

GOVERNMENT PATENTS BOARD

Office of the Chairman.

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Administrative Order No. 5April 26, 1951

RULES AND REGULATIONS FOR THE ADMINISTRATION OF A
UNIFORM PATENT POLICY WITH RESPECT TO THE DOMESTIC RIGHTS IN
INVENTIONS MADE BY GOVERNMENT EMPLOYEES

Section 1. Purpose:

The purpose of this order is to provide for the administration of a uniform patent policy for the Government with respect to the domestic rights in inventions made by Government employees and to prescribe rules and regulations for implementing and effectuating such policy.

Section 2. Authority:

Authority for the administration of a uniform patent policy is provided in Executive Order 10096, dated January 23, 1950 (15 F.R. 389).

Section 3. Scope:

This order applies to any invention made by a Government employee on or after January 23, 1950, and to any action taken with respect thereto.

Section 4. Definitions:

(a) The term "Government agency", as used in this order, means any Executive department or independent establishment of the Executive branch of the Government (including any independent regulatory commission or board, any corporation wholly owned by the United States, and the Smithsonian Institution), but does not include the Atomic Energy Commission.

(b) The term "Government employee", as used in this order, means any officer or employee, civilian or military, of any Government agency, including any part-time consultant or part-time employee except as may otherwise be provided for by agency regulation approved by the Chairman.

(c) The term "invention", as used in this order, 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 under the patent laws of the United States.

(d) The term "Chairman", as used in this order, means the Chairman of the Government Patents Board.

Section 5. Determination of invention:

Each Government agency will determine whether the results of research, development, or other activity within the agency constitute invention within the purview of Executive Order 10096.

Section 6. Determination of rights in and to inventions:

(a) Subject to review by the Chairman as provided for in this order, each Government agency will determine the respective rights of the Government and of the inventor in and to any invention made by a Government employee while under the administrative jurisdiction of such agency.

(b) The following rules shall be applied in determining the respective rights of the Government and of the inventor in and to any invention that is subject to the provisions of this order:

(1) The Government shall obtain the entire domestic right, title and interest in and to all inventions made by any Government employee (i) during working hours, or (ii) with a contribution by the Government of facilities, equipment, materials, funds, or information, or of time or services of other Government employees on official duty, or (iii) which bear a direct relation to or are made in consequence of the official duties of the inventor.

(2) In any case where the contribution of the Government, as measured by any one or more of the criteria set forth in subparagraph (1) last above, to the invention is insufficient equitably to justify a requirement of assignment to the Government of the entire domestic right, title, and interest in and to such invention, or in any case where the Government has insufficient interest in an invention to obtain the entire domestic right, title, and interest therein (although the Government could obtain same under subparagraph (1) above), the Government agency concerned, subject to the approval of the Chairman, shall leave title to such invention in the employee, subject, however, to the reservation to the Government of a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, such reservation, in the terms thereof, to appear, where practicable, in any patent, domestic or foreign, which may issue on such invention.

(3) In applying the provisions of subparagraphs (1) and (2) above to the facts and circumstances relating to the making of any particular invention, it shall be presumed that an invention made by an employee who is employed or assigned (i) to invent or improve or perfect any art, machine, manufacture, or composition of matter, (ii) to conduct or perform research, development work, or both, (iii) to supervise, direct, coordinate, or review Government financed or conducted research, development work, or both, or (iv) to act in a liaison capacity among governmental or non-governmental agencies or individuals engaged in such work, falls

within the provisions of subparagraph (1) above, and it shall be presumed that any invention made by any other employee falls within the provisions of subparagraph (2) above. Either presumption may be rebutted by the facts or circumstances attendant upon the conditions under which any particular invention is made and, notwithstanding the foregoing, shall not preclude a determination that the invention falls within the provisions of subparagraph (4) next below.

(4) In any case wherein the Government neither (i) obtains the entire domestic right, title and interest in and to an invention pursuant to the provisions of subparagraph (1) above nor (ii) reserves a nonexclusive, irrevocable, royalty-free license in the invention, with power to grant licenses for all governmental purposes, pursuant to the provisions of subparagraph (2) above, the Government shall leave the entire right, title and interest in and to the invention in the Government employee, subject to law.

(c) In the event that a Government agency determines, pursuant to subparagraph (2) or subparagraph (4) of paragraph (b) of this section, that title to an invention will be left with an employee, the agency shall, subject to considerations of national security, or public health, safety, or welfare, report to the Chairman, promptly upon making such determination, the following information concerning the invention:

- (1) description of the invention in sufficient detail to permit a satisfactory review;
- (2) name of inventor and his employment status; and
- (3) statement of agency determination and reasons therefor.

The report in a case falling within the provisions of subparagraph (2) of paragraph (b) of this section shall be made after the expiration of the period prescribed in section 7 of this order for the taking of an appeal, or it may be made prior to the expiration of such period if the employee acquiesces in the agency determination. The Chairman thereupon shall review the determination of the Government agency, and his decision respecting the matter shall be final, subject to the right of the inventor to submit to the Chairman, within 30 days (or such longer period as the Chairman may, for good cause, fix in any case) after receiving notice of such decision, a petition for the reconsideration of the decision if it gives to the Government greater rights than the agency determination. A copy of any such petition must also be filed by the inventor with the employing agency within the prescribed period.

