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GOVERNMENT PATENTS BOARD

OFFICE OF THE CHAIRMAN

DEPARTMENT OF COMMERCE BUILDING, WASHINGTON 25, D. C.

Interpretations and Opinions No. 4

March 11, 1954

INTERPRETATION OF "SUBJECT TO LAW"

In response to an inquiry from one of the agencies with respect to the meaning of the phrase "subject to law" as used in paragraph 1(d) of Executive Order 10096 and in Section 6(b)(4) of Administrative Order No. 5, the following interpretation was given by the Chairman of the Government Patents Board:

Paragraph 1(d) of Executive Order 10096 provides that the entire right, title and interest in and to an invention shall be left in the inventor, subject to law, in any case where the agency has determined and the Chairman has decided the Government is not entitled to either an assignment or a license under subparagraph (a), (b) or (c) of paragraph 1 of the Order.

The phrase "subject to law" means that the Government is not entitled to and does not claim any rights in and to the invention under the provisions of the Executive Order, but may nevertheless acquire certain rights in and to the invention by reason of the provisions of existing law or under other general principles of law applicable thereto.

Various statutes may, when applicable, give the Government certain rights in and to an invention entirely independent of Executive Order 10096, such as 35 U.S.C. 266 (the so-called 1883 non-fee Act), 42 U.S.C. 1811 (the Atomic Energy Act), 16 U.S.C. 831d (the Tennessee Valley Authority Act), and statutes which relate to incentives, awards and rewards.

The Government may also acquire certain rights in and to an invention by contract, agreement, purchase, voluntary grant or gift, even though the Government may not otherwise be entitled to such rights.

Similarly, the determination of rights in and to an invention under Executive Order 10096 is subject to the provisions of such statutes as 28 U.S.C. 1498 and 35 U.S.C. 4 as they relate to inventions made by Government employees.



Archie M. Palmer
Chairman

JUNE 24, 1954

GOVERNMENT PATENTS BOARD

OFFICE OF THE CHAIRMAN

[Reprinted from Federal Register of June 29, 1954]

TITLE 37—PATENTS, TRADE-MARKS, AND COPYRIGHTS

Chapter III—Government Patents Board

[Administrative Order 6]

PART 301—ACQUISITION AND PROTECTION OF FOREIGN RIGHTS IN INVENTIONS

JUNE 24, 1954.

- Sec.
- 301.1 Purpose.
- 301.2 Authority.
- 301.3 Scope.
- 301.4 Option to be obtained.
- 301.5 Action by Agency concerned.
- 301.6 Action by the Department of Commerce.
- 301.7 Publication in lieu of patenting.
- 301.8 Foreign filing by inventor.
- 301.9 Administration of foreign patents.
- 301.10 Reports and records.
- 301.11 Dissemination of this part.

AUTHORITY: §§ 301.1 to 301.11 issued under E. O. 9865, 12 F. R. 3907, 3 CFR, 1947 Supp., E. O. 10096, 15 F. R. 389, 3 CFR, 1950 Supp.

§ 301.1 *Purpose.* The purpose of this part is to provide for the administration of a uniform policy for the Government with respect to the acquisition and protection of foreign rights in and to certain inventions.

§ 301.2 *Authority.* Authority for the issuance of this part is provided in Executive Order 9865, dated June 14, 1947 (12 F. R. 3907), as amended by paragraph 5 of Executive Order 10096, dated January 23, 1950 (15 F. R. 389).

§ 301.3 *Scope.* This part is restricted to inventions to which the Government is entitled to acquire, or may acquire, title or the right to file foreign patent applications or otherwise to seek protection abroad thereon. Exempted from the provisions of this part are (a) inventions within the jurisdiction of the Atomic Energy Commission, except in such cases as the said Commission specifically authorizes the inclusion of an invention, and (b) inventions officially classified for reasons of the national security, until such inventions become declassified.

§ 301.4 *Option to be obtained.* (a) When the Government is entitled to acquire foreign rights in and to an invention made by a Government employee, including the right to file foreign patent applications or otherwise to seek protection abroad on the invention, the Government agency concerned shall obtain an option to acquire such rights.

