

# **Intellectual Property and Media Release**

## **Intellectual Property - Summary**

In addition to any rights granted to NIA Recipients, as applicable, recipients of monetary awards under the Gateways to Blue Skies (Blue Skies) Competition agree to grant to NASA and the Federal Government, as the source of awards funding, the Rights in Data and Patent Rights set forth in detail below. In summary, awardees agree to grant to NASA and the Federal Government (i) a license to use, distribute, reproduce, perform, display, and prepare derivative works, any data first produced by recipient in carrying out recipient's responsibilities under this award in which the recipient asserts copyright, or data for which copyright ownership was acquired under the grant for Federal purposes and to have or permit others to do so for Federal purposes only, and (ii) a license to practice or have practiced for or on behalf of the United States any invention of the recipient conceived or first actually reduced to practice in the performance of work under this award if recipient chooses to retain title to such invention, and NASA may elect to obtain title or patent such invention if recipient chooses not to do so, all as set forth more particularly in the below Rights in Data and Patent Rights provisions.

*Please see "[Intellectual Property – Terms](#)" below for full details.*

## **Media Release**

The recipients of monetary awards under the Blue Skies Competition ("Teams") agree to give permission to be recorded, photographed and/or videotaped by or for NIA, NASA or their representatives or designees for the purpose of announcements and other outreach or informational purposes, including public announcements, external media coverage, and other promotional opportunities, concerning the Competition.

The Teams further give permission to NIA, NASA or their representatives or designees to use, reproduce, prepare derivative works, publish, distribute to the public, perform publicly, and/or publicly display all deliverables, including excerpts and any ancillary material, which may include each team participants' names, affiliations (schools), images, voice, and/or likenesses. NIA or NASA may distribute the materials, including excerpts therefrom, and any ancillary material through a variety of media in existence now or in the future, including but not limited to print, television, websites, radio, or any other means. NASA may also permit a third party to exercise NASA's rights, including but not limited to the right to display or distribute the recording, including excerpts therefrom, and any ancillary material, in any manner NASA deems appropriate.

The teams also understand that this permission to use each participant's name, image, voice and/ or likeness in such materials is not limited in time and team participant will not receive compensation for granting this permission.

Teams acknowledge that NASA has no obligation to use any participant's name, affiliation, image, voice, and/or likeness in any materials produced by NASA, but if NASA so decides to use them, each participant waives the right to inspect or approve any such use.

Teams hereby unconditionally release NASA and its representatives from any and all claims and demands arising out of the activities authorized under this Media Release.

## **Intellectual Property – Terms**

### Rights in Data

- (a) "Data," as used in this term and condition, means recorded information, regardless of form, the media on which it may be recorded, or the method of recording. The term includes, but is not limited to, data of a scientific or technical nature, and any copyrightable work, including computer software and documentation thereof.

- (b) As to data first produced by recipient in carrying out recipient's responsibilities under this award in which the recipient asserts copyright, or data for which copyright ownership was acquired under the grant, the recipient grants to the Federal Government (Government), a royalty-free, nonexclusive and irrevocable license to use, reproduce, distribute (including distribution by transmission) to the public, perform publicly, prepare derivative works, and display publicly, data in whole or in part and in any manner for Federal purposes and to have or permit others to do so for Federal purposes only.
- (c) In order that the Government may exercise its license rights in data, the Government, upon request to the recipient, shall have the right to review and/or obtain delivery of data resulting from the performance of work under this award or acquired under this award, and authorize others to receive such data to use for Federal purposes.
- (d) As to data first produced by NASA in carrying out NASA's responsibilities under a cooperative agreement and which data would embody trade secrets or would comprise commercial or financial information that is privileged or confidential if it has been obtained from the recipient, such data will be marked with an appropriate legend and maintained in confidence for 1 year after development of the information, with the express understanding that during the aforesaid period such data may be disclosed and used (under suitable protective conditions) by or on behalf of the Government for Government purposes only, and thereafter for any purpose whatsoever without restriction on disclosure and use. Recipient agrees not to disclose such data to any third party without NASA's written approval until the aforementioned restricted period expires.

#### Patent Rights

##### (a) Definitions

- (1) Invention means any invention or discovery which is or may be patentable or Subject invention means any invention of the recipient conceived or first actually reduced to practice in the performance of work under this award, provided that in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act, 7 U.S.C. 2401(d)) must also occur during the period of award performance.
- (2) Practical Application means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and, in each case, under such conditions as to establish that the invention is being utilized and that its benefits are, to the extent permitted by law or government regulations, available to the public on reasonable terms.
- (3) Made when used in relation to any invention means the conception or first actual reduction to practice of such invention.
- (4) Small Business Firm means a small business concern as defined at section 2 of Pub. L. 85-536 (15 U.S.C. 632) and implementing regulations of the Administrator of the Small Business Administration. For the purpose of this clause, the size standards for small business concerns involved in government procurement and subawarding at 13 CFR 121.3-8 and 13 CFR 121.3-12, respectively, will be used.
- (5) Nonprofit Organization means a university or other institution of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 501(c) and exempt from taxation under section 501(a) of the Internal Revenue Code (25 U.S.C. 501(a)) or any nonprofit scientific or educational organization qualified under a state nonprofit organization statute.
- (6) The term statutory period means the one-year period before the effective filing date of a claimed invention during which exceptions to prior art exist per 35 U.S.C. 102(b) as amended by the Leahy-Smith America Invents Act, Public Law 112-29.

