

Army Regulation 27-60

Legal Services

Intellectual Property

**Headquarters
Department of the Army
Washington, DC
1 June 1993**

Unclassified

SUMMARY of CHANGE

AR 27-60

Intellectual Property

This revision--

- o Specifies the duties of the Intellectual Property Counsel of the Army. A new position established in June 1987 (paras 1-4 and 1-5).
- o Updates the procedure for keeping and maintaining laboratory notebooks (paras 1-8 and 2-3).
- o Establishes policy for the payment of maintenance fees on Army owned U.S. and foreign patents (paras 2-8 and 2-10).
- o Provides for the filing of patent applications in foreign countries (para 2-9).
- o Updates invention rights determination procedures (paras 2-12 and 2-14 to 2-15).
- o Updates policy and procedure on copyrights including use of copyrighted software (paras 4-1 to 4-6).
- o Updates Army trademark procedures (paras 4-7 to 4-9).
- o Updates patent and copyright litigation procedures, including new litigation report procedures (chap 5).
- o Revises administrative claim (paras 6-1 to 6-10) and license proffer procedures (paras 6-11 and 6-12).
- o Updates the delegation of authority to purchase intellectual property rights (paras 6-13 to 6-15).
- o Updates the licensing of Army owned patents including procedures under the Technology Transfer Act of 1986 (chap 7).
- o Updates invention awards to reflect the increase in the amount of the awards (chap 8).
- o Provides for the contracting for the preparation and prosecution of patent applications (chap 9).
- o Deletes chapter 3, Inventive Proposals, and related forms: DA Form 2875, January 1965; DA Form 4226-R, May 1974; and DA Form 4227-R, 1 May 1974. DA Form 2875, DA Form 4226-R, and DA Form 4227-R are now obsolete.

Effective 1 July 1993

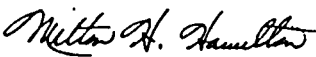
Legal Services

Intellectual Property

By Order of the Secretary of the Army:

GORDON R. SULLIVAN
General, United States Army
Chief of Staff

Official:



MILTON H. HAMILTON
Administrative Assistant to the
Secretary of the Army

History. This UPDATE printing publishes a revision of the publication. Because the publication has been extensively revised, the changed portions have not been highlighted. This publication has been reorganized to make it compatible with the Army electronic publishing database. No content has been changed.

Summary. This regulation prescribes policy and procedures with regard to the acquisition,

protection, transfer and use of patents, copyrights, trademarks, and other intellectual property by the Department of the Army.

Applicability. This regulation applies to the Active Army and to all Department of the Army civilian employees, and during partial and full mobilization.

Proponent and exception authority. The proponent of this regulation is The Judge Advocate General. The Judge Advocate General has the authority to approve exceptions to this regulation which are consistent with controlling law and regulation. The Judge Advocate General may delegate this authority in writing to a division chief within the proponent agency who holds the rank of colonel or the civilian equivalent. The approval authority will coordinate all questions regarding the scop of authority to approve exceptions with HQDA (DAJA-AL), WASH DC 20310-2200.

Army management control process. This regulation is not subject to the requirements of AR 11-2. It does not contain internal control provisions.

Supplementation. Supplementation of this regulation and the establishment of command

or local forms are prohibited without prior approval from the Intellectual Property Counsel of the Army, Office of The Judge Advocate General.

Interim changes. Interim changes to this regulation are not official unless they are authenticated by the Administrative Assistant to the Secretary of the Army. Users will destroy interim changes on their expiration dates unless sooner superseded or rescinded.

Suggested Improvements. Users are invited to send comments and suggested improvements on DA Form 2028 (Recommended Changes to Publications and Blank Forms) directly to the Intellectual Property Counsel of the Army, Office of The Judge Advocate General, Department of the Army, 901 N. Stuart Street, Arlington, VA 22203-1837.

Distribution. Distribution of this publication is made in accordance with DA Form 12-09-E, block number 3234, intended for command levels A, B, C, D, and E for the Active Army, the Army National Guard, and the U.S. Army Reserve.

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Chapter 1 General Provisions

Section I General

1-1. Purpose

This regulation pertains to the legal aspects of intellectual property, involving such matters as the creation, acquisition, use, control, transfer, and disposition of intellectual property and the rights to such property.

1-2. References

Required and related publications and prescribed and referenced forms are listed in appendix A.

1-3. Explanation of abbreviations and terms

Abbreviations and special terms used in this regulation are explained in the glossary.

Section II Responsibilities

1-4. The Judge Advocate General

The Judge Advocate General (TJAG), Department of the Army (DA) is responsible for the control, management and supervision of the Army's intellectual property law program. This responsibility has been delegated to the Intellectual Property Counsel of the Army (IPCA). The IPCA also serves as the Chief of the Intellectual Property Law Division (JALS-IP) within the Office of The Judge Advocate General (OTJAG).

1-5. The Intellectual Property Counsel of the Army

The IPCA will perform the following duties and responsibilities:

- a. Control, manage, and supervise the Army's intellectual property law program.
- b. Provide technical supervision of all the intellectual property personnel of the Army.
- c. Establish Army policies, regulations, and guidelines relating to intellectual property law.
- d. Provide legal advice concerning intellectual property to the Army's Acquisition Executive.
- e. Perform, on behalf of the Secretary of the Army, duties imposed by Executive Orders (EO) 10096 and 10930 and Government wide implementing regulations issued pursuant thereto. (Determinations of rights in inventions made by Army employees).
- f. Grant nonexclusive licenses, on behalf of the Secretary of the Army, in Army-owned patents and patent applications.
- g. Sign, by the direction of the Secretary of the Army, letters requesting that patent applications be placed under 35 USC 267, letters requesting that patent application be placed under 37 CFR 1.102 of the United States Patent and Trademark Office (USPTO), and letters requesting that applications be placed under 37 CFR 1.103 of the USPTO.
- h. Sign, by direction of the Secretary of the Army, powers of attorney or authorizations of agents to represent the Army before the USPTO, and to revoke existing powers of attorney or authorizations of agents.
- i. Sign, by direction of the Secretary of the Army, applications for foreign letters patent when title is in the United States Government, as represented by the Secretary of the Army.
- j. Appoint DA members to the Patents, Data, and Copyright Committee of the Defense Acquisition Regulation (DAR) Council.
- k. Appoint DA members to the Armed Services Patent Advisory Board (ASPAB).
- l. Serve as Chief of the Intellectual Property Law Division and supervise activities of that Division.
- m. Represent the United States on the technical property committees provided for in the bilateral agreements for the "Interchange of Patent Rights and Technical Information for Defense Purposes"

by appointment of the Department of State upon recommendation of Department of Defense (DOD).

n. Review, endorse, and forward through The Judge Advocate General to the Assistant Secretary of the Army for Research Development and Acquisition (ASA(RD&A)) for signature those documents cited in paragraph 1-6 below.

o. Represent the DA in litigation matters pertaining to patents, copyrights, and trademarks.

p. Sole authority for settlement of patent, copyright, and trademark litigation on behalf of the DA.

q. Execute, on behalf of the Army, a terminal disclaimer in a patent application pending before the USPTO.

1-6. The Assistant Secretary of the Army (Research, Development, and Acquisition)

The ASA(RD&A) is delegated the authority to—

a. Grant exclusive licenses on behalf of the Secretary of the Army in Army-owned patents and patent applications.

b. Sign, on behalf of the Army, agreements to settle interference proceedings pending before the USPTO and other instruments acknowledging a disclaimer or concession of priority or abandonment of the invention.

c. Execute, on behalf of the Army, documents relating to change of inventors in an application pending before the USPTO.

d. Authority and functions of the ASA(RD&A) related to Cooperative Research and Development Agreements and laboratory patent license agreements are addressed in AR 70-57 and chapter 7 herein.

1-7. Duties of the Intellectual Property Law Division

The Chief of the JALS-IP Division, and the attorneys or agents assigned to that division are designated and authorized to perform the following functions involving the legal aspects of intellectual property:

a. Represent the Army in legal proceedings relating to intellectual property including liaison with the Department of Justice (DOJ).

b. Process and assign for action administrative claims alleging patent or copyright infringement.

c. Provide legal advice at all levels on Army cooperative research and development agreements, and advise the ASA(RD&A) concerning such agreements.

d. Negotiate licenses on Army-owned patents.

e. Prosecute and maintain trademark registrations for the Army and selected DOD agencies.

f. Represent the Army on the Patents, Data, and Copyrights Committee of the DAR Council.

g. Negotiate and approve settlement of claims alleging patent or copyright infringement by the Army and assist the DOJ in negotiations of settlement of court suits alleging patent or copyright infringement by the Army.

h. Prepare and prosecute applications for those Army activities not assigned patent attorneys or agents.

i. By delegation from DOD, administratively support and manage the ASPAB.

j. Maintain a record of all patents, copyrights, and trademarks licensed or assigned to the Army.

k. Supervise patent secrecy review for the Army.

l. Advise Army staff and Army activities not assigned intellectual property attorneys or agents.

m. Develop special expertise in copyright matters and provide copyright assistance upon request to servicing legal offices and in appropriate cases directly to individuals.

n. Advise Army field intellectual property personnel on matters within scope of assigned duties.

o. Provide liaison with other U.S. Government agencies and foreign agencies on intellectual property matters.

1-8. Laboratory notebooks

The commanding officer of each Army laboratory is responsible for

assuring that every research and development investigation is properly recorded in a laboratory notebook.

1-9. Standards of Conduct for Intellectual Property Law Personnel

a. Officers and employees of the Government who are registered patent attorneys or agents must comply with USPTO rules relating to practice by Government employees found in 37 CFR, Part 10. Government employees whose status is affected by changes in their employment should notify the Commissioner accordingly.

b. Government employees are proscribed from participation for compensation on behalf of private parties in proceedings before the USPTO, under the provisions of 18 USC 203, as the predecessor of that section has been interpreted (41 Op. Att'y Gen. 21(1949)).

c. All civilian and military personnel whose official duties relate to intellectual property activities of the Government should scrupulously refrain from any activities which might conflict in any way with the above rules or with official duties or which might otherwise give rise to a conflict of interest.

Chapter 2 Inventions, Patents, and Invention Rights

Section I Inventions

2-1. General

Inventions are conceived under varying circumstances. Government employees engaged in scientific, technological, or engineering activities may make inventions in the course of their work. An employee may conceive of an invention while off duty and work on it with or without a contribution by the Government toward the making of the invention. Employees engaged in liaison with research and development contractors are likely to discuss project problems with contractor representatives and, as a result of such discussion, make a patentable contribution toward development of the project. In all such cases, the Government employee should make accurate records to ensure that his or her contribution is recognized. Such records should be dated and signed by two or more competent witnesses who should attest that they have read and understood the invention. If the invention has been built and operated, it should be shown to witnesses who should sign a statement that they saw the device work successfully on a certain date. Such witnessed documents should be carefully preserved.

2-2. State-of-the-art patent searches

A considerable savings in time, money and effort of research personnel may be realized if a state-of-the-art patent search is made at the start of a research and development project. When personnel, time, and money permit, patent counsel of the related activity are encouraged to conduct searches and should encourage research personnel to conduct such searches. When research personnel are going to conduct the search, local patent counsel will assist the researcher in developing the field of search in the USPTO. When available, automated state-of-the-art patent searches should be conducted by patent personnel or by research personnel with the assistance of patent personnel. Data banks at the Defense Documentation Center should also be consulted to determine whether similar research has been conducted or is being conducted by any DOD agencies.

2-3. Laboratory notebooks procedures

a. Policy. Maximum procedural flexibility will be left to subordinate command elements. All instructions should be coordinated with supporting patent counsel to assure the legal adequacy of the recorded data. Implementing guidance may be in the form of a supplement to this regulation if approved in accordance with current procedures. Implementing guidance should reflect the minimum requirements set forth below:

(1) Personnel in research and development laboratories are required to use individually issued notebooks to record their own research work.

(2) Laboratory notebook entries will be classified and handled in accordance with AR 380-5. Notebooks will be classified and controlled in accordance with the most highly classified information recorded thereon. Disposition of laboratory notebooks will be in accordance with AR 25-400-2.