Section 7. Appeals by employees:

(a) Any Government employee who is aggrieved by an agency determination pursuant to subparagraph (1) or subparagraph (2) of paragraph (b) of section 6 of this order may obtain a review of the agency determination by filing, within 30 days (or such longer period as the Chairman may, for good cause, fix in any case) after receiving notice of such determination, a written appeal with the Chairman and a copy of the appeal with the Government agency.

(b) In the event of the filing of an appeal pursuant to paragraph (a) of this section, the Government agency which made the determination shall, subject to considerations of national security, or public health, safety, or welfare, furnish the Chairman in writing, promptly upon the filing of the appeal, the following information concerning the invention involved in the appeal:

(1) description of the invention in sufficient detail to permit a satisfactory review;

(2) name of the inventor and his employment status, including a detailed statement of his official duties and responsibilities at the time of making the invention; and

(3) detailed statement of the nature of the dispute or controversy, together with copies of the agency determination, of any briefs or written arguments that may have been filed, of any statements or other evidence that may have been considered by the agency, and of other relevant material.

(c) The decision of the Chairman upon any appeal taken pursuant to this section shall be final.

Section 8. Patent protection:

(a) A Government agency, upon determining that an invention coming within the scope of subparagraph (1) or subparagraph (2) of paragraph (b) of section 6 of this order has been made, shall thereupon determine whether patent protection will be sought in the United States by the agency for such invention. A controversy over the respective rights of the Government and of the inventor in any case shall not delay the taking of the actions provided for in this section. In cases coming within the scope of subparagraph (2) of paragraph (b) of section 6 of this order, agency action looking toward such patent protection shall be contingent upon the consent of the inventor.

(b) Where there is a dispute as to whether subparagraph (1) or subparagraph (2) of paragraph (b) of section 6 of this order applies in determining the respective rights of the Government and of an employee in and to any invention, the agency will determine whether patent protection will be sought in the United States pending the Chairman's decision on the dispute, and, if it decides that an application for patent should be filed, will take such rights as are specified in subparagraph (2) of paragraph (b) of section 6 of this order, but this shall be without prejudice to acquiring the rights specified in subparagraph (1) of that paragraph should the Chairman so decide.

(c) Where an agency has determined to leave title to an invention with an employee under subparagraph (2) of paragraph (b) of section 6 of this order, the agency will, upon the filing of an application for patent and pending review of the determination by the Chairman, take the rights specified in that subparagraph without prejudice to the subsequent acquisition by the Government of the rights specified in subparagraph (1) of that paragraph should the Chairman so decide.

(d) In the event that patent protection is sought by an agency for an invention made by a Government employee, the agency shall, subject to considerations of national security, or public health, safety, or welfare, report to the Chairman, promptly upon the filing of an application for patent, the following information concerning the invention:

- (1) brief description of the invention;
- (2) name of the inventor and his employment status; and
- (3) serial number, title of invention, and date on which the application was filed.

(e) In the event that a Government agency determines that an application for patent will not be filed on an invention made under the circumstances specified in subparagraph (1) of paragraph (b) of section 6 of this order, giving the United States the right to title thereto, the agency shall, subject to considerations of national security, or public health, safety, or welfare, report to the Chairman, promptly upon making such determination, the following information concerning the invention:

- (1) description of the invention in sufficient detail to permit a satisfactory review;
- (2) name of the inventor and his employment status; and
- (3) statement of agency determination and reasons therefor.

The Chairman may, if he determines that the interest of the Government so requires and subject to considerations of national security, or public health, safety, or welfare, cause an application for patent to be filed or cause the invention to be fully disclosed by publication thereof: Provided, however, That no application for patent respecting any variety of plant invented by an employee of the Department of Agriculture shall be filed without the approval of the Secretary of Agriculture.

(f) Whenever a patent hereafter issues on an invention made by a Government employee, in respect to which the Government has any right, title, or interest, including a license, the Government agency concerned shall, promptly upon the issuance of the patent, furnish to the Chairman:

- (1) an abstract of the invention;
- (2) name of the inventor and his employment status;
- (3) a copy of the patent; and
- (4) statement of the nature and extent of the right, title, or interest of the Government in the invention.

Section 9. Report forms:

The Chairman will prescribe the forms to be used by Government agencies in submitting the reports specified in this order.

Section 10. Liaison:

Each Government agency shall designate a liaison officer at the agency level to deal with the Office of the Chairman: Provided, however, That the Departments of the Army, the Navy, and the Air Force may each designate a liaison officer.

Section 11. Dissemination of order:

Each Government agency shall make appropriate arrangements for the dissemination to its employees of the provisions of this order.

Section 12. Revocation:

Administrative Order No. 1, dated September 6, 1950, is superseded by the provisions of this order, which shall remain in effect until further notice.

/s/ Archie M. Palmer

Chairman

Approved:

/s/ Harry S. Truman

President

Date: April 26, 1951