



Assignment to the Government and License to the Contractor (Previously Waived Invention)

WHEREAS, _____ of _____ [the Contractor] enters into Contract _____ with the National Aeronautics and Space Administration (NASA); and

WHEREAS, in the performance of work under said Contract, an invention was made by the employee(s) of the Contractor and reported to NASA wherein the Subject Invention became the exclusive property of the Government of the United States of America in accordance with Section 305(a) of the National Aeronautics and Space (NAS) Act of 1958, as amended, [42 U.S. C. 2457(a)]; and,

WHEREAS, pursuant to Section 305(f) of the NASA Act, the Contractor submitted to the Administrator of NASA a petition for Waiver of rights of the Government of the United States to the Subject Invention and, said petition was granted; and,

WHEREAS, in order to protect the rights to said invention, the Inventor(s) have assigned their entire right, title, interest and control to the Contractor; and,

SAID ASSIGNMENT to the Contractor from said Inventor(s) is recorded in the U.S. Patent and Trademark office at Reel _____, Frame _____; and,

WHEREAS, a patent application was filed on the invention and NASA desires to assume the prosecution of said patent application; and,

WHEREAS, the Administrator of NASA has now caused to be voided the Waiver of Rights to the subject invention; and,

NOW THEREFORE, the Contractor hereby transfers and assigns to the Government of the United States of America, as represented by the Administrator of NASA, the full and exclusive right in and to said Subject Invention and to the entire right, title, interest and control of:

Serial No.: Contractor Case No.:
Filed: Inventor(s):
NASA Case No.:
Waiver No.: Patent/Issued:
Title:

The Contractor further agrees to make, execute, and deliver unto the Government, upon request, but at the expense of the Government, any and all papers, documents, affidavits, statements, or other instruments that may be necessary in the prosecution of the aforesaid application and of any substitutions, divisions, continuations, or reissues of said application, and further agrees to aid the Government in every way in protecting this invention as may be requested, provided that any expense arising through extending such assistance will be paid by the Government.

FURTHERMORE, the Contractor is granted, pursuant to 14 CFR 1245.204(a), a revocable, nonexclusive, royalty-free license in the said application, Serial No. _____, Filing Date _____ cited above on the Subject Invention. The license shall extend to the Contractor's domestic subsidiaries and affiliates, if any, within the corporate structure of which the Contractor is a part and shall include the right to grant sublicenses of the same scope to the extent the Contractor was legally obligated to do so at the

time contract was awarded. The license shall be transferable only with the approval of the Administrator except when transferred to the successor of that part of the Contractor's business to which the invention pertains. The license may be revoked or modified by the Administrator to the extent necessary to achieve the earliest practical application of the Subject Invention pursuant to an application for exclusive license submitted in accordance with 14 CFR 1245.207. This license shall not be revoked in that field of use and/or the geographic areas in which the Contractor has achieved practical application and continues to make the benefits of the Subject Invention reasonably accessible to the public. The license in any foreign country may be revoked or modified at the discretion of the Administrator to the extent the Contractor or its domestic affiliates have failed to achieve practical application in that foreign country. Before revocation or modification of the license, the Contractor shall be allowed 30 days (or such other time as may be allowed by the Administrator for good cause shown by the Contractor) after the notice to show cause why the license should not be revoked or modified. The Contractor shall have the right to appeal, accordance with 14 CFR 1245.211(c), any decision concerning the revocation or modification of its license.

The _____, has caused this agreement to be executed by its duly authorized representative on _____.

NAME (*Type or print*) _____

TITLE (*Of corporate officer*) _____

SIGNATURE _____

Accepted for the benefit of the Government of the United States on behalf of NASA:

SIGNATURE _____
Associate General Counsel Intellectual Property

DATE _____