(3) Laboratory notebooks will be documented in a manner that will satisfy the requirements for evidence in legal proceedings to establish the dates of conception and reduction to practice of inventions.

(4) Laboratory notebooks should be reviewed on a continuing basis by local counsel in order to identify potentially patentable inventions. Inventions having sufficient interest to the agency should be disclosed in accordance with paragraph 2-5.

b. Format. A research and development laboratory notebook may be any suitable commercially available notebook with a permanent binding. All pages must be numbered consecutively prior to issue. If copies of entries are desired, the notebook may include interleaved second sheets. Numbering of second sheets is not mandatory.

c. Maintenance. Laboratory notebooks will be maintained in accordance with recognized laboratory practice, and the following procedures will be followed so far as practicable:

(1) Entries should be made daily or weekly. They should be brief and concise but include all pertinent facts. Where extensive remarks are required, reports or memoranda may be used for such purposes. The notebook entry should, however, make reference to such reports or memoranda.

(2) All entries, except graphs and sketches, will be made in ink. No erasures will be made, and mistakes and changes will be indicated by crossing out. The crossing out will be initialled.

(3) Each sheet will be signed and dated by the person entering the data, and each sheet containing potentially patentable material, including any supplementary reports or memoranda, will also be signed by two witnesses who understand the entry. Co-inventors should not be used as witnesses. More than one entry may be made per sheet, provided each such entry is dated and signed.

(4) Original pages will not be removed from any Army laboratory notebook. Carbon copies, if desired, may be made on interleaved second sheets which may be removed from the notebook.

2-4. Untimely publication of inventions

Disclosure of an invention to others before a patent application is filed can jeopardize the patent rights of the employee and the Government. Employees wishing to publish information about their inventions or make a disclosure to persons outside the Government should discuss the matter with supporting patent counsel or JALS-IP.

Section II Patent Applications

2-5. Submission of inventions by Government employees

a. Requirement to submit invention disclosures. Employees who make inventions as part of their official duties must submit invention disclosures for patent consideration. Employees who make inventions which are unrelated or only indirectly related to their official duties may submit invention disclosures for patent consideration, but patent counsel should be consulted for advice on the relationship of the invention to their duties when any Government facilities have been used in the making of the invention. In either case, the employee must submit a rights determination, DA Form 2871-R (Invention Rights Questionnaire), in accordance with section IV, below.

b. Form for submission. Invention disclosures should be submitted on DA Form 4734-R (Invention Disclosure Form). A copy of this form is included in DA Pam 27-11.

c. Direct submission. Employees may submit their invention

disclosure directly to the patent counsel supporting the Army activity to which the invention relates unless local directives provide for special routing. If the activity is not supported by patent counsel, the invention disclosure will be submitted to JALS-IP.

d. Correspondence.

(1) Direct correspondence between the employee and patent counsel is authorized, provided that such correspondence pertains solely to unpatented inventions and the patenting thereof. No invention that has been previously rejected by any activity shall be submitted for evaluation to another Army activity without an accompanying explanation of the former rejection.

(2) If the subject matter of an invention disclosure requires classification, correspondence will be marked and handled in accordance with DOD 5200.1-R and AR 380-5.

2-6. Preliminary patentability searches

Prior to selection of an invention for filing of a patent application, a preliminary patentability search should be conducted by supporting patent counsel. Counsel will review the invention disclosure submitted by the inventor and examine prior patents and literature on related technology to determine whether the invention appears to be patentable. The inventor will be advised of the results of the search and determination.

2-7. Government filing of domestic patent applications

a. All Government agencies are required to pay fees to the USPTO to obtain patents and for services in connection with a patent application. Before the Army can take action to obtain a patent on inventions submitted by Government employees or, subject inventions submitted by a contractor (where the contractor has decided not to file a patent application), a DA activity must express an interest in the invention. This interest must be based upon an evaluation that the invention will be or is likely to be used by or for that activity or has commercial potential that may cause it to be included in a cooperative research and development agreement or be the subject of a patent license.

b. If the Army decides to file a patent application on an invention submitted by a Government employee which was not made in the course of the employee's official duties, it is the policy of the DA to file and prosecute the application at no expense to the employee if the employee has granted to the Government a royalty-free license, DA Form 2873-R (License of Invention). Patent counsel should advise Government employees at the time a license is executed that the DA reserves the right to discontinue patent prosecution when it appears that further prosecution is not warranted; every effort will be made in those cases to notify the inventor in sufficient time to permit continuation of patent prosecution by the inventor at no expense to the DA. In no case shall an Army patent attorney or agent prepare and prosecute a patent application unless the employee has executed an unconditional license or assignment of the invention to the United States of America as represented by the Secretary of the Army.

2-8. Maintenance fees

a. In general. Under the provisions of 35 USC 41(b), three separate fees must be paid over the 17-year life of a patent to maintain the patent in force. The fees are due 3 years and 6 months, 7 years and 6 months, and 11 years and 6 months, respectively, from the date of issuance of the patent for all utility patents issued from applications filed on or after 12 December 1980. Failure to pay any maintenance fee results in the expiration of the patent.

b. Policy. It is the DA policy to maintain in force only those Army-owned patents in which an Army agency or activity has expressed a substantial interest and for which a clear commercial potential can be demonstrated. The DA will not maintain a patent for which it has only a license except upon a determination that there exists an overriding Government interest for doing so.

c. Army-owned patents. The head of an Army agency or activity may maintain an Army-owned patent in force by paying the fees required by law upon a determination of continued Army interest

and commercial potential. However, the fees due at 7 years and 6 months, and 11 years and 6 months may not be paid without the approval of the IPCA, unless, at the time the fees are due, a viable license exists or a license is being negotiated on the patent to be maintained.

d. Army-licensed patents. No maintenance fee will be paid on a patent for which the Army has only a license without the approval of the IPCA. All agreements licensing patents to the Army which require the Army to pay maintenance fees must also be approved by the IPCA.

e. Notification. When the Army decides not to pay the maintenance fee on a patent it owns, all licensees will be informed of that decision when notification is required by the terms of their respective licenses. Every effort will be made to notify licensees whose license terms do not require notification by the Army and to notify all inventor(s) named in the patent. In all cases, notification should be given in sufficient time to permit payment of the maintenance fee by a licensee or inventor by the due date.

2-9. Filing of foreign patent applications

a. By agreement with foreign defense agencies, Army-owned inventions may be offered for filing by those agencies in their countries. In return for the effort and expense of such filing, the foreign government receives a royalty-free, nonexclusive license to practice the invention under the foreign patent.

b. Custody of the Government's rights in an Army-owned invention may be transferred to another Government agency, such as the National Technical Information Service (NTIS) of the Department of Commerce, for filing foreign patent applications in one or more countries and assuming management responsibility for the resulting patents.

c. The DA may also file foreign patent applications directly, upon coordination with JALS-IP and approval by the IPCA.

d. When the Government is entitled to an assignment of the foreign rights in an invention, foreign filing should be considered in conjunction with preparation of the domestic patent application. If the defense needs of the Government would be furthered by foreign patent filing or if the invention has strong commercial potential which would be transferable in the public interest, a recommendation concerning foreign filing with supporting reasons will be forwarded to JALS-IP, as soon as practicable.

2-10. Maintenance fees on Army-owned foreign patents

No maintenance fees will be paid by the Army on Army-owned foreign patents unless approved by the IPCA.

Section III Rights In Employee Inventions

2-11. Ownership of domestic rights

Depending on the circumstances surrounding the making of an invention by one or more Government employees, the Government may own all domestic rights in the invention; the employee may own title to the invention, subject to a royalty-free license to the Government; or the employee may own all rights to the invention, subject only to such rights in the Government as the employee has conveyed voluntarily. EO 10096 dated 23 January 1953 as amended and as implemented by 37 CFR, Part 501, requires that a determination of the respective rights of the Government and the employee be made whenever a Government employee makes an invention.

2-12. Criteria for determination of domestic rights

The EO 10096 provides that:

a. The Government shall obtain (except as herein otherwise provided), the entire domestic right, title, and interest in and to any invention made by any Government employee—

(1) During working hours.

(2) With a contribution by the Government of facilities, equipment, materials, funds, or information, or of the time or services of other Government employees on official duty.

(3) Which bears a direct relation to or is made in consequence of the official duties of the inventor.

(4) On assignment. (Assignments may be prepared on DA Form 2874-R (Assignment of Invention)).

b. In any case where the Government contribution to the invention, as measured by any one or more the criteria set forth in *a* above, 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 *a* above), the Government agency concerned shall leave title to such invention in the employee, subject 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. Licenses may be prepared on DA Form 2873-R.

c. In applying the provisions of *a* and *b* above to the facts and circumstances relating to the making of an invention, it shall be presumed that an invention made by an employee who is employed or assigned:

(1) To invent or improve or perfect any art, machine, design, manufacture, or composition of matter.

(2) To conduct or perform research or developmental work or both.

(3) To supervise, direct, coordinate, or review Government financed or conducted research or developmental work or both.

(4) To act in a liaison capacity among governmental or non-governmental agencies or individuals engaged in such research or development work or made by an employee included within any other category of employees specified by regulations issued pursuant to section 4(b), EO 10096, falls within the provisions of *a* above, and it shall be presumed that any invention made by any other employee falls within the provisions of *b* above. Either presumption may be rebutted by a showing of relevant facts.

d. Neither of the above presumptions will preclude a determination that the facts justify leaving the entire right, title, and interest in the invention with the employee, subject to law. Such a determination is appropriate when none of the factors in *a* above are present. When the entire right, title, and interest is left with the employee, the Government may otherwise obtain rights in the invention, such as the royalty-free license discussed in paragraph 2-7, a royalty-free license obtained in return for an incentive award, or an interest acquired by purchase of rights from the inventor.

2-13. Foreign rights

a. When the Government is entitled to obtain the entire domestic rights in an invention, it is also entitled to obtain all foreign rights in the invention. The Government has an exclusive option to file a foreign or international patent application for such invention at any time prior to the expiration of 8 months after a domestic patent application is filed or 6 months after a classified domestic application becomes unclassified, whichever is later. The Government's option may be exercised by actual filing of a foreign or international patent application, by notifying the employee of an intent to exercise the option, or by undertaking through a patent attorney, patent agent, or governmental agency to have a foreign or international patent application filed. The Government may exercise its option for any one or more foreign countries. The Government may also elect to eliminate the need for filing a foreign patent application by making a publication of the invention which would constitute a bar to foreign patenting by another.

b. If the Government does not exercise its option prior to the end of the option period, the employee may file a foreign or international patent application for any one or more countries in which the Government is not filing a patent application. The employee may file such foreign applications individually or may arrange by contract or license with another party for that party to file the patent application.

(1) If the Government is not entitled to obtain the entire domestic

and foreign rights in the invention but is entitled to reserve a license under the criteria of paragraph 2-12*b*, the employee may file a foreign or international patent application at any time. Such filing is subject to the restrictions of 35 USC 184.

(2) If the employee or another acting on behalf of the employee files a foreign or international patent application under *a* or *b* above, the Government is entitled to and retains a nonexclusive, irrevocable, royalty-free license throughout the world in any patent which may issue on the invention in any foreign country, including the power to issue sublicenses in furtherance of the foreign policies of the Government.

(3) If the entire right, title, and interest in the invention is left with the employee under the criteria of paragraph 2-12*d*, foreign patent filing is within the discretion of the employee. Such filing is subject to the restriction of 35 USC 184.

