

or later if NASA has not initiated the procedures, then NASA shall, within 60 days after it receives the comment, either initiate the procedures or notify the waiver recipient, in writing, that it will not pursue march-in rights on the basis of the available information.

(c) If march-in procedures are to be initiated, the Administrator of NASA, or designee, shall undertake or refer the matter for fact finding to the NASA Board of Contract Appeals (BCA) and its Chairperson.

(d) Fact-finding shall be conducted by the NASA BCA and its Chairperson in accordance with its procedures that are consistent with the procedures set forth in 37 CFR 401.6. Any portion of the march-in proceeding, including a fact-finding hearing that involves testimony or evidence relating to the utilization or efforts at obtaining utilization that are being made by the waiver recipient, its assignee, or licensees shall be closed to the public, including potential licensees. In accordance with 35 U.S.C. 202(c)(5), NASA shall not disclose any such information obtained during a march-in proceeding to persons outside the Government except when such release is authorized by the waiver recipient (assignee or licensee).

(e) The preparation of written findings of fact and recommended determination by the Chairperson of the NASA BCA and the determination by the Administrator, or designee, of NASA shall be in accordance with 37 CFR 401.6.

(f) NASA may, at any time, terminate a march-in proceeding if it is satisfied that it does not wish to exercise march-in rights.

**§ 1245.118 Record of decisions.**

The findings of fact and recommendations made to the Administrator by the Board with respect to each petition for waiver shall be recorded by the Board and be available to the public.

**Subpart 2 [Reserved]**

**Subpart 3—NASA Foreign Patent Program**

AUTHORITY: 42 U.S.C. 2457(h) and Executive Orders 9865 and 10096.

SOURCE: 30 FR 1844, Feb. 10, 1965, unless otherwise noted.

**§ 1245.300 Scope of subpart.**

This subpart establishes policy, criteria, and procedures concerning the NASA Foreign Patent Program.

**§ 1245.301 Inventions under NASA contracts.**

(a) Pursuant to §1245.113, NASA has facilitated the filing of foreign patent applications by contractors by providing for the granting of a waiver of title to a contractor to any identified invention in countries other than the United States in the event the Administrator of NASA does not desire to file a patent application covering the invention in such countries. However, any such waiver is subject to the reservation by the Administrator of the license required to be retained by NASA under section 305(f) of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457(f)).

(b) Conversely, where the principal rights in an invention made under a NASA contract remain in the contractor by virtue of waiver, §1245.19(a)(5) provides that the contractor, upon written request, will convey to the Administrator of NASA the entire right, title, and interest in the invention in any foreign country in which the contractor has elected not to file a patent application.

(c) With respect to inventions in which NASA has acquired and retained the principal rights, NASA will file patent applications in countries other than the United States on inventions selected in accordance with the criteria set forth in §1245.303.

**§ 1245.302 Inventions by NASA employees.**

(a) The foreign rights of NASA and of the NASA employee making an invention are determinable in accordance with Executive Orders 9865 and 10096

### § 1245.303

and Government Patent Board Administrative Order No. 6 issued pursuant thereto.

(b) Where NASA acquires an assignment of the domestic rights in an invention made by a NASA employee, NASA will also obtain an option to acquire the foreign rights, including the right to file foreign patent applications on the invention.

(c) Where NASA is entitled to only a governmental license in the invention, the principal foreign rights in the invention are retained by the employee unless he agrees in writing to assign such rights to NASA.

#### § 1245.303 Criteria.

The following categories of inventions will be considered for the filing of patent applications by NASA in countries other than the United States:

(a) Inventions which may be utilized abroad in governmental programs of the United States.

(b) Inventions which may be exploited abroad in the public interest by license to U.S. nationals or others.

(c) Inventions which may be utilized in applications type satellites, such as communications and meteorological satellites.

(d) Inventions considered to be basic discoveries or of major significance in an art.

(e) Inventions in fields which directly concern the public health or public welfare.

#### § 1245.304 Procedures.

(a) The patent counsel at each NASA field installation will review all invention disclosures at the time of docketing and will expedite the processing and preparation of a U.S. patent application, if justified, on those inventions which appear to fall within the criteria set forth in § 1245.303. The patent counsel will make a recommendation as to whether or not foreign patent coverage appears justified at the time of assigning a priority evaluation to a disclosed invention.

(b) Preparation and filing of patent applications in foreign countries will be subject to approval of the Assistant General Counsel for Patent Matters, NASA Headquarters.

### 14 CFR Ch. V (1-1-07 Edition)

(c) The Office of Assistant General Counsel for Patent Matters will budget for and administer the filing of all patent applications in countries other than the United States.

(d) Coordination with other interested NASA offices will be undertaken by the Assistant General Counsel for Patent Matters.

### Subpart 4—Foreign Patent Licensing Regulations

AUTHORITY: 42 U.S.C. 2457(g) and (h).

SOURCE: 31 FR 10958, Aug. 18, 1966, unless otherwise noted.

#### § 1245.400 Scope of subpart.

(a) The subpart establishes the policy, terms, conditions, and procedures under which NASA-owned foreign patents and patent applications may be licensed.

(b) The provisions of this subpart apply to all NASA-owned patents granted in countries other than the United States and to NASA-owned patent applications pending in such countries and supplement the provisions of subpart 2 of this part for foreign patent licensing.

#### § 1245.401 Policy.

The foreign licensing program of the National Aeronautics and Space Administration serves to promote and utilize foreign patent rights vested in the Administration. The objectives of this program are to further the interests of United States industry in foreign commerce, to enhance the economic interests of the United States and to advance the international relationships of the United States.

#### § 1245.402 Types of licenses and terms and conditions.

Licenses will be individually negotiated and may be granted to any applicant, foreign or domestic, on a non-exclusive or exclusive basis for royalties or other considerations and on such other terms and conditions as are deemed appropriate to the interests of the United States. Preference in the granting of foreign license rights will be shown to those applicants who have previously been granted a license under