

AFFIRMATIVE DUTY TO REPORT INVENTIONS

At TACOM-ARDEC the following notice was distributed to alert our scientific and technical staff concerning their duty to report inventions and also to raise the level of awareness of inventive contributions so that patents can be obtained as one of the mission functions. This awareness is considered to be an important aspect of the culture of TACOM-ARDEC in maximizing the benefit and recognition of the way we perform our mission for the soldier as a research and development organization for munitions and weapon systems.

AMSTA-AR-GCL

22 January 2002

MEMORANDUM FOR ARDEC TECHNICAL COMMUNITY

SUBJECT: AFFIRMATIVE DUTY TO REPORT INVENTIONS

This notice is being distributed as a reminder to our technical staff, particularly S&Es, of their obligation to report to the Picatinny Legal Office all inventions developed or related to their job description.

On a number of occasions, particularly in dealing with contractors, there has been a failure to report inventions to the Legal Office in accordance with ARMY REGULATION 27-60. Just as contractor employees are obligated to report inventions made in the course of their employment to their employers, Federal employees are obligated to report inventions to the Army acting on behalf of the United States Government or for that matter the Agency that employs them. Typically in the private sector, technical employees are required to sign an agreement giving the company the right of ownership or title to all inventions and other intellectual property developed or related to their work duties.

How important is the execution of such a document? Well if the prospective employee fails to agree to assign these rights when first joining the company, the usual course of action is that they are simply not hired on. In the case of the Army there is the foregoing regulation placing a similar obligation on the Federal employee.

Almost every day in the business news we hear about issues of intellectual property often concerning patent matters where patent rights are being asserted by one company against another or being acquired in a given technology. The impact of such developments is so crucial to their business outlook that there is an immediate

impact on its stock price that determines the market evaluation of the publicly traded company.

Patents are very important to the Government too. Congress requests that information on patents being granted to the various government agencies be reported to them each year. This information is collected for quarterly System Measurement Reviews for the Commander and reported up through the chain of command since it is a measure of the Intellectual Activity of the various Federal Laboratories such as TACOM-ARDEC. It is taken as an indication of productivity to see how we compare to the research and development activity of other organizations in the government and also to outside entities such as companies.

Although our major function is to develop munitions and weapon systems for the soldier, the protection of the innovative aspects of such developments shows how creative we are as an organization in forging ahead with those new designs. Patent protection of these innovative aspects is a clear recognition of their value that has significance in terms of the recognition of intellectual achievement as well as potential licensing for commercial markets.

It was in recognition of this research and development activity that Congress passed the Technology Transfer Act. The Technology Transfer Act encourages licensing of government technology to industry. Through licensing of government patents to industry, the private sector benefits from advances in technology developed by the Federal Laboratories.

The best way you can fulfill this obligation and ensure these benefits is to alert us by timely filing an invention disclosure. Do not rely on the contractor to notify us on your behalf. Sometimes there are cases where the government inventors' contribution is not even recognized by failing to include them as inventors. If you are named as an inventor, your signing of legal documents such as a declaration of inventorship and an assignment will be required as part of the application process. Never execute such papers without first consulting with one of the patent attorneys in building 3 (Picatinny Legal Office). If you have reason to suspect that a patent is being filed and you are not presented with legal papers requiring your signature then your contribution is most likely not even being acknowledged, as indicated by the failure to name you as an inventor. When inventions are formulated from the exchange of thoughts/ideas from discussions at meetings, the identity of inventorship contributions can be problematic. The best practice would be for the government employees to discuss and review what

occurred at the meeting to identify who made inventorship contributions and agree that one of them will record or document the invention as part of an invention disclosure form for all to sign as inventors for submission to the Legal Office. Remember that most inventions are improvements to existing technology and are not totally new. They typically provide an advancement of some kind such as one or more new features or a better way of doing a known function, etc. If you are not clear or have a doubt whether an invention was actually made or who qualifies as an inventor, please contact us to discuss the matter.

Invention disclosures forms should be filed electronically. The forms may be accessed through the following link:
<https://w4.pica.army.mil/legal/IP.htm>

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