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

IN THE MATTER OF: WILLIAM R. PHILLIPS
GPB Case No. 10-4261
March 3, 1987

Donald W. Peterson

Deputy Commissioner of Patents and Trademarks

DECISION ON APPEAL FROM GOVERNMENT EMPLOYEE INVENTION RIGHTS DETERMINATION

***1** This is an appeal by a Government employee, William R. Phillips (Phillips), from a determination by the Department of the Army (Army) that title to an invention made by the employee be left in the employee subject to a reservation to the Government of a non-exclusive, irrevocable, royalty-free license in the invention with power to grant a license for all governmental purposes.

The determination of the Army is affirmed.

Background

The invention relates to a method of providing TV surveillance without the need for cumbersome pan and tilt mechanisms. The method involves underscanning a conventional TV camera and dynamically moving the resultant reduced size raster over the photo conductive surface. Movement of the raster over the photo conductive surface emulates the vertical and horizontal movement provided by the pan and tilt mechanism.

An 'invention rights questionnaire' signed by Phillips was prepared which states that:

(1) Phillips is employed as a GS-13 team leader for the Electro Optical Simulation System (EOSS) with responsibilities for operation and maintenance of the EOSS; design, development and implementation of hardware-in-the-loop simulations using the EOSS; and development of electro-optical simulation techniques and devices at the U.S. Army Missile Command.

(2) No Government time, facilities, equipment, materials or funds were used in making the invention.

(3) The contribution the Government made to his invention was 'information on underscanning techniques and camera circuit modification . . . obtained from previous invention disclosure entitled 'Electronic Image Stabilization,' Serial No. 771,751, AMPC Docket Number 4331, dated 3 Sep 85.'

(4) This invention was prompted by knowledge and insight gained from

the invention disclosure identified above.

(5) Phillips' supervisor, Donald H. Dublin (Dublin), states that the invention was 'related, but not directly' to Phillips' specific job or project assignment; Phillips would have had to obtain approval of any project he worked on; Phillips was under no obligation to reveal this particular invention to his supervisor; and Dublin had no knowledge of this invention.

Discussion

Paragraph 1(a) of Executive Order 10096 (1950), as amended by Executive Order 10930 (1961), provides that the Government shall obtain the entire right, title and interest in and to all inventions made by any Government employee with a contribution by the Government of information or 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 in applying the provisions of Paragraph 1(a) to the facts and circumstances relating to the making of any invention:

***2** 'It shall be presumed that an invention made by an employee who is employed or assigned . . . to conduct or perform research, development work, or both . . . [or] to supervise, direct, coordinate, or review Government financed or conducted research, development work, or both . . . falls within the provision of paragraph (a) . . ..

***

[The] . . . presumption may be rebutted by the facts and circumstances attendant upon the conditions under which any particular invention is made . . ..'

See also 37 CFR § 100.6(b)(3).

The Army argues that Phillips developed his invention using Government information, and that the invention was made as a consequence of official duties under Paragraph 1(a) of the Executive Order. Further the Army maintains that the inventor has ignored the wording of the Executive Order by arguing only the alleged lack of 'direct relation' of his invention to his duties. The Army also points to the inventor's position description at itemized task number 2 wherein it states the inventor, '[o]ffers suggestions in those areas dealing with applied research and directs technical changes of approach in development work' and would therefore have developed the invention as a consequence of his official duties.

Under Paragraph 1(c)(ii) of Executive Order 10096 (1950), as amended, Phillips' invention is presumed to fall within Paragraph 1(a) of the Executive Order since he was employed to conduct or perform development work for the Army according to both his 'invention rights questionnaire' and his position description. This presumption may be overcome based on the facts of this case. See Paragraph 1(c) of the Executive Order and 37 CFR 100.6(b)(3).

The facts demonstrate that the Government contributed information under Paragraph 1(a) of Executive Order 10096, as amended. Phillips

admits that he obtained the information on underscanning techniques and camera modification from U. S. Patent Application Serial No. 771,751, AMPC Docket Number 4331. The Army asserts that the invention in Serial No. 771,751 was made on Government time, using Government equipment and in accordance with assigned Government duties. Phillips does not challenge this assertion. Moreover, Patent No. 4,637,571 (issued January 20, 1987) which resulted from Serial No. 771,751 is assigned to the Government, which supports the assertion by the Army.

35 U.S.C. § 122 requires that patent applications be maintained in confidence by the Patent and Trademark Office and are not available to the public. Consequently, the patent which issued from Serial No. 771,751 was not open to the public until after Phillips made the instant invention. On this record the information Phillips obtained for his invention on underscanning techniques and camera modifications appears to come from Serial No. 771,751; thus, Phillips received information from the Army. No documentation has been presented to show that this information was otherwise available. See In re Smeh, 228 USPQ 49 (1985). Phillips' invention therefore falls within Paragraph 1(a)(1) of Executive Order 10096; 37 CFR § 100.6(b)(1)(ii). Although the Government could obtain the entire right, title and interest to this invention, the Army determined that it would be inequitable for the Government to do so considering the circumstances of this case. No Government time, facilities, equipment, material or funds were used in the development of the invention. There is no basis for questioning the Army's determination that the information received from Serial No. 771,751 was insufficient alone to equitably justify assignment of the entire right. Therefore, the Army properly invoked Paragraph 1(b) of Executive Order 10096; 37 CFR § 100.6(b)(2).

***3** In light of the affirmance based on Phillips' receipt and use of Government information, it is unnecessary to decide whether the invention was directly related to Phillips' job responsibilities.

Decision

The decision of the Department of the Army that title to the invention made by the employee be left in the employee subject to a reservation to the Government of a non-exclusive, irrevocable, royalty-free license in the invention with power to grant a license for all governmental purposes is affirmed.

2 U.S.P.Q.2d 1644

END OF DOCUMENT