

United States Public Health Service Technology Transfer Procedure Manual

Chapter 203.1

NIH Procedures Related to Disposition of Rights in Inventions by Non-Employees Working at NIH, Receiving NIH Intramural Training Support or Working On-Site under Research Collaborations

A. PURPOSE

This Manual Chapter sets forth the NIH policy and procedures related to the disposition of rights in inventions made by non-employees working at NIH, receiving NIH intramural training support, or working on-site under research collaborations.

B. BACKGROUND

NIH Policy Manual Chapters 2300-308-1, Guest Researcher/Special Volunteer Programs, and 2300-308-4, NIH On-Site Research Collaboration Policy, provide that, in accordance with Executive Order 10096, as amended, and 45 CFR Part 7, patent rights for inventions developed in NIH facilities are NIH property unless NIH waives its rights. On a case by case basis, exceptions to this policy may be made.

C. PROCEDURES

NIH normally requires an assignment of invention rights from non-employees working at NIH or in NIH programs in exchange for the use of NIH facilities, equipment, materials, funds, information, and/or time and assistance of NIH employees to conduct research.

NIH may also determine, on a case-by-case basis, that it is advisable to assert less than an entire interest (but ordinarily no less than a joint ownership interest) in an invention where, for example, it determines that a university, sponsoring institution, collaborator or other partner contributes significant facilities, equipment, materials, funds, information or time and services to the support of the non-employee, or satisfies other criteria that NIH may wish to establish. In that case a royalty distribution between NIH and the partner might be negotiated separately, where royalties would ordinarily be equally shared or otherwise determined as agreed by the parties.

NIH program officials or supervisors may seek approval from the Deputy Director for Intramural Research (DDIR), in consultation with the Deputy Director for Extramural Research (DDER) as appropriate, to obtain less than the entire right to an invention made by a non-employee working at NIH or individual receiving intramural training support if the program, based on the facts, satisfies criteria established by the PHS Technology Transfer Policy Board (TTPB) or approval is otherwise deemed appropriate. An NIH program may seek approval for agreement language from the DDIR, in consultation with the DDER, where appropriate, for NIH to obtain less than the entire right to an invention made by a participant in a joint training program supported by NIH if the program partner satisfies criteria established by the TTPB or approval is otherwise deemed appropriate.

If NIH has agreed to obtain less than the entire right to an invention made by a non-employee working at NIH, then an Employee Invention Report submitted to NIH Office of Technology Transfer in which the non-employee is identified as an inventor should so indicate and include a copy of the agreement.

D. EFFECTIVE DATE

This manual chapter is effective September 23, 2013, and supersedes in its entirety PHS Technology Transfer Policy Manual Chapter 203, which was first approved on March 22, 2007.

E. ADDITIONAL INFORMATION

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