

## National Science Foundation

## § 650.18

by an awardee to comply with the requirements of paragraph (c) of the Patent Rights clause in §650.4(a). The interested institution, the inventor, the patent holder, and any other interested party will be given an opportunity to explain why a particular invention was not disclosed, why an election was not made, or why a patent application was not filed. If the Patent Assistant determines that a genuine dispute over material facts exists, a cross-directorate fact-finding panel will be appointed by the General Counsel. The panel will establish its own fact-finding procedures based on the dimensions of the particular dispute. Written findings of facts will be submitted to the General Counsel, sent by certified mail to the patent holder, and made available to all other interested parties.

(d) The NSF General Counsel will determine whether the Foundation should request conveyance of title or if it should retain title obtained under §650.14(b).

### § 650.15 Appeals.

(a) All actions by the NSF Patent Assistant under §650.8 denying an inventor's request to retain rights to a subject invention, under §650.12 denying a request for waiver, or under §650.14(d) denying the existence of a material dispute may be appealed to the Director of the NSF Division of Grants and Contracts by an affected party within thirty days. A request under §650.14(b) to immediately convey title to the Foundation may be appealed to the DGC Director by the title holder within five days.

(b) All actions by a Grants and Agreements Officer or Contracting Officer refusing to eliminate restrictions on or limitation of the right of an awardee to retain title to subject inventions imposed under §650.5 of this regulation may be appealed to the Director of the NSF Division of Contracts, Policy, and Oversight (CPO) by an affected party within thirty days.

(c) A decision by the General Counsel to exercise a march-in right or to request conveyance of title may be appealed by the patent holder or any affected licensee to the NSF Deputy Director within thirty days. When a march-in was initiated in response to a

petition, the General Counsel's decision not to exercise a march-in right or to exercise it in a manner different from that requested in the petition may be appealed by the petitioner to the NSF Deputy Director within thirty days.

(d) In reviewing the actions of the NSF Patent Assistant, a Grants and Agreements Officer, a Contracting Officer, or the General Counsel, the CPO Director or NSF Deputy Director will consider both the factual and legal basis for the action or determination and its consistency with the policies and objectives of the Foundation and, if applicable, the Bayh-Dole Act (35 U.S.C. 200-212) and implementing regulations at part 401 of title 37 of the Code of Federal Regulations.

[57 FR 18053, Apr. 28, 1992, as amended at 61 FR 51022, Sept. 30, 1996]

### § 650.16 Background rights.

The Foundation will acquire rights to a research performer's pre-existing technology only in exceptional circumstances where, due to the nature of the research being supported, the Foundation requires greater control over resulting inventions. The NSF Grants or Contracts Officer, with concurrence of the cognizant Program Manager, will negotiate a background rights provision. If the affected awardee is a small business firm or nonprofit organization, the provision will conform to the requirements of the Bayh-Dole Act (35 U.S.C. 202(f)) as implemented by 37 CFR 401.12).

### § 650.17 Subcontracts.

As provided in paragraph (g) of the Patent Rights clause in §650.4(a), awardees should normally use that clause in all subcontracts. At the request of the awardee or subcontractor or on recommendation from NSF staff, the cognizant Grants or Contracts Officer may direct the awardee to insert into subcontracts relating to scientific research a special patent provision negotiated under §650.5.

### § 650.18 Delegation of authority.

The General Counsel is responsible for implementing this regulation and is authorized to make any exceptions to or extensions of the NSF Patent Policy