(b) When the Government is entitled to acquire foreign rights in and to an invention made pursuant to contract, including the right to file foreign patent applications or otherwise to seek protec-

tion abroad on the invention, the Government agency concerned shall, when the agency deems it desirable, obtain an option to acquire such rights.

§ 301.5 *Action by agency concerned.* Subject to the approval of the Chairman of the Government Patents Board on all matters of policy, the Government agency concerned shall, with respect to each invention on which the option specified in § 301.4 is obtained or on which the foreign rights have been acquired, determine whether or not and in what foreign jurisdictions patent protection should be sought in the public interest. Upon determining that foreign patent protection is desirable, the agency shall:

(a) To the extent of available funds within its own appropriation, take or cause to be taken all action necessary to secure such foreign patent protection of the invention, consistent with existing law and the requirements of the Government;

(b) If sufficient funds are not available within its own appropriation or the agency does not see fit to use funds when available, furnish the Secretary of Commerce as soon as practicable, preferably not later than two months after the filing of the application for United States patent on the invention, through the use of Foreign Patent Protection Reporting Form TS-12, sufficient information concerning the invention and the reasons for its determination with respect to the desirability of foreign patent protection, to enable the Secretary of Commerce to seek the financial support of other interested Government agencies and/or of industry in securing foreign patent protection of the invention.

§ 301.6 *Action by the Department of Commerce.* Subject to the approval of the Chairman of the Government Patents Board on all matters of policy, the Secretary of Commerce shall, immediately upon receipt of a Foreign Patent Protection Reporting Form TS-12 on an invention, pursuant to § 301.5 (b):

(a) Consult with Government agencies and with United States industry and commerce, familiar with the technical, scientific, industrial, commercial or other economic or social factors affecting the invention involved, to ascertain possible interest in foreign patent protection of the invention and willingness to finance such protection; and

(b) After such consultation and consideration of such factors as the availability of valid patent protection in the countries selected and to the extent of funds made available by Government agencies and/or industry, take or cause to be taken all action necessary to secure

such protection of the invention, consistent with existing law and the requirements of the Government.

§ 301.7 *Publication in lieu of patenting.* When the foreign rights of the Government with respect to an invention may be adequately protected through prompt disclosure of the invention in lieu of patenting, the Government agency concerned, or the Secretary of Commerce in cooperation with the Government agency concerned, may, with the approval of the Chairman of the Government Patents Board, cause the invention to be disclosed by publication thereof.

§ 301.8 *Foreign filing by inventor.* When the foreign rights in and to an invention are not assigned to the Government but the Government may, at its option or on request, acquire such rights and determines not to cause an application to be filed in any particular foreign country or otherwise to seek protection of the invention, or fails to take such action, (a) within six months of the filing of an application for United States patent on the invention, or (b) within six months of declassification of an invention previously under a security classification, or (c) within six months after disclosure of an invention to the Government pursuant to contract, whichever is later, such determination or such failure to act shall constitute a decision by the Government to leave such rights to the inventor subject, to the extent practicable, to a nonexclusive, irrevocable, royalty-free license to the Government in any patent which may issue thereon in any foreign country, including the power to issue sublicenses for use in behalf of the Government and/or in furtherance of the foreign policies of the Government.

§ 301.9 *Administration of foreign patents.* The functions and duties of the Chairman of the Government Patents Board under paragraphs 4 and 5 of Executive Order 9865, as amended by paragraph 5 of Executive Order 10096, are, until further notice, hereby delegated to the Secretary of Commerce: *Provided, however,* That all matters of policy arising under this delegation shall be subject to the approval of the Chairman of the Government Patents Board.

§ 301.10 *Reports and records.* (a) Each Government agency shall report promptly to the Secretary of Commerce, with a copy to the Chairman of the Government Patents Board, all actions by the agency taken pursuant to §§ 301.5 and 301.7, as well as disclosures by publication by the agency made pursuant to

paragraph 2 (a) of Executive Order 10096.

