EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of this title.

§ 203. March-in rights

(a) With respect to any subject invention in which a small business firm or nonprofit organization has acquired title under this chapter, the Federal agency under whose funding agreement the subject invention was made shall have the right, in accordance with such procedures as are provided in regulations promulgated hereunder to require the contractor, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the contractor, assignee, or exclusive licensee refuses such request, to grant such a license itself, if the Federal agency determines that such—

(1) action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(2) action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee, or their licensees;

(3) action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee, or licensees; or

(4) action is necessary because the agreement required by section 204 has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of its agreement obtained pursuant to section 204.

(b) A determination pursuant to this section or section 202(b)(4)[1] shall not be subject to chapter 71 of title 41. An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Court of Federal Claims, which shall have jurisdiction to determine the appeal on the record and to affirm, reverse, remand or modify, as appropriate, the determination of the Federal agency. In cases described in paragraphs (1) and (3) of subsection (a), the agency's determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3022; amended Pub. L. 98–620, title V, § 501(9), Nov. 8, 1984, 98 Stat. 3367; Pub. L. 102–572, title IX, § 902(b)(1), Oct. 29, 1992, 106 Stat. 4516; Pub. L. 107–273, div. C, title III, § 13206(a)(14), Nov. 2, 2002, 116 Stat. 1905; Pub. L. 111–350, § 5(i)(2), Jan. 4, 2011, 124 Stat. 3850.)

[1] See References in Text note below.

REFERENCES IN TEXT

Section 202(b)(4), referred to in subsec. (b), was redesignated section 202(b)(3) of this title by Pub. L. 111–8, div. G, title I, § 1301(h), Mar. 11, 2009, 123 Stat. 829.

AMENDMENTS

2011—Subsec. (b). Pub. L. 111–350 substituted ''chapter 71 of title 41'' for ''the Contract Disputes Act (41 U.S.C. § 601 et seq.)''.

2002—Pub. L. 107–273 redesignated par. (1) as subsec. (a) and former subpars. (a) to (d) as pars. (1) to (4), respectively, redesignated former par. (2) as subsec. (b), struck out quotation marks and comma before ''as appropriate'', and substituted ''paragraphs (1) and (3) of subsection (a)'' for ''paragraphs (a) and (c)''.

1992—Par. (2). Pub. L. 102–572 substituted ''United States Court of Federal Claims'' for ''United States Claims Court''.

1984—Pub. L. 98–620 designated existing provisions as par. (1) and added par. (2).

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102–572 effective Oct. 29, 1992, see section 911 of Pub. L. 102–572, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

§ 204. Preference for United States industry

Notwithstanding any other provision of this chapter, no small business firm or nonprofit organization which receives title to any subject invention and no assignee of any such small business firm or nonprofit organization shall grant to any person the exclusive right to use or sell any subject invention in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by the Federal agency under whose funding agreement the invention was made upon a showing by the small business firm, nonprofit organization, or assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3023.)

§ 205. Confidentiality

Federal agencies are authorized to withhold from disclosure to the public information disclosing any invention in which the Federal Government owns or may own a right, title, or interest (including a nonexclusive license) for a reasonable time in order for a patent application to be filed. Furthermore, Federal agencies shall not be required to release copies of any document which is part of an application for patent filed with the United States Patent and Trademark Office or with any foreign patent office.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3023.)

§ 206. Uniform clauses and regulations

The Secretary of Commerce may issue regulations which may be made applicable to Federal

agencies implementing the provisions of sections 202 through 204 of this chapter and shall establish standard funding agreement provisions required under this chapter. The regulations and the standard funding agreement shall be subject to public comment before their issuance.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3023; amended Pub. L. 98–620, title V, § 501(10), Nov. 8, 1984, 98 Stat. 3367.)

AMENDMENTS

1984—Pub. L. 98–620 amended section generally. Prior to amendment, section read as follows: ''The Office of Federal Procurement Policy, after receiving recommendations of the Office of Science and Technology Policy, may issue regulations which may be made applicable to Federal agencies implementing the provisions of sections 202 through 204 of this chapter and the Office of Federal Procurement Policy shall establish standard funding agreement provisions required under this chapter.''

§ 207. Domestic and foreign protection of federally owned inventions

(a) Each Federal agency is authorized to—

(1) apply for, obtain, and maintain patents or other forms of protection in the United States and in foreign countries on inventions in which the Federal Government owns a right, title, or interest;

(2) grant nonexclusive, exclusive, or partially exclusive licenses under federally owned inventions, royalty-free or for royalties or other consideration, and on such terms and conditions, including the grant to the licensee of the right of enforcement pursuant to the provisions of chapter 29 of this title as determined appropriate in the public interest;

(3) undertake all other suitable and necessary steps to protect and administer rights to federally owned inventions on behalf of the Federal Government either directly or through contract, including acquiring rights for and administering royalties to the Federal Government in any invention, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction, to facilitate the licensing of a federally owned invention; and

(4) transfer custody and administration, in whole or in part, to another Federal agency, of the right, title, or interest in any federally owned invention.

(b) For the purpose of assuring the effective management of Government-owned inventions, the Secretary of Commerce is authorized to—

(1) assist Federal agency efforts to promote the licensing and utilization of Government-owned inventions;

(2) assist Federal agencies in seeking protection and maintaining inventions in foreign countries, including the payment of fees and costs connected therewith; and

(3) consult with and advise Federal agencies as to areas of science and technology research and development with potential for commercial utilization.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3023; amended Pub. L. 98–620, title V, § 501(11), Nov. 8, 1984, 98 Stat. 3367; Pub. L. 106–404, § 6(2), Nov. 1, 2000, 114 Stat. 1745.)

AMENDMENTS

2000—Subsec. (a)(2). Pub. L. 106–404, § 6(2)(A), substituted ''inventions'' for ''patent applications, patents, or other forms of protection obtained''.

Subsec. (a)(3). Pub. L. 106–404, § 6(2)(B), inserted '', including acquiring rights for and administering royalties to the Federal Government in any invention, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction, to facilitate the licensing of a federally owned invention'' after ''or through contract''.

1984—Pub. L. 98–620 designated existing provisions as subsec. (a) and added subsec. (b).

EX. ORD. NO. 9424. ESTABLISHMENT OF A REGISTER OF GOVERNMENT INTERESTS IN PATENTS

Ex. Ord. No. 9424, Feb. 18, 1944, 9 F.R. 1959, provided:

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

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

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

4. The Commissioner of Patents [now Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office], with the approval of the Secretary of Commerce, shall prescribe such rules and regulations as he may deem necessary to effectuate the purposes of this order.

EX. ORD. NO. 9865. PATENT PROTECTION ABROAD OF INVENTIONS RESULTING FROM RESEARCH FINANCED BY THE GOVERNMENT

Ex. Ord. No. 9865, June 14, 1947, 12 F.R. 3907, as amended by Ex. Ord. No. 10096, Jan. 23, 1950, 15 F.R. 389, provided:

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

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