description of the invention, is not a subject for official invention disclosure. In that case the same idea may later be proposed by another actor. On the other hand, you may be able to take your idea to a whole new level using the means of **open innovation**.

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**Basic scheme of the ownership of rights in various circumstances**

(Bruun, N., Välimäki, M. 2007. Korkeakoulukeksinnöt [Inventions in Institutions of Higher Education]. IPR University Center publications)
4 Practices of the universities

4.1 Intellectual property rights and invention regulations

Section 14 of the HEI Invention Act states that institutions of higher education may provide more detailed regulations concerning the application of the Act. The more detailed regulations of institutions of higher education are provided in their intellectual property rights regulations (TTY) or invention regulations (TaY). Universities also prepare a transfer of rights agreement either as part of the contract of employment or on a project-by-project basis. These regulations apply to all individuals employed at universities. Unlike the HEI Invention Act, the regulations also apply to students when students are used as resources in a “customer project or project with separate funding” (cf. being employed by a university in collaborative research). The regulations pertain to the intellectual property rights related to research findings, as well as commercialisation, and the compensation for inventions, among other things. The regulations also briefly comment on recommended practices with regard to the utilisation of research findings. Note that as a rule, the institution of higher education has the ownership and access rights to any material which has been obtained with project funding granted to the institution. Visit the university’s intranet page to check
the currently valid and up-to-date regulations.

4.2 Transfer of rights agreement

Every employee signs a transfer of rights agreement in connection with their first contract of employment or research project. This agreement is valid for the entire duration of the individual’s employment relationship, even if his/her contract of employment or job title changes. **The transfer of rights agreement applies to collaborative research.**

By signing the form, the employee certifies that he/she understands that the rights to any research findings he/she achieves in collaborative research are transferred to the university at that scope what is needed by the university. The agreement does not exempt the employee from having to submit an invention disclosure. The transfer of rights applies to all material created in collaborative research (reports, inventions, discoveries, databases, computer programmes and source codes) and all intellectual property rights related to the findings. **The rights to any background material and the obligation to maintain confidentiality should also be addressed in conjunction with the preparation of a transfer of rights agreement.**

4.3 General terms and conditions for commissioned research

Collaborative research that is funded in full by an external company is referred to as **commissioned research.** Commissioned research observes the terms agreed upon with the customer or the general terms and conditions of universities. The terms and conditions determine the ownership of the background material and foreground information as well as intellectual property rights, among other things. The terms and conditions also include guidelines for compensating inventors. In commissioned research, it is also possible to prepare a written agreement on terms other than those determined in the general terms and conditions. However, as a general rule:

1. The intellectual property rights to any foreground information belong to the university until the client approves this information and makes all agreed payments. The intellectual property rights are then transferred in full to the client.
2. The intellectual property rights to the background material belong to the party who submitted them for the research.
3. The client must inform the university whether he/she intends to claim the rights to an invention made during the commissioned research.

4.4 Public research funding in Finland and Europe

Research funded by the Academy of Finland and Tekes has constituted contract research since 2007. An institution of higher education may therefore claim the rights to any research that is funded by these parties. The academy does not own the rights to any inventions made in employment relationships at institutions of higher education. **Similarly to other contract research, inventors must also submit an invention disclosure to the institution of higher education in research funded by the academy.** In jointly funded projects, i.e. when a project is funded by the academy as well as other parties, **the ownership of the rights depends on the research agreement. The general terms and conditions** of the Academy of Finland and Tekes regarding funding decisions apply to funding application processes and the funding decisions made based on them. Research services provide assistance in the preparation of application processes, and in the application and interpretation of terms and conditions as part of the everyday activities in research projects.
The EU's primary funding programme for research and innovation in 2014–2020 is called Horizon2020. The application processes for funding are open to both individual researchers and research groups. Similarly to other collaborative research, inventors must also submit an invention disclosure to the institution of higher education for projects of the EU and SHOK.

4.5 Inventor compensation

If the institution of higher education claims the rights to an invention in accordance with the HEI Invention Act, the institution will make the decisions on the protection and utilisation of the invention independently. If the university decides to commercialise the invention, the inventor will receive 50\% of the net income generated by the invention. This compensation will only be granted if the income received from the invention by the university is not low, and if there is no other written agreement regarding the distribution of income. The institution of higher education deducts the direct costs incurred after the submitting of the invention disclosure (such as patenting costs) from the income received. If there is more than one inventor, their share of the income is distributed among them in accordance with the shares reported in the invention disclosure, or other, separately agreed upon terms of commercialisation. If the net income received by the institution from the sale or licensing of an invention that is transferred to its possession or the sale or licensing of other intellectual property rights is low, the inventor(s) will be compensated in full with a single payment.

