STANDARD OPERATING PROCEDURES

FOR

PATENTING
INVENTIONS OWNED BY THE DEPARTMENT OF VETERANS AFFAIRS

Purpose:

This document establishes procedures for patenting inventions owned by the Department of Veterans Affairs (VA).

Responsibility: Technology Transfer Program (TTP) staff

Information:

a. Once a determination of rights (DOR) has been made by the Office of General Counsel (OGC) for VA to retain ownership of an invention, the VA patent process begins. Under 35 U.S.C. §207, VA is authorized to apply for, obtain and maintain patents or other forms of protection in the U.S. and in foreign countries on inventions in which VA owns a right, title or interest. Any eligible invention in which VA asserts an ownership interest needs to be protected by an application for a domestic patent.

Authority*:* 38 CFR §1.654.

b. All VA-owned inventions not covered by a Cooperative Technology Administration Agreement (CTAA) must receive centralized patenting support arranged and coordinated through the TTP. This support includes handling patent applications, provisional patents, patent filings, follow-up requests for information concerning pending patent applications, international filings where applicable, and other necessary actions. In order to accomplish these tasks VA may elect to use outside counsel or other means to be identified.

NOTE: *These services are provided at no cost to the facility or investigator.*

c. Inventions arising from a medical center that is covered under a CTAA receive patenting support as outlined in the appropriate CTAA.

d. If it is determined that the employee inventor is entitled to full ownership consistent with 37 CFR §501.6, subject to a non-exclusive, irrevocable, royalty-free license to the Government, it is the duty of the employee inventor to notify TTP of the status of the patent application, including the patent application number so that VA may protect interests reserved to the Government.

Authority: 38 CFR §1.655.

Procedures for Patenting VA - Owned Inventions:

Once it has been determined that VA is responsible for patent filings, the following procedures will occur:

a) TTP coordinates and manages the patent application and prosecution process for VA-owned inventions. TTP integrates this process with all other necessary actions for commercial assessment, licensing and marketing. The inventors will be involved as necessary regarding scientific input. The inventors and other pertinent parties are informed of the status of the application process at milestones.

b) TTP submits the invention disclosure (ID), filed by the VA employee, to a marketing contractor for commercial assessment.

c) Concomitantly with sending the ID for commercial assessment, TTP contracts with a patent law firm that has expertise in the subject matter of the invention to initiate the process for advising TTP on patentability and application choices available for the specific invention. This usually leads to filing a provisional patent application. A provisional patent provides TTP with a 12 month timeframe in which to make a decision whether or not to convert the provisional patent application to a nonprovision or Patent Cooperation Treaty (PCT) application. It also allows for a stronger application based on additional data and claims generated before filing the non-provisional application.

d) The results of the commercial assessment, along with any patent searches and other available data provided by the inventor, will be used by TTP staff to decide whether or not to proceed with patent prosecution or if it would best serve the US Government to dedicate the invention to the public. This data will also guide TTP to determine if foreign filing is recommended.

e) If TTP decides to continue patent prosecution, then TTP will contract with a patent law firm. TTP's patent application and prosecution process is to have the contract patent attorney work directly with VA inventors to provide the necessary details and data on their invention to prepare the patent applications and to prepare responses to Office Actions received from US or foreign patent offices throughout the prosecution period. The inventors are also required to provide copies of all prior art, including copies of publications used as references in the application and invention disclosure which must be submitted to the patent office within a short time of filing the non-provisional patent application.

f) Foreign Patents: TTP may file a PCT application. This provides VA a specified time span (currently up to 30 months) before deciding whether to enter the process of filing in foreign countries. One hundred seventeen countries have signed onto this Treaty. TTP's policy is to file in select foreign countries only when a licensee, or potential licensee (one in negotiation for a license) desires that protection. There may be exceptions for limited foreign filings if the invention is early stage and the commercial assessment identifies the invention as having a very high potential of success. As this process can be expensive careful consideration is given to the potential of the invention and the benefit to the veteran population prior to making a decision to move forward.

g) Legal Documents: The inventors are required to execute two documents; 1.) an assignment document assigning ownership rights to the US Government as represented by the Department of Veterans Affairs; and 2.) a Declaration and power of attorney (POA) allowing the VA's contract attorney to represent them before the US and/ or foreign patent authority . The VA must also execute a POA allowing the contract attorney to represent the assignee (VA) before the US PTO or subcontract with representatives in foreign countries. The inventors must cooperate and timely execute other legal domestic and foreign documents as needed during the prosecution and issuance period of the application.

h) If TTP decides not to pursue patenting, there are several possible outcomes. If the decision is based on the finding that due to prior art the invention is ineligible for patenting or TTP determines that patenting would restrict its use, e.g. the invention is a research tool, then the VA would retain ownership rights and otherwise promote the invention's use . However, if the findings identify that the cost of patenting would not be warranted when weighted against the strength and future use of the potential patent claims, then the ownership rights could be returned to the inventors if they indicate that they will file a patent application. In this latter case, an amended DOR letter will be issued from OGC returning all rights to the inventor(s) while maintaining a government use license.

i) TTP is responsible for maintaining all applications filed by VA and all issued patents. This can involve contracting with a firm that specializes in insuring that maintenance fees, domestic and foreign, are paid on time.

REFERENCES
VHA Handbook 1200.18

FOLLOW UP DATE
October 2009