



INTELLECTUAL PROPERTY RIGHTS & GOVERNMENT PROCUREMENT

USAMRAA Stand-down 26 March 2009



USAMRMC OSJA

- Staff Judge Advocate (Military)
- Senior Counsel
- Deputy Staff Judge Advocate (Military)
 - Business Operations Group
 - Installation Support Group
 - Military Justice Group



USAMRMC OSJA

Business Operations Group

- Contracts
- Technology Transfer
- Intellectual Property
- Human Subjects Protection
- Food & Drug Law



ISSUE SPOTTING

- Reports of invention
- Protecting others inventions and proprietary information/data
- Contractor education

Patents

- Invention must be:
- New
- Useful
- Nonobvious

U.S. FILING

- Regular utility patent application
 - Provisional patent application
- Design
- Plant



FOREIGN PATENT FILING

- Individual Countries
 - Thailand, Great Britain, etc.
- Regional
 - European Patent Office: European Union
- International
 - Patent Cooperation Treaty (PCT)

BENEFITS OF PATENTING

- Right to exclude others from making, using, selling the invention
 - Done through Licensing
 - Government: royalty Sharing, money back to lab for research, etc.
 - Contractor: Manufacturing or sublicensing, sales to government
- For government: royalties, funding for research, good publicity, incentive for inventors, technology transfer

OWNERSHIP

- Ownership follows inventorship
- Unless:
 - An agreement states otherwise
 - Cooperative Research & Development Agreement (CRADA)
 - Law states otherwise
 - FAR, Bayh-Dole Act

GOVERNMENT MADE INVENTION

- If only government employee inventors:
- Government owns invention
- Government can assign or license invention to others
- But government always retains a non-exclusive, royalty-free license to use or make the invention or to have the invention used or made by others for governmental purposes.

EXTRAMURAL PATENT REPORTING

- 35 United States Code 200 *et seq.*
- 37 Code of Federal Regulations Part 401
- Federal Acquisition Regulation Part 27.3

EXTRAMURAL PATENT REPORTING

Contractor generally may retain title to any invention made while performing under a government contract, grant, or cooperative agreement.

Government retains a non-exclusive license to use or make the invention.

CONTRACT/GRANT REQUIREMENTS

- To Retain Title to Invention, Contractor Must:
 - **DISCLOSE** *INVENTION TO GOVT*
 - **ELECT** *TO RETAIN TITLE*
 - **FILE** *PATENT APPLICATION*

DISCLOSURE

- **DISCLOSE INVENTION TO GOVERNMENT (Contracting Officer)**
 - Within 2 MONTHS of Disclosure to Inventor's Employer (Grantee or Awardee)
 - DD 882 Report of Invention Or Similar Document
 - Complete, Original Signed Document

ELECTION

- **ELECT TO RETAIN TITLE**
OR
- **ELECT NOT TO RETAIN TITLE**
- **Grantee/Awardee Notifies Contracting Officer**
 - Within 2 YEARS of Disclosure to Government
(Contracting Officer)

FILE PATENT APPLICATION

- **FILE PATENT APPLICATION WITH PATENT OFFICE**
 - Within 1 YEAR of Notification to Contracting Officer that Grantee/Awardee Elects to Take Title to Invention
 - Grantee/Awardee Provides Copy of Patent Application
 - Grantee/Awardee Provides Copy of Confirmatory Instrument (License To Govt)

PATENT APPLICATION

- APPLICATION SHOULD INCLUDE STATEMENT THAT GOVT HAS AN INTEREST IN INVENTION (at beginning of application)
- “The U.S. Government has a paid-up license in this invention and the right in limited circumstances to require the patent owner to license others on reasonable terms as provided for by the terms of (contract/grant number) awarded by (agency).”

CONFIRMATORY INSTRUMENT (LICENSE)

- Grantee/Awardee Provides Copy of Confirmatory Instrument
- Confirmatory Instrument is a License To Govt to Make/Use Invention
- Confirmatory Instrument is Recorded at Patent Office
- Original Signed Document Needed

CONTRACTOR WAIVERS

- If Contractor can take title to invention but wants to waive its rights in favor of its inventor employees
 - Make request in writing
 - Government gets rights over contractor employee inventors
 - But government may permit title to go to contractor employee inventors (IEC recommendation)
 - Government retains royalty-free, non-exclusive license to use, make, sell invention or have these actions taken on its behalf

USAMRMC PROCESS

- Submit Invention Disclosure (ID) or patent application
- Reviewed by Invention Evaluation Committee (IEC)
- If Army interest, we require assignment of title and continue patent prosecution
- If no Army interest, we indicate that title may remain with contractor employee inventors but government gets license

CONTRACTOR RIGHTS IN INVENTION

- When contractor employee is a co-inventor with government employee co-inventor:
- Contractor can take title to its share of invention if:
 - Report making of invention to govt
 - Elect to take title
 - File patent application
- Contractor & government share ownership of invention if contractor perfects title-jointly owned



CONTRACTOR REPORTING

- iEdison (Interagency Edison)
 - Electronic invention and patent reporting system
 - Grantees & contractors

How You Can Help

- Double check with government's technical representative when you receive a negative report of invention
- Send copy of every interim & final DD 882 Report of Invention, Invention Disclosure, Patent Application, Confirmatory Instrument to OSJA
- If your clients have IP relevant to a contracting action, make sure it is identified in the contract, especially if providing materials to contractor