- (7) The term recipient means any person, small business firm or nonprofit organization, or, as set forth in section 1, paragraph (b)(4) of Executive Order 12591, as amended, any business firm regardless of size, which is a party to a funding agreement.

(b) Allocation of Principal Rights

The Recipient may retain the entire right, title, and interest throughout the world to each subject invention subject to the provisions of this clause and 35 U.S.C. 203. With respect to any subject invention in which the Recipient retains title, the Federal government shall have a nonexclusive, nontransferable, irrevocable, paid up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

(c) Invention Disclosure, Election of Title and Filing of Patent Application by Recipient

- (1) The recipient will disclose each subject invention to NASA within two months after detail to convey a clear understanding to the extent known at the time of the disclosure, of the nature, purpose, operation, and the physical, chemical, biological or electrical characteristics of the invention. The disclosure shall also identify any publication, on sale or public use of the invention and whether a manuscript describing the invention has been submitted for publication and, if so, whether it has been accepted for publication at the time of disclosure. In addition, after disclosure to NASA, the Recipient will promptly notify NASA of the acceptance of any manuscript describing the invention for publication or of any on sale or public use planned by the recipient.
- (2) The recipient will elect in writing whether or not to retain title to any such invention by notifying NASA within two years of disclosure to NASA. However, in any case where a patent, a printed publication, public use, sale, or other availability to the public has initiated the one-year statutory period wherein valid patent protection can still be obtained in the United States, the period for election of title may be shortened by NASA to a date that is no more than 60 days prior to the end of the statutory period.
- (3) The recipient will file its initial patent application on a subject invention to which it elects to retain title within one year after election of title or, if earlier, prior to the end of any statutory period wherein valid patent protection can be obtained in the United States after a publication, on sale, or public use. If the recipient files a provisional application as its initial patent application, it shall file a non-provisional application within 10 months of the filing of the provisional application. The recipient will file patent applications in additional countries or international patent offices within either ten months of the first filed patent application or six months from the date permission is granted by the Commissioner of Patents to file foreign patent applications where such filing has been prohibited by a Secrecy Order.
- (4) For any subject invention with NASA and recipient co-inventors, where NASA employing such co-inventor determines that it would be in the interest of the government, pursuant to 35 U.S.C. 207(a)(3), to file an initial patent application on the subject invention, NASA employing such coinventor, at its discretion and in consultation with the recipient, may file such application at its own expense, provided that the recipient retains the ability to elect title pursuant to 35 U.S.C. 202(a).
- (5) Requests for extension of the time for disclosure, election, and filing under paragraphs (1), (2), and (3) of this clause may, at the discretion of NASA, be granted. When a recipient has requested an extension for filing a non-provisional application after filing a provisional application, a one year extension will be granted unless NASA notifies the recipient within 60 days of receiving the request.
- (6) The recipient may use whatever format is convenient to disclose subject invention required in subparagraph (c)(1). NASA prefers that the recipient use either the electronic or paper version of NASA Form 1679, Disclosure of Invention and New Technology (Including Software), to disclose subject inventions. Both the electronic and paper version of NASA Form 1679 may be accessed at the electronic New Technology Reporting Web site <https://invention.nasa.gov>.

(7) In addition to the above, the recipient shall provide the New Technology Representative, as designated under term and condition “Designation of New Technology Representative and Patent Representative” at Appendix D24 of the GCAM, the following:

- (i) A yearly interim new technology summary report listing any subject inventions required to be disclosed during the preceding year (or a statement certifying there were none).
- (ii) A final new technology summary report listing all subject inventions (or a statement certifying there were none) for the entire award period; which report shall be submitted within 120 days after the end date for the period of performance within the designated system noted within the award document.

(d) Conditions When the Government May Obtain Title

The recipient will convey to NASA, upon written request, title to any subject invention -

- (1) If the recipient fails to disclose or elect title to the subject invention within the times specified in paragraph (c) of this clause, or elects not to retain title.
- (2) In those countries in which the recipient fails to file patent applications within the times specified in paragraph (c) of this clause; provided, however, that if the recipient has filed a patent application in a country after the times specified in paragraph (c) of this clause, but prior to its receipt of the written request of NASA, the recipient shall continue to retain title in that country.
- (3) In any country in which the recipient decides not to continue the prosecution of any nonprovisional patent application for, to pay a maintenance, annuity or renewal fee on, or to defend in a reexamination or opposition proceeding on, a patent on a subject invention.