(b) The Secretary of Commerce shall maintain adequate records and other necessary files, to provide readily available information on all inventions included under the provisions of §§ 301.5, 301.6, 301.7, and paragraph (a) of this section, and shall submit to the Chairman of the Government Patents Board

a written report quarterly, or otherwise as the Chairman may request, on all operations of this program during the preceding calendar quarter or other period designated.

§ 301.11 *Dissemination of this part.* Each Government agency shall make appropriate dissemination of the provisions of this part.

Revocation. Administrative Order No. 2, dated September 6, 1950 (15 F. R. 6131), and Administrative Order No. 4, dated March 12, 1951 (16 F. R. 2507), are superseded by the provisions of this part, which shall remain in effect until further notice.

ARCHIE M. PALMER,
Chairman.

JUNE 24, 1954

GOVERNMENT PATENTS BOARD

OFFICE OF THE CHAIRMAN

[Reprinted from Federal Register of June 29, 1954]

[Administrative Order 7]

PART 302—LICENSING OF FOREIGN PATENTS
ACQUIRED BY THE GOVERNMENT

JUNE 24, 1954.

Sec.

- 302.1 Purpose.
 302.2 Authority.
 302.3 Scope.
 302.4 The Department of State.
 302.5 Licenses under foreign patents.
 302.6 Reports and records.

AUTHORITY: §§ 302.1 to 302.6 issued under E. O. 9865, 12 F. R. 3907, 3 CFR, 1947 Supp., E. O. 10096, 15 F. R. 389, 3 CFR, 1950 Supp.

§ 302.1 *Purpose.* The purpose of this part is to provide for the administration of a uniform policy for the Government with respect to the licensing of foreign patents acquired by the Government.

§ 302.2 *Authority.* Authority for the issuance of this part is provided in Executive Order 9865, dated June 14, 1947 (12 F. R. 3907), as amended by paragraph 5 of Executive Order 10096, dated January 23, 1950 (15 F. R. 389).

§ 302.3 *Scope.* This part is to implement and supplement § 301.9 of this chapter,¹ with respect to inventions on which the Government has acquired foreign patents, except inventions within the jurisdiction of the Atomic Energy Commission which are not specifi-

¹ See Part 301 of this chapter (A. O. 6).

cally authorized by said Commission for inclusion within the terms of this part.

§ 302.4 *The Department of State.* Pursuant to Executive Orders 9865 and 10096, it is the responsibility of the Department of State, in consultation with the Chairman of the Government Patents Board and the Secretary of Commerce, to seek arrangements among governments under which each government and its nationals shall have access to the foreign patents of the other participating governments.

§ 302.5 *Licenses under foreign patents.* (a) Licenses under foreign patents acquired by the United States Government shall be granted by the Secretary of Commerce to nationals of the United States on a nonexclusive, revocable, royalty-free basis, except in such cases as the Secretary of Commerce, with the approval of the Chairman of the Government Patents Board, shall determine it to be inconsistent with the public interest to issue such licenses on a nonexclusive, royalty-free basis.

(b) Licenses under foreign patents acquired by the United States Government may be granted by the Secretary of Commerce to a foreign government or its nationals pursuant to any arrangements which may come into force with such foreign government as provided in § 302.4, or, in the absence of such ar-

rangements, on such terms as the Secretary of Commerce, with the approval of the Chairman of the Government Patents Board and of the Secretary of State, shall determine, in accordance with law, to be in the public interest, subject to outstanding licenses.

(c) With respect to foreign patents relating to matters of public health, licenses under such patents issued to the United States Government may be granted by the Secretary of Commerce to a foreign government or its nationals on a nonexclusive, revocable, royalty-free basis unless the Chairman of the Government Patents Board, on the recommendation of the Secretary of State, shall determine otherwise, regardless of whether such foreign government is a party to the arrangements specified in § 302.4.

