

Proposed Acquisition Regulation Changes/ Considerations Related to Patent Rights

Presented to: FLC Northeast Regional Meeting

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Federal Aviation
Administration

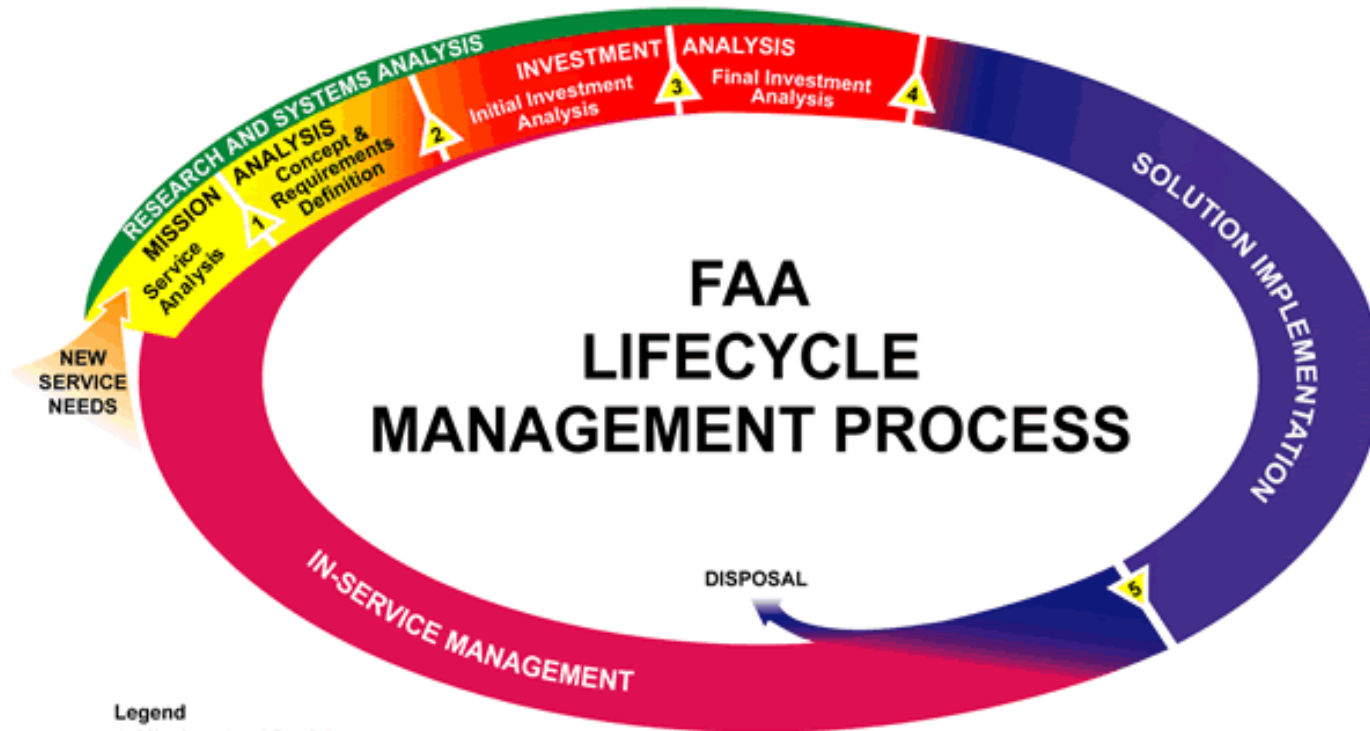


Objectives and Goals

- Inform about the acquisition lifecycle
- Market Research process – include current available technologies
- Use that information in developing acquisition strategy
- Establish invention reporting and process
- Establish process to access available technologies which may involve ORTAs



Acquisition Lifecycle*



Legend

- 1. Mission Need Decision
- 2. Investment Analysis Readiness Decision
- 3. Initial Investment Decision
- 4. Final Investment Decision
- 5. In-Service Decision

*From FAA's Acquisition Management System (AMS)
– FAA was exempt from the Federal Acquisition Regulations (FAR) in 1996

Market Research

- Both Federal Acquisition Regulations (FAR) and AMS set policies and procedures for market research
- Performed early in the early stage of procurement planning
- Helps shape appropriate procurement strategy



Techniques (Examples)

- Contacting knowledgeable individuals in Government and industry regarding market capabilities
- Publishing formal requests for information in technical, scientific, business or Government publications
- Reviewing Government and commercial databases that provide relevant information
 - I reviewed the USPTO and found **59** active patents filed by FAA contractors and grantees

Use the Results to: (Examples)

- Determine if sources capable of satisfying agency's requirements exist
- Determine if commercial items are available
- Determine the extent to which commercial items could be incorporated at the component level
- Were any of those 59 commercialized and determine how can they be used in requirement?

