

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 University Patent Fund 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 will support various types of applications receiving approval from the University's Patent Committee.

II. Application

- 4) All CUHK staff are eligible to apply.
- 5) Applications are open all year round until the budget is fully utilized.
- 6) To apply, Inventor should complete the **Invention Disclosure Form**, which is available for download on the Office of Research and Knowledge Transfer Services website (<https://www.orkts.cuhk.edu.hk/en/knowledge-transfer/ip-roadmap-cuhk/for-academic-and-research-staff>), 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

- 7) All applications will initially be processed on a first-come-first-served basis by the ORKTS. 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.

- 8) For PAF application(s) with Provisional Patent:

A fund request with necessary supporting information such as new data generated should be submitted to ORKTS before the expiration of the Provisional Patent, for evaluation by the Patent Committee.

- 9) For PAF application(s) claiming priority of an earlier patent (other than Provisional Patent):

Application(s) should be submitted to ORKTS 4 months before the expiration of the earlier patent, for evaluation by the Patent Committee.

- 10) For PAF application(s) without claiming priority of an earlier patent:

- (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 PC is required for the filing.

- (b) 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.

- (c) 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. Upfront Inventor Contribution for PAF 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 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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