In accordance with the HEI Invention Act, the inventor(s) are entitled to reasonable compensation for the invention. In practice, this compensation is divided into a notification reward for an approved invention disclosure for inventions for which the institution has claimed the rights and/or which have been transferred to a company, and a patenting reward for the first approved patent.

For inventions made in collaborative research, the inventors receive an invention reward according to the terms of the research agreement. If there is more than one inventor, the reward will be distributed among them according to their share of the invention. For more detailed information on compensation paid by client companies, see the general terms and conditions for commissioned research. The client company’s regulations on invention rewards are primarily applied. Unless otherwise agreed, the basic model containing the invention reward, patent application reward and patenting reward is observed.

4.6 What should I do when I make an invention?

If you feel that you have made an invention, you should first research publications and available patent databases independently. You should then contact Innovation Services to receive confidential advice regarding your idea. After this, fill in an invention disclosure without delay either directly online or on a separate form. An invention disclosure must be submitted regardless of whether the invention is made in open research, collaborative research or under other circumstances. If there is more than one inventor, submit a joint form. If the inventors are employed by more than one institution of higher education or other organisations or companies, the invention disclosure must be submitted with the same content to each of these employers. Submit the form to your institution’s Innovation Services and mark it “invention-related matters”. According to Section 11 of the HEI Invention Act, institutions of higher education must keep any information related to an invention secret until the invention is adequately protected. It is therefore safe to ask Research and Innovation Services for advice regarding the preparation of an invention disclosure. According to the Universities Act, the teaching and degree language of the universities and institutions of higher
education in Finland is Finnish or Swedish, and other languages may be used in addition to these. Invention disclosures are prepared and processed in Finnish or English.

The institution of higher education replies with a **counter-notification** within two months of the day the invention disclosure is submitted. In the counter-notification, the institution must provide its own view of the type of research the invention was made in. The institution also has the right to request clarifications to the invention disclosure if it is deemed incomplete. A notification of deficiency must also be documented.

### 4.7 Preparing an invention disclosure

All sections of an invention disclosure must be filled in carefully, including the signatures. An invention disclosure cannot be revised and nothing can be added after it has been submitted and accepted.

**Main points in an invention disclosure:**

1. The names and organisations of all individuals who participated in the invention process
2. A descriptive name for the invention, such as a toothbrush that measures brushing force and time
3. A publication plan for the invention, if possible (such as Yes, conference in six months / No)
4. Information as to whether the invention process took place in open research, collaborative research, or under other circumstances, or whether the invention is related to the background material
5. A preliminary commercialisation plan and the degree of maturity of the invention (such as idea, prototype, tested, etc.). How can the invention be utilised or commercialised: setting up a company, licensing or selling
6. A detailed description of the invention. Attach drawings, formulas and figures to the invention disclosure, as these will help the examiners visualise the invention and evaluate its novelty value and inventive step.
7. The signatures of all individuals who participated in the invention process, and their share of the invention. The possible compensation for the invention will later be distributed according to the shares reported in the invention disclosure.
8. Describe other issues related to invention (e.g. inventor/inventors other liabilities and/or employment contracts)
9. Signature of the supervisor/director of the department/school. Witness (supervisor or, in his/her absence, the professor in charge of the field of research or the director/dean of the department/school):

[Link to the forms/ tools](https://www.tut.fi/tutka/tutkimus/tutkimustulosten-kaupallistaminen/keksinnot/index.htm)
4.8 Invention disclosure process in more detail:
IMMATERIAL PROPERTY RIGHTS RELATED ISSUES

5 Protecting the invention

Inventions should always be evaluated as a business or other utilisation opportunity. In order to stop competitors from obtaining utilisation opportunities, inventions should be protected with the legal right to prohibit others from using the invention, with a patent, for example. In order to stop others from preventing the use of the invention with their own patents, the invention should be published at some point. The invention can be published after filing a patent application, for example. These measures are particularly important for products that take time to develop (such as in the pharmaceutical industry or biotechnology). There are also other forms of protection besides patenting. Such forms of protection include a utility model, design protection, or trademark. In research-oriented inventions, a patent is often the primary form of protection. If protecting the invention does not seem sensible, the invention can only be published, for example (to prevent others from patenting the same invention), or it can be kept secret (trade secret) for as long as possible. The danger with trade secrets is that someone else may patent the invention if they make the invention themselves. Trade secrets are rarely compatible with other objectives of research.

If you intend to utilise the invention or the solutions based on it, it is important that you ensure that these activities will not infringe existing patents or other rights. Due to this, you should evaluate your freedom to operate to a sufficient extent at some point for your utilisation plans. The purpose of evaluating your freedom to operate is to determine whether the planned activities infringe upon the intellectual property rights, such as patents or utility models, of someone else. When evaluating patent infringement, the focus is on the scope of protection determined by the patent requirements. A patent application that is no longer pending or a patent that is no longer valid does not restrict your actions. Even if a patent would seem to restrict your actions, this does not necessarily mean it prevents you from patenting your own invention. On the contrary, the owner or an earlier invention may be very interested in the new invention, which improves on his/her invention. In this case, you may obtain access rights to the earlier invention by cross-licensing rights, for example (more detail on licensing later in this document). Alternatively, a patent may be sold to the owner of an earlier invention.