§ 302.6 *Reports and records.* The Secretary of Commerce shall maintain adequate records and other necessary files, to provide readily available information on all licenses granted under § 302.5, and shall submit to the Chairman of the Government Patents Board a written report, with a copy to the Secretary of State, quarterly or otherwise as the Chairman may request, on all operations of the licensing program during the preceding calendar quarter or other period designated.

ARCHIE M. PALMER,
Chairman.

ADMINISTRATIVE ORDERS NOS. 6 AND 7

Historical Background. Executive Order 9865, issued by the President under date of June 14, 1947, to implement recommendations submitted to the Secretary of State by the Executive Committee on Economic Foreign Policy after an extended study, initiated a program for the protection abroad of inventions resulting from Government-financed research and the acquisition and administration by the Government of foreign patent rights in such inventions.

The program was designed originally (1) to insure that access by United States nationals to foreign markets for products based on Government-financed inventions might not be blocked by foreign-owned patents; (2) to counteract a tendency of the increasing ownership of United States patents by foreign governments to lead to control by them of important segments of American production and trade; and (3) to provide the Government with bargaining power to obtain for its nationals the use of foreign patents held by other governments.

Executive Order 9865 placed certain administrative responsibilities on the Secretary of Commerce, the Department of Commerce, the Secretary of State, and the Department of State. Largely because of lack of available funds and lack of interest in the program on the part of American industry, progress in its development had been slow and unsatisfactory.

Paragraph 5 of Executive Order 10096, issued by the President under date of January 23, 1950, transferred the functions and duties of the Secretary of Commerce and of the Department of Commerce under the provisions of Executive Order 9865 to the Chairman of the Government Patents Board, with authority to delegate the whole or any part of such functions and duties to any Government agency or officer.

Pending the determination of a definitive and practicable program for the protection abroad of inventions resulting from Government-financed research, the Chairman issued Administrative Order No. 2 under date of September 6, 1950, delegating to the Secretary of Commerce the operational functions of the foreign patent protection program, but reserving to himself responsibility for the approval of all matters of policy arising under this delegation.

During the course of an exploratory study of the problems involved in the effective conduct of the program the assistance of an interagency working committee was enlisted, the advice of the Government Patents Board was obtained, comments of Government agencies were sought, conferences were held with representatives of industry and the patent bar, and the matter was discussed individually with informed persons, both within and outside Government, concerned with and experienced in foreign patent protection.

Upon the basis of the exploratory study, it was decided to continue temporarily the existing foreign patent protection program, with limited filings abroad in a few of the chief industrial countries to the extent feasible under available funds. Administrative Order No. 4, which was issued by the Chairman of the Government Patents Board under date of March 12, 1951, prescribes procedures for effectuating the policy of the Government, as set forth in Executive Order 9865, with respect to the administration of the program for patent protection abroad of inventions resulting from Government-financed research to which the Government has acquired title or the right to file foreign patent applications thereon.

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Further study of the problem was made by an interagency working committee in the light of current needs of the Government, including the Mutual Security Program, plans for rendering military, technical, and economic assistance to friendly countries, and the offshore procurement requirements of the Armed Forces.

On the basis of this further study and the recommendations of the interagency working committee, the experience of the Government under the existing foreign patent protection program since its initiation in 1947, related experience of the British and Canadian Governments under similar programs, the reactions of American industry and the patent bar, the position of the Department of Commerce with respect to the operation of the program, and analysis of the current requirements of the Government and of possible ways of meeting those requirements, revised procedures for achieving the objectives of Executive Order 9865, as amended by Executive Order 10096, without recourse to legislation have been developed.

Revised Procedures. The revised procedures, accomplished within the authority of the Chairman of the Government Patents Board under paragraph 5 of Executive Order 10096, are incorporated in Administrative Orders Nos. 6 and 7. Through these Administrative Orders the foreign patent protection program of the Government, initiated under Executive Order 9865 in 1947, has been resolved in the light of the present defensive requirements and interests of the Government and of American industry.

Both Orders, which were prepared with the assistance of an interagency working group, have been cleared with the various departments and agencies in the executive branch of the Government through their designated liaison officers and have been accepted by the Government Patents Board. The Orders have also been submitted to the President for review and their issuance by the Chairman has been authorized.

