

Responsible Office: Intellectual Property Division (Code GP)
Subject: Process to Evaluate Candidates to License NASA Technologies and Negotiate Licenses



Office of General Counsel (Code G/HQ)

Office Work Instruction

Process to Evaluate Candidates to License NASA Technologies and Negotiate Licenses

Approved by: Original signed by Robert M. Stephens, Deputy General Counsel, for
Edward D. Frankle
General Counsel

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1. Purpose

The purpose of this procedure is to document the process by which the Office of General Counsel evaluates candidates to license NASA-patented technologies and grant or deny the grant of those licenses.

2. Scope and Applicability

- 2.1 This OWI covers the process performed in Code G to give public notification of NASA's intent to license NASA technologies, evaluate applications from the public to license NASA patented technologies, and grant or deny the grant of those licenses.

3. Definitions

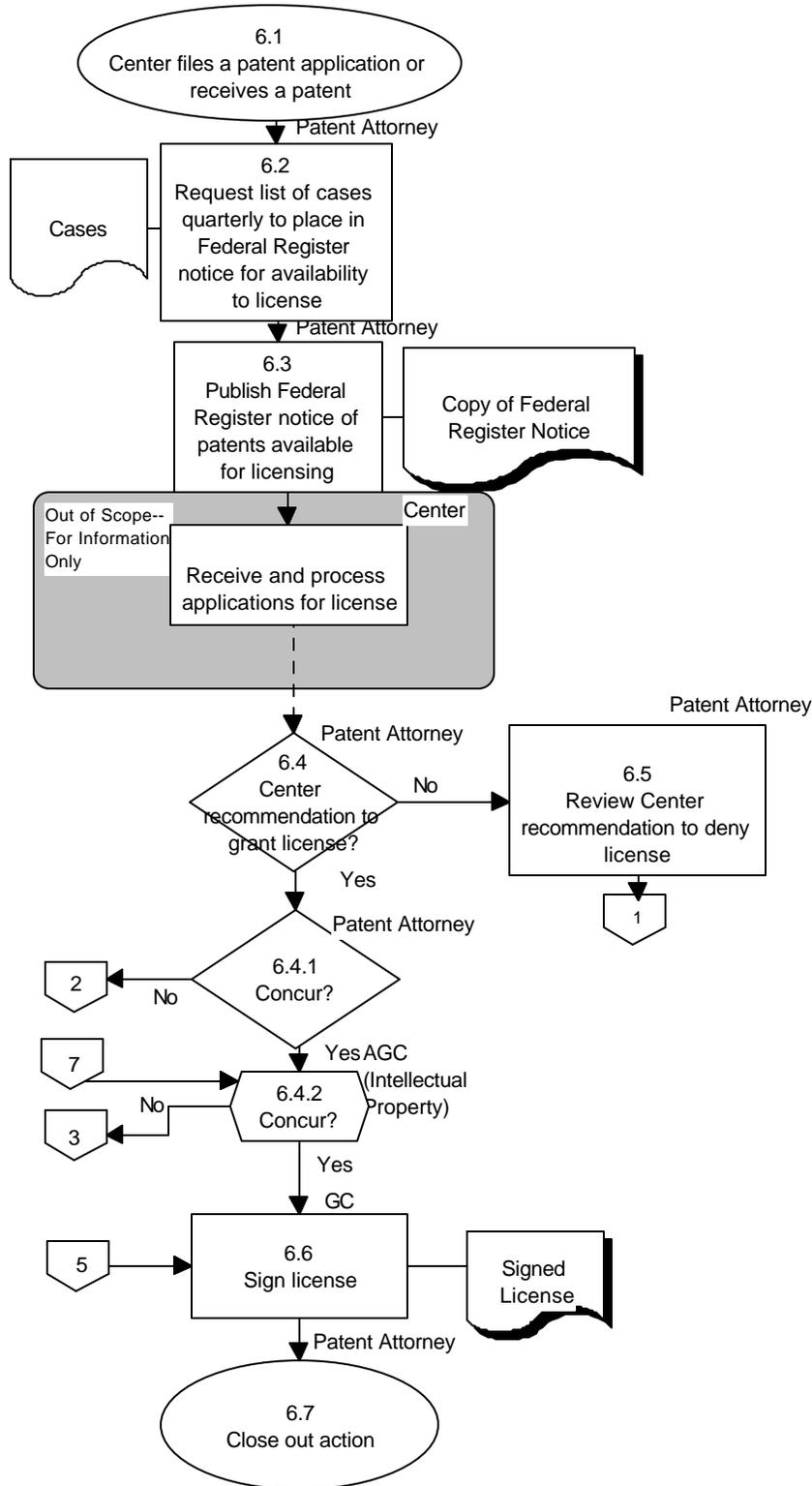
- 3.1 AGC (Intellectual Property). Assistant General Counsel for Intellectual Property
- 3.2 Determination to Deny License. Agency action to deny a license.
- 3.3 Determination to Grant License. Agency action to grant a license.
- 3.4 FRC. Federal Records Center
- 3.5 GC. General Counsel
- 3.6 License. A right to make, use, or sell a patented or patentable invention.
- 3.7 Patent. A grant of a right to exclude others from making, using, or selling an invention. Includes right to license others to make, use, or sell the invention
- 3.8 Patent Attorney. Code GP attorney responsible to (1) work with Center to publish a Federal Register notice that lists NASA-held patents that are available for licensing and (2) review recommendations made by the Center from the pool of respondents to the Federal Register notice regarding whether to grant or deny respondent applications to license the NASA-held patent.
- 3.9 USC. U.S. Code