5.1 Patenting in some more detail

A patent is an exclusive right granted by an authority in a country or region to an inventor for a limited period of time to prevent others from making commercial use of an invention in the country in question. This exclusive right is limited to the country (or region) in which the patent is valid. International actors usually have several patents for the same invention in multiple countries. This exclusive right is also of limited duration. A patent is usually valid for 20 years from the filing date of the application. A patent may be valid for a shorter period of time if the annual fees (renewal fees) are not paid, for example. In Finland, patents are granted by the Finnish Patent and Registration Office (PRH) and the European Patent Office (EPO). The authorities do not monitor patent infringements, and patent holders are therefore personally responsible for monitoring possible infringements and taking legal action in the country in which the patent is valid and in which the infringement takes place. The juridical environment is constantly developing so it is strongly recommended that in protection planning through Innovation services there is always EPO certified, up-to-date specialist in the case.
A mere idea cannot be patented – only its technical implementation can. To give an example, a discovery, scientific theory, mathematical method, rules of a game, or a business idea cannot be patented in Finland as such. Instead, a device or method that utilises the theory or method referred to above, or a computer programme that implements the method may be patentable.

A patent may only be granted to a new and inventive solution that is applicable in the industry and which does not go against good practices. Many countries also require inventions to be technical in nature. A computer programme, for example, is considered to be technical if it causes a technical effect. This is the case in the control applications of many processes in particular. When evaluating the patentability of an invention, authorities primarily evaluate the clarity, novelty and inventive step of the patent requirements. Inventions are usually applicable in the industry. This may not be the case if, for example, the invention does not function in the described manner or cannot be reproduced. Individual patentable inventions almost without exception require a consultation with a patent agent or patent attorney who has extensive knowledge on the subject (technical and legal expertise) in order to ensure that the very first application is of a high quality and that the protection obtained is sufficiently comprehensive.

A solution can be called inventive when it is not obvious to others skilled in the same field based on their general knowledge and the technology they are familiar with. An individual who is skilled in the field is someone who is able to identify problems in known issues and name solutions to them, and he/she is also able to apply these known solutions to the same problems, for example. These individuals are therefore able to combine parts of known technology, at least when they have a reason to do so. With regard to computer software, please note that open source code, for example, can prevent patenting as it is considered to be known technology.

5.2 Patent application

A patent application must describe the invention with a level of detail that allows individuals skilled in the field to use the invention based on this explanation. The invention must also solve the problem identified in the application, i.e. it must work as promised. Patent applications must be clear and understandable. A patent application must clearly indicate what type of solutions are included in the scope of protection determined in the application, as well as what type of solutions are excluded from it.

You should apply for a patent if:

- the invention can be utilised commercially as part of new or existing business operations, or if applying for a patent is part of the IPR strategy. At present, the strategy of the universities and universities of applied sciences that follow this guide is not to amass patents.

- the protection is important to companies (the company itself and/or others) that operate in the industry, i.e. the patent protection is strong

- patents can be monitored (the responsibility for monitoring is always left to the patent holder)

- patents are not easy to circumvent; or at least the patent requirements can be written in a way that makes them difficult to evade

- the invention is considered to be patentable, i.e. to provide a technical solution to a problem, and the invention is new and inventive at least in the inventor's own opinion. When evaluating
As demonstrated later in this document, patenting is an expensive and time-consuming process. It may therefore not be worth it to patent all inventions. You should consider carefully which inventions are worth patenting and whether you should do this by yourself.

To apply for a patent, submit a patent application to a patent authority. A patent application may be national (such as Finnish), regional (such as European), or international (known as PCT). The earliest patent application related to a specific invention is referred to as the first application in this document. Once a patent application is submitted to an authority, the application receives a filing date. From the filing date of the first application begins a period known as a priority year, which lasts 12 months. During the priority year, the applicant can file national, regional and/or international subsequent patent applications for the same invention by claiming a priority right based on the first application. Due to this, no subsequent application – in so far as it corresponds to the first – is obstructed by anything that has been disclosed to the public on the filing date of the first application or after. During the processing, nothing can be added to the patent application. The removal of something from the application can also be considered to be generalisation, i.e. adding subject-matter. For these reasons it is important that the first patent application is prepared carefully. It would be preferable, if nothing needed to be added or removed when preparing subsequent applications.