Section IV Procedures For Determining Rights

2-14. Reporting of inventions

a. All inventions made by employees, whether made as part of their official duties or on their own, will be reported through the employee's supervisor on DA Form 2871-R (Invention Rights Questionnaire). DA Form 2871-R will be locally reproduced on 8½ by 11 inch paper. A copy for reproduction is located at the back of this regulation. Additionally, DA Form 2871-R may be electronically generated. The electronically generated form must contain all data elements and follow the exact format of the existing printed form. The form number of the electronically generated form will be shown as DA Form 2871R-E and the date will be the same as the date of the current edition of the printed form.

b. If the employee worked under a different supervisor at the time the invention was made, the DA Form 2871-R should be forwarded through that earlier supervisor, if practicable. If there are joint employee-inventors, a separate DA Form 2871-R must be completed for each employee. If the joint inventors are not Government employees, the DA Form 2871-R should be accompanied by sufficient information to establish the identity of the other inventors and the relative contributions of each inventor. When completing the items indicating how much of the inventor's own time and how much Government time was spent in making the invention, the employee should exclude time involved in preparation of a proposal for Government adoption of the invention or consideration by patent counsel, for example: invention disclosure forms and DA Form 2871-R. If the employee signs the statement of DA Form 2871-R indicating a desire to assign the invention rights to the Government, the subsequent portions of the form need not be completed; an assignment form (as provided in para 2-21) will be executed by the employee, and no further determination of invention rights is required.

c. If the employee does not desire to assign the invention rights to the Government, patent counsel supporting the activity to which the employee is assigned will determine if the subject matter of the invention disclosure constitutes an invention. If no invention is found to exist, the activity will not request a determination of rights unless requested to do so by the inventor.

d. If invention is found to exist and the inventor does not desire to assign the invention to the Government, or if no invention is found, but a determination is requested by the inventor, the inventor will prepare the DA Form 2871-R, and the patent counsel will forward the DA Form 2871-R and related papers, through channels to JALS-IP. The transmittal will include determination request form DA Form 2872-R (Request for Determination of Invention Rights) and copies of the inventor's job description or, for military personnel, the inventor's duty military occupation specialty (MOS) at the time the invention was made.

e. If the activity receiving the invention disclosure contemplates filing a patent application, the case will be forwarded to JALS-IP before an application is prepared for a determination of rights when the employee inventor refuses to execute either a license or an assignment to the Government. The execution of an assignment or a

license shall not be contingent upon the outcome of the rights determination. If no Government patent application is contemplated, the case should be forwarded to JALS-IP as soon as practicable.

f. If the DA Form 2871-R is received by an activity which is not supported by patent counsel, the form and job description or MOS will be forwarded in duplicate directly to JALS-IP. No DA Form 2872-R will be prepared by the agency in that case.

2-15. Preparation of DA Form 2872-R

a. DA Form 2872-R (Determination of Invention Rights) will be locally reproduced on 8½ by 11 inch paper. A copy for reproduction is located at the back of this regulation. Additionally, DA Form 2871-R may be electronically generated. The electronically generated form must contain all data elements and follow the exact format of the existing printed form. The form number of the electronically generated form will be shown as DA Form 2872-R-E and the date will be the same as the date of the current edition of the printed form.

b. The GPB case number will be completed by JALS-IP upon receipt of DA Form 2872-R.

c. Only blocks 1 through 11 should be completed for submission to JALS-IP.

d. The recommendation in item 11 should be justified and supported by applicable reasons such as the relationship of the invention to the employee's official duties or the contribution of any Government time, money, or material to the making of the invention. Any apparent conflict between the answers by an employee and the supervisor on DA 2871-R will be resolved before submission to JALS-IP, if possible. If irreconcilable differences exist, the supporting patent counsel will indicate which statement is believed to be correct with supporting documentation.

e. If the invention is classified, the form will be prepared in the normal manner, except that the description of the invention will be omitted and in its place will be a statement that the invention is classified. A brief description of the invention, properly classified, will be enclosed with the form, and the form will be marked "REGRADED UNCLASSIFIED when separated from classified enclosures."

2-16. Determination of rights

The IPCA will make the determination of invention rights on behalf of the DA, applying the criteria of EO 10096 as amended and 37 CFR, Part 501. The determination will be recorded on DA Form 2872-R. Depending on the nature of the determination, JALS-IP will take one of the following actions:

a. If it is determined that the Government is entitled to all rights in the invention, the employee will be notified of the determination and right to appeal under 37 CFR, section 501.8. If the employee files an appeal with the Under Secretary of Commerce for Technology (the Secretary), JALS-IP will forward a report concerning the case to the Secretary upon notice of the appeal. In the absence of an appeal, no further review is required.

b. If it is determined that title to the invention remains with the employee, subject to reservation of a license to the Government, and no such license is recited in item 9 of DA Form 2872-R, the employee will be notified of the determination and right to appeal under 37 CFR, section 501.8. As in a above, in the absence of an appeal, no further review is required.

c. If it is determined that title to the invention remains with the employee subject to reservation of a license to the Government and if item 9 of DA Form 2872-R recites that the employee has executed a license to the Government, the employee will be notified of the decision and that the decision is final. An employee may only appeal an agency determination if he or she is aggrieved by the decision. An employee who has already executed a license is not aggrieved by a determination that the Army is entitled to such a license since the employee would not gain any right by a successful appeal.

d. If it is determined that all rights in the invention are to be left

with the employee subject to law, the employee will be notified of the decision and that the decision is final.

2-17. Appeal

a. If an aggrieved employee is dissatisfied with a Department of the Army's determination, the employee may appeal the determination. To exercise the right of appeal, the employee must file two copies of the appeal with the Secretary within 30 days of actual receipt of the determination. To preclude loss of appeal rights because of late filing, the appeal should be sent directly to Office of the Under Secretary for Technology, United States Department of Commerce, Room H4824, Herbert C. Hoover Building, Washington, DC 20230.

b. There is no required format for an appeal. The appeal may be accompanied by any documents deemed pertinent. The employee may request that the Secretary hear oral arguments presented by the employee or by an attorney hired by the employee. The employee is not required to retain an attorney or request an oral hearing and may rely exclusively on the written appeal. An appeal should contain the following:

(1) The Government Patent Board (GPB) case number (as shown on DA Form 2872-R).

(2) The name of the employee.

(3) The title of the invention.

(4) An explicit statement that it is an appeal.

(5) The date of actual receipt of the determination.

(6) The basis for the belief that the determination is in error.

c. Upon receipt of a copy of the appeal from the Secretary, JALS-IP will furnish to the Secretary and the employee-inventor a report concerning the invention and determination including a detailed statement of the points of disputes with relevant evidence considered in making the determination.

d. The employee-inventor may, within 25 days after the date of actual receipt of a copy of the report or such longer period as the Secretary may fix, file a reply with the Secretary with a copy thereof to JALS-IP. The employee may expedite the procedure by notifying the Secretary when no reply to the report is intended.

2-18. Time for submitting appeals, petitions, and requests for reconsideration

The times for submitting appeals, and requests for reconsideration are set out in paragraphs 2-17 and 2-19. These times are prescribed by the Secretary of Commerce under the authority of EO 10930 dated 28 March 1961 and are strictly enforced. Delays due to mailing time or administrative processing will not extend the allowable times. No time in excess of the prescribed time is allowed unless a written request for an extension, supported by reasons for granting the extension, is submitted to and approved by the Secretary prior to the expiration of the prescribed period.

2-19. Request for reconsideration of the Secretary's decision on Appeal of the Army Determination

a. Either the employee or the IPCA can file a request asking the Secretary to reconsider the Secretary's decision on appeal. To exercise this right, a copy of the request must be filed with the Secretary within 30 days of the date of the Secretary's decision or within such longer time as the Secretary may set before the original period expires. A copy of the request must be furnished to the other party, within the same period. To preclude loss of this right because of late filing, copies of the petition should be sent directly to the appropriate party.

b. There is no required format for a request for reconsideration, but petitions should contain the following:

(1) The GPB case number (as shown on the decision).

(2) The name of the employee.

(3) The title of the invention.

(4) An explicit statement that it is a request for reconsideration of the decision of the Secretary on an employee's appeal.

(5) The date of the decision.

(6) The basis for the belief that the decision is in error.

Section V Conveyance of Rights In Employee Inventions and Contractor Inventions

2-20. Notification to DA of change of rights in patents

All employees of the DA who secure patents under which the Government is licensed must notify JALS-IP and any agency having an interest in the invention of any further licenses or assignments of their patent interest. Contracting officers need this information to protect the Government from being improperly charged with royalties on such patents.

2-21. License and assignment forms

DA Form 2873-R (License of Invention) and DA Form 2874-R (Assignment of Invention) may be used for granting rights in inventions to the Government by Government employees. Supplemental signature form, DA Form 4230-R (Supplemental Signature Sheet), may be used with DA Form 2873-R and DA Form 2874-R, when needed to accommodate the signatures and notarizations. Signatures and notarizations are to be completed in black ink. DA Forms 2873-R, 2874-R, and 4230-R will be locally reproduced on 8½ by 11 inch paper. Copies for reproduction are located at the back of this regulation. Additionally, DA Forms 2873-R, 2874-R, and 4230-R may be electronically generated. The electronically generated forms must contain all data elements and follow the exact format of the existing printed forms. The form numbers of the electronically generated forms will be shown as DA Form 2873-R-E, DA Form 2874-R-E, and DA Form 4230-R-E, and the dates will be the same as the dates of the current editions of the printed forms.

2-22. Contractor employee inventions

a. Patent rights clauses prescribed by the Federal Acquisition Regulation (FAR), 48 CFR Chapter 1, and DOD Federal Acquisition Regulation Supplement (DFARS), 48 CFR Chapter 2, require that a contractor disclose to the Government all inventions made under the contract. Additional requirements and procedures are established in the FAR and DFARS for the administration and follow up of patent rights clauses.

b. The head of each Army activity or agency will establish procedures to protect the Government's contractual patent rights. For all contracts, these procedures should include a review process to ensure adequate disclosure of all inventions made under the contract. For contracts where the contractor has elected to take title, patent section personnel will conduct a review to ensure that a formal licensing instrument has been executed by the contractor and that the specification of the patent application contains an appropriate acknowledgment of the Government's rights. For contracts where the contractor elects not to take title or the Government is entitled to take title, the review should confirm that a formal assignment instrument has been executed by the contractor. Additionally, where the contractor elects not to take title, patent section personnel should ensure that each disclosure is reviewed for Army interest and possible patenting. Where the Army agency concerned does not have a patent section, JALS-IP should be contacted for assistance.

Chapter 3 Recording and Reporting

3-1. Recording of assignments, licenses, and other instruments

a. All assignments, licenses, and other instruments evidencing rights and interests of the Government in patents or applications for patent will be recorded in the USPTO by the head of the Army agency concerned. Assignments will be recorded in the Statutory Register 35 USC 261 and licenses and other instruments in the Register of Government Interests in Patents and Applications for Patents established in the USPTO by EO 9424 dated 18 February

1944. Assignments should be notarized to provide prima facie evidence of regular execution. The original (or a duplicate original) of all assignments, licenses, and other instruments, after being recorded in the USPTO, shall be transmitted without delay to JALS-IP.

b. Copies of all recorded instruments and the recording data are available from JALS-IP, upon request.

3-2. Intellectual Property Report (Requirement Control Symbol (RCS): JAG-14)

The Intellectual Property Report will be submitted annually by the head of each Army agency having a patent soliciting section. The report will include the following information: number of invention disclosures received, the number of patent applications filed, the number of SIRS filed and/or applications converted to SIRS, patent applications abandoned and/or lapsed, and patents and SIRS issued. It is recommended that the foregoing information be submitted in two separate categories, employee inventions and contractor inventions. The report will be submitted to JALS-IP to arrive within 30 days after the end of the fiscal year.

Chapter 4 Copyrights and Trademarks

Section I Copyrights

4-1. Copyright policy

It is DA policy to recognize the rights of copyright owners consistent with the Army's unique mission and worldwide commitments. As a general rule, copyrighted works will not be reproduced, distributed, or performed without the permission of the copyright owner unless such use is within an exception under United States Copyright Law, 17 USC, or such use is required to meet an immediate, mission-essential need for which noninfringing alternatives are either unavailable or unsatisfactory. Use of a copyrighted work by the Army without permission of the owner must be approved by the IPCA.

4-2. Permissions and licenses

a. Copyright owners frequently grant the military departments free permission to use copyrighted material for certain purposes, particularly when the morale and welfare of military personnel are involved. Heads of Army activities and agencies should take care to assure that such permission is not abused by improper use of the material.

b. Authority to acquire a copyright license with appropriated funds arises under 10 USC 2386 and is described in paragraph 7-15. However, the procedures for the acquisition of permissions or licenses for specific uses may be governed by other regulations. See paragraph 4-6 below.