The Administrative Orders involve (1) delegating to the agencies wherein and/or under whose jurisdiction the inventions originate responsibility for determining which inventions should, for defensive purposes, be protected abroad and for seeking and acquiring the necessary foreign patent protection; (2) delegating to the Secretary of Commerce responsibility for affording American industry opportunity to protect its interests, when it so desires, by underwriting foreign filing on inventions of unusual commercial promise; and (3) prescribing the procedures for the granting of licenses under foreign patents acquired by the Government.

Administrative Order No. 6 provides for the administration of a uniform policy for the Government with respect to the acquisition and protection of foreign rights in and to certain inventions.

Administrative Order No. 7 provides for the administration of a uniform policy for the Government with respect to the licensing of foreign patents acquired by the Government.

In essence, the two Orders clarify and make more flexible and effective the achievement of the objective of building up a portfolio of foreign patents and foreign patent rights for defensive purposes under the provisions of Executive Order 9865, as amended by Executive Order 10096, without recourse to legislation. The new Orders supersede Administrative Orders Nos. 2 and 4 and, by spelling out in greater detail the procedures to be followed, enable the agencies concerned to obtain the desired foreign patent protection more expeditiously.

Both Administrative Orders provide that, in order to obtain uniformity and consistency in the operation of the foreign patent protection program, the Chairman of the Government Patents Board retains the right to pass upon all matters of policy.

Administrative Order No. 6. In accordance with the provisions of Executive Order 9865 and the authority of the Chairman of the Government Patents Board under paragraph 5 of Executive Order 10096, Administrative Order No. 6 places upon the Government agency concerned the primary responsibility for determining whether or not and in what foreign jurisdictions patent protection should be sought on inventions made by employees of the agency, or made under contract with the agency, and for taking the necessary action to obtain such protection.

In those cases where the agency concerned determines that foreign patent protection is desirable but the agency is unable, or does not see fit, to obtain such protection itself, Administrative Order No. 6 provides that the agency report the facts promptly to the Secretary of Commerce, whereupon it becomes his responsibility to ascertain whether any other Government agency or private industry is interested enough and willing to finance the cost of obtaining foreign patent protection of the invention.

If neither a Government agency nor industry is interested and willing to finance such foreign patent protection within the six-month period specified in paragraph 8 of Administrative Order No. 6 and the invention has not been disclosed by publication as provided in paragraph 7 thereof, the Administrative Order provides the opportunity for the inventor to seek foreign patent protection on the invention, reserving to the Government the right to a nonexclusive, irrevocable, royalty-free license under any foreign patents which may issue thereon.

Paragraphs 1, 2, and 3 of Administrative Order No. 6 cover the purpose, authority and scope of the Order, in accordance with the provisions of Executive Order 9865 as amended.

Paragraph 4 prescribes the procedure for obtaining an option to acquire foreign patent rights by the Government and is in accordance with paragraph 3 of Executive Order 9865 as amended.

Paragraph 5 prescribes the procedure for the Government agency concerned to determine whether and where foreign patent protection is to be sought and to take the necessary action to obtain such protection, if the agency is able and sees fit to do so.

Paragraph 6 prescribes the procedure the Secretary of Commerce is to follow in obtaining foreign patent protection on inventions when cases are referred to him in accordance with subparagraph (b) of paragraph 5 above.

Paragraph 7 provides for disclosure of the invention through publication in lieu of patenting, when such disclosure would adequately protect the interests of the Government. This procedure, which has been in effect under Administrative Order No. 4, is designed to save money through the medium of publication wherever possible and adequate.

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Paragraph 8 prescribes the procedure and the conditions under which the inventor may seek foreign patent protection of an invention when the Government does not exercise the option obtained under paragraph 4 above. This procedure enables the Government to obtain a license and thereby protect its interests. The terms of the license include the power to issue sublicenses "for use in behalf of the Government and/or in furtherance of the foreign policies of the Government," instead of the usual "for governmental purposes," in order to meet any defensive requirements of the Government that might arise under the Mutual Security Program, particularly offshore procurement, or in the furtherance of any present or future foreign policy of the Government.

