

§ 2200.211 Applicability of Subparts A through G.

The provisions of Subpart D (except for § 2200.57) and §§ 2200.34, 2200.37(d)(5), 2200.38, 2200.71, 2200.73 and 2200.74 will not apply to E-Z Trials. All other rules contained in Subparts A through G of the Commission's rules of procedure will apply when consistent with the rules in this subpart governing E-Z Trials.

Dated: August 8, 1995.

Earl R. Ohman, Jr.,
General Counsel.

[FR Doc. 95-19975 Filed 8-11-95; 8:45 am]

BILLING CODE 7600-01-M

DEPARTMENT OF COMMERCE**Assistant Secretary for Technology Policy****37 CFR Part 401**

[Docket No. 950615153-5153-01]

RIN 0692-AA14

Rights to Inventions Made by Nonprofit Organizations and Small Business Firms Under Government Grants, Contracts, and Cooperative Agreements; Electronic Filing of Written Submissions; Definition of the Term "Patent Application" or "Application for Patent"

AGENCY: Assistant Secretary for Technology Policy, Commerce.

ACTION: Interim rule with request for comments.

SUMMARY: This interim rule (1) authorizes certain government contractors and grantees to report electronically to the funding agencies their inventions and respective election of title on agency-approved systems; (2) recognizes that the law now authorizes the filing of provisional U.S. patent applications by defining the term "patent application" or "application for patent" to include provisional patent applications; and (3) updates the name and address of the office to where all submissions and inquiries should be sent.

Federal agencies each year enter into many research funding agreements with nonprofit organizations and small business firms, which require them to submit written reports and other information to the agencies relating to inventions made under the funding agreements. The reports and information must then be manually processed by the agencies. A number of these contractors, grantees and agencies have established computer systems for

keeping track of their inventions. It is desirable to utilize these systems to facilitate the invention reporting requirements by permitting contractors and grantees to submit reports and information to the agencies in electronic form. This would result in a reduction of time, paper and postage for the contractors and grantees and allow the agencies to more easily keep track of the inventions.

DATES: Interim rule effective August 14, 1995; comments must be received on or before September 13, 1995.

ADDRESSES: Comments may be mailed to Mr. Jon Paugh, Director, Technology Competitiveness Staff, Office of Technology Policy, Room 4418, Herbert C. Hoover Building, U.S. Department of Commerce, Washington, DC 20230.

FOR FURTHER INFORMATION CONTACT: Mr. Jon Paugh at telephone: (202) 482-2100.
SUPPLEMENTARY INFORMATION: Under the authority of 35 U.S.C. 206 and the delegation by the Secretary of Commerce in sec. 3(g) of DDO 10-18, the Assistant Secretary of Commerce for Technology Policy may issue revisions to 37 CFR Part 401.

Under the rule now in effect, contractors and grantees must report in writing to the funding agencies their inventions and respective election of title. They may also be required to indicate if an invention was not made. The reports are then manually placed by the agencies in their respective contract or grant files, a very burdensome and time consuming task.

Therefore, in order to facilitate reporting by contractors and grantees, new §§ 401.16 (a) and (b) are being added to 37 CFR Part 401 to authorize certain government contractors and grantees to report electronically to the funding agencies their inventions and respective election of title on agency-approved electronic or optical-electronic systems. These changes will help the agencies to maintain an up-to-date record of government-funded inventions which can be used to automatically track the status of these inventions so that rights in valuable inventions are not inadvertently lost.

New § 401.16(c) is being added to authorize a government contractor and grantee to electronically submit the close-out report in § 401.5(f)(1) and the information identified in §§ 401.5(f) (2) and (3), which at the present time, although not required, are usually submitted in writing to the agencies.