5.3 Patenting process in general

As the following the three most typical ways to apply for a patent are illuminated in general level. One way is to file the first patent application with the patent authority in Finland. You can then claim a priority right when filing an international application (i.e. a PCT application) within one year of the first application. A novelty examination will be conducted for the international application, as well as a patentability examination by request. Applications will be disclosed to the public no later than soon after 18 months have passed since the filing of the first application. By request, the application may be published before this time. **Approximately 30 months after the filing date of the first application**, the applicant must decide in which countries and/or regions he/she wants the international patent application to be filed as a local patent application. These patent applications are processed by local agencies that may issue a national patent, regional patent, or several of them. An international patent application without national stages will not result in a patent.

5.4 International aspects

Alternatively, the first application may be filed as an international patent application (PCT). As an international patent application may be subsequently filed in a number of countries, this option typically does not require any action during the priority year. However, Taiwan and some countries in South America, Africa and the Middle East fall outside the PCT system, which is why an application must be filed in them during the priority year. This also applies to the first option mentioned (chapter 5.3.).

In particular, if the applicant is only interested in patent protection that covers Europe, he/she should also consider filing a European patent application as the first application. In this case, an international
A patent application may not necessarily be needed at all. Countries outside Europe can be taken into account during the priority year by filing corresponding local patent applications. The decision to not apply for a patent somewhere (such as the USA and China) should often be connected to the decision to publish the invention. This way, you can at least ensure that no one is able to obtain a patent protection for the same invention in these countries.

The national legislation of certain countries regulates which country the first patent application must be filed in. For example, if at least part of the invention was made in the United States or China, the first application must be filed at the patent office of the United States or China accordingly (USPTO, SIPO). This type of situation may occur if one of the inventors in the inventor group works abroad. Similarly, if one of the inventors involved in the invention lives in France or Italy, or is a citizen of Greece, for example, the first application must be submitted to the patent authority of the country in question. This matter is regulated by the national legislation of each country, and the practices vary widely. The legislation of a number of countries regulates the filing of the first application when the invention is related to national security, such as national defence or nuclear power. For example, if an inventor living in Finland makes an invention that is relevant to national defence, the first patent application (Finnish, international or European patent application) that concerns this invention must be submitted to the patent authority in Finland. In particular, if the invention was made or developed abroad or if the inventor is a foreign national or an individual living abroad, these formalities must also be taken care of with Innovation Services.

5.5 Views on patenting costs

When applying for a patent, costs are incurred on a case-by-case basis from preparing the application, filing it at an agency, translating the text, filing subsequent applications (international application and/or local applications) at agencies, examination fees, annual fees, replies to office actions and publication fees, among other things. A Finnish patent application may be prepared and processed in English, in which case a separate translation is not needed at the international or European stages, thus reducing the costs. Translations into local languages (such as Russian, Chinese, or Japanese) may, however, be needed at national stages.

Examples of costs in 2014:
- Application fee for a Finnish application (incl. novelty examination and examination fee): approximately EUR 500
- Application fee for a European patent application (incl. novelty examination fee): approximately EUR 1,500
- Examination fee for a European patent application (incl. naming): approximately EUR 2,500
- Application fee for an international patent application (incl. novelty examination fee): approximately EUR 3,000
- Patentability examination fee for an international patent application: approximately EUR 2,000
- The aforementioned actions as a service provided by a patent office and an additional EUR 500–2,000 depending on the action
- Writing a patent application as a service provided by a patent office: approximately EUR 3,000–10,000, depending fully on the invention
- Translating the application: EUR 3,000–10,000, depending on the language and the amount of text
- Processing the application and office actions in Finland: approximately EUR 5,000

Publication fee and annual patent fees (renewal fees) in Finland for the entire 20-year period: a total of approximately EUR 8,500

The costs of a Finnish patent up until the patent is granted may total approximately EUR 10,000
- European patent (after an international stage or by itself): approximately EUR 20,000–40,000
- Patents in countries outside Europe (after an international stage or by themselves): approximately EUR 30,000–60,000, depending somewhat on the country

The granting of a patent is in many countries followed by an opposition period during which others may file an opposition against the patent, i.e. demand that the patent be revoked or the scope of its protection reduced. This is referred to as the opposition procedure in the images in the annexes.

It is very difficult to estimate the costs of a patent during its entire lifecycle, as the process includes agency fees as well as processing and agent fees in relation to various office actions and possible other legal actions. From the perspective of a starting company, the actual costs of an international patent always accumulate towards the end of the process. In international patent protection, the main costs only begin accumulating once the application is filed as a local application after the international stage or priority year, for example. For more information on the costs of a patent application, contact the Finnish Patent and Registration Office or visit the European Patent Office website, for example. The institution of higher education, university, or university of applied sciences does not share the costs related to the patent application if the inventor(s) retain the rights to the invention.