Investment Analysis

- Perform cost/benefit analysis
- Evaluate alternative solutions to mission need
- Provide realistic options
- Develop detailed plans and final requirements for a proposed investment opportunity



Investment Analysis Results

- The Contractor may retain the entire right, title, and interest throughout the world to each subject invention
- The Government retains a nonexclusive, nontransferable, irrevocable, paid-up license to practice for or on behalf of the United States the subject invention throughout the world
- Government can provide to their contractors to use for Government purpose
- If technologies are already available, you don't want to reinvent the wheel; take into consideration with cost/benefit analysis – may save time and money; we can use on a cost-free basis; do we develop or are they already being manufactured

Solution Implementation

- Develop statement of work, technical evaluation criteria, IGCE, whether or Government Furnished Equipment is to be furnished, rights in data (especially software)
- Contracting Officers determine type of contract and clauses for solicitation and award phases

Contract Administration

Re: Patents

- Monitor contractor invention disclosures and reporting requirements
 - Clause says submit to agency, to whom and then what?
- Ensure compliance with deadlines for filing, retaining title
- Determine to retain title if contractor does not
- Close-out: disposal of GFP and patents – title retention, etc.

Allocation of Principal Patent Rights Under Contracts

- The Contractor may retain the entire right, title, and interest throughout the world to each subject invention
- The Government retains a nonexclusive, nontransferable, irrevocable, paid-up license to practice for or on behalf of the United States the subject invention throughout the world

Patent Application Specification

“This invention was made in the performance of a Contract No. _____ with the Federal Aviation Administration, Department of Transportation. The Government of the United States has certain rights to use the invention.”

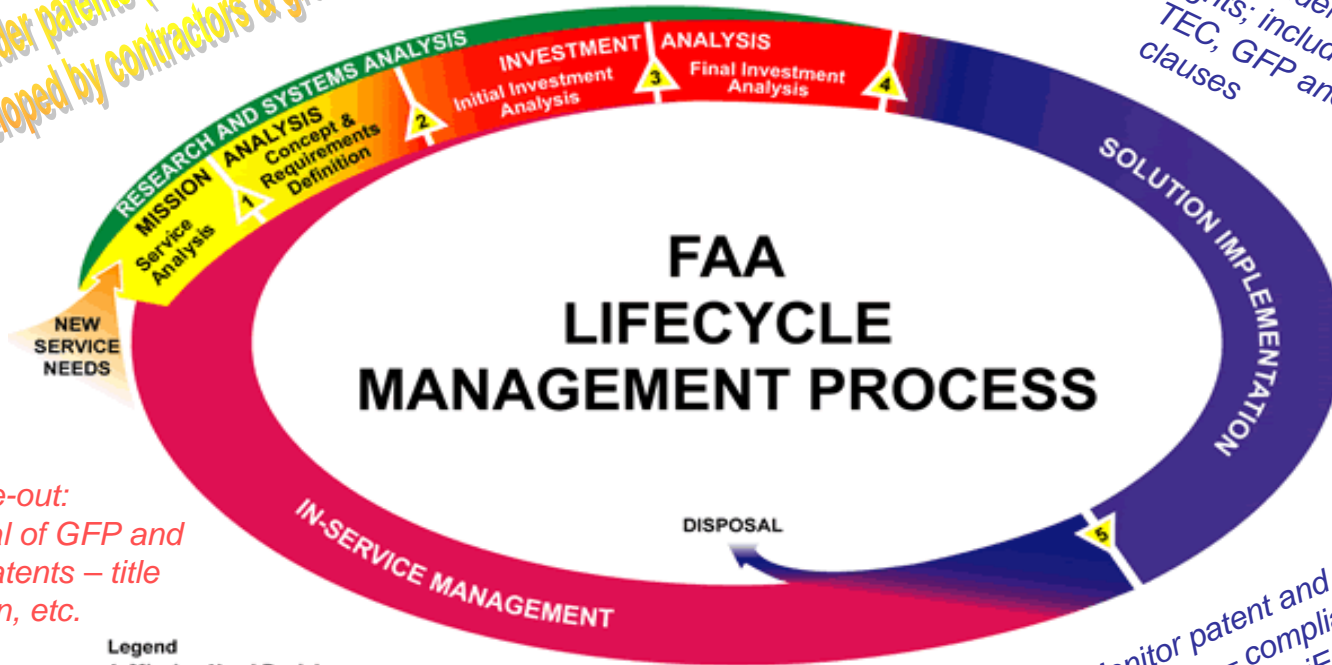


Consequences

1. Consider patents (new technologies) developed by contractors & grantees

2. Cost/Benefit Analysis

3. Consider software rights; include in SOW, TEC, GFP and contract clauses



5. Close-out: Disposal of GFP and other patents – title retention, etc.

4. Monitor patent and invention disclosures – compliance dates – retention; (Use iEdison ?)

- Legend
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Proposal

- Modify the FAR and AMS to ensure Investment Analysis and Market Research take into consideration all patented technologies that are available to the Government
- Establish pre and post award IP responsibilities and process
- Submitted request to AMS Policy Board

NIH's iEdison (Option)

- Allows Government grantees and contractors to report government-funded inventions, patents and utilization data
- Created and operated by the National Institutes of Health (NIH)
- Supports Bayh-Dole reporting to participating Federal agencies (only requires a MOA)
- Supports internal and external users
- Inconsistency in application



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Questions/Comments/ Thoughts?