4-3. Government employee works

a. Generally, the copyright in a work belongs to the work's author. An exception is a work of the United States Government in which, by law, no copyright can subsist.

b. A work of the United States Government is defined as a work prepared by an officer or employee of the United States Government as part of that person's official duties. Those duties may be expressed or implied. A Government work results even though the work was prepared using the author-employee's own time, material, or facilities. Two examples of Government works are—

(1) A work the preparation of which is necessary for the proper performance and accomplishment of an employee's duties or responsibilities, as those duties or responsibilities are specifically prescribed in the employee's job description.

(2) A work the preparation of which requested, directed, instructed, or otherwise ordered by an appropriate official.

c. The use of Government time, material, or facilities in creating a work does not necessarily result in that work being a work of the

United States Government. Also, the subject matter of the work, unless the work is prepared as part of the employee's official duties, does not automatically establish the work as a work of the United States Government. This is true even though the subject matter of the work may be directly related to the author-employee's official duties. Thus, the above factors do not preclude the existence of a copyright belonging to the author-employee. However, the use of Government assistance to create an unofficial and, hence, copyrighted work may result in a violation of AR 600-50.

d. Where Government time, material, or facilities are used in the preparation of the work, but, based on the principles above, a copyright subsists in the work, 28 USC 1498(b) does not confer a right of action on the Government employee copyright owner or his or her assignee for infringement by the Government. This is interpreted to mean that the Government is entitled to a royalty free license to duplicate, distribute, and use the copyrighted work and to have others do so for its benefit.

e. The author of a work of the United States Government has no rights in the work which can be conveyed. If a potential publisher asks the employee to sign an assignment of a copyright, the publisher should be advised that the work is a work of the United States Government. However, if the publisher insists on the employee executing a document as a prerequisite to publishing the work, the employee may sign a statement which indicates he or she is assigning whatever copyright rights may exist in the work. When material subject to a Government license (para *d* above) is submitted to a publisher, the publisher should be advised of the existence of the license to the Government. This will avoid subsequent embarrassment to the author or the publisher if the Government exercises its license.

f. If a copyrighted work consists of one or more works of the United States Government, the law requires affirmative or negative identification of the sections which are actually copyrighted, thereby indicating which portions are works of the United States Government.

4-4. Computer software

a. Computer software is copyrightable. Whether a copyright subsists in a particular piece of Government employee developed software depends on the same general principles discussed in paragraph 4-3.

b. Generally, Government use of copyrighted software it procures will be governed by the contract clauses used in the acquisition. However, to the extent that standard contract provisions are not applicable to a particular software acquisition, e.g., the purchase of off-the-shelf software products from third party vendors, then the use of the software will be governed by the copyright law, 17 USC. Copying of software under these circumstances is permissible:

(1) When preparing a backup copy to protect against the damage or loss of the original.

(2) When loading a copy of the software into a computer's random access memory or hard disk for more rapid access.

(3) When several computers operate as terminals on a network sharing a hard disk for software, data storage, and rapid retrieval and sharing. However, there must be an original copy of the software for each terminal in the network, or a Government purchased license authorizing the use of the software on a network.

(4) When otherwise authorized by the Vendor's Copyright Statement of Understanding contained in the User's guide or by special agreement with the copyright owner.

4-5. Liability for infringement

The exclusive remedy for infringement of copyright by the Government is by action against the United States in the U.S. Claims Court or by administrative claim.

4-6. Copyright references

The following references may be consulted concerning the use of copyrighted materials:

a. 17 USC.

b. 37 CFR, Chapter II.

c. DODD 5535.4, August 31, 1984.

d. AR 25-30, section IV.

e. AR 25-1.

f. DODD 5040.2, 7 December 1987.

g. AR 215-2.

h. DFARS 227-480.

Section II Trademarks

4-7. General

The DA may apply for trademarks and other types of trademarks provided for under the Trademark Act of 1946 (Lanham Act), 15 USC 1051-1127. Trademark Act protection should be considered as a means of preventing unwanted exploitation by commercial entities of trademarks and phrases developed and funded by the Army. (See, e.g., AR 360-81, para 3-5j, which encourages commanders to trademark their newspaper names).

4-8. Applying for trademark act protection

Heads of Army activities and agencies desiring trademark registration shall submit requests for Trademark Act protection to the IPCA for preparation and filing of applications. All such requests will contain:

a. The signature block of the official who will sign the application (normally the activity or agency head).

b. The date of first use of the trademark.

c. The date of first use of the trademark in commerce.

d. A description of how the trademark is affixed to the goods on which it is used.

e. Six specimens of the trademark, e.g., the actual label or tag on which it is placed.

4-9. Records

The JALS-IP maintains a record of all trademarks obtained by the DA in accordance with AR 25-400-2. Copies of registrations and other information pertaining to the Army's trademark portfolio are available upon request from the JALS-IP.

Chapter 5 Litigation

5-1. Litigation policy

It is the policy of the DA to avoid, whenever practicable, the infringement of privately-owned rights in inventions and copyrighted works.

5-2. Representation

The IPCA is designated to represent the DA in litigation matters pertaining to patents, copyrights, and trademarks, per AR 27-40, paragraph 1-4a. Sole authority for settlement of such litigation on behalf of the DA is vested in the IPCA. JALS-IP has the responsibility for furnishing a timely response to calls upon the Secretary of the Army from the Court of Federal Claims and from the Attorney General for information and assistance. To fulfill its responsibility for representation, JALS-IP will maintain liaison with the DOJ and other governmental agencies in connection with all litigation concerning patents, copyrights, trademarks and other intellectual property related matters involving the DA.

5-3. Reporting pending or prospective litigation

Whenever a DA activity becomes aware of any pending or prospective litigation concerning patents, copyrights, trademarks, rights in technical data, trade secrets (18 USC 1905) or computer software involving that activity or one of its contractors, the activity shall promptly notify the IPCA of the details of the litigation as required by AR 27-40, paragraph 2-1c(1).

5-4. Investigative reports

a. Requirement. Whenever a suit for alleged patent or copyright infringement or other cause of action related to intellectual property is filed, which appears to involve the DA, the DOJ issues a call on the Secretary of the Army under the authority of 28 USC 520, requesting all facts, circumstances and evidence within the possession of the DA that touch upon the suit. A copy of the petition or complaint is attached to the DOJ call, and in some cases an addendum is also attached requesting specific information. As the DOJ is required to file an answer to the plaintiff's petition or complaint within 60 days, an initial response must be made to the DOJ Civil Division providing all information available. In order to provide that initial response, JALS-IP may request that the specific Army activity or activities concerned with the subject matter of the litigation, prepare an investigative report covering the subject matter of the litigation. Unless otherwise directed, an activity requested to provide an investigative report shall forward a report containing the information set forth in paragraph *b* within 30 days of receipt of such request. If the time limit cannot be met, an interim report will be submitted to JALS-IP providing as much of the information set forth in paragraph *b* as possible. Such interim report will be supplemented as the additional information becomes available.

b. Content. A tabbed and indexed investigative report will be prepared as follows:

(1) *Part I, Statement of Facts.* Include a complete statement of the facts upon which the action and any defenses thereto are predicated. In each instance in which a fact or facts can be supported by documents or statements of witnesses (see (5) below) appropriate parenthetical references to such documents or statements will be inserted into the statement of facts. Include details of any previous administrative action such as the filing of an administrative claim. The statement of facts should include the following:

(a) Any information bearing on the plaintiff and the development and dates of the invention.

(b) Description of all devices manufactured by or for, or used by or for, the Government, which might correspond to the charge of infringement. Where possible, specifications, including drawings, diagrams and operating information must be included.

(c) The names and addresses of contractors with numbers and dates of contracts, contract paragraph numbers containing authorization of consent and patent indemnity clauses, and names and addresses of surety on the contracts.

(d) The amount and costs of procurement under each contract specified in (c) above.

(2) *Part II, Indemnity/Defenses.* Include a statement whether provisions for indemnification for any Government liability has been provided for in the procurement of the alleged infringing items. Additionally, facts setting forth possible defenses, with special reference to the existence of license rights for the Government to use the invention, must be provided. Also include a statement of known, relevant prior art and comments upon the validity of the patents, or copyrights in suit, as well as, any other grounds for asserting legitimate defenses to the suit.

(3) *Part III, Response to Pleadings.* A draft proposed answer should be prepared. The proposed answer should include a statement responding, in order, to each allegation of fact in the complaint (or other pleading) by either admitting or denying the same. Where possible, refer to exhibits to support each response.

(4) *Part IV, Memorandum of Law.* Include a brief statement of the applicable law with citation to legal authority and such argument and comments upon the facts of the case as is necessary to show the applicability of the authority cited. An extensive memorandum of law is not required. The primary purpose of the investigative report is to provide the relevant facts of the case to the DOJ and to point out relevant issues. As such, exhaustive research of the legal issues is neither required nor contemplated.

(5) *Part V, Exhibits and Witnesses.*

(a) Exhibits will include — all pertinent documentary evidence; copies of any pertinent contracts, subcontracts, collateral agreements or assignments, and extracts therefrom which are involved in the

action; copies of all relevant prior art references; and copies of any correspondence which relate to either the subject matter or the parties involved in the litigation.

(b) Include a list of all possible witnesses for the Government with — present or last known home and office addresses; home and office telephone numbers; and social security account numbers. In determining who may be a witness, special consideration should be given to employees of the Army who know engineering and procurement facts relevant to the accused devices.

(c) Where possible, include a statement from each witness reflecting his or her knowledge of the facts upon which he or she may be able to testify. If the witness is unable to furnish a statement, a summary of the testimony he or she might be expected to give, if known, should be substituted for his or her statement. Transmission of investigative reports should not, however, be delayed because a witness is not available. Such statements or a summary thereof, should be forwarded as soon as practicable.

5-5. Additional requirements

Copies of reports of administrative claims will be used to avoid duplication of effort. Such reports, however, will not be submitted alone in place of an investigative report. Care should be exercised in selecting and compiling the appendices and exhibits attached to the investigative report. Ordinarily, unless otherwise instructed or requested, each exhibit submitted should be tabbed and internally paginated. All references to exhibits in the body of the investigative report should be to the page numbers within the particular exhibit. In-house memorandums if attached to correspondence, should be separated from the correspondence and both forwarded as two exhibits, each paginated. In preparing exhibits to the attachments, care should be taken to safeguard information which is classified or is otherwise subject to restrictions on disclosure. These items should all be separately marked indicating the respective restrictions on their disclosure.

5-6. Distribution of investigative reports

Investigative reports will be forwarded in duplicate to JALS-IP. The use of expedited mail or courier services is authorized to transmit investigative reports and other documents and items needed to support litigation.

5-7. Release of information and appearance of witnesses

Requests for the release of official information and the appearance of present and former DA military and civilian personnel in response to subpoenas, litigation related requests and orders for information, interviews or attendance at quasi-judicial proceedings shall be processed in accordance with AR 27-40, chapter 6.

Chapter 6 Administrative Claims, Proffers, and Purchases of Rights

Section I Administrative Claims

6-1. Administrative claims policy

Any patent or copywrite owner who believes that the DA has infringed his or her patent or copyright, or has caused him or her damage by imposing a secrecy order may file an administrative claim for compensation or damages instead of filing suit against the United States.

6-2. Initiation of patent infringement and secrecy order claims

A copy of any written communication received by a DA activity alleging either patent infringement or damages incurred by reason of the imposition of a secrecy order shall be promptly transmitted by such activity's servicing legal office to the JALS-IP in accordance

with DFARS Subpart 227.70 and Army Federal Acquisition Regulation Supplement (AFARS) 27.7006-91, for coordination and review to determine if the claimant is legally entitled to present the claim. The letter of transmittal should include a summary of any pertinent facts known to the activity concerning the claim or allegation. The activity's servicing legal office will provide a written acknowledgment to the claimant that such communication has been received and is being reviewed.

