



Notice of Patent Application/Patent Determination and Waiver of Title

WHEREAS, the Reportable Item identified below was made in the performance of work under a contract entered into by and between the United States of America and the Contractor, as identified below:

Advance Waiver (Number and Date)

Contractor:

Address:

Contract No.:

Date of Contract:

Title of Invention:

Inventors:

Contractor's Invention
Disclosure Number:

NASA Invention
Disclosure Number:

WHEREAS, the "New Technology Clause," hereinafter called the "clause," contained in the above identified contract provides that any Reportable Item (*Invention, improvement or innovation*) made in the performance of work under the contract shall be presumed to have been made in the manner specified in paragraph (1) or (2) of the National Aeronautics and Space Act of 1958 as amended (*Hereinafter called the "Act"*), unless the Contractor at the time of reporting the invention submits to NASA a written statement, containing supporting details, demonstrating that the Reportable Item was not made in the manner specified in Section 305(a)(1) or (2) of the Act [see the Clause, paragraph (b)(1)(i)], which statement has not been submitted; and

WHEREAS, the Advance Waiver findings of the NASA Patent Waiver Regulations (1977) (14 CFR 1245.104) have been made and are applicable to this contract; and

WHEREAS, the Contractor has indicated its intention to file or has so filed a U.S. patent application on the Reportable Item identified above.

NOW, THEREFORE, the Administrator determines, pursuant to the provisions of Section 305(a) of the Act, based upon the presumption set forth in the above identified contract that the Reportable Item (*Invention*) identified above was made in the manner specified in Section 305(a)(1) or (2) of the Act, and has waived title in the above identified invention to the Contractor subject to: (1) the reservation of an irrevocable, nonexclusive, nontransferable, royalty-free license for the practice of the invention throughout the world by or on behalf of the United States of America or any agency thereof, State, or domestic municipal government, or any foreign government pursuant to any existing or future treaty or agreement with the United States of America; and (2) the additional RESERVATIONS set forth in the New Technology Clause of the contract, the Waiver Regulation 14 CFR 1245.107 and the Instrument of Waiver applicable to this contract which has been accepted by the Contractor.

CONDITIONS UNDER WHICH THIS WAIVER SHALL BE VOIDABLE

The waiver of domestic rights granted herein shall be voidable at the option of the Administrator, unless the Contractor:

Files or causes an application for U.S. Letters Patent to be filed within 6 months from the date of reporting an invention under the contract, claiming the invention and including within the first paragraph of the specification, the following statement:

"The invention described herein was made in the performance of work under NASA Contract No. _____ and is subject to the provisions of Section 305 of the National Aeronautics and Space Act of 1958, as amended (72 Stat. 435; 42 U.S.C. 2457)."

Within 2 months after the filing, or within 2 months after the date of the grant of waiver if such patent application previously has been filed, delivers to the Chairman, Inventions and Contributions Board, a copy of the application including the filing date and serial number.

Within 6 months after the filing, or within 6 months after the grant of waiver if a patent application previously has been filed, delivers to the Chairman a duly executed and approved instrument, prepared by the Government, fully confirmatory of all the rights in which the Government is entitled, and provides the Administrator the irrevocable power to inspect and make copies of the patent application.

Furnishes to the Chairman a copy of the patent within 2 months after the patent is issued on such application.

Notifies the Chairman, not less than 30 days before the expiration of the initial response period for any action required by the U.S. Patent and Trademark Office, of any decision not to continue prosecution of the application and delivers to the Chairman executed instruments granting the Government a power of attorney to prosecute the application.

Grants any license the Administrator may require pursuant to the RESERVATIONS specified below.

Files a utilization report with the Chairman, upon NASA's written request, not more often than annually. Such report shall set forth in detail the steps taken by the Contractor or its transferee regarding the progress, development, application and commercial use being made and that is intended to be made of the waived invention.

Notifies the Chairman in not less than 60 days prior to any transfer of principal rights in such invention to any party, and submits a statement of the transferee's development and commercialization plans to bring the invention to the point of practical application. Such statement should accompany the notification or it may be submitted in not less than 30 days prior to the transfer of rights. The statement must show to the Inventions and Contributions Board's satisfaction that the property rights in the transferee will increase the likelihood that the benefits of the invention will be made readily available to the public at an early date.

FOREIGN RIGHTS

In the event the Waiver Instrument includes a Waiver of Foreign Rights, these rights shall be voidable at the option of the Administrator, unless the Contractor:

Files or causes to be filed a corresponding patent application in each country within 8 months from the date the U.S. application is filed, or 6 months from the date granted by the Commissioner of Patents and Trademarks to file foreign applications where such filing has been prohibited for security reasons; or, such longer periods as may be expressly approved by the Administrator.

FOREIGN RIGHTS (continued)

Furnishes to the Chairman the identifying serial number and filing date of each foreign patent application promptly upon receipt thereof; and, upon request, without additional compensation, a copy of an English language version of the foreign application and a copy of the foreign references and/or patents;

Executes and furnishes to the Chairman instruments fully confirmatory of the rights herein reserved by the Government; and

In the event an election is made not to continue prosecution of any foreign application filed on such invention or, to abandon a foreign patent by the nonpayment of maintenance tax, notifies the Chairman within sufficient time to allow assumption of prosecution by the Government, or payment of the maintenance tax, respectively, and delivers to the Chairman such duly executed instruments as are necessary to vest in the Administrator title thereto, including an instrument of assignment.

RESERVATIONS

With respect to any particular Reportable Item, the waiver of domestic rights granted herein shall be subject to the reservation by the Administrator of the right to require the granting of a nonexclusive or exclusive license for the practice of the invention upon terms that are reasonable under the circumstances.

(a) Unless the Contractor, its licensees or assigns, have taken effective steps within 3 years after a U.S. patent issues on the invention to bring it to the point of practical application and thereafter continue to work the invention and make its benefits reasonably accessible to the public; or

(b) Unless within 3 years after a U.S. patent issues on the invention, the Contractor, its licensees, or its assigns have made the invention available for licensing royalty - free or on terms that are reasonable in the circumstances; or

(c) To the extent that the invention is required for public use by government regulations or as may be necessary to fulfill health, safety, or welfare needs, or for other public purposes stipulated in the contract.

Before any of the rights set forth in the RESERVATIONS above are exercised, notice shall be given to the Contractor that it may show cause before the Inventions and Contributions Board why it should not be required to grant such a license or why it should retain principal or exclusive rights as provided by the waiver for a further period of time.

The waiver of domestic and foreign rights granted herein shall be subject to the reservation by the Administrator of the right to require refund of any amounts received as royalty charges on the waived invention on procurements for or on behalf of the Government and to provide for that refund in any instrument transferring rights to any party in the waived invention.

Notice is hereby given that this Reportable Item may be disclosed and published at any time by the Administrator if such action is deemed by the Administration to be in the interests of the United States.

This Notice of Determination and Waiver of Title is duly executed in Washington, DC on _____