4. References

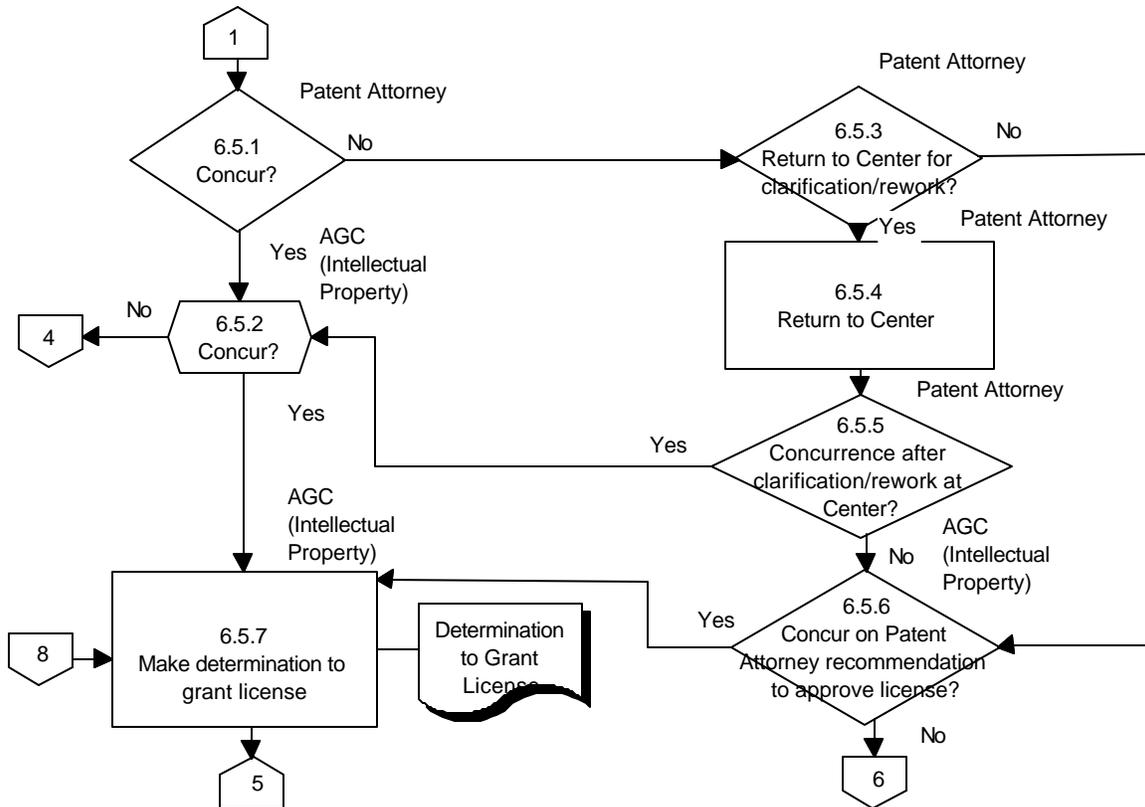
- 4.1 35 USC 200 et. seq. Patent Rights in Inventions Made with Federal Assistance, Policy and Objective

