

PATENTS

INVENTIONS, PATENTS, AND PATENT INFRINGEMENT CLAIMS

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SECTION I

GENERAL

1. Policy of Department of the Army concerning rights in inventions and patents.—The policy of the Department of the Army with respect to inventions made by officers, warrant officers, enlisted personnel and civilian employees under its jurisdiction is governed by Executive Order 10096 and the administrative orders issued pursuant thereto.

2. Delegation of authority.—The Judge Advocate General, Department of the Army, is delegated the authority to take all necessary action on behalf of the Secretary of the Army pursuant to these regulations. The Chief, Patents Division, Office of The Judge Advocate General, is designated liaison agent for the Department of the Army to deal with the Office of the Chairman of the Government Patents Board.

SECTION II

INVENTIONS AND IMPROVEMENTS

3. Procedure.—*a.* All communications relating to inventions, including suggestions, ideas, or plans for new material or the improvement of existing material, will be referred direct to The Adjutant General, Department of the Army, Washington 25, D. C., except as indicated in paragraph 5.

*These regulations supersede AR 850-50, 17 July 1942, including C 1, 9 January 1945, and C 3, 7 June 1949.

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b. Persons desiring to submit their inventions or ideas in person will be referred to The Adjutant General.

4. **Distribution of communications.**—*a.* All suggestions for inventions or devices originating from sources outside the services, including those submitted through Members of Congress, received or now on hand by any agency or component of the Department of the Army, may be forwarded without action, by office slip or check indorsement, to The Adjutant General, who will transmit them to the National Inventors Council, Department of Commerce Building, Washington, D. C.

b. After preliminary review by the National Inventors Council, those which do not warrant Department of the Army study will be disposed of by the Council. Those which appear to be worthy of more detailed investigation by the Department of the Army will be sent to The Adjutant General by the Council for reference to the appropriate agency or component of the Department of the Army for investigation by its technical staff.

c. After investigation, each case will be returned to The Adjutant General with the report of the technical committee and the recommendation of the head of the agency or component.

d. Heads of agencies or components of the Department of the Army may communicate direct with the inventor for such additional information as may be required, or to arrange for demonstrations. If and when a suggested invention reaches the stage that a patent application is to be made, the case will be retained for patenting by the head of the agency or component of the Department of the Army, the technical staff of which has made such determination, if such agency or component maintains a patent section; and if such agency or component does not maintain a patent section, the head thereof will transmitt the case to The Judge Advocate General for patenting.

5. **Inventions submitted for patenting.**—The provisions of paragraphs 3 and 4 will not apply to correspondence relating to inventions submitted by officers, warrant officers, enlisted personnel, or civilian employees of the Department of the Army, the purpose of which is the patenting of such inventions. Such correspondence will be handled in accordance with section III.

SECTION III

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6. **Exclusion from right to sue United States for infringement of patent.**—An inventor while in the Government service or his assignee may not sue the United States in tort for infringement of a patent, nor may he so sue after leaving the Government service if the invention is made during such service (62 Stat. 941, as amended; 63 Stat. 102; 28 U. S. C. 1498); but Government inventors have the same right as other persons to sue the United States in the Court of Claims on contracts express or implied.

7. **Title to patents in inventions made by employees of Department of the Army.**—*a.* The Government may require assignment of title to inventions made by employees of the Department of the Army, and to any patents that may be issued on such inventions if any of the following conditions are present:

- (1) If the invention was made during working hours; or

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- (2) If the invention was made 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) If the invention bears a direct relation to or was made in consequence of the official duties of the inventor.

b. In determining whether a condition set forth above was present in the making of the invention the following definitions shall apply:

- (1) Working hours for civilian employees shall mean time spent during either the usual working hours, or overtime, or both, and for military personnel time spent during the hours actually engaged in officially assigned duties,
- (2) A contribution of facilities shall mean that the facilities were used in the making of the invention and while so used were unavailable for other purposes,
- (3) A contribution of equipment shall mean that the equipment was used in the making of the invention and was thus made unavailable for other purposes,
- (4) A contribution of materials shall mean that the materials were specifically obtained and used for the purpose of making the invention and were thus rendered unavailable for other use,
- (5) A contribution of funds shall mean that Government funds were actually expended for the purpose of making the invention,
- (6) A contribution of information shall mean that the information used in the making of the invention was available only by reason of the inventor's official duties and was obtained from sources not otherwise available,
- (7) A contribution of time or services of other Government employees on official duty shall mean that their time or services were utilized during working hours as defined in (1) above.
- (8) Bearing a direct relation to or made in consequence of the official duties of the inventor means that the duties to which the inventor had been assigned were such that the invention could reasonably be expected to arise therefrom.

c. When any of the conditions set forth in *a* above, as defined in *b* above, are present, the domestic rights and, in the discretion of the Secretary of the Army, foreign rights in and to the invention shall belong to the Government if—

- (1) The conditions are equitably sufficient to justify assignment thereof by the employee to the Government; and
- (2) The Government has sufficient interest in the invention to require assignment thereof by the employee.