This rule change does not require contractors and grantees to electronically report their inventions to the Federal agencies and some may wish to continue to communicate in

writing. However, since a number of contractors and grantees have established computer systems to track their own inventions, it is expected that they would be interested in reporting their inventions electronically to the agencies. For this purpose, an electronic system named "EDISON" is being developed by the Division of Extramural Invention Reporting of the National Institutes of Health which will allow various contractors and grantees to submit certain information on their inventions by computer to the agencies. For information on EDISON, Sue Ohata, Acting Director, Division of Extramural Invention Reporting, NIH may be contacted at (301) 402-0850, by fax (301) 480-8443 or by e-mail at ohata@NIHOD1.bitnet.

New paragraphs (k) and (l) are being added to § 401.2 in order to define the terms "electronically filed" and "electronic or optical-electronic system" which are used in the new § 401.16.

Section 401.2(j) is being amended to define the term "Secretary" as the Assistant Secretary of Commerce for Technology Policy to conform with the authority citation for 37 CFR Part 401.

Public Law 103-465 amended 35 U.S.C. 111 to provide for the filing of provisional applications on or after June 8, 1995. To reflect this change in the law, the Patent and Trademark Office (PTO) amended 37 CFR Parts 1 and 3 to cover these provisional applications as indicated in the **Federal Register**, 60 FR 20195, April 25, 1995. The changes to 35 U.S.C. 111 and 37 CFR Parts 1 and 3 also affected 37 CFR Part 401. Accordingly, new paragraph (m) is being added to § 401.2 to recognize these changes by defining the term "patent application" or "application for patent" to include a provisional or nonprovisional U.S. national application for patent as defined in 37 CFR 1.9 (a)(2) and (a)(3), respectively, or an application for patent in a foreign country or in an international patent office.

New paragraph (n) is being added to § 401.2 to define the term "initial patent application" as a nonprovisional U.S. national application for patent as defined in 37 CFR 1.9(a)(3) to make it clear that the requirements stated in paragraph (c) of the standard clause at § 401.14(a) and in paragraph (c) of § 401.13 are not being changed. These paragraphs are based on 35 U.S.C. §§ 202(c) and 205, respectively, which refer to a U.S. national patent application filed under 35 U.S.C. 111 before it was amended by the Uruguay Round Agreements Act (Public Law 103-465).

Section 401.5(f)(2) is being amended to refer to patent application number rather than serial number by replacing the term "serial" with "patent application" in order to conform to the change made by the PTO to the title and paragraph (a) of 37 CFR 1.53 as indicated in the **Federal Register**, 60 FR 20195, April 25, 1995.

Section 401.13(c)(2) has been editorially amended to refer to a patent application rather than just an application.

Finally, current § 401.16 is being redesignated as § 401.17 and the address to where any submissions or inquiries should be sent is being updated since the Federal Technology Management Policy Division is now the Technology Competitiveness Staff which is part of the Office of Technology Policy (OTP)/ Technology Administration.

Pursuant to section 553 of the Administrative Procedure Act (5 U.S.C. 553) (APA), the Assistant Secretary of Commerce for Technology Policy finds that there is good cause for waiving, as impracticable, unnecessary, and contrary to public interest, the prior notice of proposed rulemaking and the required 30-day delay in the effective date because: (1) This interim rule provides a contractor or grantee the opportunity to report electronically inventions and respective election of title to the funding agency using an agency-approved electronic system which may result in cost savings to the contractor, grantee and/or the funding agency; (2) These changes are not considered substantive; and (3) This interim rule provides a 30-day comment period and any comments received will be considered prior to finalization of this interim rule.

This interim rule has been determined to be significant for purposes of E.O. 12866 (58 FR 51735, October 4, 1993).

This interim rule does not contain policies with Federalism implications sufficient to warrant preparation of a Federalism assessment under E.O. 12612.

Because a notice of proposed rulemaking and an opportunity for public comment are not required to be given for this rule by section 553 of the APA (5 U.S.C. 553) or by any other law, under sections 3(a) of the Regulatory Flexibility Act (5 U.S.C. 603(a) and 604(a)) no initial or final Regulatory Flexibility Analysis has to be or will be prepared.

