

§ 650.8

such rights in any subject invention as are contemplated in the international agreement. The award instrument will identify the applicable agreement or treaty.

(b) After an invention is disclosed to the Patent Assistant, the recipient of an award subject to an international agreement will be informed as to what rights, if any, it must transfer to foreign participants. Recipients may also ask the Program Manager to provide them with copies of the identified international agreements before or after accepting an award.

§ 650.8 Retention of rights by inventor.

If an awardee elects not to retain rights to an invention, the inventor may request the NSF Patent Assistant for permission to retain principal patent rights. Such requests should be made as soon as possible after the awardee notifies the Patent Assistant that it does not want to patent the invention. Such requests will normally be granted unless either the awardee or the employer of the inventor shows that it would be harmed by that action. As required by § 401.9 of the implementing regulations for the Bayh-Dole Act (37 CFR 401.9), the inventor will be subject to the same conditions that the awardee would have been, except that the special restrictions imposed on nonprofit organizations will not apply to the inventor.

§ 650.9 Unwanted inventions.

(a) The Foundation will normally allow any patent rights not wanted by the awardee or inventor to be dedicated to the public through publication in scientific and engineering journals or as a statutory invention registration under section 157 of title 35 of the United States Code. Except as provided in paragraph (b) of this section, the NSF Patent Assistant will acknowledge a negative election by encouraging the awardee and inventor to promptly make all research results available to the scientific and engineering community.

(b) If the NSF Patent Assistant believes that another Federal agency is interested in the relevant technology, he or she may, after receiving the awardee's election not to patent and

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ascertaining that the inventor also does not want to patent, send a copy of the invention disclosure to that agency to give it an opportunity to review and patent the invention. Unless the agency expresses an interest in the invention within thirty days, the Patent Assistant will acknowledge the awardee's negative election by encouraging prompt publication of all research results. If the agency does express an interest in patenting the invention, the Patent Assistant will transfer to it all rights to the invention.

§ 650.10 Inventions also supported by another Federal Agency.

Section 401.13(a) of the implementing regulation for the Bayh-Dole Act (37 CFR 401.13(a)) provides that in the event that an invention is made under funding agreements of more than one federal agency, the agencies involved will, at the request of the grantee or contractor or on their own initiative, designate one agency to be responsible for the administration of the invention. Whenever the NSF Patent Assistant finds that another agency also supported an NSF subject invention, he or she will consult with the grantee or contractor and appropriate personnel in the other agency to determine if a single agency should be designated to administer the Government's rights in the invention. The Patent Assistant may transfer to, or accept from, any other Federal agency, responsibility for administering a jointly-supported invention.

§ 650.11 Utilization reports.

Paragraph (h) of the standard Patent Rights clause set forth in § 650.4 obliges grantees "to submit on request periodic reports no more frequently than annually on the utilization of a subject invention or on efforts at obtaining such utilization". At this time, the Foundation does not plan to request such reports except in connection with march-in investigations conducted under § 650.13. This section will be amended to describe periodic reporting requirements if such are ever established.

[57 FR 18053, Apr. 28, 1992, as amended at 59 FR 37438, July 22, 1994]