CHAPTER 6-30

CRITERIA FOR PATENTING OR PUBLICATION--PROOF OF INVENTION

6-30-00 PURPOSE

This chapter provides supplementary criteria for Department personnel who are charged with responsibility for making recommendations as to the patenting or publication of inventions in which the Department has an interest (45C.F.R. 7.5). It is issued, with the approval of the Department Patents Board, pursuant to Department Regulations (45 C.F.R. 6.5).

6-30-10 GENERAL ASSUMPTIONS

A. The Department's interest in inventions is almost the reverse of that which generally prompts a private patent application. It8 *concern is* not to withhold the *invention* from the public *or* to charge royalties for its use but to assure the availability of the invention to all (45 C.F.R. 6.2). This assurance with respect to an invention may be lost if an individual claiming priority of invention files a patent application.

B. The Department therefore does have au interest, and under Executive Order 10096 it has an obligation, to take appropriate defensive action, to protect the interest of the Government and the public against potential adverse claims. Such action may take the form of initiating a patent application or by full disclosure through publication.

C. Since not all inventions are of sufficient importance to warrant the labor and expense of patenting, and since the Department does not itself maintain staff or facilities for such purpose, the need for patenting and the resources available for handling a patent application need to be weighed carefully *before* a determination as to patenting is made.

6-30-20 DETERMINATION AS TO PATENTABILITY

A. No recommendation as to patenting should in any case be made unless it is first determined that the invention may be patentable.

(6-30-20 continued)

3. The determination as to whether the invention "may be patentable" should Identify the originality of concept, as well as the elements of novelty and usefulness, believed to be present in the invention. This is for the reason that, even though an invention is "new and useful" it is not patentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have bsen obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." (35 U.S.C. 103)

C. Whether it is determined that the invention may or may not be patentable, the basis for the conclusions reached should bs indicated in the determination. For example, a written report on these points by research workers who have familiarity with the art in the particular field is valuable, because it may indicate that the invention has been fully anticipated. In any event, the report itself will constitute a record bearing on the relation of the invention to the prior art, and so may serve a protective purpose.

D. The determination should set forth fully the dates of conception and of reductiontopractice (or of the successful test or performance) of the invention, and of any prior disclosure (speeches, writings, printed publication, etc.) or use thereof. These are important because the invention will not be patentable if at the time of the determination it has been for more than one year either—

1. described in a printed publication in this country or abroad; or

2. in public use or on sale in this country (35 U.S.C 102(b)).

6-30-30 INVENTIONS OF TRIVIAL VALUE OR SIGNIFICANCE

A. Unless "useful" to some degree, the invention will not be patentable.

B. Even though the invention is possibly patentable, it may be recommended that title be left with the inventor, pursuant to section 7.3 (b) of the Department Regulations on grounds of "insufficient interest," subject to license to the Government under any patent which may be secured.

C. Government "interest" has two aspects. First, the Government has an interest as a potential user of the invention in its own operation8 or as a purchaser of products embodying the invention. Second, it has an interest (particularly strong in the field of research) of preserving for the public the products of its work and investment. Ordinarily, therefore, a recommendation of dedication to the public by publication rather than a finding of insufficient interest is appropriate in the case of all but patently trivial gadgets in which there has been no substantial investment of Government time or facilities, .

D. Determinations of "insufficient interest" are subject to review by the Chairman of the Government Patents Board.

6-30-40 INVENTIONS OF SUBSTANTIAL VALUE OR SIGNIFICANCE

A. In general patenting should not be recommended when printed publication of a technically adequate description can be, or has been, arranged, or disclosure to or use by others can be, or has been, arranged under safeguards which will assure the availability of proofs as to time of conception, reduction to practice, and disclosure. (A person is not entitled to a patent if "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." 35 U.S.C. 102 (a).) Certainly patenting should not in the absence of unusual justification be recommended if the one year period which may elapse between a printed publication and the filing of an application has almost elapsed.

