CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.

[266. Repealed.]
267. Time for taking action in Government applications.

Historical Note

1965 Amendment. Pub.L. 89–83, § 8, July 24, 1965, 79 Stat. 261, struck out item 266 "Issue of patents without fees to Government employees".

[§ 266. Repealed. Pub.L. 89–83, § 8, July 24, 1965, 79 Stat. 261]

Historical Note

Section, Act July 19, 1952, c. 950, § 1, 66 Stat. 811, provided for the issuance of patents to government employees without fees.

Effective Date of Repeal. Repeal of section by Pub.L. 89–83 effective three months after July 24, 1965, see section 7(a) of Pub.L. 89–83, set out as a note under section 41 of this title.

EXECUTIVE ORDER NO. 9424

Feb. 18, 1944, 9 F.R. 1959

ESTABLISHMENT OF A REGISTER OF GOVERNMENT INTERESTS IN PATENTS

1. The Secretary of Commerce shall cause to be established in the United States Patent Office [now Patent and Trademark Office] a separate register for the recording of all rights and interests of the Government in or under patents and applications for patents.

2. The several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, shall forward promptly to the Commissioner of Patents [now Patents and Trademarks] for recording in the separate register provided for in paragraph 1 hereof all licenses, assignments, or other interests of the Government in or under patents or applications for patents, in accordance with such rules and regulations as may be prescribed pursuant to paragraph 4 hereof; but the lack of recordation in such register of any right or interest of the Government in or under any patent or application therefor shall not prejudice in any way the assertion of such right or interest by the Government.

3. The register shall be open to inspection except as to such entries or documents which, in the opinion of the department or agency submitting them for recording, should be maintained in secrecy: Provided, however, That the right of inspection may be restricted to authorized representatives of the Government pending the final report to the President by the National Patent Planning Commission under Executive Order No. 8977 of December 12, 1941, and action thereon by the President.

4. The Commissioner of Patents [now Patents and Trademarks], with the approval of the Secretary of Commerce, shall prescribe such rules and regulations as he may deem necessary to effectuate the purposes of this order.

EXECUTIVE ORDER NO. 9865

June 16, 1947, 12 F.R. 3907, as amended by Ex.Ord. No. 10096, Jan. 23, 1950, 15 F.R. 389

PATENT PROTECTION ABROAD OF INVENTIONS RESULTING FROM RESEARCH FINANCED BY THE GOVERNMENT

1. All Government departments and agencies shall, whenever practicable, acquire the right to file foreign patent applications on inventions resulting from research conducted or financed by the Government.

2. All Government departments and agencies which have or may hereafter acquire title to inventions or the right to file patent applications abroad thereon, shall fully and continuously inform the Chairman of Government Patents Board [now Secretary of Commerce. See Ex.Ord. No. 10930 set out as a note below] concerning such inventions, except as provided in section 6 hereof, and shall make recommendations to the Chairman of Government Patents Board [now Secretary of Commerce] as to which of such inventions should receive patent protection by the United States abroad and the foreign jurisdictions in which such patent protection should be sought. The recommendations of such departments and agencies shall indicate the immediate or future industrial, commercial or other value of the invention concerned, including its value to public health.

3. The Chairman of Government Patents Board [now Secretary of Commerce] shall determine whether, and in what foreign jurisdictions, the United States should seek patents for such inventions, and, to the extent of appropriations available therefor, shall procure patent protection for such inventions, taking all action, consistent with existing law, necessary to acquire and maintain patent rights abroad. Such determinations of the said Department shall be made after full consultation with United States industry and commerce, with the Department of State, and with other Government agencies familiar with the technical, scientific, industrial, commercial or other economic or social factors affecting the invention involved, and after consideration of the availability of valid patent protection in the countries determined to be immediate or potential markets for, or producers of, products, processes, or services covered by or relating to the invention.