5.6 Patent claims have an important role

The explanation and patent requirements provided in the application may be amended during the processing of the application, but only in such a way that the application as a whole does not contain any subject-matter which extends beyond the content of the application as filed. The authorities are very strict regarding this matter. The deletion of subject-matter may also be considered to be generalisation, which is prohibited. During the priority year, subject-matter can in principle be added, but no such additions are entitled to the right of priority, i.e. they are considered to have been received at the agency at the filing date of a subsequent application. As a result, a presentation and/or marketing work completed after the filing date of the first application but before an international application may easily become an obstacle to the patenting of the added subject-matter. It is also possible that as a result of the generalisation, the applicant’s own first application becomes an obstacle to a subsequent application even when the right of priority has been claimed. Due to this, it is of paramount importance that the first application is prepared carefully. Patent agents and
patent attorneys who specialise in the field assist applicants in preparing the patent protection, defining reasonable patent requirements, and making decisions regarding the geographic scope (territory) of the protection. They also plead their client's case with a power of attorney as part of the patenting process. At institutions of higher education, Innovation Services are in charge of making the agreements with patent attorneys. For more information on patenting an invention, contact your university's Innovation Services. Innovation Services utilise external patent agents and patent attorneys on a case-by-case basis.

5.7 Patenting is a strategic decision

Once a specific invention is granted several patents in multiple countries, these patents form a patent family. A patent family includes all the patents taken out in various countries that are related to the same invention. A collection of patent families is referred to as a patent portfolio. A patent portfolio may be connected to a single product, for example, or it can refer to all the patents owned by a single entity. International management (buying, selling and licensing) of patents, patent families or patent portfolios, and various legal actions, such as actions for damages by patent trolls, provide a good reason for why you should understand the basic terms related to patenting and evaluating your freedom to operate as part of this invention guide. Without strategic choices and a vision for utilisation, institutions of higher education do not seek to increase their own patent portfolio. Usually, if an institution of higher education decides to apply for a patent, this requires a strong vision for the utilisation of the invention or the strategic importance of the field of research.

In general, patenting is considered to have many positive effects on a company's business operations:

- the right to prohibit provides the company with an opportunity to stand out from its competitors, as others are not allowed to manufacture the same product;
- a patent or patent application is good advertisement for the company and the product;
- a patent may bring in money through licensing or sale;
- intellectual property rights make it easier to obtain investment capital;
- publications that are relevant to the company's freedom to operate and that can help plan the company's operations may be discovered in connection with the patenting process; and
- a patented solution may reduce manufacturing costs.

5.8 Utility model

Unlike a patent, a utility model may only be sought for a product, and not for a method or the use of product, for example. A utility model provides a product with the same protection as a patent, though a utility model is valid for a maximum of 10 years. In Finland, a utility model can be granted for an invention as long as the invention clearly differs from other known products, while for a patent, the invention must be substantially different from other products. It is generally thought that a utility model can be used to protect an invention that is less inventive than a patentable product. An application for a utility model is not examined in terms of novelty or a clear difference. Due to this, the Finnish Patent and Registration Office may be requested, as an administrative process, to revoke utility models that have possibly been granted on false grounds at any time during their lifecycle. A utility model is usually published very quickly unless the applicant specifically requests that the
disclosure to the public be delayed. A published utility model may constitute an obstacle if the inventor wishes to patent the product once he/she has developed it further.

A utility model can be considered in particular when the invention is a product, when the invention is expected to have a relatively short period of commercial utilisation, when the invention does not require significant further development, and/or when the product has a short lifecycle. The utility model is not available as a form of protection in every country. A pending patent application that applies to Finland may be converted into an application for a Finnish utility model. Similarly, a utility model application or a granted utility model may, on a case-by-case basis, be used as a basis for claiming a right of priority for an international or European patent application, for example.

5.9 Other possible methods of protection

The HEI Invention Act does not obligate inventors to protect their inventions, and the invention can instead be published or kept as a trade secret. The HEI Invention Act does, however, obligate inventors to submit an invention disclosure, and the institution of higher education is entitled to decide the methods of protection or whether the invention will be protected at all. The publishing of an invention prevents the inventor and others from patenting the same invention later on. In some cases, there are reasonable grounds for keeping an invention a trade secret, i.e. to decide against obtaining a patent or making the invention public. The patent application and patent are public documents, which will in time also be available to competitors.

One form of protection that often generates interest is a trademark. A trademark is the commercial identification of a product or service that can be illustrated graphically. For example, a sound can be illustrated using musical notes, in which case the sound can serve as the trademark (and not the corresponding musical notes). In matters relating to trademarks, please contact Innovation Services. You can also contact the Finnish Patent and Registration Office for more information. In connection with or regardless of a trademark, you should also consider whether the product or operations should have their own domain. The products may also involve design. For design, you may seek design protection.

