



IP Protection Process

Tim Wittig
Principal

202/841-0655

Wittigsall@aol.com

SAIC[®]
From Science to Solutions™

Who Are We?

- SAIC - A Nation-wide High Technology Company
- Technology Management Advisors

Tim Wittig, J.D.

Don Townsend, J.D.

Kevin Smith, Ph.D.

Clark Tyler

Michael Martin, BS, MBA

Bernie Chachula JD, MBA, LLM

Rick Lilley, J.D.

Dick Stern, M.S.

Charesse Evans, JD - MBA

Robert Goozman, PhD, JD

Jane Kuhl, BS, MS

Current Clients

- Army Research Laboratory
- Army Armaments RDEC at Picatinny NJ
- Benet Laboratories, Watervliet NY
- Maryland Dept. of Business and Economic Development
- Naval Air Warfare Center, Lakehurst, NJ and Pax River MD
- Army Aviation and Missile RDEC, Huntsville, AL
- Army Game Project
- TechLink, Montana State University*
- SpringBoard Alaska
- Program Manager Battle Command, Ft. Monmouth NJ
- GSA

Patent Protection Process

- Your Partnership
- Disclosure
 - General Requirements
 - Inventor(s) Determination
 - Disclosure
 - Assignments
 - Invention Evaluation Board
- Application
- Prosecution
- Grant
- Maintenance Fees
- Alternatives

Your Partnership

- To be Effective, establish a partnership
 - Legal Office
 - ORTA
 - Inventors
 - Invention Review Board

- Goal – A Transparent Process
 - Help all to understand progress
 - Keep a running record (case management)

US Patent Requirements

Proper Subject Matter

Process, Machine, Manufacture,
Composition, New Use
or Improvement of the Above
(Do Not Forget Software!)

A relatively low threshold

New

Useful

Non-obvious

Focus on these
and teach how
to make and use
the invention

No Statutory Bar

e.g., Publication or On Sale Bars

AVOID THESE!

Statutory Bars

To Be Avoided!

Publication

More Than One Year Prior to Filing
Date Bars US Patent Eligibility

Anywhere Other Than the US,
Instant Bar to Patent Protection

In Use
On Sale

More Than One Year Prior to Filing
in the US Bars US Patent Eligibility

Do Not Self-Censure!

- Too Often, Inventors Do Not Disclose Inventions, Saying "It Probably Isn't Patentable"
- What About These?

United States Patent (19) Patent Number: **4,998,724**
Hartman (40) Date of Patent: Mar. 12, 1991

(34) **THUMB WRESTLING GAME APPARATUS WITH STABILIZING HANDLE**
OTHER PUBLICATIONS
The Washington Post Magazine, 8-5-1984, p. 47, Rules of Thumb for Oidians.
Primary Examiner—Paul E. Shapiro

(70) Inventor: **Richard B. Hartman**, 7116 201st SE, Innesport, Wash. 98027

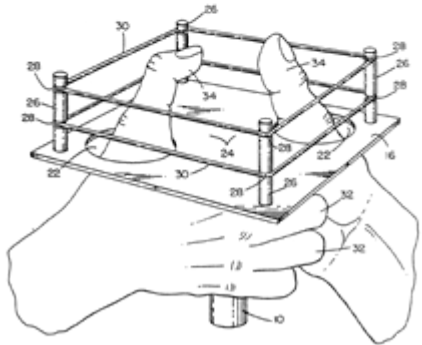
(21) Appl. No.: **066,792**
(22) Filed: **Aug. 25, 1990**

(31) Int. Cl.⁷ **A63B 79/04**
(32) U.S. Cl. **27B/3.02**
(33) Field of Search: **27B/3.02**

(54) **References Cited**
U.S. PATENT DOCUMENTS
3,790,347 2/1974 Schmidt et al. 27B/3.02

(57) **ABSTRACT**
Improved apparatus for playing a game of thumb wrestling includes a stabilizing handle which employs forces generated by freely interlocking segments of players hands to stabilize and anchor a game ring surface. Game ring surface includes holes through which the thumbs of opponents are inserted oppositely, and a solid wrestling region spot which one thumb can facilitate pin another thumb, thereby giving the realistic impression of a pin in wrestling.

3 Claims, 4 Drawing Sheets



Device For Thumb Wrestling US 4,998,724

United States Patent (19) Patent Number: **3,771,192**
Zaleski (40) Date of Patent: Nov. 13, 1973

(54) **COMBINATION TOY DOG AND VACUUM CLEANER**
FOREIGN PATENTS OR APPLICATIONS
2,421,288 6/1947 Moore 46/116 UK
383,041 2/1953 Gross Britain 10/768
353,865 9/1961 Switzerland 15/323

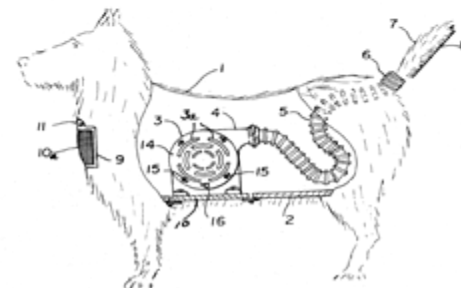
(70) Inventor: **Anne Margaret Zaleski**, 314 37th St., Pittsburgh, Pa. 15201