4. The Chairman of Government Patents Board [now Secretary of Commerce] shall administer foreign patents acquired by the United States under the terms of this order and shall issue licenses thereunder in accordance with law under such rules and regulations as he shall prescribe. Nationals of the United States shall be granted licenses on a nonexclusive royalty free basis except in such cases as he shall determine and proclaim it to be inconsistent with the public interest to issue such licenses on a nonexclusive royalty free basis.

5. The Department of State, in consultation with the Chairman of Government Patents Board [now Secretary of Commerce], shall negotiate arrangements among governments under which each government and its nationals shall have access to the foreign patents of the other participating governments. Patents relating to matters of public health may be licensed by the Chairman of Government Patents Board [now Secretary of Commerce], with the approval of the Secretary of State, to any country or its nationals upon such terms and conditions as are in accordance with law and as the Chairman of Government Patents Board [now Secretary of Commerce] determines to be appropriate, regardless of whether such country is a party to the arrangements provided for in this section.

6. There shall be exempted from the provisions of this order (a) all inventions within the jurisdiction of the Atomic Energy Commission except in such cases as the said Commission specifically authorizes the inclusion of an invention under the terms of this order; and (b) all other inventions officially classified as secret or confidential for reasons of the national security. Nothing in this order shall supersede the declassification policies and procedures established by Executive Orders Nos. 9568 of June 8, 1945, 9604 of August 25, 1945, and 9809 of December 12, 1946.

Transfer of Functions. The Atomic Energy Commission was abolished and all functions were transferred to the Administrator of the Energy Research and Development Administration (unless otherwise specifically provided) by section 5814 of Title 42, The Public Health and Welfare. The Energy Research and Development Administration was terminated and functions vested by law in the Administrator thereof were transferred to the Secretary of Energy (unless otherwise specifically provided) by sections 7151(a) and 7293 of Title 42.

EXECUTIVE ORDER NO. 10096

Jan. 23, 1950, 15 F.R. 389, as amended by Ex.Ord. No. 10695, Jan. 17, 1957, 22 F.R. 365; Ex.Ord. No. 10930, Mar. 27, 1961, 26 F.R. 2583

UNIFORM GOVERNMENT PATENT POLICY FOR INVENTIONS BY GOVERNMENT EMPLOYEES

NOW, THEREFORE, by virtue of the authority vested in me by the Constitution and statutes, and as President of the United States and Commander in Chief of the armed forces of the United States, in the interest of the establishment and operation of a uniform pat-

ent policy for the Government with respect to inventions made by Government employees, it is hereby ordered as follows:

1. The following basic policy is established for all Government agencies with respect to inventions hereafter made by any Government employee:

(a) The Government shall obtain the entire right, title and interest in and to all inventions made by any Government employee (1) during working hours, or (2) 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 (3) which bear a direct relation to or are made in consequence of the official duties of the inventor.

(b) In any case where the contribution of the Government, as measured by any one or more of the criteria set forth in paragraph (a) last above, to the invention is insufficient equitably to justify a requirement of assignment to the Government of the entire right, title and interest to such invention, or in any case where the Government has insufficient interest in an invention to obtain entire right, title and interest therein (although the Government could obtain some under paragraph (a), above), the Government agency concerned, subject to the approval of the Chairman of the Government Patents Board [now Secretary of Commerce. See Ex.Ord. No. 10930 set out as a note below] (provided for in paragraph 3 of this order and hereinafter referred to as 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.

(c) In applying the provisions of paragraphs (a) and (b), 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 nongovernmental agencies or individuals engaged in such work, or made by an employee included within any other category of employees specified by regulations issued pursuant to section 4(b) hereof, falls within the provisions of paragraph (a), above, and it shall be presumed that any invention made by any other employee falls within the provisions of paragraph (b), 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 paragraph (d) next below.

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

(e) Actions taken, and rights acquired, under the foregoing provisions of this section, shall be reported to the Chairman [now Secretary of Commerce] in accordance with procedures established by him.