Paragraph 9 continues the delegation of the operational aspects of the foreign patent protection program to the Secretary of Commerce, which has been in effect under Administrative Order No. 2,

Paragraph 10 prescribes uniform reporting procedures and provides for centralized maintenance of records.

Paragraph 11 provides for appropriate dissemination of the provisions of the Order.

Paragraph 12 provides for the revocation of Administrative Orders Nos. 2 and 4, which are superseded by Administrative Orders Nos. 6 and 7.

Administrative Order No. 7. Administrative procedures, implementing and supplementing paragraph 9 of Administrative Order No. 6, are set forth separately in Administrative Order No. 7. These procedures, which are acceptable to the Department of Commerce and the Department of State, are in accordance with the provisions of Executive Order 9865 as amended and the delegation of the licensing aspects of the foreign patent protection program to the Secretary of Commerce, continuing the situation, which has existed under Administrative Orders Nos. 2 and 4.

Paragraphs 1, 2, and 3 of Administrative Order No. 7 cover the purpose, authority and scope of the Order, in accordance with the provisions of Executive Order 9865 as amended and the continuance of the delegation of licensing responsibilities to the Secretary of Commerce.

Paragraph 4 restates the responsibility of the Department of State as prescribed in Executive Order 9865 as amended.

Paragraph 5 continues the existing procedure for the granting of licenses under foreign patents acquired by the Government.

Paragraph 6 provides for centralized maintenance of records on all licenses granted under paragraph 5 above and the submission of periodic reports to the Chairman of the Government Patents Board.

June 24, 1954

GOVERNMENT PATENTS BOARD

Office of the Chairman

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

GOVERNMENT PATENTS BOARD
Office of the Chairman

April 26, 1951

PROCEDURAL INSTRUCTIONS FOR SUBMITTING THE REPORTS SPECIFIED
IN ADMINISTRATIVE ORDER NO. 5

Administrative Order No. 5, entitled Rules and Regulations for the Administration of a Uniform Patent Policy with Respect to the Domestic Rights in Inventions Made by Government Employees, which supersedes Administrative Order No. 1, has been approved by the President and is being issued under date of April 26, 1951. Section 9 of that Order provides that the Chairman of the Government Patents Board will prescribe the forms to be used in submitting the reports specified in that order. A copy of Administrative Order No. 5 accompanies these revised procedural instructions, which supersede those issued under date of February 12, 1951.

1. Case Number: Each invention will be reported as a separate case and each report will be assigned a case number by the originating agency, consisting of the code number indicated on the accompanying lists (or, if not so indicated, as assigned at the request of the agency), followed by a dash and a serial number assigned by the agency. For example, if the agency code number is 5, its first case will be 5-1.

2. Type of Case: Following the case number the agency will indicate, in parentheses, the type of case. The several types of cases will be indicated by reference to the section and paragraph of Administrative Order No. 5 under which the invention is reported, as follows:

- 6c - Report of agency determination that title be left with inventor
- 8d - Report when patent application is filed
- 8e - Report of agency determination not to file application
- 8f - Report when patent issues
- 7b - Report by agency subsequent to appeal by employee

It may be that several reports will be submitted on one invention, as for example under 8d and 8f or under 8d and 6c. The same case number will be used in all reports on the same invention, but separate reference will be made on each report to the applicable section and paragraph.

3. Submission of Reports: Except for reports on disputes and controversies, all reports will be submitted in duplicate, single spaced, on paper size 8 x 10½. Reports on disputes and controversies (type 7b) will be submitted in quadruplicate, single spaced, on paper size 8 x 10½. Only one copy of the patent need accompany reports on type 8f cases.

4. Information as to Date Invention Is Made: All reports will indicate whether the invention was made (1) prior to, or (2) on or after the date of Executive Order 10096 (January 23, 1950). In this connection see Interpretations and Opinions No. 1, entitled Interpretation of "Made".

Enclosures

Archie M. Palmer
Chairman