(22) Filed: **Mar. 16, 1972**
(31) Appl. No.: **338,289**

(52) **References Cited**
U.S. PATENT DOCUMENTS
15,336 44/116
4479 5/12
46/116 15/257, 323,
15/327 D, 327 R, 328, 330, 335

(57) **ABSTRACT**
A toy dog closely resembling a real dog and having a hollow interior in which is mounted a vacuum cleaner having a suction hose which is retractable from the tail end of the dog. This enables vacuuming a dog after a hair cut and grooming without causing fear to the dog, inasmuch as the vacuum cleaner motor is greatly muffled by such enclosure. The vacuum cleaner is convertible to a blower and air issuing from the tail end can be heated so as to serve as a dryer.

3 Claims, 3 Drawing Figures



Dog Vacuum Cleaner US 3,771,192

The Lab Notebook

- Who Cares?
 - No one can remember!
- What's Needed
 - Bound book
 - Serially numbered pages
 - Witnessed on a periodic basis
- Issues
 - Mistakes
 - Successful and unsuccessful experiments
 - Software

Ask the Inventor to Visit the Legal Office

- Suggest that your inventor visit the legal office
 - Begins a Relationship
 - Opportunity to Raise Issues
 - Discuss the Forms
 - What is Expected
 - Problem areas identified early
 - Software
 - Multiple Inventors
 - Reduction to Practice
 - Enabling Disclosure
- Plan to work with your inventors

Record of Invention

NAME OF INVENTOR(S) **list all of them**

ADDRESS OF INVENTOR(S):

Short description of the contribution this inventor made

STATUS (MIL OR CIV or Contractor):

INVENTION TITLE:

INVENTION HISTORY:

FEATURE	DATE	PLACE OF ACTION OR NAMES OF PERSONS
---------	------	-------------------------------------

- (a) Conception of Invention
- (b) First Sketch of Drawing
- (c) First Written Description
- (d) Disclosure to Others
- (e) Completion of Model
- (f) Completion of Full-Scale Item
- (g) First Test of Inventive Item

INDIVIDUALS HAVING FIRST HAND KNOWLEDGE OF ANY OF THE FEATURES OF THE INVENTION HISTORY:

NAME	ADDRESS	FEATURE
------	---------	---------

General Contract IP Rules

Includes STAS, SBIR and STTR Contracts

- **Inventions Only by Contractor**
 - 60 Days to Notify POC
 - 2 Years to Decide to Prosecute
 - Contractor Can Own the Invention With Government Use Rights Attached
 - 1 Year to Prosecute
- **Joint Inventions Will Be Owned Jointly**
- **Data**
 - Data First Fixed Belongs to the Contractor With Government Use Rights Attached
 - Non-commercial Technical Data & Software
 - Unlimited or SBIR Data Rights (5 Years)
- **Final Report of IP Disposition Always Required**

Record of Invention (Cont'd)

RESULTS OF TEST:

___ SUCCESSFUL ___ marginally successful ___ UNSUCCESSFUL

REPOSITORIES OF INVENTION DATA:

DOCUMENT, TITLE, LOCATION

INVENTION PUBLICATION (DISCLOSED OUTSIDE OF GOVERNMENT):

PUBLICATION MEDIA DATE OF PUBLICATION

List also planned publication

KNOWN RELATED PATENTS AND APPLICATIONS

NATURE AND EXTENT OF PRESENT AND PAST USE

THE ATTACHED INVENTION DISCLOSURE HAS BEEN READ AND UNDERSTOOD BY TWO WITNESSES WHO HAVE SIGNED A STATEMENT TO THIS EFFECT AT THE END THEREOF.

INVENTOR SIGNATURE: _____ DATE: _____

INVENTOR SIGNATURE: _____ DATE: _____

JURISDICTIONAL PATENT ACTIVITY: _____

NAME

DATE OF RECEIPT

Describing the Invention

- 1. BRIEF ABSTRACT OR SUMMARY
 - a. What is the Invention, not what it does or how it works (preferably in approximately 1/2 page or less).
 - b. Next, In a half page describe what it does and how that is different from or better than the prior art).

- 2. BACKGROUND of the TECHNOLOGY
 - a. Problem to be solved
 - b. Current State of Technology
 - c. How others have attacked the problem
 - d. How is your invention different (better not required, but order of magnitude useful)
 - e. Describe all other possible other uses different from the purpose for which the invention was made. Specifically include non-governmental uses
 - f. Who would be interested in licensing this development?