6-3. Assignment of the patent or secrecy order claim

The JALS-IP shall review the communication to determine if it meets the requirements of DFARS 227.7004 for filing an administrative patent infringement claim and whether the claimant is legally entitled to make such a claim. Once the infringement claim is considered to be in proper form, the JALS-IP will docket the claim and assign it for investigation to patent counsel assigned to the alleged infringing DA activity. If there is no patent counsel assigned to the alleged infringing activity or if the claim is solely under 35 USC 183, the JALS-IP shall assign the claim for investigation by patent counsel from the activity with the most expertise in the relevant technology. Before assigning the claim, JALS-IP will review its files and the files in the USPTO for any record of Government rights. JALS-IP will notify all agencies and military departments having a probable interest in the claim and request that they provide assigned Army patent counsel with any pertinent information available to them.

6-4. Investigation (Exempt report, AR 335-15, para 5-2e.)

The assigned patent counsel shall promptly investigate the claim. The investigation will examine every area required to be addressed in the final report (para 6-5). A status report addressing the progress of the investigation will be submitted to JALS-IP every 3 months.

6-5. Final report (Exempt report, AR 335-15, para 5-2e.)

A final report (in duplicate) of the results of the investigation including recommendations and conclusions, will be drafted no later than 18 months after the investigation is assigned to patent counsel. If denial of the claim is recommended, a copy of the final report and a draft denial letter shall be forwarded by the assigned patent counsel to, JALS-IP. A copy of the final report shall also be forwarded by the patent counsel to each interested head of a procuring activity. Each such report shall be signed by the investigating attorney, dated and clearly marked FINAL REPORT and ATTORNEY WORK PRODUCT. If settlement of the claim is recommended, the assigned patent counsel shall negotiate for a settlement agreement. Such agreements are subject to the same approval requirements as set forth in section III concerning the purchase of intellectual property rights. The final report shall include the following information:

a. The name and address of each contractor and subcontractor, numbers and dates of all contracts and subcontracts for procurement of the item in question, and for all other possibly infringing items which the Government has procured or used.

b. The text of each contractor's agreement, if any, to indemnify the Government against liability for infringement, or a statement that there is no such indemnity agreement.

c. The extent and dates of the alleged infringement or, when no dates are alleged, the period over which infringement has been investigated.

d. The text of any contract clause granting (or, if there is no such clause, any other information relating to) authorization and consent by the Government to the manufacture or use of the article, material, design, or process upon which such claim is based.

e. A copy of each patent alleged to be infringed.

f. The results of a title search in the USPTO.

g. A complete disclosure of any device, material, design, or process which is alleged to infringe or which is sufficiently close to the patented item to raise a possible inference of infringement. The disclosure should include a detailed description thereof, together with drawings, sketches, photographs, and specimens in proper cases, sufficient to determine whether infringement is present.

h. An analysis of the independent patent claims in comparison with the alleged infringing item or items which might raise an inference of infringement. The analysis should be in the form of a claims chart.

i. A report of the date and extent of searches, if any, in each of the following categories:

(1) Prior art patents and publications.

(2) Pending patent applications filed by the procuring activity conducting the investigation.

(3) Prior public uses.

j. A copy of each prior art patent and publication, and full and complete description (and where practicable, a drawing, sketch, photograph, or specimen) of any prior uses relied upon by the patent counsel.

k. A statement whether the inventor or patent owner was a Government employee in a position to order, influence, or induce use of the invention by the Government.

l. A statement whether the invention was made during the time the inventor was in employment or service of the Government and if so, a description of the inventor's official functions at the time and a statement whether Government time, materials, or facilities were used.

m. The names and addresses of prospective factual and expert witnesses and, if pertinent to validity or infringement, signed statements of witnesses. Where a witness refuses to sign a statement, the interviewing officer shall submit a statement setting forth the facts which the witness may be expected to state if called to testify.

n. Conclusions regarding infringement with respect to all procurement involved and reasons therefor.

o. Conclusions regarding validity and reasons therefor.

p. Conclusions regarding the Government's potential liability, for both past and future procurement and the basis for such conclusions.

q. A statement of the position taken by indemnitor(s) where pertinent.

r. A summary of negotiations for settlement, if any.

s. Any recommendations concerning the disposition of the claims.

6-6. Initiation of copyright infringement claims

Any DA activity which receives correspondence asserting copyright infringement by the DA will forward it to JALS-IP. In addition, the activity should forward such of the following as may be available:

a. Any other correspondence from the claimant which concerns the same matter.

b. Any written consent giving the Government the right to use the material. If such written consent has previously been submitted to the DA, information concerning the disposition will be furnished.

c. A statement disclosing the extent of distribution of the Army publication.

d. A statement disclosing the purpose for which the Army publication was originated.

e. A description of the source material asserted to have been infringed, including the title, author, publisher, date of publication, date and owner of the copyright, and, if disclosed in the work, the Library of Congress catalog card number and International Standard Book Number or International Standard Serial Number to allow further verification of the work.

f. A statement disclosing whether the author of the source material was hired by the Government to produce the source material or if the source material was produced with the use of Government time, material, or facilities.

6-7. Assignment of the copyright claim

If the correspondence contains sufficient information, it will be docketed as a claim and assigned for investigation to patent or legal counsel for the alleged infringing activity. If there is no counsel, JALS-IP will conduct the investigation or assign it to another counsel.

6-8. Final report of copyright claim if no settlement(Exempt report, AR 335-15, para 5-2e .)

A final report of the results of the investigation(including recommendations, conclusions and, if appropriate, a draft denial letter), shall be submitted by the assigned counsel to JALS-IP. Each such report shall be signed by the investigating attorney, dated and clearly marked FINAL REPORT and ATTORNEY WORK PRODUCT. It shall also include, so far as is practicable, the information required in paragraphs 6-5a through d and m through s, as well as the following information:

- a. The registration number of the copyright alleged to be infringed.
- b. The results of a title investigation.
- c. A copy of any device, work, or publication which is alleged to infringe or which is sufficiently close to the copyrighted work as to raise a possible inference of infringement.
- d. A copy of the work protected by the allegedly infringed copyright.
- e. The extent, if any, to which the claimant has licensed the copyright.
- f. A statement whether the copyrighted work was made during a time when the author of the work was in the employment or service of the Government, and if so, a description of the author's official functions and duties at the time; whether Government time, materials, or facilities were used; and whether the employee was in a position to order, influence, or induce use of the copyrighted work by the Government.
- g. A statement whether the work was produced under a Government contract, and, if so, the contract number.

6-9. Review and action on all final reports

JALS-IP shall review each final report and, if the report is approved, deny the claim on behalf of the DA or take other appropriate action leading to the disposition of the claim. JALS-IP will provide copies of any denial letter or other correspondence to the assigned counsel, and other interested military departments. JALS-IP may prepare a concurring memorandum or if the final report is not acceptable, return the report to the assigned legal counsel with a nonconcurring memorandum including appropriate instructions for further actions.

6-10. Request for reconsideration

If a claimant files a request for reconsideration from a denial by JALS-IP, the request will be forwarded to the assigned patent counsel for comment and recommendations. The decision whether or not the claim will be reconsidered will be made by the IPCA.

Section II Proffers

6-11. Requests for clearance

Any written proffer of a license or assignment in a patent or patent application received by a DA activity shall be promptly transmitted via its counsel, if any, to the JALS-IP in accordance with AFARS 27.7011-90. The letter of transmittal must state all pertinent facts known to the activity about the proffer and indicate whether or not the activity is interested in pursuing the matter with the profferrer. An interest will be presumed if the activity requests clearance from JALS-IP to consider and procure a license or assignment on behalf of the DA. If the activity is not interested in the proffer, it should so state and provide its reasons. Since there is no obligation on the DA to consider proffers, such reasons may be brief.

- a. Each request for clearance shall include:
 - (1) The name and address of the patent owner.
 - (2) The number and date of each patent, and the serial number and filing date of each patent application involved, and the name of the inventor(s).
 - (3) A copy of any communication from the patent owner (or his or her representative) making the offer.
 - (4) A description of the invention in sufficient detail to permit

other procuring activities to determine whether they may have an interest in the matter.

(5) A summary of the nature and terms of the proposed license or assignment including a copy of the instrument submitted.

(6) The names of any other DA activities which might have an interest, and a statement as to the probable interest of the Departments of Navy and Air Force and the Defense Supply Agency.

(7) Any other pertinent information.

b. JALS-IP, upon receipt of the request for clearance, shall review its files and the files in the USPTO to determine whether the Government has any license or other interest in any patent or patent application involved and grant appropriate clearance in writing.

c. Upon receipt of clearance, the assigned counsel shall consider the proposed license or assignment on behalf of the DA in coordination with any other interested DOD agencies and procure the same in accordance with section III of this chapter.

6-12. Final report if no license or assignment is procured

Assigned counsel shall make a final report(in duplicate) (Exempt report, AR 335-15, para 5-2e), to JALS-IP with respect to each proposed license or assignment, the procurement of which is believed to be inadvisable or as to which the counsel has been unable to negotiate terms deemed reasonable. Counsel will forward a copy of the final report to each head of an interested procuring activity. JALS-IP, if it accepts the report, shall send a letter to the patent owner or his or her representative (with copies to the counsel and head of each interested procuring activity) rejecting the proffer.

Section III Purchase of Intellectual Property Rights

6-13. Authority and delegations

The purchase of rights in patents, patent applications, copyrights and in technical data is authorized by 10 USC 2386. Under AFARS 27.7006-90, the Commander, U.S. Army Materiel Command; the Commander, U.S. Army Corps of Engineers; The Surgeon General; the U.S. Army Strategic Defense Command; and their designees may acquire these rights and enter into settlement agreements subject to the limitations in DFARS 227.70. All other DA activities shall forward any proposed agreement for signature by the ASA(RD&A) through the IPCA except for copyright licenses of \$2, 500 or less. Claims asserted under 22 USC 2356, may be settled by the Commander, U.S. Army Materiel Command; the Commander, U.S. Army Corps of Engineers; and the Commander, U.S. Army Information Systems Command.

6-14. Approval of agreements

a. Notwithstanding the above authorities to enter into agreements, the approval of TJAG or his designee is required consistent with AFARS 27.7006-94 for the purchase of rights under 10 USC 2386. This applies to technology licenses or options whether or not a specific patent is mentioned.

b. To obtain approval of the agreement, a copy of any proposed agreement shall be submitted in draft to JALS-IP, for review. The draft shall be accompanied by a memorandum of facts setting forth, where pertinent:

- (1) The identification and brief description of the subject matter of the patent, patent application, or technology involved.
- (2) The date of clearance granted, if a claim or proffer.
- (3) A statement of the extent of use by the DA of the patent or technology, and an estimate of the Government's potential liability, if any.
- (4) A statement of the interest of any other Department in the matter with a summary of extent to which coordination has been effected or should be effected.
- (5) A specific reference to the reasons the requested approval is necessary as cited in a above.
- (6) The reasons for any deviation from any prescribed contract clause and a precise statement of such deviation.
- (7) A recommendation, with supporting reasons, that the agreement be approved.

(8) A recommendation that the agreement, if approved, be filed in the public register, departmental register, or the secret register of the USPTO as appropriate.

(9) A statement that the agreement effects settlement of the claim for which clearance was granted.

(10) A statement that the evidence indicates that the licensor has title to the patents or copyrights forming the basis of the agreement.

c. If the IPCA finds the draft acceptable, he or she will notify the assigned counsel that it may be finalized and executed by the parties if it includes, when appropriate, the clause: "Approval of Contract. This contract shall be subject to approval for the Secretary of the Army by or on behalf of The Judge Advocate General, Department of the Army, and shall not be binding until so approved."

d. The DA activity will then forward three executed copies to JALS-IP.

e. After approval, when approval is required by TJAG or his designee, JALS-IP will forward one executed copy to the USPTO for recordation in the recommended register if a specific patent or application is identified in the agreement. One signed copy will be retained in the JALS-IP and one will be returned to the activity.

6-15. Gratuitous grants

The IPCA may accept for the DA royalty-free licenses, assignments or releases in patents or patent applications in accordance with AR 1-100. Pursuant to AFARS 27.7011-92, these gratuitous grants will use the standard clauses in DFARS 227.7009-1 to the extent practical except that the words "grant" and "grant or" shall be substituted for "contract" and "contractor."