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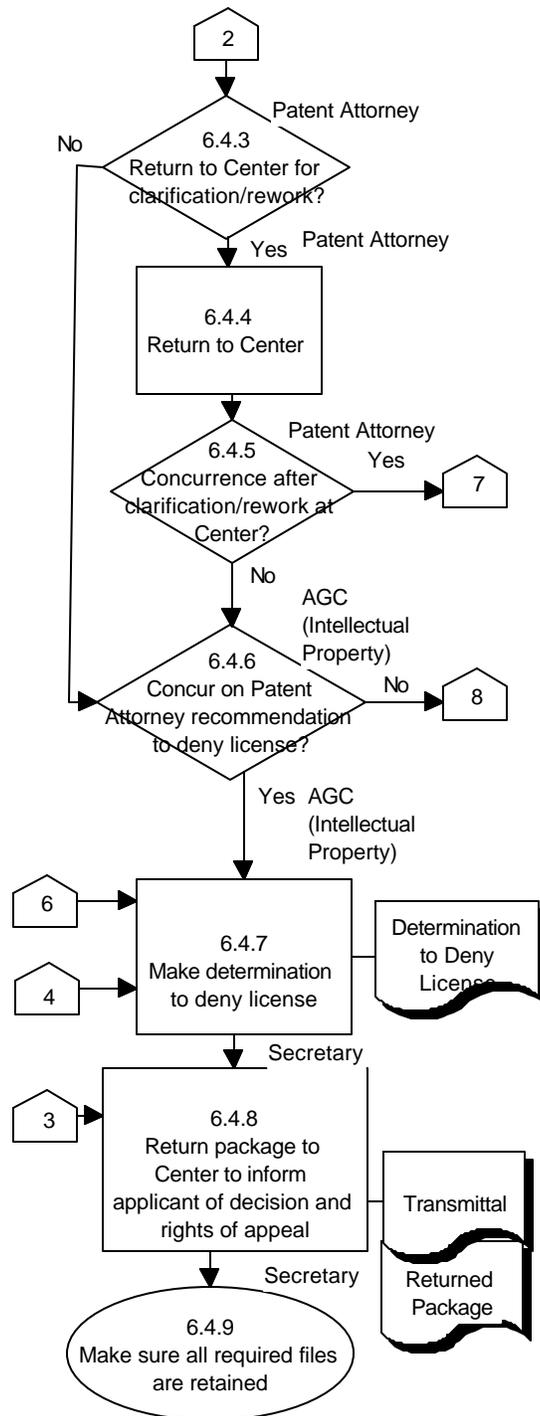
5. Flowchart



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6. Procedure

<u>Step</u>	<u>Actionee</u>	<u>Action</u>
6.1		Center files a patent application or receives a patent.
6.2	Patent Attorney	Request list of cases quarterly to place in a Federal Register notice that lists NASA-held patents that are available for licensing.
6.3	Patent Attorney	Forward required paperwork to National Archives to publish Federal Register notice. Retain copy of published Federal Register notice in records.
6.4	Patent Attorney	Review Center recommendations on the disposition of licenses forwarded to Headquarters from applications for licenses received in response to Federal Register notice. Go to Step 6.4.1 for Center recommendations to grant a license. Go to Step 6.5 for Center recommendations to deny a license.
6.4.1	Patent Attorney	If a concurrence is given on the Center recommendation to grant a license, concur by signature on the Center's recommendation, and forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.4.2). If a Determination to Grant a License is not made, go to Step 6.4.3.
6.4.2	AGC (Intellectual Property)	If a Determination is made to grant a license, forward the package to the GC for signature as a license (see Step 6.6). If Determination to Deny a License is made, go to Step 6.4.8.
6.4.3	Patent Attorney	Decide whether to return the recommendation package to the Center for clarification and/or rework. If the decision is to return the package, go to Step 6.4.4. If the decision is not to return the package, recommend that the AGC (Intellectual Property) make a Determination to Deny a License, note on the package that recommendation to deny the license and forward the package to the AGC (Intellectual Property) for a Determination to Deny a License (see Step 6.4.6).
6.4.4	Patent Attorney	Return the package to the Center for clarification and/or rework with an explanation regarding questions about the recommendation and/or issues that have to be reworked before the recommendation can be concurred on.
6.4.5	Patent Attorney	Review the reworked package from the Center, and decide whether to concur on the Center's recommendation to grant a license. This decision is made based on whether questions about the