- 3. INVENTION DESCRIPTION - **Enabling Disclosure!**
 - a. Drawings, sketches, flow diagrams
 - b. Operational description
 - c. Describe all uses and methods of construction and operation
 - c. Best Mode description
 - d. Usefulness must be established

Invention Rights Questionnaire

SECTION I - TO BE COMPLETED BY THE INVENTORPART A - BASIC DATA

1. BRIEF TITLE OF INVENTION
2. NAME OF INVENTOR
3. GRADE AT TIME INVENTION WAS MADE
4. JOB TITLE AT TIME INVENTION WAS MADE
5. COMPLETE NAME OF ORGANIZATION AT TIME INVENTION WAS MADE (Include , applicable, unit, section, branch, division, department, lab, post, camp, station, branch of Army)
6. I DESIRE TO ASSIGN TO THE UNITED STATES GOVERNMENT THE ENTIRE RIGHT, TITLE AND INTEREST IN AND TO THE ABOVE IDENTIFIED INVENTION.

(Signature below is necessary only if assigning rights of invention to the Government. Completion of the remainder of this form is not necessary if you sign below.)

- a. SIGNATURE OF INVENTOR
- b. DATE

PUBLIC RELEASE APPROVAL REQUIRED FOR ARMY INVENTIONS

Evaluation Form

Please review the attached invention disclosure and assist this office in evaluating the invention by completing this questionnaire. Your evaluation should be based on your present knowledge with a minimum of outside consultation.

SIGNIFICANCE (On the spectrum line below, check the relative importance of the invention in its field of technology.)

No Advance Modest Advance Substantial Advance Major Advance Basic or Pioneering Discovery

Comments regarding technical significance of the disclosure:

STATE OF DEVELOPMENT (Check on the spectrum line below.)

Concept Only Theoretically Verified Tested (Actual or Simulation) Fully Developed Production Stage Fielded System UNK

LIKELIHOOD OF USE BY THE ARMY (Check on the spectrum line below.)

Not Likely 25% Likelihood 50% Likelihood 75% Likelihood In Production or Use

If the likelihood of use by the Army is appreciable, give application (e.g. STINGER missile guidance) and the extent of anticipated use.

LIKELIHOOD OF COMMERCIAL (NON MILITARY) POTENTIAL

Not Likely 25% Likelihood 50% Likelihood 75% likelihood 100% Likelihood

If the commercial potential is considered appreciable, please provide specific comments.

What's Next?

- Keep Inventor Informed!
- Application Drafting
 - In House or Contracted Out
- Consider PCT application here and
 - file within 1 year of US filing.
- Prosecution
 - Office Actions
 - Now almost 3 years to grant
- After Grant
 - Maintenance Fees
 - Years 4, 8, and 12
 - Use your IEB to determine fee payment

Licensing Options

- Use Abstract as the basis for invention description
- Go to first pages to find uses and interest of others
- Look carefully for the issues Joan raised
 - Reduction To Practice
 - Ease Of Insertion
 - List Fields Of Use
 - Order Of Magnitude Improvement
 - Government Approval
 - Inventor Team Will Cooperate
- Advertise general availability
 - Consider multiple postings
- What is Licensable
 - Is or may be patentable
 - Patentable Subject Matter 37 CFR 404

Recap

- Your Partnership is Critical,
 - keep it active and open
- Keep the Process Transparent
- Help Inventors with Disclosure
 - Difficult, not always seen as part of the job
- Assignments
 - Make sure you get them early
- Invention Evaluation Board
 - Can be a great help and spreads the word
- Application
 - Takes too long so start licensing process with filing
- Don't forget PCT applications
- Watch Maintenance Fee payment
- Keep at it

Got a Question?
Need Help?

Tim Wittig

SAIC Technology Management Advisors

Wittigsall@aol.com

202 841 0655

301 924 0848 fax

Code of Federal Regulations is amended as follows:

PART 223—SALE AND DISPOSAL OF NATIONAL FOREST SYSTEM TIMBER

Subpart B—Timber Sale Contracts

■ 1. The Authority citation for part 223 continues to read as follows:

Authority: 90 Stat. 2958, 16 U.S.C. 472a; 98 Stat. 2213; 16 U.S.C. 618, 104 Stat. 714–726, 16 U.S.C. 620–620], unless otherwise noted.

■ 2. Revise § 223.41 to read as follows:

§ 223.41 Payment when purchaser elects government road construction.

Each contract having a provision for construction of specified roads with total estimated construction costs of \$50,000 or more shall include a provision to ensure that if the purchaser elects government road construction, the purchaser shall pay, in addition to the price paid for the timber or other forest products, an amount equal to the estimated cost of the roads.

■ 3. Revise § 223.63 to read as follows:

§ 223.63 Advertised rates.

Timber shall be advertised for sale at its appraised value. The road construction cost used to develop appraised value means the total estimated cost of constructing all permanent roads specified in the timber sale contract, estimated as if construction is to be accomplished by the timber purchaser. The advertised rates shall be not less than minimum stumpage rates, except that sales of insect-infested, diseased, dead, or distressed timber may be sold at less than minimum rates when harvest of such timber is necessary to protect or improve the forest or prevent waste of usable wood fiber.

■ 4. Revise § 223.82 (b) introductory text to read as follows:

§ 223.82 Contents of advertisement.

* * * * *

(b) For each timber sale which includes specified road construction with total estimated construction costs of \$50,000 or more, the advertisement shall also include:

* * * * *

■ 5. Amend § 223.83 by revising paragraphs (a)(16) and (a)(17)(i) to read as follows:

§ 223.83 Contents of prospectus.