If it should be found that assignment is not required under (1) and (2) of this subparagraph, the employee nevertheless shall be required to grant to the Government a nonexclusive, irrevocable, royalty-free license in the invention and under any patents, domestic or foreign, which may issue thereon, with power to grant licenses for all governmental purposes.

d. When none of the conditions set forth in *a* above, as defined in *b* above, are present, the entire right, title and interest in and to the invention shall be left to the employee, subject to law.

e. Where an assignment to the Government of the domestic rights in and to an invention is required, the employee shall, if requested, assign the foreign rights in and to the invention to the Government. The Secretary of the Army may, pursuant to c above, upon request of the inventor, permit the foreign rights to remain in the inventor. Where, however, an assignment of the domestic rights is not required, an assignment of the foreign rights in and to the invention may be made by the employee upon request.

f. It is presumed that the conditions of a above, as defined in b above, are present, when the employee is employed or assigned to—

- (1) Invent or improve or perfect any art, machine, manufacture, design, or composition of matter;
- (2) Conduct or perform research or development work or both;
- (3) Supervise, direct, coordinate or review Government financed or conducted research or development work, or both;
- (4) Act in a liaison capacity among governmental or nongovernmental agencies or individuals engaged in such research or development work, or both.

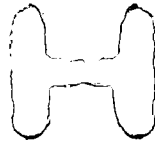
g. Employees within the classes defined in f above, may submit evidence that will enable the Government to establish the absence of any one or more of the conditions of a above, as defined by b above, or that the conditions which are present are insufficient equitably to justify a requirement that assignment be made to the Government of the invention and any patent which may issue thereon.

h. For employees not within the classes defined in f above, the Government must establish that the conditions of a above, as defined by b above, if present, are sufficient equitably to require an assignment to the Government of the invention and any patent which may issue thereon.

i. Whenever an invention is made under any of the conditions set forth in a above, as defined in b above, the employee must report the invention through the proper official channels to the Chief, Patents Division, Office of The Judge Advocate General, Department of the Army, Washington 25, D. C., for further report to the Chairman of the Government Patents Board. The reporting of inventions not falling in the above-defined category relating to subject matter of a potential governmental interest, while not required, should be encouraged.

j. Determination of the relative rights of the Government and an employee in an invention made by an employee of the Department of the Army shall be made by the Secretary of the Army in accordance with these regulations.

- (1) The head of the technical service or his delegated representative, if that agency or component maintains a patent section, shall determine whether the results of research, development or other activity within that agency constitute invention within the purview of R. S. 4886. In the event it is determined that a particular invention disclosure does not constitute invention, no further action is required under Executive Order 10096.
- (2) The head of the agency or component of the Department of the Army involved, if that agency or component maintains a patent section, shall recommend disposition of the relative rights of the Government and the employee in inventions and submit the recommendations to the Secretary



of the Army for determination of the relative rights of the Government and the employee.

- (3) The Secretary of the Army shall make a determination of the relative rights between the Government and an employee inventor on behalf of the Department of the Army and submit those determinations to the Chairman, Government Patents Board, for review.
- (4) Any employee of the Department of the Army who is aggrieved by a determination of the relative rights of the Government and the employee made by the Secretary of the Army may obtain a review of the determination by filing, within such time after receiving notice of such determination as may be fixed by the Chairman, Government Patents Board, a written appeal with the Chairman of the Government Patents Board, and a copy of the appeal with the Chief, Patents Division, Office of The Judge Advocate General.
- (5) In the event of the filing of an appeal, as set out in (4) above, the Secretary of the Army, subject to considerations of national security, shall furnish the Chairman, Government Patents Board, in writing, promptly upon the filing of the appeal, such information as may be required by the Chairman. The decision of the Chairman upon any appeal taken pursuant to (4) above, shall be final.
- (6) In the event that the Secretary of the Army determines, pursuant to either c or d above, that the domestic rights in and to an invention will be left with an employee with or without a license to the Government, a report of this determination is required to be submitted to the Chairman, Government Patents Board, for review, subject to the right of the employee, if he acquiesces in the determination, to file a petition in the event of a decision of the Chairman less favorable to him.
- (7) The Chairman, Government Patents Board, will review the determination of the Secretary of the Army pursuant to (6) above, and his decision respecting the matter shall be final, subject to the right of the employee to submit to the Chairman, within such period after receiving notice of such decision as the Chairman may fix, a petition for a reconsideration of the decision, if it gives to the Government greater rights than the determination made by the Secretary of the Army. A copy of any such petition must also be filed by the employee with the Chief, Patents Division, Office of The Judge Advocate General.