B. Patenting, however, is appropriately recommended when--

1. it is deemed advisable, in the case of an invention of high potential significance to the public health, safety, *or welfare,* to obtain maximum assurance against potential rival claims by establishing priority of invention and diligence in reducing to practice; or

2. it is deemed advisable, for reasons of health or safety, to retain control (beyond that afforded under the Federal Food, Drug, and Cosmetic Act, as amended, or the Public Health Service Act, as amended, or other Federal control legislation) of the invention itself, with legal authority to impose restrictive conditions on its use; or

3. other Federal agencies have such interest in the invention that they would be prepared to prosecute the patent application.

C. 1. Filing may be especially important as a protective device when there is likely to be a considerable lag between conception and actual reduction to practice and the invention is in a highly competitive field or when the invention is a basic one likely to constitue a key to subsequent advances in the art.

2. The filing of a patent application may be of great practical importance in case of competing claims because the Commissioner of Patents is under a duty to give notice and have questions of priority determined by a board of patent interferences whenever an application is made which would seem to interfere with any pending application or any unexpired patent. (35 U.S.C. 135)

3. "In determining priority of invention there shall be considered not only the respective dates of a conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, for a time prior to conception by the other." (35 U.S.C. 102 (g))

(6-30-40 continued)

4. If a patent has issued, the filing of an allowable application is regarded in litigation involving priority or" invention as a constructive reduction to practice and as evidence that the inventor made his invention at least as early as the date of filing,

D. The inventor's interest, as a matter of prestige and professional reputation, in having a patent issued in his name does not justify a recommendation for a patent application to be prosecuted at the expense Of the Government.

E. In order that final determinations as to ownership may not be delayed pendingresolution of the question of patenting, the operating agency may make a determination to patent contingent upon the availability of timely arrangements for the prosecution of a patent appli cation, with reliance, in the event that these are not feasible, upon publication to protect the public interest.

6-30-50 PUBLICATION AS AN ALTERNATIVE TO PATENTING"PRINTED" PUBLICATION

A. Publication, to be effective as an anticipation, requires a full disclosure setting forth the essential elements of the invention, and the manner of making and using it.

B. Such publication may be mad8 in a technical journal *or* digest, in a publication of the operating agency (e.g., Public Health Reports, Social Security Bulletin) or in any other printed publication.

C. Additionally, the Office of Technical Services in the Department of Commerce, through the monthly publication of "U. S. Government Research Reports", provides a means of achieving technical "publication" as well as a means of disseminating papers which disclose the results of research. Original reports filed with the Office of Technical Cervices are deposited in the Library of Congress and copies may be ordered from the Library in photocopy or microfilm. In addition, Office of Technical Services is prepared to distribute stock copies of scientific research reports for government agencies. Listing in "Research Reports", together with the deposit of a typewritten or other copy in an appropriate Federal library, and published announcement of a means provided for duplication of copies for the public have been held to constitute 'printed publication" under 35 U.S.C. 102(b). An operating agency wishing to avail itself Of this channel should communicate with the Chief, Technology Division, Office Of Technical Services, Department of Commerce.

6-30-60 NOTEBOOKS AND ORIGINAL RECORDS-EVIDENCE OF INVENTION

A. Whether or not a patent application is filed, written records, and particularly original records, properly dated, are important evidence of invention both as to completeness and the time when made. When these exist they may be used defensively to prevent the issuance of a patent on an invention subsequently conceived, or to contest the validity of a patent which may have been granted to some other person. For such purpose, the conception should be recorded, with indication of the date of conception, and immediately corroborated by communication to a competent witness who may be asked to read and initial the record, indicating the date of his initialing. Reduction to practice should be corrobated by a witness who observes the actual test or performance. Accurate dating is an essential factor in such records.

B. The operating agency, to the extent deemed consistent with good research practice, should require of its research workers the making ad preservation of records which will serve a probative purpose. This is especially desirable in the case of developments failing within section 6-30-40.B1.