(a) * * *

(16) The estimated road construction cost and the estimated public works construction cost.

(17) For deficit sales:

(i) An estimate of the difference between fair market value and

advertised value, that is, the amount by which the advertised value exceeds the appraised value.

* * * * *

■ 6. Amend § 223.84 by revising the section heading to read as follows:

§ 223.84 Small business bid form provisions on sales with specified road construction.

* * * * *

Dated: March 2, 2006.

Dale N. Bosworth,

Chief.

[FR Doc. 06–2161 Filed 3–7–06; 8:45 am]

BILLING CODE 3410–11–P

DEPARTMENT OF COMMERCE

37 CFR Part 404

[Docket No. 040305084–5095–02]

RIN 0692–AA19

Assistant Secretary for Technology Policy; Licensing of Government Owned Inventions

AGENCY: Assistant Secretary for Technology Policy, Department of Commerce (DOC).

ACTION: Final rule.

SUMMARY: The Assistant Secretary for Technology Policy, DOC issues this final rule with respect to the granting of licenses by Federal agencies on Federally owned inventions. This rule is intended to incorporate changes made by the Technology Transfer Commercialization Act of 2000 and streamlines the licensing procedures to focus primarily on statutory requirements. This final rule responds to comments received in response to a proposed rule published on January 7, 2005 (70 FR 1403).

DATES: This rule is effective on April 7, 2006.

FOR FURTHER INFORMATION CONTACT: Mr. John Raubitschek, Patent Counsel, at telephone: (202) 482–8010 and e-mail: JRaubits@doc.gov.

SUPPLEMENTARY INFORMATION: Under the authority of 35 U.S.C. 208 and the delegation by the Secretary of Commerce in section 3(d)(3) of DOO 10–18, the Assistant Secretary of Commerce for Technology Policy may issue revisions to 37 CFR part 401.

Background

The Technology Transfer Commercialization Act of 2000 (TTCA) made several changes to the law for licensing Government-owned inventions in 35 U.S.C. 207 and 209,

which are implemented in this rule. This rule also streamlines the licensing procedures to focus primarily on statutory requirements. DOC published a proposed rule in the **Federal Register** on January 7, 2005 (70 FR 1403) seeking public comment on changes to §§ 404.1, 404.3, 404.4, 404.5, 404.6, 404.7, 404.9, 404.10, 404.11, 404.12 and 404.14. The comment period closed on February 7, 2005. The basis for this rulemaking was described in the preamble to the proposed rule and is not repeated here.

Summary of Public Comments Received by DOC in Response to the January 7, 2005 Proposed Rule and DOC's Response to Those Comments

DOC received seven responses to the request for comments. Four responses were from Federal government agencies. One was from a not-for-profit institution and two were from private individuals. Several responses made more than one comment. An analysis of the comments follows.

Comment: One comment suggested adding “formal” before “patent disputes” in § 404.1(c) to narrow the exemption from the licensing requirements in Part 404.

Response: DOC doubts that an agency will use this exemption to resolve a trivial or contrived dispute. Further, the addition of the word “formal” may not avoid this problem.

Comment: One comment suggested adding “,for example” after “protectable” in § 404.3(a).

Response: This definition is taken from 35 U.S.C. 201(d) and should remain as written for the sake of consistency.

Comment: Two comments noted a typographical error in § 404.5(a)(2) that “license” should be “licensee.”

Response: DOC agrees with the comments and has made the suggested change.

Comment: One comment suggested replacing “However” in 404.5(a)(2) with “For example.”

Response: No change has been made in response to this comment. The stated bases for waiving the domestic manufacturing requirement are not merely examples but the only reasons for the agency making the waiver.

Comment: One comment was concerned that § 404.5(a)(2) required an agency to find one or more companies which would refuse a license with the domestic manufacturing requirement in order to grant a waiver of such a requirement. The comment suggested adding “or no such candidates are known.”

Response: The waiver language was taken from 35 U.S.C. 204, which has

proven effective for universities and small business firms seeking a waiver. The intent is that the licensing agency should make an effort to find a company that will accept such a requirement. If there is only one company interested in a license and that company is unwilling to accept the domestic manufacturing requirement, the agency may waive the requirement if it has made reasonable efforts to find other potential licensees. Thus, DOC does not accept the proposed language because it would not impose a duty on the agency to look for other companies which may accept the requirement.

Comment: One comment felt that the public notice requirement in § 404.4 was not clearly limited to inventions that the agency had determined were available for license and suggested that “available” be added before inventions of which the public is to be notified.

Response: DOC agrees with the comment and has made the suggested change.

Comment: One comment was concerned that the explanation in paragraph no. 5 of the proposed rule about the abbreviated development plan for a research license in § 404.5(a)(1) implied that background inventions could be licensed in a cooperative research and development agreement (CRADA) only on for research purposes. Another comment supported the concept of an abbreviated development plan for small mom-and-pop research entities.

Response: The suggestion that a background invention be licensed for research purposes under a CRADA was not intended to preclude it from being commercially licensed. Further, there is no limitation in § 404.5(a)(1) for background inventions.