2. Subject to considerations of national security, or public health, safety, or welfare, the following basic policy is established for the collection, and dissemination to the public, of information concerning inventions resulting from Government research and development activities:

(a) When an invention is made under circumstances defined in paragraph 1(a) of this order giving the United States the right to title thereto, the Government agency concerned shall either prepare and file an application for patent therefor in the United States Patent Office [now Patent and Trademark Office] or make a full disclosure of the invention promptly to the Chairman [now Secretary of Commerce], who may, if he determines the Government interest so requires, cause application for patent to be filed or cause the invention to be fully disclosed by publication thereof: Provided, however, That, consistent with present practice of the Department of Agriculture, no application for patent shall, without the approval of the Secretary of Agriculture, be filed in respect of any variety of plant invented by any employee of that Department.

(b) [Revoked. Ex.Ord. No. 10695, Jan. 17, 1957, 22 F.R. 365]

Sec. 3. (a) [Revoked. Ex.Ord. No. 10930, Mar. 27, 1961, 26 F.R. 2583]

(b) The Government Patents Board shall advise and confer with the Chairman concerning the operation of those aspects of the Government's patent policy which are affected by the provisions of this order or of Executive Order No. 9865, and suggest modifications or improvements where necessary.

(c) [Revoked. Ex.Ord. No. 10930, Mar. 27, 1961, 26 F.R. 2583]

(d) The Chairman [now Secretary of Commerce] shall establish such committees and other working groups as may be required to advise or assist him in the performance of any of his functions.

(e) The Chairman of the Government Patents Board [now Secretary of Commerce] and the Chairman of the Interdepartmental Committee on Scientific Research and Development (provided for by Executive Order No. 9912 of December 24, 1947), shall establish and maintain such mutual consultation as will effect the proper coordination of affairs of common concern.

4. With a view to obtaining uniform application of the policies set out in this order and uniform operations thereunder, the Chairman [now Secretary of Commerce] is authorized and directed:

(a) To consult and advise with Government agencies concerning the application and operation of the policies outlined herein;

(b) After consultation with the Government Patents Board, to formulate and submit to the President for approval such proposed rules and regulations as may be necessary or desirable to implement and effectuate the aforesaid policies, together with the recommendations of the Government Patents Board thereon;

(c) To submit annually a report to the President concerning the operation of such policies, and from time to time such recommendations for modification thereof as may be deemed desirable;

(d) To determine with finality any controversies or disputes between any Government agency and its employees, to the extent submitted by any party to the dispute, concerning the ownership of inventions made by such employees or rights therein; and

(e) To perform such other or further functions or duties as may from time to time be prescribed by the President or by statute.

5. The functions and duties of the Secretary of Commerce and the Department of Commerce under the provisions of Executive Order No. 9865 of June 14, 1947 are hereby transferred to the Chairman and the whole or any part of such functions and duties may be delegated by him to any Government agency or officer: Provided, that said Executive Order No. 9865 shall not be deemed to be amended or affected by any provision of this Executive order other than this paragraph 5.

6. Each Government agency shall take all steps appropriate to effectuate this order, including the promulgation of necessary regulations which shall not be inconsistent with this order or with regulations issued pursuant to paragraph 4(b) hereof.

7. As used in this Executive Order, the next stated terms, in singular and plural, are defined as follows for the purposes hereof:

(a) "Government agency" includes any executive department and any independent commission, board, office, agency, authority, or other establishment of the Executive Branch of the Government of the United States (including any such independent regulatory commission or board, any such wholly-owned corporation, and the Smithsonian Institution), but excludes the Atomic Energy Commission.

(b) "Government employee" includes any officer or employee, civilian or military, of any Government agency, except such part-time consultants or employees as may be excluded by regulations promulgated pursuant to paragraph 4(b) hereof.

(c) "Invention" includes 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.

Transfer of Functions. The Atomic Energy Commission was abolished and all functions were transferred to the Administrator of the Energy Research and Development Administration (unless otherwise specifically provided) by section 5814 of Title 42, The Public Health and Welfare. The Energy Research and Development Administration was terminated and functions vested by law in the Administrator thereof were transferred to the Secretary of Energy (unless otherwise specifically provided) by sections 7151(a) and 7293 of Title 42.