

## National Aeronautics and Space Admin.

## § 1245.501

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

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the Administrator, has an interest by way of either title or license;

(c) *Application papers and statements.* To receive patent applications, documents, and statements transmitted to the Administrator pursuant to section 305(c) of the National Aeronautics and Space Act of 1958, as amended;

(d) *Acceptance of licenses and assignments.* To accept on behalf of the United States licenses under, assignments of, and other rights in inventions, patents, and applications for patents;

(e) *Secrecy orders.* To exercise all powers of the Administrator with respect to secrecy orders in patent cases and foreign filing under 35 U.S.C. 181 et seq.;

(f) *Certifications.* To exercise the authority of the Administrator with respect to certifications in support of requests for extensions of time under 35 U.S.C. 267;

(g) *Foreign patent program.* To exercise the authority of the Administrator in taking all necessary action to obtain and maintain patents in foreign countries, including the execution of instruments necessary for filing, prosecution, and maintenance of foreign applications and patents;

(h) *Authority under section 305(d) and (e).* To represent the Administrator and to appoint attorneys to represent the Administrator in the conduct of business under sections 305(d) and (e) of the National Aeronautics and Space Act of 1958, as amended, including execution of requests pursuant to said sections of the act that patents be issued to the Administrator on behalf of the United States or that title be transferred to the Administrator;

(i) *Acquisition authority.* To exercise the power conferred on the Administrator by the National Aeronautics and Space Act of 1958, as amended, to acquire an interest in patents and patent applications, including the purchase of such interests in settlement of claims for the unauthorized use of patented inventions and to acquire interests in copyrights, trademarks, and trade names;

(j) *Authority to settle copyright claims.* To exercise all powers conferred on the Administrator by 28 U.S.C. 1498(b), in-

cluding the settlement of claims for copyright infringement;

(k) *Granting of licenses.* To make the determinations and to take any and all actions with respect to the licensing of NASA inventions vested in the Administrator by the NASA Domestic Patent Licensing Regulations, 14 CFR subpart 1245.2 (NASA Management Instruction 5109.3) and the NASA Foreign Patent Licensing Regulations, 14 CFR subpart 1245.4 (NASA Management Instruction 5109.5) to sign all FEDERAL REGISTER notice material required by the patent licensing regulations and to otherwise grant licenses on any invention in which the Administrator has reserved the right to grant licenses; and

(l) *Waiver determinations and instruments.* To sign for the Administrator attestations of determinations of grant or denial of waiver of title to inventions and to execute instruments of waiver, when in accordance with the recommendations of the Inventions and Contributions Board, and the NASA Patent Waiver Regulations, 14 CFR subpart 1245.1 (NASA Management Instruction 5109.2).

**§ 1245.502 Associate General Counsel for Intellectual Property.**

The Associate General Counsel for Intellectual Property provides functional direction to all Patent Counsel and is redelegate the authority to take the following actions:

(a) *Rights determinations.* (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";