Comment: One comment recommended that all references be to Title 5 instead of title 5.

Response: DOC agrees with this comment and made the suggested change in §§ 404.3 and 404.14.

Comment: One comment questioned whether the new basis for terminating a license in § 404.5(b)(8)(v) for an adjudicated violation of the antitrust laws imposed an additional responsibility on the agency granting an exclusive license. The comment was concerned that if the agency did not meet such a duty, it might be liable and recommended that the license contain a disclaimer of such liability.

Response: The additional basis for termination has nothing to do with the granting of a license although there is a requirement in § 404.7(a)(iii) that the agency has not determined that the grant of the license will tend

substantially to lessen competition or be in violation of the antitrust laws. As far as a disclaimer goes, many Government licenses include one based on the language in § 404.5(b)(11).

Comment: One comment criticized the criterion “in the public interest” as being vague for permitting in § 404.5(b)(2) a nonexclusive licensee the right to enforce a Government owned patent. The comment questioned who was going to make the determination of public interest: The agency or the Department of Justice and suggested language that would include the right of enforcement as an amendment to the license as approved by the parties and the Department of Justice at the time the enforcement issue arises. Another comment supports the concept of letting a nonexclusive licensee enforce the patent against infringers but suggests that the licensee provide notice to the agency before filing suit so that the agency could advise if the party to be sued already has a license.

Response: With respect to the first comment about the vagueness of “in the public interest,” DOC notes that this phrase also appears in 35 U.S.C. 207(a)(2) and § 404.7(a)(2)(iv). The determination of allowing the licensee the right to enforce is made by the agency and the licensee. With respect to prior notice to the agency, there is nothing in this section that precludes requiring such notice in a license agreement and in fact, many agencies have such a requirement for exclusive licensees.

Comment: One comment questioned the desirability of entering into co-exclusive licenses to resolve competition between two applicants for a license.

Response: The regulation does not require an agency to enter into co-exclusive licenses for any reason. The regulation merely recognizes that some agencies may grant co-exclusive licenses, which must follow the rules applicable to exclusive licenses.

Comment: Two comments questioned the scope of licensing unpatented inventions and whether it could include know-how or unpatentable inventions and be subject to royalty sharing with the inventor. One comment wondered if the rights under such a license would be different than obtaining information under the Freedom of Information Act (FOIA).

Response: The authority to license inventions is contained in 35 U.S.C. 207(a)(2). An invention is defined in 35 U.S.C. 201(d) as “any invention or discovery which is or may be patentable or otherwise protectable under this title” or a novel plant variety “which is

or may be protectable under the Plant Variety Protection Act.” This language preceded the Bayh-Dole Act and appeared in the definition of invention in the Presidential Memoranda and Statements of Government Patent Policy in 1963 and 1971. However, the meaning of this phrase is not certain. See Steven Robert Fuschler, “A Study of How the Government obtains Patent Rights under the DAR and the FPR Patent Rights Clauses,” 10 Pub. Cont. L. J. 296, 339 (1978) (“there appears to be an unspoken agreement to let reason and equity govern the application of this phrase”). DOC interprets the term to mean that the invention must have the potential of being protected and so could include computer software and biological materials or any other subject matter in 35 U.S.C. 101. If know-how includes an invention, then it can be licensed. Any royalties must be shared with the inventors as required by 15 U.S.C. 3710c which applies to the licensing or assignment of Government owned inventions.

The licensing of an invention which is not protected by any intellectual property can be considered as creating a bailment of the personal property which is subject to certain conditions of use. Those terms may be enforced as a matter of contract. In the absence of any underlying intellectual property, there are no rights available to enforce against third parties.

With respect to an invention which has been in public use or on sale for more than a year because of a license, it may not be patentable under 35 U.S.C. 102(b). In addition, an invention may not be patentable because it would have been obvious under 35 U.S.C. 103. Since sections 102 and 103 both contain conditions for patentability, they are not considered to affect the licensability of unpatented inventions. All that is required is that the invention have patentable subject matter.

Further, the licensing of an invention may not be a bar under section 102(b) if the invention is leased but not sold and if there are secrecy requirements associated with providing access to the invention. There are also other requirements for an “on sale” bar, such as the invention must be “ready for patenting.” See *Pfaff v. Wells Elec., Inc.*, 525 U.S. 55, 67–68 (1998). Finally, we note that under the old 35 U.S.C. 207, an agency could license a patent application which might never issue as a patent because the Patent and Trademark Office determined that it was unpatentable.

FOIA raises an issue with respect to inventions which have an information content because under FOIA that

information may be available for free or for the cost of reproduction. This would obviously complicate the licensing of inventions. However, the invention may not be a record which is subject to FOIA. Biological materials are not a record subject to FOIA.