Chapter 7 Licensing of Army-Owned Inventions

7-1. Licensing policy

It is the policy of the DA to promote the utilization and commercialization of inventions arising from Army supported research and development.

7-2. Authority

a. Patent Rights in Inventions made with Federal Assistance, 35 USC 207-209.

b. Licensing of Government Owned Inventions, 37 CFR, Part 404.

c. The Federal Technology Transfer Act of 1986, Public Law 99-502 (codified as amendments to 15 USC 3701-3715) EO 12591, April 10, 1987.

7-3. Federal Technology Transfer Act of 1986

a. The authority to enter into cooperative research and development agreements and license, assign or waive rights to intellectual property developed either under such cooperation research and development agreements or from within individual laboratories has been delegated to Commanders and Directors of Army laboratories. The authority to disapprove or require modification of such agreements has been retained by the ASA(RD&A).

b. The Army regulation relating to cooperative research and development agreements and patent license agreements is AR 70-57.

c. When a laboratory commander or director desires to enter into a cooperative research and development agreement or desires to license a laboratory derived invention, the commander or director shall notify the intellectual property counsel assigned to the laboratory before entering into any negotiations for an agreement. If an intellectual property attorney is not assigned to a given laboratory, the laboratory commander or director shall notify the IPCA that the laboratory is planning to enter into a cooperative research and development agreement or planning to grant a license on a laboratory derived invention.

d. A laboratory assigned intellectual property attorney or an attorney from JALS-IP shall assist the laboratory commander or director and laboratory staff in the negotiations and development of all

cooperative research and development agreements and patent license agreements. Further, the intellectual property attorney shall be responsible for drafting the cooperative research and development agreement or patent license agreement. In all cases, the party entering into a cooperative research and development agreement or laboratory patent license with the laboratory shall be put on notice that the ASA(RD&A) may within 30 days disapprove or modify any agreement. The technology transfer manager will acknowledge the receipt of each agreement by a letter to the commander or director of the laboratory stating a control number and log date which officially begins the 30 day period during which the agreement may be disapproved or modified.

e. While the Technology Transfer Act of 1986 does provide for patent license agreements that are not included in a cooperative research and development agreement, such license agreements are granted under the authority of 35 USC 207-209 and shall comply with all the requirements of 35 USC 207-209 and 37 CFR 400 et. seq. However, for all other purposes such patent license agreements will be processed in accordance with the procedures in c above for processing cooperative research and development agreements. The ASA(RD&A) reserves the right to disapprove and modify any laboratory patent license agreement within the 30 day period set forth in c above.

f. A legal review of all cooperative research and development agreements and laboratory patent license agreements will be made by JALS-IP. The JALS-IP will advise the Deputy Assistant Secretary of the Army for Research and Technology, ATTN: SARD-TR, of the findings of the division and may recommend disapproval or modification of an agreement.

g. Before beginning any negotiation for a cooperative research and development agreement that will include a license under an Army-owned patent or patent application or negotiations for a laboratory patent license agreement, the intellectual property attorney assigned to the laboratory will provide JALS-IP with the patent number(s) or the application serial number(s) and request clearance to negotiate such a license from JALS-IP. JALS-IP will check the division records to determine if there has been any prior license activities involving the patent(s) or patent application(s) and will inform the requesting attorney of its findings and will grant clearance to negotiate unless a proposed license conflicts with any earlier granted license or licenses.

h. Immediately after the effective date of a cooperative research and development or laboratory patent license agreement, the laboratory will provide JALS-IP with a copy of the executed agreement. JALS-IP will maintain a record of all Army cooperative research and development agreements and a record of all laboratory patent license agreements.

i. At the end of every calendar year, each Army laboratory will provide JALS-IP with a report setting forth the status of each of the cooperative research and development agreements and patent license agreements of the laboratory and the total amount of royalties, if any, received by the laboratories under of the agreements. The report will also set forth in detail the disposition of any royalties received by the laboratory.

j. For patent license agreements not included as part of cooperative research and development agreements, any royalties received by a laboratory on such patent license agreements shall be divided as provided for in Army regulations and guidelines implementing the Technology Transfer Act of 1986.

7-4. Non-laboratory cooperative research and development agreements, and patent license agreements

a. Army employees other than employees assigned to an Army laboratory, may conceive patentable inventions that are assigned to the Army. While patents or patent applications on such inventions do not fall within the delegation authority set forth above in paragraph 7-3, the inventions may have commercial potential and should be made available to the private sector under a patent license agreement or as part of a cooperative research and development agreement.

b. For any patent license agreement or cooperative research and

development agreement not provided for in paragraph 7-3, an intellectual property attorney assigned to JALS-IP will in cooperation with personnel from the cognizant Army activity negotiate and draft such agreements. Such agreements will be processed in the same manner that laboratory derived cooperative research and development agreements and laboratory patent license agreements are processed as set forth in paragraph 7-3 including disapproval or modification by the ASA(RD&A).

Chapter 8 Invention Awards

8-1. General

a. Invention awards are cash Incentive Awards under the provisions of AR 672-20, chapter 3, granted to Government civilian employees and military personnel in recognition of their act of invention which has resulted in the filing of a patent application, a request for publication of a statutory invention registration (SIR), the grant of a United States patent, publication of a SIR, or the licensing of a patent application or patent.

b. In the event of any discrepancy between the dollar amount indicated for specific awards in this chapter and the amounts authorized in AR 672-20; the figure authorized by AR 672-20 shall govern, and the IPCA shall take appropriate measure to reconcile the discrepancy.

8-2. Responsibility of supporting patent counsel

a. *Initial award.* The supporting patent counsel will notify the Incentive Awards Office of the major Army command (MACOM) or organization on whose behalf a patent application or a SIR was prepared that the inventor is eligible for an initial invention award. The notification is made after the application has been filed in the USPTO, and assigned a serial number by the USPTO.

b. *Final award.* When a patent or SIR covering an invention has been issued or published, the supporting patent counsel will advise the appropriate Incentive Awards Office of that fact. This will establish the inventor's eligibility for the final invention award. When a Notice of Allowability has been issued for an application withheld from issue because of national security interests, it will have the status of an issued patent for final invention award eligibility.

8-3. Requirements for eligibility

a. Government civilian employees and military personnel may be considered for an initial award of \$200 if the conditions in paragraph 8-2a have been met. They may be considered for a final award of \$500 if the conditions in paragraph 8-2b have been met.

b. Supporting patent counsel may decide to file more than one patent or SIR application on an invention disclosure or to file continuation-in-part or divisional applications. If so, the sole inventor may be considered for the initial award of \$200 for each application and for the final award of \$500 for each patent issued or SIR published, or for each application under a Notice of Allowability, whether or not separate invention disclosures were originally involved. For a continuation-in-part application or a divisional application to qualify for invention awards, it must contain inventions independent and distinct from the invention of the original patent application.

c. When two or more eligible persons are co-inventors, each will receive an initial award of \$200. The final award to each eligible co-inventor will be \$250.

d. If one or more eligible inventors are joined as co-inventors with one or more persons who are ineligible to receive a cash award under this paragraph, the eligible inventors will be entitled to a pro rata share of the cash award that would be authorized if all co-inventors were eligible.

e. If a cash award has been paid for the invention under the Army Suggestion Program, awards under this paragraph are not authorized. An exception may be made if prior awards have totaled

less than that authorized by this chapter, in which case the difference between the two cash awards may be awarded.

f. An award paid on issuance of a Notice of Allowability precludes payment of a final award under this paragraph upon issuance of the patent on the same application covered by the Notice of Allowability.

g. Incentive awards committees will accept the following as valid evidence on which to approve awards:

(1) *Initial award.* A brief abstract of the invention from the patent application or request for publication of a SIR and a statement from the supporting patent counsel that the conditions set forth in paragraph 8-2a have been met.

(2) *Final award.* A statement from the supporting patent counsel that a patent, a SIR, or a Notice of Allowability has been issued. The statement should include the name of the inventor, title of the invention, and, in the case of a patent or a SIR, the date of issue or publication and the number of the patent or SIR.

8-4. Additional awards

When the actual value of the invention can be determined, an additional award, over and above the initial and final awards, may be made based on the invention's actual value. This award may be granted notwithstanding the granting of an award under a chapter of AR 672-20 other than chapter 3.

a. The procedures in AR 672-20 will be used to determine the amount of any additional award. The approval authorities for additional awards will be the same as those specified for a cash award in AR 672-20. An inventor is eligible for an additional award even when the making of the invention is within the inventor's job responsibility.

b. When an additional award is granted, the amount of this award will be reduced by the amount of any awards granted under paragraph 8-3a above. Co-inventors who are eligible to receive awards under this chapter will share any additional award equally. If one or more co-inventors are ineligible to receive awards under this chapter, any additional award will be shared as provided in paragraph 8-3d.

Chapter 9 Contracting for the Preparation and Prosecution of Patent Applications

9-1. Contracting policy

It is the policy of the DA not to contract for the preparation and prosecution of patent applications except under unusual circumstances. Every effort will be made to have patent applications prepared and prosecuted by staff attorneys and agents.

9-2. Invention evaluation committee

a. Every Army activity that averages more than 12 invention disclosures per year will establish an invention evaluation committee. The invention evaluation committee, with the assistance of patent counsel, will review all invention disclosures from the committee's activity for potential interest by the Army. When no potential Army interest is found, supporting patent counsel will determine whether the subject matter of the disclosure constitutes an invention. If the subject matter of the disclosure does constitute an invention, supporting patent counsel will institute a rights determination in accordance with chapter 2, section IV. Also the inventor(s) will be notified of the fact that the Army will not prepare a patent application on the invention.

b. When reviewing an invention disclosure, the invention evaluation committee shall assign a priority to an invention disclosure based on the level of Army interest. Further, the invention evaluation committee will take into account the number of staff attorneys or agents available to prepare patent applications. However, an invention disclosure shall not be assigned a low priority merely because the backlog of invention disclosures awaiting preparation of

patent applications is greater than the capability of the patent staff to timely prepare patent applications.

9-3. Patent applications and SIRs

Patent applications will normally be prepared on invention disclosures in the order in which they are received by the patent attorney. However, if the backlog of disclosures exceeds the capability of the patent staff to timely prepare patent applications on all of the invention disclosures, patent applications will be prepared first on the disclosures having the highest priority. Also, patent applications will be prepared on invention disclosures that may be subject to a statutory bar so that the application will be filed in the USPTO before the bar date. For those invention disclosures assigned a low priority and for which a commercial potential either does not exist or is limited, a SIR will be prepared in lieu of a patent application.

9-4. Patent application goals

The chief patent counsel shall establish a numerical goal of the number of patent applications that shall be prepared per year by each patent attorney or agent under his or her supervision. The numerical goal will be based on the average number of invention disclosures received per year and the overall duties of a given patent attorney or agent. Each chief counsel will provide the IPCA with the goals established for his or her office.

9-5. Contracting

When the backlog of invention disclosures exceeds the annual goals established for a given patent activity, that activity may consider contracting for the preparation and prosecution of patent applications. However, the chief counsel will explore other methods of reducing the backlog before contracting, such as reviewing of the invention disclosures on hand to determine if some of the disclosures should be closed without the preparation of a patent application, increasing the size of the staff, or increasing productivity. Only after the chief counsel has determined that contracting for the preparation and prosecution of patent applications is required to reduce the backlog, will contracting be permitted. Contracting for the preparation and/or the prosecution of patent applications must be approved by the IPCA annually at the beginning of each fiscal year.

9-6. Contract reports (RCS-JAG 79 (Contracting for the Preparation and Prosecution of Patent Applications))

After permission to contract is granted by the IPCA and contracting is initiated, the IPCA will be notified by the chief counsel that his or her office is contracting for the preparation and/or prosecution of patent applications. Thereafter, annually on 1 October of each year during which a patent activity is contracting, each contracting patent activity will submit a report on its contracting activities to the IPCA. Each report will cover the previous 12 months and will include the following:

- a.* The number of patent applications prepared under contract.
- b.* The number of applications for which the contractor is prosecuting an application in addition to preparing the application.
- c.* The dollar amount spent during the reporting period for contracting.
- d.* The number of invention disclosures on hand at the beginning and at the end of the reporting period.
- e.* The number of patent applications prepared by staff patent attorneys and agents during the reporting period.
- f.* A statement of planned contracting activity during the next 12 months.

