

S. 2171
 Analysis of Effect of
 Proposed Changes to Chapter
18 (old chapter 38) of PL 96-517

<u>Change</u>	<u>Section</u>	<u>Effect</u>
(1)	201(d)	✓ Include new plant varieties within definition of invention.
(2)	201(e)	Would include "date of determination" for plant varieties in addition to "conception" or "actual reduction to practice" when defining subject inventions.
(3)	202(a)	✓ Would no longer authorize other provisions in funding agreements for operation of Government owned facilities. Would authorize other patent provisions when contractor does not have a U.S. place of business.
(4)	202(b)	Would have Commerce Department and OFPP review instances when other patent provisions were used rather than the Controller General and Small Business Administration.
(5)	202(c) subparagraph 1.	Would change the time to: report subject inventions from "within a reasonable time after it is made" to "within a reasonable time after it becomes known to contractor personnel responsible for administration of patent matters."
	subparagraph 2.	Time for election to retain title would be changed from "reasonable time after disclosure" to "2 years after disclosure to the Federal agency" and the 2 year period "may be shortened by the agency to a date not more than 60 days prior to end of statutory period."
	subparagraph 3.	Would change the time for filing patent applications from "within

reasonable times" to "prior to any statutory bar date."

subparagraph 4.

Instead of permitting the funding agreements to give the government "rights to sublicense" foreign governments or other organizations "pursuant to existing or future treaty or agreements," the funding agreement could provide for "additional rights including the rights to assign or have assigned" foreign patent rights "necessary for meeting the obligations of the United States under any treaty" as well as various other stated types of agreements.

(6) 202(g)

✓
Would permit the agency to "waive all or any part of the rights of the United States" if the agency determines "the interests of the general public will be best served" or many other stated conditions would warrant a waiver.

(7) 202(c)(5)

✓
Instead of saying that utilization of invention information may be treated as not subject to FOI Act it (shall) be so treated. Not only will utilization of invention information be so treated but also information obtained pursuant to 203 (March-in Rights) will be so treated.

(8) 202(c)(7)
Clause A

✓
Would permit a subject invention to be assigned to a patent management organization even if it was itself engaged in Commerce which might utilize the invention.

Clause B

✓ ✓
The prohibition against granting exclusive licenses to big business except for short term is eliminated.

(9) 203

A paragraph would be added to March-in Rights to the effect that a dispute would not be subject to the Contract Dispute Act but instead would be subject to petition in the U.S. Claims Court.

- (10) 206 ✓ Regulations and funding agreement standard provisions would be issued by Commerce rather than OFPP.
- (11) 207 Would add a paragraph to the effect that Commerce is authorized to advise and assist in agency efforts to license and solicit patents for government owned inventions.
- (12) 208 Commerce instead of General Services would be authorized to issue regulations concerning licensing of government owned inventions. ✓
- (13) 209 subsection (c)(2) and subsection (d) Eliminate the prohibition against exclusive licenses when it would "lessen competition" or result in "undue concentration" of Commerce.
- (14) 211 Would limit "any antitrust law" to "any antitrust law of the United States."

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