On the other hand, there is a question whether software is a government record subject to FOIA. See *Gilmore v. DOE*, 4 F. Supp. 2d 912, 920 (N.D. Cal. 1998) (“Even if DOE actually owned and controlled CLERVER [video conferencing software created by Sandia National Laboratories under contract with DOE] at the time of Gilmore’s FOIA request, CLERVER still would not be an agency record subject to FOIA because CLERVER does not illuminate the structure, operation, or decision making structure of DOE.” On the other hand in *DeLorme Pub. Co. v. NOAA*, 907 F. Supp. 10 (D. Me. 1995), software was held to be a record but later found to be protectable under the FTTA, *DeLorme Pub. Co. v. NOAA*, 917 F. Supp. 867 (D. Me. 1996). Further, even if software is subject to FOIA, the agency is not limited to charging only for the cost of reproduction under 5 U.S.C. 552(a)(4)(vi) when other fees are authorized by statute. See *Jack Wade Warren, Jr v. Department of Commerce*, Civil Action No. 96–0717 RMU (D.D.C. Feb. 25, 1998).

Changes From the Proposed Rule

In response to comments, editorial changes were made to §§ 404.3, 404.5(a)(2) and 404.14. In addition, the word “available” was added to § 404.4 as proposed by a comment. Finally, “Federally owned” in §§ 404.3, 404.4, 404.5, 404.7 and 404.12 was replaced by “Government owned” to make it consistent with the title of the regulation.

Classification

Executive Order 12866

This final rule has been determined to be not significant for purposes of E.O. 12866.

Executive Order 13132

This rule does not contain policies with Federalism implications as that term is defined in E.O. 13132.

Administrative Procedure Act

This rule involves rules of agency practice and procedure under 5 U.S.C. 553(b)(A) and prior notice and an opportunity for public comment are, therefore, not required by the Administrative Procedure Act, or any other statute or regulation, for this rule.

Regulatory Flexibility Act

Because a notice of proposed rulemaking and an opportunity for public comment are not required to be given for this rule pursuant to 5 U.S.C. 553(b)(A), or by any other law, this rule is not subject to the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*).

Paperwork Reduction Act

The rule was changed to include a utilization report requirement in 404.5(a)(6) and so imposes a new collection of information requirement under the Paperwork Reduction Act (PRA) (44 U.S.C. 3501 *et seq.*). Office of Management and Budget (OMB) approval was sought and obtained for the application for a license in 404.8 and the utilization report in 404.5(a)(6) and the approval (number 0692–0006) has been extended until January 31, 2009. The time to complete the license application and the utilization report is estimated to be 2 hours and 1 hour, respectively.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the PRA, unless that collection of information displays a currently valid OMB control number. However, this collection of information does not include a document to display the OMB Control No. 0692–0006.

List of Subjects in 37 CFR Part 404

Inventions, Patents, Licenses.

Dated: February 13, 2006.

Daniel W. Caprio, Jr.,

(Acting) Assistant Secretary of Commerce for Technology Policy.

■ For the reasons set forth in the preamble, 37 CFR Part 404 is amended as follows:

PART 404—LICENSING OF GOVERNMENT OWNED INVENTIONS

■ 1. The authority citation for Part 404 is revised to read as follows:

Authority: 35 U.S.C. 207–209.

■ 2. Section 404.1 is revised to read as follows:

§ 404.1 Scope of part.

This part prescribes the terms, conditions, and procedures upon which a federally owned invention, other than an invention in the custody of the Tennessee Valley Authority, may be licensed. This part does not affect licenses which:

(a) Were in effect prior to April 7, 2006;

(b) May exist at the time of the Government’s acquisition of title to the invention, including those resulting from the allocation of rights to inventions made under Government research and development contracts;

(c) Are the result of an authorized exchange of rights in the settlement of patent disputes, including interferences; or

(d) Are otherwise authorized by law or treaty, including 35 U.S.C. 202(e), 35 U.S.C. 207(a)(3) and 15 U.S.C. 3710a, which also may authorize the assignment of inventions. Although licenses on inventions made under a cooperative research and development agreement (CRADA) are not subject to this regulation, agencies are encouraged to apply the same policies and use similar terms when appropriate. Similarly, this should be done for licenses granted under inventions where the agency has acquired rights pursuant to 35 U.S.C. 207(a)(3).

■ 3. In § 404.3, paragraph (a) is revised to read as follows:

§ 404.3 Definitions.

(a) *Government owned invention* means an invention, whether or not covered by a patent or patent application, or discovery which is or may be patentable or otherwise protectable under Title 35, the Plant Variety Protection Act (7 U.S.C. 2321 *et seq.*) or foreign patent law, owned in whole or in part by the United States Government.

* * * * *

■ 4. Section 404.4 is revised to read as follows:

§ 404.4 Authority to grant licenses.

Federally owned inventions shall be made available for licensing as deemed appropriate in the public interest and each agency shall notify the public of these available inventions. The agencies having custody of these inventions may grant nonexclusive, co-exclusive, partially exclusive, or exclusive licenses thereto under this part. Licenses may be royalty-free or for royalties or other consideration. They may be for all or less than all fields of use or in specified geographic areas and may include a release for past infringement. Any license shall not confer on any person immunity from the antitrust laws or from a charge of patent misuse, and the exercise of such rights pursuant to this part shall not be immunized from the operation of state or federal law by reason of the source of the grant.