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- recommendation have been clarified and/or issues associated with the approval of that recommendation have been reworked. If the decision is to concur on the Center's recommendation, forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.4.2). If the decision is not to concur on the reworked package, recommend that the AGC make a Determination to Deny a License, note that recommendation on the package, and forward the package to the AGC for a Determination to Deny a License (see Step 6.4.6).
- 6.4.6 AGC (Intellectual Property) Review Patent Attorney's recommendation to deny the license. If the decision is to concur on the Patent Attorney's recommendation, go to Step 6.4.7. If the decision is not to concur on the Patent Attorney's recommendation, go to Step 6.5.7.
- 6.4.7 AGC (Intellectual Property) Make determination to deny the license. Forward to the Secretary for return to the Center (see Step 6.4.8).
- 6.4.8 Secretary Return package to Center for the Center to inform the applicant of NASA's decision and the applicant's rights of appeal.
- 6.4.9 Secretary Make sure all required files are retained.
- 6.5 Patent Attorney Review the Center's recommendation to deny the license.
- 6.5.1 Patent Attorney If a concurrence is given on the Center recommendation to deny a license, concur by signature on the Center's recommendation, and forward the package to the AGC (Intellectual Property) for a Determination to Deny a License (see Step 6.5.2). If a nonconcurrence is given on the Center's recommendation, go to Step 6.5.3.
- 6.5.2 AGC (Intellectual Property) If a concurrence is given on the Center's recommendation to deny a license, go to Step 6.4.7. If a nonconcurrence is given on the Center's recommendation, go to Step 6.5.7.
- 6.5.3 Patent Attorney Decide whether to return the recommendation package to the Center for clarification and/or rework. If the decision is to return the package, go to Step 6.5.4. If the decision is not to return the package, recommend that the AGC (Intellectual Property) make a Determination to Grant a License, note on the package that recommendation to grant the license and forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.5.6).
- 6.5.4 Patent Attorney Return the package to the Center for clarification

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- and/or rework with an explanation regarding questions about the recommendation and/or issues that have to be reworked before the recommendation can be approved.
- 6.5.5 Patent Attorney Review the reworked package from the Center, and decide whether to concur on the Center's recommendation to deny a license. This decision is made based on whether questions about the recommendation have been clarified and/or issues associated with the approval of that recommendation have been reworked. If the decision is to concur on the Center's recommendation, forward the package to the AGC (Intellectual Property) for a Determination to Grant a License (see Step 6.5.2). If the decision is not to concur on the reworked package, recommend that the AGC make a Determination to Grant a License, note that recommendation on the package, and forward the package to the AGC for a Determination to Grant a License (see Step 6.5.6).
- 6.5.6 AGC (Intellectual Property) Review Patent Attorney's recommendation to grant the license. If the decision is to concur on the Patent Attorney's recommendation, go to Step 6.5.7. If the decision is not to concur on the Patent Attorney's recommendation, go to Step 6.4.7.
- 6.5.7 AGC (Intellectual Property) Make Determination to Grant a License. Forward the package to the GC for signature as a license (see Step 6.6).
- 6.6 GC Sign the license
- 6.7 Secretary Close out action. Retain three copies of the signed license. Retain one for Headquarters files. Send two to the Center. Ensure all required files are retained.

7. Quality Records

Record Identification	Owner	Location	Record Media: Electronic or Hard Copy	Schedule Number and Item Number (NPG 1441.1)	Retention/Disposition
Copy of Published Federal Register Notice	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Determination to Deny License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Transmittal	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old

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Returned Package	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Determination to Grant License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.B	Destroy when 2 years old
Signed License	Code GP	Code GP files	Hard Copy	Schedule 5, Item 17.A	Retire to FRC when 5 years old. Destroy when 25 years old.