Chapter 10 Patent Secrecy (Reserved)

Appendix A References

Section I Required Publications

AR 25-1

The Army Information Resource Management Program. (Cited in para 4-6e.)

AR 25-30

The Army Integrated Publishing and Printing Program. (Cited in para 4-6d.)

AR 25-400-2

The Modern Army Recordkeeping System. (Cited in paras 2-3a(2) and 4-9.)

AR 27-40

Litigation. (Cited in paras 5-2, 5-3, 5-7.)

AR 70-57

Military-Civilian Technology Transfer. (Cited in para 7-3b.)

AR 215-2

The Management and Operation of Army Morale, Welfare, and Recreation Programs and Nonappropriated Funds Instrumentalities. (Cited in para 4-6g.)

AR 380-5

Department of the Army Information Security Program. (Cited in paras 2-3b(2) and 2-5d(2).)

AR 600-50

Standards of Conduct for Department of Army Personnel. (Cited in para 4-3c.)

AR 672-20

Incentive Awards. (Cited in paras 8-1, 8-4, and 8-4a.)

AFARS 27.7006-90

(Cited in para 6-13.)

AFARS 27-7006-91

(Cited in para 6-2.)

AFARS 27-7006-94

(Cited in para 6-14.)

AFARS 27-7011-90

(Cited in para 6-11.)

AFARS 27-7011-92

(Cited in para 6-15.)

37 CFR, Chapter 11

(Cited in para 4-6b.)

37 CFR, Part 10

(Cited in para 1-9a.)

37 CFR, Part 404

(Cited in para 7-2b.)

37 CFR, Part 501

(Cited in paras 2-11, 2-16.)

37 CFR 400

(Cited in para 7-3e.)

37 CFR, Section 501.8

(Cited in paras 2-16a, and 2-16b.)

37 CFR 1.102

(Cited in para 1-5g.)

37 CFR 1.103

(Cited in para 1-5g.)

DA Pam 27-11

Army Patents. (Cited in para 2-5b.)

DFARS 48 CFR Chapter 2

(Cited in para 2-22a.)

DFARS Subpart 227.70

(Cited in paras 6-2 and 6-13.)

DFARS 227-480

(Cited in para 4-6h.)

DFARS 227-70

(Cited in para 6-13.)

DFARS 227.7004

(Cited in para 6-3.)

DFARS 227.7009-1

(Cited in para 6-15.)

EO 9424

(Cited in para 3-1a.)

EO 10096

(Cited in paras 1-5e, 2-11.)

EO 10930

(Cited in paras 1-5e, 2-18.)

EO 12591

(Cited in para 7-2c.)

Federal Acquisition Regulation, 48 CFR Chapter 2

(Cited in para 2-22a.)

Public Law 99-502

(Cited in para 7-2c.)

10 USC 2386

(Cited in paras 4-2b, 6-13, and 6-14a.)

15 USC 1051-1127

(Cited in para 4-7.)

15 USC 3701-3715

(Cited in para 7-2c.)

17 USC

(Cited in paras 4-1 and 4-6a.)

18 USC 203

(Cited in para 1-9b.)

18 USC 1905

(Cited in para 5-3.)

28 USC 520

(Cited in para 5-4a.)

28 USC 1498(b)

(Cited in para 4-3d.)

35 USC 41(b)
(Cited in para 2–8a.)

35 USC 183
(Cited in para 6–3.)

35 USC 184
(Cited in paras 2–13b(1) and 2–13b(3).)

35 USC 207–209
(Cited in paras 7–2a and 7–3e.)

35 USC 261
(Cited in para 3–1a.)

35 USC 267
(Cited in para 1–5g.)

Section II

Related Publications

A related publication is merely a source of additional information. The user does not have to read it to understand this publication.

AR 335–15
Management Information Control System

DOD 5200.1–R
DOD Information Program Regulation

DODD 5040.2
Visual Information

DODD 5535.4
Copyrighted Sound and Video Recordings

RCS: JAG–14
Intellectual Property Report

RCS: JAG–79
Contracting for the Preparation and Prosecution of Patent Applications

Section III

Prescribed Forms

DA Form 2871–R
Invention Rights Questionnaire (Prescribed in paras 2–5a, 2–14a, 2–14b, 2–14d, 2–14f, and 2–15d.)

DA Form 2872–R
Request for Determination of Invention Rights (Prescribed in paras 2–14d, 2–14f, 2–15, 2–16b, and 2–16c.)

DA Form 2873–R
License of Invention. (Prescribed in paras 2–7b, 2–12b, and 2–21.)

DA Form 2874–R
Assignment of Invention. (Prescribed in paras 2–12a(30), and 2–21.)

DA Form 4230–R
Supplemental Signature Sheet. (Prescribed in para 2–21.)

Section IV

Referenced Forms

DA Form 4734–R
Invention Disclosure

Glossary

Section I Abbreviations

AFARS

Army Federal Acquisition Regulation Supplement

ASA(RD&A)

Assistant Secretary of the Army (Research, Development, and Acquisition)

ASPAB

Armed Services Patent Advisory Board

CFR

Code of Federal Regulations

DAR

Defense Acquisition Regulation

DFARS

Department of Defense Federal Acquisition Regulation Supplement

DOD

Department of Defense

GPB

Government Patent Board

IPCA

Intellectual Property Counsel of the Army

JALS-IP

Intellectual Property Law Division, Office of the Judge Advocate General

MACOM

major Army command

MOS

military occupation specialty

USPTO

United States Patent and Trademark Office

SIR

Statutory Invention Registration

TJAG

The Judge Advocate General of the Army

USC

United States Code

Section II Terms

Army-owned invention

An invention owned by the United States of America, as represented by the Secretary of the Army.

Claim

A written demand for a sum of money, received by an activity of the DA, before a court suit is filed, alleging a right to compensation under an "applicable statute," based upon past actions of the DA. Such actions

could include acquisition or use of intellectual property or imposition of a secrecy order. Further actions, such as contemplated acquisition, are not a basis for a claim. Patent infringement claims must comply substantially with the requirements set forth in DFAR 9-404 and a claim must sufficiently identify the intellectual property involved and state the nature of the damages so that the validity of the claim may be properly considered.

Commissioner

The Commissioner of Patents and Trademarks

Employee

Any military member or civilian employee of the DA, including any part-time consultant or part-time employee.

Intellectual property

A product of the human mind which is protected by law. It includes, but is not limited to, patents, inventions, designs, copyrights, works of authorship, trademarks, service marks, technical data, trade secrets, computer software, unsolicited inventive proposals, and technical know-how. The intangible rights in such property are described as intellectual property rights.

Invention

Any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, or any new and original and ornamental design or on article of manufacture, or any variety of plant, which is or may be patentable under the patent laws of the United States or any foreign country.

Practical application

To manufacture in the case of a composition or product, to practice in the case of a process, or to operate in the case of a machine; under conditions as to establish that the invention is being worked and that its benefits are reasonable accessible to the public.

Assigned patent counsel

The principal patent attorney, patent advisor, or other legal advisor providing support to an activity, command or installation on intellectual property matters, whether directly employed by that activity, command or installation or acting under a support agreement. For those activities, commands or installations not having assigned patent counsel, JALS-IP provides this support.

Potential Army interest in an invention

Possible use of the invention by the Army or that the invention has commercial potential or may be included in a cooperative research and development agreement.

Chief Counsel

The chief or supervisor of an Army intellectual property law or patent law activity.

Section III

Special Abbreviations and Terms

This section contains no entries.

Index

This index is organized alphabetically by topic and subtopic within a topic. Topics and subtopics are identified by paragraph number.

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INVENTION RIGHTS QUESTIONNAIRE

For use of this form, see AR 27-60; the proponent agency is OTJAG

READ THE INSTRUCTIONS BELOW BEFORE COMPLETING THIS FORM

o Under Executive Order 10096, 23 January 1950, and AR 27-60, whenever an invention is made by a military or civilian employee of the Department of the Army, it is necessary to determine the rights in the invention as between the Government and the inventor. There are three ways in which rights may be determined:

- The inventor may be entitled to all rights and the Government to none (and hence the inventor need sign no document giving any rights to the Government);
- The Government may be entitled to a license permitting it to use or practice the invention and the inventor entitled to all other rights (and hence the inventor signs a license to the Government);
- The Government may be entitled to all rights and the inventor to none (and hence the inventor signs an assignment to the Government).

o Separate and distinct from the determination of rights, and even though it may appear that the inventor is entitled to all rights in the invention, the inventor may sign a license permitting the Government to use and practice the invention in return for which the Government will prosecute an application for a patent on the invention at no expense to the inventor, provided the Government is sufficiently interested in the invention.

o If the inventor desires voluntarily to assign all rights in the invention to the Government, he may complete PART A below. The remaining questions need not be answered.

o If the inventor does not desire to voluntarily assign all rights in the invention to the Government, it is necessary that all questions be answered completely. The determination of the rights in the invention depends upon the facts and circumstances under which the invention was made. In almost every case a failure to provide sufficient information works to the disadvantage of the inventor. If additional space is needed to fully answer any question, an attached sheet will be used. Many questions may be answered by a check mark; however, every question must be answered even if the appropriate answer is "No", "None", or "NA" (not applicable). Print or type all answers.

SECTION I - TO BE COMPLETED BY THE INVENTOR

PART A - BASIC DATA

1. BRIEF TITLE OF INVENTION

2. NAME OF INVENTOR

3. GRADE AT TIME INVENTION WAS MADE

4. JOB TITLE AT TIME INVENTION WAS MADE

5. COMPLETE NAME OF ORGANIZATION AT TIME INVENTION WAS MADE *(Include, as applicable, unit, section, branch, division, department, laboratory, post, camp, station, branch of Army)*

6. I DESIRE TO ASSIGN TO THE UNITED STATES GOVERNMENT THE ENTIRE RIGHT, TITLE AND INTEREST IN AND TO THE ABOVE IDENTIFIED INVENTION. *(Signature below is necessary only if assigning rights of invention to the Government. Completion of the remainder of this form is not necessary if you sign below.)*

a. SIGNATURE OF INVENTOR

b. DATE

SECTION I - (CONTINUED)

PART B - MAKING OF THE INVENTION

NOTE: The making of an invention generally involves its conception or discovery followed by a series of acts which establish the correctness or operativeness of the idea. Depending upon the nature of the invention, these acts may involve the making of sketches, drawings, written descriptions, the making and testing of a model, the carrying out of a process, or the production of a composition of matter.

