

§ 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.

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(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

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the corresponding U.S. patent or patent application.

§ 1245.403 Government license.

There will be reserved from each exclusive license an irrevocable, non-exclusive, nontransferable, royalty-free license for the practice of such invention throughout the world by or on behalf of the United States or any foreign government pursuant to any existing or future treaty or agreement with the United States.

§ 1245.404 Enforcement of patent rights.

An exclusive licensee will be authorized to enforce the licensed patent and to sue infringers of the patent at its own expense.

§ 1245.405 Procedures.

(a) NASA will publish in the United States, and elsewhere as may be appropriate, lists of NASA-owned foreign patents or patent applications available for licensing.

(b) NASA will also furnish written notice of the availability for licensing of NASA-owned foreign patents or patent applications to any licensee under the corresponding U.S. patent or patent application.

(c) Applications for license should be addressed to the Administrator, National Aeronautics and Space Administration, Washington, DC 20456. The application must fully identify the patent or patent application, and state the type of license requested together with proposed terms and conditions thereof.

(d) The conduct of negotiations with prospective licensees will be the responsibility of the General Counsel, NASA. In the conduct of such negotiations, due regard shall be had for the possible interests of NASA program and staff offices, and their coordination will be obtained as deemed appropriate.

(e) NASA will publish notice in the FEDERAL REGISTER, and elsewhere as may be appropriate, of its intention to grant an exclusive license under an identified patent or patent application. An exclusive license will not be granted until the expiration of 60 days from the date of notice in order to provide a suitable time interval for interested

persons or other Government agencies to interpose comment or objection.

(f) All licenses shall become effective upon the written acceptance by the licensee of a license instrument specifying the type of license and terms and conditions thereof.

Subpart 5—Authority and Delegations To Take Certain Actions Relating to Patents and Other Intellectual Property Rights

AUTHORITY: 42 U.S.C. 2473, 2457; 14 CFR 1204.506.

SOURCE: 43 FR 34122, Aug. 3, 1978, unless otherwise noted.

§ 1245.500 Scope.

This subpart 5 sets forth the authority and delegations relating to intellectual property rights, and the administration of the NASA patent program.

§ 1245.501 General Counsel.

The General Counsel administers the NASA patent program and is delegated authority to take the following specific actions related to intellectual property, including patent, copyright, trademark, and related matters:

(a) *Determination of rights.* (1) To execute notifications of the Administrator's determinations made pursuant to section 305(a) of the National Aeronautics and Space Act of 1958, as amended;

(2) To make determinations, under Executive Order 10096 of January 23, 1950, as amended, of the respective rights of the Government and of the inventor in and to inventions made by employees under the administrative jurisdiction of the National Aeronautics and Space Administration, and to appoint a liaison officer to deal with the Commissioner of Patents in such matters pursuant to 37 CFR 100.10, "Administration of a Uniform Patent Policy With Respect to the Domestic Rights in Inventions Made by Government Employees";

(b) *Powers of attorney.* To appoint and/or revoke principal attorneys and to execute necessary powers of attorney for the purpose of filing and prosecuting patent applications in which the United States, as represented by