6 Utilisation and commercialisation of an invention

6.1 The university’s commercialisation paths

An invention should be examined broadly from the perspectives of various utilisation opportunities, and the opportunities for productising and commercialising the invention should also be considered as early as possible. The first step when planning the commercialisation of an invention is to determine who will carry out the commercialisation and who owns the rights to the invention. Important factors in the commercialisation plan for an invention are the timeliness, degree of readiness and purpose of the invention, as well as the costs of commercialisation and similar products offered by competitors. Optional ways of commercialising an invention typically include licensing the invention, selling the invention, and setting up a company. The relevant parties agree upon the terms on a case-by-case basis.
6.2 Licensing

In licensing, the access rights relating to certain technology, a patent or patent application are handed over to another party against a fee. However, the ownership rights to the invention remain with the inventor or the institution of higher education. This is a good option, if the inventor or institution does not wish to completely relinquish the rights to an invention. When licensing an invention, the inventor must decide upon the term of the license, its scope (full or partial) and territory, the grounds for the fee paid by the licensee (part of the income or something else) etc. A license benefits the inventor in the form of license income either directly or based on the institution’s practices. As a licensee is responsible for the costs of production and marketing (resources), among other things, the inventor may receive income without much effort on his/her part. To licensees, a license provides a product or technology advantage over their competitors.

6.3 Selling intellectual property rights

An inventor may consider selling the intellectual property rights to an invention if the inventor is unable or unwilling to develop the invention further him/herself. The rights are usually sold in full to a third party; in the case of an institution of higher education, the institution usually seeks to retain the rights to further research and teaching. All the inventor’s rights to utilise the invention usually end with the sale. Inventors may also consider selling the invention if it was made in a collaboration.
project and one of the corporate parties is interested in developing the invention further, or the invention is related to that particular company’s key area of expertise.

6.4 Setting up a company

You can set up a company in order to commercialise an invention. Within the boundaries set by legislation and internal regulations, a researcher can continue working at the university and serve as an expert at the company, in which case it is particularly important that the researcher builds a team and obtains permission for a secondary occupation, among other things. Building a team that is able to navigate the challenges of business life is equally as important in a situation where the researcher feels that he/she wants to become a full-time entrepreneur. Important factors in establishing and running a company include sufficient and versatile expertise and financial planning.

6.5 Support services at universities for commercialising research findings

Innovation Services provide support services and guidance in the commercial utilisation of research findings. The school or department also provides assistance in issues relating to the ownership of the findings, determining the related rights, and protecting and publishing the foreground information. With issues relating to starting a business, you can turn to entrepreneurship services, which are offered by some institutions of higher education.
**Terminology**

**Commercial utilisation**
Commercial utilisation includes the manufacture, selling, licensing, use and importing of a (patented) product or the use of a patented method in business operations.

**Open innovation**
Companies and various communities have begun searching for new approaches in order to improve the efficiency and productivity of their innovation processes. These approaches include actively searching for ideas and technologies from outside the company, and cooperating with suppliers and competitors in order to create customer value. One important feature is further development or licensing of ideas and technologies that do not fit the company’s strategy. Open innovation is an approach that meets these challenges. Open innovation determines which information from outside the company should be utilised in the company’s operations and which internal information should be externalised or made available to others in order to refine it further.

**Open research**
Research that is conducted in an employment relationship without funding from outside the institution of higher education. Also includes research funded by a foundation or a charitable association. In practice, we can refer to open research when the sponsor has no commercial interest in the research findings. Collaborative research can also be considered to be open research if the relevant parties have agreed to this prior to the start of the research.

**Priority (priority year)**
A priority right that lasts for 12 months begins from the day the first patent application related to an invention is filed at the patent office. During this period, the applicant may file other applications relating to the same invention in other countries or file an international patent application (PCT), and all these applications will be considered to have been filed together with the first application.

**Personnel**
In the context of this guide, the term personnel refers to individuals who belong to the university community. The university community includes the teaching and research personnel of the university, as well as other employees and students.

**Utility model**
The registered exclusive right to the commercial utilisation of an invention for a limited period of time. In practice, a utility model covers the manufacture, sale and importation of the invention. It is simpler to apply for a utility model than a patent. A utility model is valid for a maximum period of 10 years. A utility model should be used when the invention has a short expected period of commercial utilisation.

**Intellectual Property Rights, IPR**
Intellectual property rights refer to the exclusive rights to set the rules regarding the commercial use of a protected invention. Intellectual property rights are in part limited by time and they pertain to inventions, research findings, software, and works of art, among other things. Intellectual property rights are divided further into copyright and industrial property rights. The term refers to any registered or unregistered patent, utility model, trademark, design right, business name, auxiliary
business name or domain name, as well as any know-how, right to databases, copyright, right to inventions, trade secrets, other confidential information, and all other similar or corresponding intellectual property rights that are valid in any country now or in the future.

**Innovation**

An innovation is a new or significantly improved product (goods, technology or service) introduced to the market, a new or significantly improved process adopted by a company, a new marketing method adopted by a company, or a new organisational method in a company that relates to business practices, the work organisation or external relations. Note that works in progress are typically refined from an idea into an invention and from there to an innovation.

