Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

JOHN C. LOCKER APPELLANT
v.
DEPARTMENT OF THE ARMY, APPELLEE
GPB No. 10-4288
September 29, 1988

Donald J. Quigg

Assistant Secretary and Commissioner of Patents and Trademarks

DECISION ON APPEAL FROM GOVERNMENT EMPLOYEE RIGHTS DETERMINATION

***1** This is an appeal by John C. Locker (Locker) under 37 CFR 100.7 from a determination by the Department of the Army (Army) that the Government shall obtain the entire right, title and interest in an invention made by Locker. The invention is described in U.S. Patent Application, Serial No. 913,299, filed September 30, 1986.

The determination is vacated and remanded to the Army.

Background

The invention relates to a cam-operated spacing device for securing multiple electronic circuit boards in a spaced parallel relationship to one another and maintaining this spacing in environments where the circuit boards are subjected to high shock and vibration. The lobes of the cam-lock device are rotated 180 <<degrees>> to cause the lobes to engage the edges of the circuit board and secure them in place.

An Invention Rights Questionnaire, Form DA 2871, signed by Locker on October 22, 1986, reveals the following:

(1) Twenty-eight hours were spent by Locker making the invention; eight of those hours were on Government time.

(2) A drawing board, drafting machine and drafting room supplies, all owned by the Government, were used to prepare a drawing of the invention.

(3) The making of the invention was prompted when a problem was offered to the drafting department as a design challenge, the solution for which came from Locker's experience as an automobile mechanic.

(4) Locker was neither employed nor assigned to do any of the following:

a. invent, improve or perfect any process;
b. conduct or perform research or development;
c. act in a liaison capacity for research and development.

(5) Paul O. Prince (Prince), a lead engineering technician who was Locker's supervisor, states that those in the drafting department thought about the problem it had been given from time-to-time and sketched out some solutions. Prince further states that the design proposed by Locker "was accomplished over and above his assigned duties," which were to prepare "details of electrical and mechanical

assemblies, electronic and mechanical layouts and schematics ... from rough sketches and verbal instructions provided by electronic and mechanical engineers and/or his supervisor." Prince concludes that the invention was not related to any specific job or project assigned to Locker nor was it the set goal of a specific task given him. However, Prince indicates that once Locker had the idea of the invention, he did not need approval to continue development work on it as a Government project but could proceed on his own. A job description, Form DA 374, indicates that:

(6) Locker is an engineering draftsman (GS-818-05), who has, as one of his major duties, the preparation of drawings portraying electrical and electromechanical engineering ideas and information. His duties also include the preparation and/or assistance in the preparation of detailed drawings of designs and revisions for devices and components of a mechanical or electronic nature independently or in conjunction with orders.

***2** In its decision on reconsideration dated February 26, 1988, the Army states that:

(7) Mr. John Miller, a mechanical engineer who was in charge of the drafting department, supervised Prince and Joseph K. Price, another mechanical engineer.

(8) Price had the responsibility to solve a space problem associated with "cramming" a large amount of electronics onto circuit boards.

(9) Price directed Prince to look at the spacing and deflection problems with circuit boards in an assembly.

A memorandum from Price dated November 30, 1987, states that:

(10) Locker "was directed to investigate whether sufficient volume existed within the [XM42 Setter] module to accomodate [sic] spacers or other commonly used circuit board mounting provisions."

(11) Motorola Corp. built and vibration tested a printed circuit board mass model with the cam-lock feature of the invention. On the basis of the testing and its advantages as a connector, the cam-lock spacer was selected for use in the XM42 Setter Module.

Discussion

Paragraph 1(a) of Executive Order 10096, as amended, provides that the Government shall obtain the entire right, title, and interest in and to all inventions made by any Government employee (1) during working hours, or (2) with a contribution by the Government of facilities, equipment, materials, funds or information or of time or services of other Government employees on official duty,or (3) which bear a direct relation to or are made in consequence of the official duties of the inventor. See also 37 CFR 100.6(b)(1).

Paragraph 1(c) of the Executive Order provides that an invention made by an employee hired to (i) invent, (ii) conduct research, (iii) supervise Government financed or conducted research, or (iv) act as liaison among Government or non- government agencies conducting such research, shall be presumed to be made under Paragraph 1(a). See also 37 CFR 100.6(b)(3). Inventions made by other employees are presumed to fall under the scope of Paragraph 1(b). Either presumption may be overcome by the facts and circumstances of a given case.

On the basis of his position as a GS-5 engineering draftsman, Locker is entitled to a presumption that the invention was made under circumstances which would require that title be left to him subject either (1) to law, or (2) to a license for the Government. See In re Viglione, 231 USPQ 158 (Comm'r Pat.1986) where the inventors were aircraft mechanics.

The Army argues that the presumption of ownership by the Government under 37 CFR 100.6(b)(3) applies because "Locker was assigned to improve or perfect a design or manufacture." Both Locker and his supervisor Prince dispute this on the rights questionnaire (5). It is manifest that Locker's position description does not require him "to improve or perfect a design or manufacture." Thus, the question becomes whether Locker's official duties were somehow expanded beyond those specifically set forth in his job description. See In re Philips, 230 USPQ 351 (Comm'r Pat.1986).

***3** According to the record, only Prince was assigned to investigate the spacing and deflection problems in the circuit board assembly (9). Although the drafting department was working on a problem with circuit boards, it is not clear what that "problem" was. The fact that Locker was asked to determine the volume requirements of the XM42 Setter Module to accommodate spacers (10) is not considered as being equivalent to looking for an alternate spacing design. Accordingly, it is concluded that the evidence is insufficient to establish that Locker was specifically assigned to improve or perfect a design or manufacture.

The Army relies on the presumption that the Government is entitled to ownership, which Locker is said not to have overcome. However, contrary to the Army's opinion, the record demonstrates that the facts support applying a different presumption, namely that the inventor is entitled to ownership. Accordingly, the Army's decision cannot be affirmed.

With respect to the issue of Government contribution to the invention including time (1), materials (2), information about the problem (3), and a reduction of practice by an Army contractor (11), the Army concludes that the contribution is not "insufficient equitably to justify a requirement of assignment." Because the Army applied the wrong presumption as explained above, it is not clear that it would have made the same rights decision if the extent of Government contribution was evaluated to determine whether it was sufficient to rebut a different presumption. Compare In re Viglione, supra with In re King, 3 USPQ 2d 1747 (Comm'r Pat.1987).

Decision

The determination of the Army that the Government is entitled to an assignment of all right, title and interest in and to the above-identified invention is vacated and remanded.

Any request for reconsideration or modification of this decision must be filed within one (1) month from the date hereof. If such a request is not made, the Army is required to make a new rights determination within two (2) months subject to review by the Patent and Trademark

Office under 37 CFR Part 100.

9 U.S.P.Q.2d 1412

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