

UNITED STATES PUBLIC HEALTH SERVICE TECHNOLOGY TRANSFER POLICY MANUAL

Chapter No. 202

PHS Policy for Leaving Title to Inventor(s) for Intramural Inventions

A. PURPOSE

This Manual Chapter sets forth the PHS policy for review and disposition of an inventor's request to leave title in a PHS invention in which it has or is owed an ownership interest (an "Intramural Invention") to the requesting inventor.

B. BACKGROUND

Under the Federal Technology Transfer Act of 1986 (FTTA), as amended and set forth in 15 U.S.C. § 3710d and 37 C.F.R. Part 501, a Government employee who is an inventor may request that the Government leave title in the invention to the employee. If the Government has insufficient interest in the invention to obtain or retain the right, title, and interest to a patent therein or to otherwise promote commercialization, the agency employing the inventor has the discretion to decide to leave title in the invention to the inventor. HHS regulations (45 C.F.R. Part 7), authorize the PHS to determine the appropriate disposition of the Government interests in a PHS Intramural Invention.

C. POLICY

PHS's policy for review and disposition of an inventor's request to leave title in a PHS Intramural Invention to the requesting inventor is directed by 15 U.S.C. § 3710d and 37 C.F.R. §§ 501.6-501.7. More specifically, PHS policy is to leave title in an Intramural Invention to an inventor when the PHS determines: (a) that the PHS does not intend to file for or maintain patent protection, or otherwise promote the commercial development of an Intramural Invention; and (b) that the transfer of rights to the requesting inventor is in the public interest. The PHS also may leave title to an inventor where the contribution of the Government is insufficient equitably to justify a requirement of assignment to the Government.

As provided in 15 U.S.C. § 3710d(a) and 37 C.F.R. § 501.6(a)(2), whenever title to an Intramural Invention is left to the employee-inventor, the Government shall reserve a nonexclusive, irrevocable, royalty-free license with the power to grant licenses for all governmental purposes, where the reservation will appear, where practicable, in any patent, domestic or foreign, which may issue on such invention.

In addition, the Government shall condition leaving title to an Intramural Invention upon compliance with all laws, regulations, and policies concerning conflict of interest that are applicable. When title to an Intramural Invention is left to an inventor who is currently a

PHS employee, the employee-inventor normally will be precluded from engaging in further work that would directly and predictably affect that financial interest as part of his or her official PHS duties in view of such conflict of interest provisions. Finally, the PHS retains sole discretion to add additional conditions, requirements, and/or restrictions that the PHS considers appropriate.

D. EFFECTIVE DATE

The policy set forth in this Manual Chapter is effective September 23, 2013, and supersedes in its entirety the policy in PHS Technology Transfer Manual Chapter 202, which was first approved on January 23, 1997 and revised on June 17, 2010.

E. ADDITIONAL INFORMATION

For further information on this Manual Chapter, contact the Office of Technology Transfer, NIH, (301) 496-7057 or <http://www.ott.nih.gov/contact-us> .