k. Definitions of terms as used in these regulations:

- (1) The term "Government employee" means any officer or employee, civilian or military, of the Government including any part time consultant or part time employee except when special circumstances in a specific case require a departure herefrom to meet the needs of the Department of the Army. Such circumstances shall be reported to the Chairman of the Government Patents Board.
- (2) The term "invention" 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.

8. Patents obtained without payment of fees.—The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted personnel



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or civilian employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes (35 U. S. C. 31) without the payment of any fee when the head of the department or independent bureau certifies such invention is used or liable to be used in the public interest, provided that the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent. *See act of 3 March 1883 (22 Stat. 625) as amended by act 30 April 1928 (45 Stat. 467; 35 U. S. C. 45; M. L. 1949, sec. 1369).*

9. Notification of Department of the Army of change of rights in patents.—All officers, warrant officers, enlisted personnel, or civilian employees of the Department of the Army who secure patents upon their inventions under any of the aforesaid circumstances, where the inventor retains title to the patent and the Government is licensed thereunder, are advised that full justice to the interests of the Government as licensee under the patent or patents concerned should prompt them to notify the Department of the Army of any further licenses or assignments they may make of their patent interests, to the end that contracting officers of the Government may at all times be informed thereof.

10. Procedure.—*a. Direct submission by inventor.*—For the purpose of obtaining patents, all persons in the military service and civilian employees of the Department of the Army may submit their unpatented inventions direct to the head of the agency or component of the Department of the Army to which the invention relates. If that agency or component does not maintain a patent section, the head of the agency or component will transmit the unpatented invention to The Judge Advocate General, if further action is deemed necessary.

b. Correspondence.

- (1) Direct correspondence between the persons and the agencies or components referred to in *a* above is authorized, provided that—
 - (a) Such correspondence pertains solely to unpatented ideas and the patenting thereof.
 - (b) No invention that has been rejected by any head of an agency or component of the Department of the Army will be resubmitted to the head of any other agency or component unless accompanied by a statement as to its former rejection or rejections.
- (2) All correspondence with reference to unpatented inventions will, if the subject matter requires classification, be classified and handled in accordance with the appropriate provisions of AR 380-5.
- (3) Correspondence received by the head of any agency or component of the Department of the Army maintaining a patent section may, at his discretion, be either—
 - (a) Handled entirely within the agency or component, or
 - (b) Referred direct to The Judge Advocate General.
- (4) When received by the head of an agency or component not maintaining a patent section it may, at his discretion, be either—
 - (a) Returned direct to the inventor or other party in interest if further action by the Department of the Army is not deemed necessary under paragraph 7j(1); or
 - (b) Referred direct to The Judge Advocate General.

- (5) Whenever referred to The Judge Advocate General, the probable military value of the invention will be stated by the head of the agency or component.

c. By heads of agencies and components of Department of the Army.

- (1) The head of an agency or component of the Department of the Army may delegate any of his duties, as hereinbefore prescribed, to any of the activities under his control.
- (2) The head of each agency or component within the Department of the Army having jurisdiction over a particular invention shall submit through proper official channels to the Chairman of the Government Patents Board such information and reports as are required by Executive Order 10096 and administrative orders promulgated pursuant thereto.

11. Patent claims received in Department of the Army.—Any communications received in any agency or component of the Department of the Army, in which claim is made that the manufacture, use, or disposition of any article, material, or process by or for that agency or component, or by or for any other agency or component of the Department of the Army, involves the use of any invention or design, whether patented or unpatented, and making a claim for compensation on account of such use or offering to grant a license therefor, will be transmitted direct to the head of the technical service which has ordered the manufacture, use, or disposition of the subject matter in question. The head of such technical service shall thereafter cause the claim to be processed in accordance with section IX, part 4, Army Procurement Procedures.

[AG 072 (1 Oct 51)]

BY ORDER OF THE SECRETARY OF THE ARMY:

OFFICIAL:

WM. E. BERGIN
Major General, USA
The Adjutant General

J. LAWTON COLLINS
Chief of Staff, United States Army

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