7. BEFORE THE INVENTION WAS PHYSICALLY TRIED OUT OR PRODUCED IN MODEL OR WORKING FORM OR A COMPOSITION OF MATTER PRODUCED, WERE THE ESSENTIAL ELEMENTS OF THE INVENTION IN ITS OPERABLE AND PRACTICABLE FORM FULLY DISCLOSED IN WRITTEN DESCRIPTION, SKETCHES OR DRAWINGS IN SUCH A MANNER THAT THE INVENTION COULD BE PRODUCED OR PRACTICED FROM THEM WITHOUT THE EXERCISE OF ANY FURTHER INVENTIVE SKILL BY A PERSON WHO IS SKILLED IN THE FIELD TO WHICH THE INVENTION RELATES? *(If the answer is "yes" give the date such description, sketches or drawings were completed.)*

NO YES

DATE _____

8. WAS A MODEL MADE; OR, IF THE INVENTION IS A PROCESS, WAS THE PROCESS TRIED OUT; OR, IF THE INVENTION IS A COMPOSITION OF MATTER, WAS A COMPOSITION PRODUCED? *(If the answer is "yes" give the date such action took place.)*

NO YES

DATE _____

9. IF A MODEL WAS MADE AND TESTED, A COMPOSITION PRODUCED OR A PROCESS CARRIED OUT, WAS IT DONE BECAUSE:

	YES	NO
a. IT WAS DESIRED TO TEST THE OPERABILITY OR PRACTICABILITY OF THE INVENTION?		
b. IT WAS DESIRED TO TEST THE USEFULNESS OF THE INVENTION TO THE GOVERNMENT?		
c. IF IT WAS DONE FOR SOME OTHER REASON STATE THAT REASON:		

10. APPROXIMATELY HOW MUCH TOTAL TIME WAS SPENT BY YOU PERSONALLY IN MAKING THE INVENTION?

a. PERSONAL TIME *(In hours) (Nonduty working hours)*

b. GOVERNMENT TIME *(In hours) (Duty hours including paid overtime)*

11. EXPLAIN BRIEFLY THE USE, IF ANY, OF THE FOLLOWING ITEMS IN CONNECTION WITH THE MAKING OF THE INVENTION:

a. THE USE OF GOVERNMENT FACILITIES *(Buildings, such as laboratories, shops or office buildings, but not buildings such as barracks or recreation buildings.)*

b. THE USE OF GOVERNMENT EQUIPMENT *(Such as instruments, tools or machinery.)*

c. THE USE OF GOVERNMENT MATERIALS *(Supplies, reagents, parts or any other materials; if scrap, waste or salvage materials were used, so state; give estimate monetary value of materials consumed.)*

d. THE USE OF GOVERNMENT FUNDS WHICH WERE ACTUALLY OBLIGATED OR EXPENDED FOR THE PURPOSE OF MAKING THE INVENTION. *(Other than salaries and wages, and Government contributions covered under other parts of this question.)*

SECTION I - (CONTINUED)

PART B - MAKING OF THE INVENTION (CONTINUED)

e. CONTRIBUTION OF INFORMATION BY THE GOVERNMENT *(Information which was available to you by reason of your official duties and not otherwise.)*

f. CONTRIBUTION OF TIME OR SERVICES OF OTHER GOVERNMENT EMPLOYEES DURING NORMAL OR OVERTIME WORKING HOURS *(State approximate number of hours and type of assistance.)*

PART C - RELATIONSHIP BETWEEN THE INVENTION AND THE INVENTOR'S DUTIES

12. BRIEFLY, WHAT PROMPTED YOU TO MAKE THE INSTANT INVENTION OR HOW DID YOU GET THE IDEA FOR THE INVENTION?

13. BRIEFLY AND IN BROAD TERMS, WHAT IS THE INVENTION SUPPOSED TO ACCOMPLISH?

14. WERE YOU EMPLOYED OR ASSIGNED:

- a. TO INVENT OR IMPROVE OR PERFECT ANY PROCESS, MACHINE, MANUFACTURE, DESIGN, OR COMPOSITION OF MATTER?
- b. TO CONDUCT OR PERFORM RESEARCH OR DEVELOPMENT WORK?
- c. TO SUPERVISE, DIRECT, COORDINATE OR REVIEW GOVERNMENT-FINANCED OR CONDUCTED RESEARCH OR DEVELOPMENT WORK?
- d. TO ACT IN A LIAISON CAPACITY AMONG GOVERNMENT OR NON-GOVERNMENTAL AGENCIES

YES NO

YES	NO

15. DESCRIBE THE DUTIES, PROJECT OR AREA OF WORK TO WHICH YOU WERE ASSIGNED AT THE TIME THE INVENTION WAS MADE. STATE IN SUFFICIENT DETAIL TO MAKE THEM UNDERSTANDABLE.

SECTION I -(CONTINUED)

PART C - RELATIONSHIP BETWEEN THE INVENTION AND THE INVENTOR'S DUTIES (CONTINUED)

16. STATE ANY FACTS OR CIRCUMSTANCES NOT COVERED IN YOUR ANSWERS ABOVE WHICH YOU BELIEVE WOULD HAVE A BEARING ON EITHER THE GOVERNMENT'S OR YOUR RIGHTS IN THE INVENTION.

17. SIGNATURE BELOW IS NECESSARY IF YOU ARE NOT ASSIGNING RIGHTS OF THE INVENTION TO THE GOVERNMENT.

a. SIGNATURE OF INVENTOR

b. DATE

SECTION II -

TO BE COMPLETED BY THE IMMEDIATE SUPERVISOR OF THE INVENTOR AT THE TIME THE INVENTION WAS MADE

18. AS THE INVENTOR'S SUPERVISOR AT THE TIME OF THE INVENTION, WHAT CONTACT DID YOU HAVE WITH THE INVENTOR AND TO WHAT EXTENT DID YOU HAVE ACTUAL PERSONAL KNOWLEDGE OF THE INVENTOR'S DUTIES AND THE SUBSTANCE OF HIS INVENTION?

19. AT THE TIME THE INVENTION WAS MADE, WHAT WERE THE OFFICIAL DUTIES OF THE INVENTOR? IN ADDITION, SUBMIT A COPY OF THE JOB DESCRIPTION THE INVENTOR WAS WORKING UNDER AT THE TIME THE INVENTION WAS MADE.

20. AT THE TIME THE INVENTION WAS MADE, WHAT WERE THE SPECIFIC JOB OR PROJECT ASSIGNMENTS OF THE INVENTOR WHICH RELATED TO THE INVENTION AND WHAT WERE THEY INTENDED TO ACCOMPLISH?

SECTION II - (CONTINUED)

21. TO THE BEST OF YOUR ABILITY, HOW WOULD YOU DESCRIBE THE RELATIONSHIP BETWEEN THE INVENTION AND THE INVENTOR'S SPECIFIC JOB OR PROJECT ASSIGNMENT MOST CLOSELY RELATED TO THE INVENTION AT THE TIME IT WAS MADE.

	YES	NO
DIRECTLY RELATED	<input type="checkbox"/>	<input type="checkbox"/>
RELATED, BUT NOT DIRECTLY	<input type="checkbox"/>	<input type="checkbox"/>
UNRELATED	<input type="checkbox"/>	<input type="checkbox"/>

22. WAS THE INVENTION THE SET GOAL OF A SPECIFIC TASK ASSIGNED TO THE INVENTOR? *(If the answer is "yes" questions 23 and 24 need not be answered.)*

YES	NO
<input type="checkbox"/>	<input type="checkbox"/>

23. ONCE THE INVENTOR HAD THE IDEA FOR THE INVENTION, WOULD HE/SHE HAVE HAD TO OBTAIN THE APPROVAL OF HIS/HER SUPERIORS TO CONTINUE DEVELOPMENT WORK ON IT AS A GOVERNMENT PROJECT OR COULD HE/SHE HAVE PROCEEDED UNDER HIS/HER OWN AUTHORITY?

NEEDED APPROVAL	YES	NO
	<input type="checkbox"/>	<input type="checkbox"/>
COULD PROCEED ON HIS/HER OWN	<input type="checkbox"/>	<input type="checkbox"/>

24. IF THE ANSWER TO QUESTION 23 WAS THAT THE INVENTOR "NEEDED APPROVAL", DO YOU THINK THAT THE INVENTION WAS SO RELATED TO HIS/HER DUTIES THAT HE/SHE WAS UNDER AN OBLIGATION TO REVEAL IT TO HIS/HER SUPERIORS WITH THE IDEA OF OBTAINING AUTHORIZATION OR AN ASSIGNMENT TO PERFORM DEVELOPMENT WORK ON IT?

YES	NO
<input type="checkbox"/>	<input type="checkbox"/>

25. ARE YOU IN ACCORD WITH THE REPLIES WHICH THE INVENTOR HAS MADE TO EACH OF THE ITEMS IN SECTION I ABOVE?

YES	NO
<input type="checkbox"/>	<input type="checkbox"/>

26. IF THE ANSWER TO QUESTION 25 IS "NO", DISCUSS AND EXPLAIN BELOW.

27. SUPERVISOR'S TITLE AT TIME INVENTION WAS MADE

28. DATE

29. TYPED OR PRINTED NAME OF SUPERVISOR

30. SIGNATURE OF SUPERVISOR

REQUEST FOR DETERMINATION OF INVENTION RIGHTS

GPB CASE NO. 10 -

For use of this form, see AR 27-80; the proponent agency is OTJAG

1. TO		2. FROM	
3. NAME OF INVENTOR		4. DATE	
5. TITLE OF INVENTION			
6. DESCRIPTION OF INVENTION			
7. PATENT APPLICATION NUMBER		8. DATE APPLICATION WAS FILED	
9. EXISTING GOVERNMENT RIGHTS <input type="checkbox"/> EXECUTED LICENSE FOR GOVERNMENT FILING OF PATENT APPLICATION <input type="checkbox"/> OTHER INSTRUMENT EXECUTED (Specify below)		10. EMPLOYMENT STATUS OF INVENTOR (<i>Title, grade, office, installation</i>)	
11. RECOMMENDATION			
THE INFORMATION BELOW IS TO BE COMPLETED BY THE INTELLECTUAL PROPERTY DIVISION (OTJAG)			
12. DEPARTMENT OF THE ARMY DETERMINATION			
13. TYPED NAME AND TITLE		14. SIGNATURE	15. DATE

LICENSE OF INVENTION

For use of this form, see AR 27-60; the proponent agency is OTJAG

Title of Invention: _____

Inventor(s) Name: _____

*Application Serial No. _____

*Date Oath Executed: _____ *Filing Date: _____

(*Data not known at execution may be added for better identification.)

WHEREAS, the nature of the services or contributions of the Government of the United States are such as to justly and lawfully entitle the Government to the hereinafter recited rights and licenses; and

WHEREAS, the Government of the United States has agreed to prepare a patent application covering the above invention and to file same and prosecute it before the Patent Office at no expense to the inventor(s);

NOW, THEREFORE, in consideration of the premises, the undersigned;

ONE: do(es) hereby grant to the Government of the United States of America as represented by the Secretary of the Army, his successors in office, or designees, a nonexclusive, irrevocable, royalty-free license throughout the world in the above invention and under any patent domestic or foreign which is or may be granted thereon, for the full term thereof and any continuation, continuation-in-part or division of said application and any reissue or extension of any patent granted thereon, to make or have made, to use or have used the invention on behalf of the Government, and to sell or otherwise dispose of in accordance with law any and all articles, machines, or compositions of matter embodying said invention, with power to grant licenses for all governmental purposes including but not limited to power to issue sublicenses in furtherance of the foreign policies of the Government.

TWO: do(es) hereby grant to the United States of America, as represented by the Secretary of the Army, his successors in office, or designees, the irrevocable and exclusive power to prosecute the application for United States patent on said invention, including any continuations, and divisions thereof or substitutions thereof; as well as any applications for reissue of any patents issued thereon, with the power to conduct and make adjustments and settlements of any interferences in which any of said applications or patents resulting therefrom may become involved, said power including the right to grant reciprocal royalty-free, nonexclusive licenses in behalf of the inventor(s) and the Government necessary to accomplish said adjustments and settlements;

THREE: do(es) hereby agree to perform upon request all acts required to obtain the grant of Letters Patent on any application under TWO above, and to render effective all other rights herein granted to the Government; and to provide any further personally known information and available documents and to execute any further documents necessary to the prosecution of said patent applications or to the prosecution and settlement of interferences;

FOUR: do(es) further agree, notwithstanding the provisions of ONE above, to assign to the Government upon its request all right, title and interest in said invention in those foreign countries in which the Government, within eight months of the filing of the United States application for patent, determines to cause an application to be filed.

NOTE: The inventor(s) may delete paragraph FOUR by crossing it out and initialing in the margin. (This form may be used for applications filed by the inventor(s) by deleting the second WHEREAS, and paragraphs TWO and THREE.)

Inventor's Signature: _____

(First name)

(Middle Initial)

(Last name)

Duty Address: _____

(Locality)

(County)

(State)

Date: _____ Inventor's Typed Name: _____

State of _____)

) SS.

County of _____)

On the above date _____ known to me to be the individual described in and who executed the foregoing instrument duly appeared before me and acknowledged to me that he executed the same as his own free act and deed.

(SEAL)

(Signature of notary public)

My Commission expires on _____

Unclassified

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