

§ 1245.200

each petition for waiver shall be recorded by the Board and be available to the public.

Subpart 2—Claims for Patent and Copyright Infringement

AUTHORITY: 51 U.S.C. 20112–20113; 22 U.S.C. 2356; 35 U.S.C. 181–188 and 286; and 28 U.S.C. 1498.

SOURCE: 77 FR 14687, Mar. 13, 2012, unless otherwise noted.

§ 1245.200 Purpose.

The purpose of this subpart is to set forth policies and procedures for the filing and disposition of claims of infringement of privately owned rights in patented inventions or copyrighted works asserted against NASA.

§ 1245.201 Objectives.

Whenever a claim of infringement of privately owned rights in patented inventions or copyrighted works is asserted against NASA, all necessary steps shall be taken to investigate and to administratively settle, deny, or otherwise dispose of such claim prior to suit against the United States. The General Counsel, or designee, is authorized to investigate, settle, deny, or otherwise dispose of all claims of patent and copyright infringement, pursuant to the above-cited statutory authority.

§ 1245.202 Contents of communication initiating claim.

(a) *Requirements for claim.* A patent or copyright infringement claim for compensation, asserted against the United States as represented by NASA under any of the applicable statutes cited above, must be actually communicated to and received by an organization, office, or within a NASA Center. Claims must be in writing and must include the following:

- (1) An allegation of infringement.
- (2) A request for compensation, either expressed or implied.
- (3) A citation to the patent(s) or copyright(s) alleged to be infringed.
- (4) In the case of a patent infringement claim, a sufficient designation to permit identification of the accused subject matter (e.g. article(s) or proc-

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ess(es)) alleged to infringe the patent(s), giving the commercial designation, if known to the claimant, or, in the case of a copyright infringement claim, the accused subject matter (e.g. act(s) or work(s)) alleged to infringe the copyright.

(5) In the case of a patent infringement claim, a designation of at least one claim of each patent alleged to be infringed or, in the case of a copyright infringement claim, a copy of each work alleged to be infringed.

(6) As an alternative to paragraphs (a)(4) and (5) of this section, certification that the claimant has made a bona fide attempt to determine the accused subject matter, which is alleged to infringe the patent(s), or the accused subject matter alleged to infringe the copyright(s), but was unable to do so, giving reasons and stating a reasonable basis for the claimant's belief that the patent(s) or copyright(s) is being infringed.

(b) *Additional information for patent infringement claims.* In addition to the information listed in paragraph (a) of this section, the following material and information generally are necessary in the course of processing a claim of patent infringement. Claimants are encouraged to furnish this information at the time of filing a claim to permit rapid processing and resolution of the claim.

(1) A copy of the asserted patent(s) and identification of all claims of the patent(s) alleged to be infringed.

(2) Identification of all procurements known to the claimants that involve the accused item(s) or process(es), including the identity of the vendor(s) or contractor(s) and the Government acquisition activity or activities.

(3) A detailed identification and description of the accused article(s) or process(es) used or acquired by the Government, particularly where the article(s) or process(es) relate to a component(s) or subcomponent(s) of an item acquired, and an element-by-element comparison of representative claim(s) with the accused article(s) or process(es). If available, the identification and description should include

documentation and drawings to illustrate the accused article(s) or process(es) in sufficient detail to enable determining whether the claim(s) of the asserted patent(s) read on the accused article(s) or process(es).

(4) Names and addresses of all past and present licensees under the patent(s) and copies of all license agreements and releases involving the patent(s). In addition, an identification of all assignees of the patent(s).

(5) A list of all persons to whom notices of infringement have been sent, including all departments and agencies of the Government, and a statement of the status or ultimate disposition of each.

(6) A brief description of all litigation involving the patent(s) which was initiated at any time prior to the claim being filed and their present status. This includes any defenses or counterclaims made and positions maintained by opposing parties regarding invalidity of the patent(s).

(7) A description of Government employment or military service, if any, by the inventor(s) or patent owner(s) including a statement from the inventor(s) or patent owner(s) certifying whether the invention claimed in the patents was conceived or reduced to practice, in part or in whole, during Government employment and whether such inventor(s) or owner(s) occupied any position from which such inventor(s) or owner(s) was capable of ordering, influencing, or inducing use of the invention by the Government.

(8) A list of all contract(s) between the Government and inventor(s), patent owner(s), or anyone in privity with the patent owner(s), under which work relating to the patented subject matter was performed.

(9) Evidence of title to the asserted patent(s) or other right to make the claim.

(10) A copy of the United States Patent and Trademark Office (USPTO) file history of each patent, if it is available to the claimant. Indicate whether the patent has been the subject of any interference proceedings, certification of correction request, reexamination, or reissue proceedings at the USPTO, or lapsed for failure to pay any maintenance fee. In addition, the status of all

corresponding foreign patents and patent applications and full copies of the same.

(11) Pertinent prior art known to the claimant not contained in the USPTO file, for example, publications and foreign prior art. In addition to the foregoing, if claimant can provide a statement that the investigation may be limited to the specifically identified accused article(s) or process(es) or to a specific acquisition (e.g. identified contract(s)), it may speed disposition of the claim. Claimants are also encouraged to provide information on any ancillary matters that may have a bearing on validity or infringement.

(c) *Denial for refusal to provide information.* In the course of investigating a claim, it may become necessary for NASA to request information in the control and custody of the claimant that is relevant to the disposition of the claim. Failure of the claimant to respond to a request for such information shall be sufficient reason alone for denying a claim.

§ 1245.203 Incomplete notice of infringement.

(a) If a communication alleging patent infringement or copyright infringement is received that does not meet the requirements set forth in § 1245.202(a), the sender shall be advised in writing by the Agency Counsel for Intellectual Property:

(1) That the claim for infringement has not been satisfactorily presented; and

(2) Of the elements necessary to establish a claim.

(b) A communication, in which no infringement is alleged in accordance with § 1245.202(a), such as a mere proffer of a license, shall not be considered a claim for infringement.

§ 1245.204 Indirect notice of infringement.

A communication by a patent or copyright owner to addressees other than those specified in § 1245.202(a), such as NASA contractors, including contractors operating Government-owned facilities, alleging that acts of infringement have occurred in the performance of a Government contract, grant, or other arrangement, shall not