■ 5. In Section 404.5, paragraph (a), paragraph (b)(2) and paragraphs (b)(4)

through (b)(9) are revised to read as follows:

§ 404.5 Restrictions and conditions on all licenses granted under this part.

(a)(1) A license may be granted only if the applicant has supplied the Federal agency with a satisfactory plan for development or marketing of the invention, or both, and with information about the applicant's capability to fulfill the plan. The plan for a non-exclusive research license may be limited to describing the research phase of development.

(2) A license granting rights to use or sell under a Government owned invention in the United States shall normally be granted only to a licensee who agrees that any products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States. However, this condition may be waived or modified if reasonable but unsuccessful efforts have been made to grant licenses to potential licensees that would be likely to manufacture substantially in the United States or if domestic manufacture is not commercially feasible.

(b) * * *

(1) * * *

(2) Any patent license may grant the licensee the right of enforcement of the licensed patent without joining the Federal agency as a party as determined appropriate in the public interest.

(3) * * *

(4) The license may provide the licensee the right to grant sublicenses under the license, subject to the approval of the Federal agency. Each sublicense shall make reference to the license, including the rights retained by the Government, and a copy of such sublicense with any modifications thereto, shall be promptly furnished to the Federal agency.

(5) The license shall require the licensee to carry out the plan for development or marketing of the invention, or both, to bring the invention to practical application within a reasonable time as specified in the license, and continue to make the benefits of the invention reasonably accessible to the public.

(6) The license shall require the licensee to report periodically on the utilization or efforts at obtaining utilization that are being made by the licensee, with particular reference to the plan submitted but only to the extent necessary to enable the agency to determine compliance with the terms of the license.

(7) Where an agreement is obtained pursuant to § 404.5(a)(2) that any

products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States, the license shall recite such an agreement.

(8) The license shall provide for the right of the Federal agency to terminate the license, in whole or in part, if the agency determines that:

(i) The licensee is not executing its commitment to achieve practical application of the invention, including commitments contained in any plan submitted in support of its request for a license and the licensee cannot otherwise demonstrate to the satisfaction of the Federal agency that it has taken, or can be expected to take within a reasonable time, effective steps to achieve practical application of the invention;

(ii) Termination is necessary to meet requirements for public use specified by Federal regulations issued after the date of the license and such requirements are not reasonably satisfied by the licensee;

(iii) The licensee has willfully made a false statement of or willfully omitted a material fact in the license application or in any report required by the license agreement;

(iv) The licensee commits a substantial breach of a covenant or provision contained in the license agreement, including the requirement in § 404.5(a)(2); or

(v) The licensee has been found by a court of competent jurisdiction to have violated the Federal antitrust laws in connection with its performance under the license agreement.

(9) The license may be modified or terminated, consistent with this part, upon mutual agreement of the Federal agency and the licensee.

* * * * *

■ 6. Section 404.6 is revised to read as follows:

§ 404.6 Nonexclusive licenses.

Nonexclusive licenses may be granted under Government owned inventions without a public notice of a prospective license.

■ 7. Section 404.7 is revised to read as follows:

§ 404.7 Exclusive, co-exclusive and partially exclusive licenses.

(a)(1) Exclusive, co-exclusive or partially exclusive domestic licenses may be granted on Government owned inventions, only if:

(i) Notice of a prospective license, identifying the invention and the prospective licensee, has been published in the **Federal Register**, providing opportunity for filing written

objections within at least a 15-day period;

(ii) After expiration of the period in § 404.7(a)(1)(i) and consideration of any written objections received during the period, the Federal agency has determined that;

(A) The public will be served by the granting of the license, in view of the applicant's intentions, plans and ability to bring the invention to the point of practical application or otherwise promote the invention's utilization by the public.

(B) Exclusive, co-exclusive or partially exclusive licensing is a reasonable and necessary incentive to call forth the investment capital and expenditures needed to bring the invention to practical application or otherwise promote the invention's utilization by the public; and

(C) The proposed scope of exclusivity is not greater than reasonably necessary to provide the incentive for bringing the invention to practical application, as proposed by the applicant, or otherwise to promote the invention's utilization by the public;

(iii) The Federal agency has not determined that the grant of such a license will tend substantially to lessen competition or create or maintain a violation of the Federal antitrust laws; and

(iv) The Federal agency has given first preference to any small business firms submitting plans that are determined by the agency to be within the capability of the firms and as having equal or greater likelihood as those from other applicants to bring the invention to practical application within a reasonable time.

(2) In addition to the provisions of § 404.5, the following terms and conditions apply to domestic exclusive, co-exclusive and partially exclusive licenses:

(i) The license shall be subject to the irrevocable, royalty-free right of the Government of the United States to practice or have practiced the invention on behalf of the United States and on behalf of any foreign government or international organization pursuant to any existing or future treaty or agreement with the United States.

(ii) The license shall reserve to the Federal agency the right to require the licensee to grant sublicenses to responsible applicants, on reasonable terms, when necessary to fulfill health or safety needs.

