

DEPARTMENTAL REGULATION		Number: 5700-001
SUBJECT: Patents	DATE: January 10, 1983	
	OPI: Office of the General Counsel	

1 PURPOSE

This regulation provides policies, procedures and responsibilities as to inventions made by Department employees or subject to Department control.

2 SPECIAL INSTRUCTIONS/CANCELLATIONS

This regulation replaces Title 1 of the Administrative Regulations, Chapter 15 in its entirety.

3 POLICY

a Invention Ownership. Executive Order 10096, paragraphs 1(a)-(d), 36 F. R. 389, which pertains to ownership of inventions made by Government employees, shall be a condition of employment of all employees of the Department. Generally, the Order provides that the Government is entitled to ownership of any invention directly related to the official duties of the inventor.

b New Plants. The Department shall not apply for patents or plant variety certificates on any inventions on new plants made by Department employees who are privy to the files of the Plant Variety Protection Office or the plant patent division of the U.S. Patent and Trademark Office.

4 DEFINITIONS

The term "invention", as used in this regulation, means any art, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable or protectible by plant variety certificate.

5 RESPONSIBILITIES

a Reporting Inventions

(1) Employee-inventors shall promptly report their inventions to their supervisors.

(2) Supervisors shall promptly forward invention reports to the patent operation in their respective agencies or in the Office of the General Counsel.

b Publication of Inventions. If an invention is disclosed in a publication, or used for its intended purpose, prior to being prepared as a U. S. patent application, such facts shall be promptly made known to the patent operation which receives the invention report. Publications include, for example, articles in journals or newspapers, abstracts distributed at professional society meetings, and publicly available microfilm.

c Determination Not to Apply for a Patent. If an agency determines not to apply for a patent on an invention, such decision shall be reported to the patent operation in the Office of the General Counsel which shall thereafter seek approval of the agency's decision from the U. S. Commissioner of Patents and Trademarks, as required by Title 37, part 100.8 (d), of the Code of Federal Regulations.

d Patent Preparation and Prosecution. The Office of the General Counsel is primarily responsible for preparing and prosecuting applications for patents and plant variety certificates. Other agencies may maintain patent operations to prepare and prosecute such applications: Provided, that the patent operation in the Office of the General Counsel shall review and approve such work, shall make amendments thereto where appropriate, and shall be primarily responsible for all transactions with the U.S. Patent and Trademark Office, or the Plant Variety Protection Office, in connection therewith.

e Administrative Functions. Administrative functions as to preparing and prosecuting applications for patents and plant variety certificates are assigned to the Office of the General Counsel. All other administrative functions pertaining to patents and plant variety certificates are assigned to the Agricultural Research Service. Such functions include, but are not limited to:

(1) Advertising Department-owned inventions as available for patent licensing;

(2) Patent licensing of Department-owned inventions; and

(3) Transferring custody of inventions to other Government agencies for purposes of patent licensing.

6 EMPLOYEE OWNERSHIP OF INVENTIONS

a Determination of ownership. If employees believe they may be entitled to ownership of their inventions, they shall make their position known to the Office of the General Counsel which thereafter shall make a formal determination of ownership.

b Foreign Patents. When the Department is entitled to ownership of an employee's invention, but decides not to seek foreign patents on the invention, the inventor shall be entitled to seek such patents in accordance with Title 37, part 101.8, of the Code of Federal Regulations, except that the employee's foreign patents shall be subject to the following limitations:

(1) The Government reserves a nonexclusive, irrevocable, royalty-free license as provided in Title 37, part 101.8, of the Code of Federal Regulations; and

(2) Materials which are manufactured or otherwise produced essentially in the United States shall not be barred, by means of any foreign patents on the employee's invention, from being sold or used in any foreign country. The employee, or anyone who obtains the employee's rights in such patents, shall grant patent licenses therein, at reasonable terms, to permit such sale or use: Provided, that the employee, or anyone who obtains the employee's rights, shall not be compelled to grant such licenses in any foreign country where said materials are staple articles or commodities of commerce suitable for substantial use other than in infringement of said patents.

7 AWARDS TO EMPLOYEE-INVENTORS

a Agency Awards. Department agencies are authorized to grant awards to employee-inventors, as set forth in the Federal Personnel Manual, Chapter 451, Subchapter 9.

b Awards from the Department of Commerce. An employee-inventor may be entitled to an award from the Department of Commerce if:

(1) Custody of the employee's invention is transferred to the Department of Commerce for purposes of licensing; and

(2) The Department of Commerce licenses the invention on royalty-bearing terms.