This interim rule involves a collection of information which has approval under the Paperwork Reduction Act. The control number is 9000-0095.

List of Subjects in 37 CFR Part 401

Inventions, Patents, Nonprofit organizations, Small business firms.

For the reasons set forth in the preamble, 37 CFR part 401 is amended as follows:

PART 401—RIGHTS TO INVENTIONS MADE BY NONPROFIT ORGANIZATIONS AND SMALL BUSINESS FIRMS UNDER GOVERNMENT GRANTS, CONTRACTS, AND COOPERATIVE AGREEMENTS

1. The authority citation for 37 CFR part 401 continues to read as follows:

Authority: 35 U.S.C. 206 and the delegation of authority by the Secretary of Commerce to the Assistant Secretary of Commerce for Technology Policy at sec. 3(g) of DOO 10-18.

2. Section 401.2 is amended by revising paragraph (j) to read as follows:

§ 401.2 Definitions.

* * * * *

(j) The term "Secretary" means the Assistant Secretary of Commerce for Technology Policy.

3. New paragraphs (k), (l), (m) and (n) are added to § 401.2 to read as follows:

§ 401.2 Definitions.

* * * * *

(k) The term *electronically filed* means any submission of information transmitted by an electronic or optical-electronic system.

(l) The term *electronic or optical-electronic system* means a software-based system approved by the agency for the transmission of information.

(m) The term *patent application* or "application for patent" includes a provisional or nonprovisional U.S. national application for patent as defined in 37 CFR 1.9 (a)(2) and (a)(3), respectively, or an application for patent in a foreign country or in an international patent office.

(n) The term *initial patent application* means a nonprovisional U.S. national application for patent as defined in 37 CFR 1.9(a)(3).

4. Section 401.5 is amended by revising paragraph (f)(2) to read as follows:

§ 401.5 Modification and tailoring of clauses.

* * * * *

(f) * * *

(2) Provide, upon request, the filing date, patent application number and title; a copy of the patent application; and patent number and issue date for any subject invention in any country in

which the contractor has applied for a patent.

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5. Section 401.13 is amended by revising paragraph (c)(2) to read as follows:

§ 401.13 Administration of patent rights clauses.

* * * * *

(c) * * *

(2) In accordance with 35 U.S.C. 205, agencies shall not disclose or release for a period of 18 months from the filing date of the patent application to third parties pursuant to requests under the Freedom of Information Act, or otherwise, copies of any document which the agency obtained under this clause which is part of an application for patent with the U.S. Patent and Trademark Office or any foreign patent office filed by the contractor (or its assignees, licensees, or employees) on a subject invention to which the contractor has elected to retain title. This prohibition does not extend to disclosure to other government agencies or contractors of government agencies under an obligation to maintain such information in confidence.

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6. Section § 401.16 is redesignated as § 401.17 and revised to read as follows:

§ 401.17 Submissions and inquiries.

All submissions or inquiries should be directed to Director, Technology Competitiveness Staff, Office of Technology Policy, Technology Administration, telephone number 202-482-2100, Room H4418, U.S. Department of Commerce, Washington, D.C. 20230.

7. A new § 401.16 is added to read as follows:

§ 401.16 Electronic filing.

Unless otherwise requested or directed by the agency,

(a) the written report required in (c)(1) of the standard clause in § 401.14(a) may be electronically filed;

(b) the written election required in (c)(2) of the standard clause in § 401.14(a) may be electronically filed; and

(c) the close-out report in (f)(1) and the information identified in (f)(2) and (f)(3) of § 401.5 may be electronically filed.

Dated: August 7, 1995.

Graham Mitchell,

Assistant Secretary of Commerce for Technology Policy.

[FR Doc. 95-20023 Filed 8-11-95; 8:45 am]