**Invention**

A new product, device, method or a new use for something old. An idea by itself is not an invention. An invention includes an implementation method for the idea. In other words, inventions respond to current needs or present a solution to a problem. Some inventions are created in response to a current obvious demand, while others may be ahead of their time. An invention is typically created by a curious, solution-oriented, determined and creative individual – an inventor. A scientific theory, work of art or plan, such as the rules of a game, are not inventions that can be patented as such.

**Invention disclosure (aka Invention report)**

A form or electronic notification that an employee uses to notify his/her employer of an invention he/she has made. When an individual employed by an institution of higher education makes an invention, he/she must inform the institution of it. This notification must be made without delay and in writing. Invention disclosures are processed confidentially and the Act on the Right in Inventions made at Higher Education Institutions will be applied to them. In the disclosure, the inventor must indicate his/her view of whether the invention was made in open or collaborative research or under other circumstances. The invention disclosure must also include sufficient information on the invention to ensure that the institution can gain a clear understanding of it. It must also include the inventor’s personal information. Upon request, the inventor must also provide the institution of higher education with other necessary information regarding the invention. If the invention has more than one inventor, the inventors must prepare a joint invention disclosure and provide information on all the inventors. If the inventors are employed at more than one institution of higher education, the disclosure must be submitted with the same content to each of them. If the institution of higher education requests additional information, this information must also be provided if it is necessary for evaluating the invention. If the invention disclosure prepared by the inventor does not meet the requirements set for it – if, for example, the information provided on the invention is incomplete – the institution must notify the inventor of this deficiency without delay in writing after receiving the disclosure.

**Inventive step**

An invention must significantly stand out from known technology and cannot be obvious to others skilled in the same field.

**Licence/licensing**

i.e. access rights. In a licence, the inventor/licensor retains the intellectual property rights. A licence is a permission to use someone else’s findings or background
material for an agreed upon purpose in a determined manner. The exact contents of a licence are subject to agreement. The compensation for a licence may be a one-time payment, recurring fee, share of the licensee's income, i.e. royalty, or some combination of these.

**Net income**

Net profit after subtracting all the incurred costs.

**Patent**

A granted patent is a registered exclusive right (the right to prohibit others from making commercial use of the invention) to utilise an invention. A patent is country-specific and valid for a maximum period of 20 years from the filing date of the application. By itself, a patent does not prevent others from using/building the invention for their own use, and the patent holder must therefore be prepared to take legal action against parties that infringe the patent. The requirements for a patent are that the invention is new, inventive, and applicable in the industry. A national patent application filed in Finland may only lead to a patent in Finland. If the inventor wishes to apply for a patent in another country, he/she must either submit a national patent application to the patent authority of the country in question, a European patent application to the European Patent Office, or an international PCT application during the priority year. When choosing the countries, you must keep in mind your own market area, the operating areas of your main competitors, and how you can monitor your patents in each of these countries. The protection should be proportional to the company's turnover and objectives, and linked to its strategic measures. Sale, marketing and possible scientific publications may be launched without delay once the first patent application has been filed.

**Patent database**

Patent databases contain information on patents and published patent applications. Patents are public information. Over the years, patent databases have grown into an extensive source of information also for those who do not seek patents for themselves. More than two million new publications are released each year. They are published in more than 100 countries in a number of languages. There are various types of patent publications, including published patent applications, published examined patent applications, and granted patents. Information on patents is also available in patent registers. The patent system produces an enormous amount of information, which is just waiting for the right user. This information is freely available in several patent databases for researches to search and study. Institutions of higher education have some tools at their disposal for examining the patent field, including Patsnap (University of Tampere) and LexisNexis (Tampere University of Applied Sciences).

**Collaborative research (a.k.a Contract research)**

Collaborative research refers to a fee-based service, as defined in the Act on Criteria for Charges Payable to the State, or research that involves at least one third party outside the institution of higher education who funds, conducts part of the research or otherwise participates in the research. The research also involves regulations or an obligation to maintain confidentiality pertaining to the findings, contents or implementation of the research. Research funded by the Academy of Finland, TEKES, the EU and companies constitutes collaborative research.
A standard (norm) is a definition proposed by an organisation regarding how something should be done. Notable standards organisations include the international ISO and IEC, German DIN, European CEN-CENELEC and ETSI, and Finnish SFS. Recently, consortiums and forums, such as W3C, that are organised jointly by companies in a rather informal fashion have assumed a key role in standardisation.

**Background material**
Any information, idea, method, solution model, device, substance, invention, programme etc. that is in the possession of the parties prior to the start of the project even if no legal protection can be provided for them. The handing over of the background material necessary for the implementation of the project is agreed upon in the project agreement. According to the institution’s general terms and conditions, the party who provided the background material retains the intellectual property rights to it.