(iii) The license shall be subject to any licenses in force at the time of the grant of the exclusive, co-exclusive or partially exclusive license.

(b)(1) Exclusive, co-exclusive or partially exclusive foreign licenses may be granted on a Government owned invention provided that;

(i) Notice of the prospective license, identifying the invention and prospective licensee, has been published in the **Federal Register**, providing opportunity for filing written objections within at least a 15-day period and following consideration of such objections received during the period;

(ii) The agency has considered whether the interests of the Federal Government or United States industry in foreign commerce will be enhanced; and

(iii) The Federal agency has not determined that the grant of such a license will tend substantially to lessen competition or create or maintain a violation of the Federal antitrust laws.

(2) In addition to the provisions of § 404.5, the following terms and conditions apply to foreign exclusive, co-exclusive and partially exclusive licenses:

(i) The license shall be subject to the irrevocable, royalty-free right of the Government of the United States to practice and have practiced the invention on behalf of the United States and on behalf of any foreign government or international organization pursuant to any existing or future treaty or agreement with the United States.

(ii) The license shall be subject to any licenses in force at the time of the grant of the exclusive, co-exclusive or partially exclusive license.

(iii) The license may grant the licensee the right to take any suitable and necessary actions to protect the licensed property, on behalf of the Federal Government.

(c) Federal agencies shall maintain a record of determinations to grant exclusive, co-exclusive or partially exclusive licenses.

§ 404.9 [Removed and reserved]

■ 8. Section 404.9 is removed and reserved.

■ 9. Section 404.10 is revised to read as follows:

§ 404.10 Modification and termination of licenses.

Before modifying or terminating a license, other than by mutual agreement, the Federal agency shall furnish the licensee and any sublicensee of record a written notice of intention to modify or terminate the license, and the licensee shall be allowed 30 days after such notice to remedy any breach of the license or show cause why the license shall not be modified or terminated.

■ 10. Section 404.11 is revised to read as follows:

§ 404.11 Appeals.

(a) In accordance with procedures prescribed by the Federal agency, the following parties may appeal to the agency head or designee any decision or determination concerning the grant, denial, modification, or termination of a license:

(1) A person whose application for a license has been denied;

(2) A licensee whose license has been modified or terminated, in whole or in part; or

(3) A person who timely filed a written objection in response to the notice required by § 404.7(a)(1)(i) or § 404.7(b)(1)(i) and who can demonstrate to the satisfaction of the Federal agency that such person may be damaged by the agency action.

(b) An appeal by a licensee under paragraph (a)(2) of this section may include a hearing, upon the request of the licensee, to address a dispute over any relevant fact. The parties may agree to Alternate Dispute Resolution in lieu of an appeal.

■ 11. Section 404.12 is revised to read as follows:

§ 404.12 Protection and administration of inventions.

A Federal agency may take any suitable and necessary steps to protect and administer rights to Government owned inventions, either directly or through contract.

■ 12. Section 404.14 is revised to read as follows:

§ 404.14 Confidentiality of information.

Title 35, United States Code, section 209, requires that any plan submitted pursuant to § 404.8(h) and any report required by § 404.5(b)(6) shall be treated as commercial or financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of Title 5 of the United States Code.

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[EPA-R03-OAR-2006-0123; FRL-8042-3]

Approval and Promulgation of Air Quality Implementation Plans; Pennsylvania; RACT Determinations for Thirteen Individual Sources

AGENCY: Environmental Protection Agency (EPA).

ACTION: Final rule.

SUMMARY: The Environmental Protection Agency (EPA) is approving State Implementation Plan (SIP) revisions submitted by the Commonwealth of Pennsylvania (Pennsylvania). The revisions impose reasonably available control technology (RACT) on thirteen major sources of volatile organic compounds (VOC) or nitrogen oxides (NO_x) located in the Commonwealth of Pennsylvania. EPA is approving these revisions to establish RACT requirements in the SIP in accordance with the Clean Air Act (CAA or the Act).

DATES: This final rule is effective on April 7, 2006.

ADDRESSES: EPA has established a docket for this action under Docket ID Number EPA-R03-OAR-2006-0123. All documents in the docket are listed in the www.regulations.gov Web site. Although listed in the electronic docket, some information is not publicly available, i.e., confidential business information (CBI) or other information whose disclosure is restricted by statute. Certain other material, such as copyrighted material, is not placed on the Internet and will be publicly available only in hard copy form. Publicly available docket materials are available either electronically through www.regulations.gov or in hard copy for public inspection during normal business hours at the Air Protection Division, U.S. Environmental Protection Agency, Region III, 1650 Arch Street, Philadelphia, Pennsylvania 19103. Copies of the State submittal are available at the Pennsylvania Department of Environmental Protection, Bureau of Air Quality, P.O. Box 8468, 400 Market Street, Harrisburg, Pennsylvania 17105.

FOR FURTHER INFORMATION CONTACT: Marcia Spink (215) 814-2104 or by e-mail at spink.marcia@epa.gov.

SUPPLEMENTARY INFORMATION:

I. Background

On April 18, 2000 (65 FR 20788), EPA published a direct final rule approving RACT determinations submitted by the