**Copyright**
Copyright protects the results of creative work, such as works of art, written works, and computer programmes. Copyright does not need to be registered in Finland, and it is automatically in force when a work meets the threshold of originality, i.e. the work is independent and original in such a way that it can be distinguished from other works. An employment relationship may affect the transfer of copyright.

**Industrial property rights**
Industrial property rights refer to the part of intellectual property rights that is formed by protection for inventions, designs, commercial names and symbols, etc. Intellectual property rights include the patent right, utility model right, protection of integrated circuits, plant breeders’ rights, design protection, trademark right, right to a company name, and also in part the protection against unfair competition (i.e. unfair business practices).

**Industrial applicability**
A patent can be obtained for an invention related any field of technology as long as it can be used in the industry. The word ‘industrial’ is understood broadly, and being applicable in agriculture, for example, is considered to be within its scope. The word ‘industrial’ refers to any physical activity of a technical nature, and it does not necessarily require the use of a machine or the manufacture of a product. An invention that does not function and that can therefore not be used for anything is not considered to be an invention. For example, a device or method that is claimed to function contrary to the laws of nature, such as a perpetual motion machine, cannot be considered to be an invention that can be used in the industry.

**Known level of technology**
An invention presented in a patent disclosure must be *new and inventive in comparison to the known level of technology*. The known level of technology covers all the information that was available to the public prior to the filing date of the application (date of priority). Material that belongs to the known level of technology may be known via writing or another format, for example through public use. An individual who claims the known level of technology as an obstacle to a patent application must be able to prove that the information was available to the public prior to the filing date. It does not matter how, in what language or where in the world this publishing took place.

**Commissioned research**
Collaborative research funded in full by a single external company. In this case, the sponsor can determine the terms and conditions for purchasing the research.

**Freedom to operate (FTO)**
Determining the patents, design protection and trademarks of named competitors. Key contents of the protection. The country-specific scope of protection, the status and validity of applications. The number of patent families to be analysed depends on the scope of the examination.

**Foreground information** (research results)
Any information, ideas, methods, solution models, devices, substances, inventions, etc. even if no legal protection can be provided for them.

**Novelty value**
An invention must be absolutely new, with no one having published or presented it in public anywhere previously. Public disclosure also includes project meetings, conference presentations and theses.
Additional information

7 Useful hyperlinks


Patentti- ja rekisterihallitus/ Finnish Patent and Registration www.prh.fi

Tuoteväylä/Product track: http://tuotevayla.fi/en

Uusitehdas/New Factory : www.uusitehdas.fi

The Lean Startup: http://theleanstartup.com/

WIPO: http://www.wipo.int/

NABC model: http://www.sri.com/engage/innovation-programs/five-disciplines-innovation

Business Model Canvas model: http://www.businessmodelgeneration.com/canvas/bmc

Hyperlinks to patent data bases:
http://www.iprinfo.com/
http://www.delphion.com/
http://fi.espacenet.com/
http://www.epo.org/
http://www.google.fi/advanced_patent_search

8 Brief summary
What is an invention?

An invention can be a new product, device, method or a new use for something old. Novelty refers to the invention not being published anywhere prior to its creation. Forms of publication include giving scientific presentations (conferences), meeting summaries, posters, websites and articles. An invention cannot be patented if it has been published prior to the filing of the patent application. A thesis is also considered to be a publication, so please contact a patent assistant before printing your thesis or dissertation if you have made an invention.
What makes this guide important?

Researchers and members of the university community should be familiar with their own rights and obligations regarding inventions. This guide summarises matters that relate to inventions and commercialising them. Income received from inventions may also be utilised in obtaining funding. If an institution of higher education sells the rights to an invention to an external company, some of the profit is distributed to the researcher, some to the department and a small part to the entire institution. The purpose of the HEI Invention Act and the internal regulations of institutions of higher education is to clarify and standardise the practices of various institutions.

1. **Submit an invention disclosure in time.**
   In the case of a dissertation, for example, an invention disclosure must be submitted before the dissertation has been approved. You should also be careful at conferences and other meeting presentations. Publishing the invention prematurely may lead to someone else making use of your invention without permission and compensation, or you may not be able to protect your invention with a patent after it has become public knowledge.

2. **Always make sure to contact** the university’s innovation officer well in advance.
   The innovation officer is bound by professional secrecy, which ensures that you can safely discuss your invention with him/her.

3. **Always check the agreement to see which type of research is in question.**

4. **Make sure that your name is included in the innovation disclosure.**
   The innovation disclosure must be filled in with care and sufficient level of detail, as it cannot be revised or corrected afterwards!

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More information

Research and Innovation Services

Confidential and free-of-charge services for all members of the university community of Pirkanmaa who are interested in entrepreneurship and innovations

Ask more about inventions and intellectual property rights:

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talli@tut.fi
innovaatiopalvelut@uta.fi