(e) Minimum Rights to Recipient and Protection of the Recipient Right to File

- (1) The recipient will retain a nonexclusive royalty-free license throughout the world in each subject invention to which the Government obtains title, except if the recipient fails to disclose the invention within the times specified in (c), above. The recipient’s license extends to its domestic subsidiary and affiliates, if any, within the corporate structure of which the recipient is a party

and includes the right to grant sublicenses of the same scope to the extent the recipient was legally obligated to do so at the time the award was awarded. The license is transferable only with the approval of NASA except when transferred to the successor of that party of the recipient’s business to which the invention pertains.

- (2) The recipient’s domestic license may be revoked or modified by NASA to the extent necessary to achieve expeditious practical application of the subject invention pursuant to an application for an exclusive license submitted in accordance with applicable provisions at 37 CFR part 404 and NASA licensing regulations (if any). This license will not be revoked in that field of use or the geographical areas in which the recipient has achieved practical application and continues to make the benefits of the invention reasonably accessible to the public. The license in any foreign country may be revoked or modified at the discretion of NASA to the extent the recipient, its licensees, or the domestic subsidiaries or affiliates have failed to achieve practical application in that foreign country.
- (3) Before revocation or modification of the license, NASA will furnish the recipient a written notice of its intention to revoke or modify the license, and the recipient will be allowed thirty days (or such other time as may be authorized by NASA for good cause shown by the recipient) after the notice to show cause why the license should not be revoked or modified. The recipient has the right to appeal, in accordance with applicable regulations in 37 CFR part 404 and NASA regulations (if any) concerning the licensing of Government-owned inventions, any decision concerning the revocation or modification of the license.

(f) Recipient Action to Protect the Government's Interest

- (1) The recipient agrees to execute or to have executed and promptly deliver to NASA all instruments necessary to (i) establish or confirm the rights the Government has throughout the world in those subject inventions to which the recipient elects to retain title, and (ii) convey title to NASA when requested under paragraph (d) above and to enable the government to obtain patent protection throughout the world in that subject invention. (iii) The recipient shall through employee agreements or other suitable recipient policy, require that its employees "will assign and do hereby assign" to the recipient all right, title and interest in any subject invention under this award."
- (2) The recipient agrees to require, by written agreement, its employees, other than clerical and nontechnical employees, to disclose promptly in writing to personnel identified as responsible for the administration of patent matters and in a format suggested by the recipient each subject invention made under award in order that the recipient can comply with the disclosure provisions of paragraph (c) of this clause, to assign to the recipient the entire right, title and interest in and to each subject invention made under award, and to execute all papers necessary to file patent applications on subject inventions and to establish the government's rights in the subject inventions. This disclosure format should require, as a minimum, the information required by paragraph (c)(1) of this clause. The recipient shall instruct such employees through employee agreements or other suitable educational programs on the importance of reporting inventions in sufficient time to permit the filing of patent applications prior to U.S. or foreign statutory bars.
- (3) For each subject invention, the recipient will, no less than 60 days prior to the expiration of the statutory deadline, notify NASA of any decision: Not to continue the prosecution of a nonprovisional patent application; not to pay a maintenance, annuity or renewal fee; not to defend in a reexamination or opposition proceeding on a patent, in any country; to request, be a party to, or take action in a trial proceeding before the Patent Trial and Appeals Board of the U.S. Patent and Trademark Office, including but not limited to post-grant review, review of a business method patent, inter partes review, and derivation proceeding; or to request, be a party to, or take action in a non-trial submission of art or information at the U.S. Patent and Trademark Office, including but not limited to a pre-issuance submission, a post-issuance submission, and supplemental examination.
- (4) The recipient agrees to include, within the specification of any United States patent applications and any patent issuing thereon covering a subject invention, the following statement, "This invention was made with government support under (identify the award) awarded by (identify NASA). The government has certain rights in the invention."

(g) Subawards

- (1) The recipient will include this clause, suitably modified to identify the parties, in all subawards (including purchase orders), regardless of tier, for experimental, developmental or research work to be performed by a Small Business Firm or Nonprofit Organization subrecipient. The recipient will not, as part of the consideration for awarding the subaward (including purchase orders), obtain rights in the subrecipient's subject inventions. The clause will be modified to identify the parties as follows: references to the Government/NASA are not changed, and in all references to the recipient the subrecipient is substituted for the recipient so that the subrecipient has all rights and obligations of the recipient in the clause (should the subaward be a subcontract, the terms recipient and award should be changed to subcontractor or subcontract, respectively).
- (2) The recipient will include in all other subawards (including purchase orders), regardless of tier, for experimental developmental or research work to be performed by other than a Small Business Firm or Nonprofit Organization, the patent rights clause required by Section 1852.227-70 of Title 48 of the Code of Federal Regulations (48 CFR §1852.227-70). At all tiers, the Section 1852.22770 (New Technology - Other than a Small Business Firm or Nonprofit Organization) clause shall be modified to identify the

parties as follows: references to the Government/NASA are not changed, and all references to the Contractor and contract shall be replaced by the words subrecipient or award, respectively, so that the subrecipient has all rights and obligations of the Contractor in the clause (should the subaward be a subcontract, the terms Contractor and contract should be changed to subcontractor or subcontract, respectively).

(h) Reporting on Utilization of Subject Inventions

The Recipient agrees to submit on request periodic reports no more frequently than annually on the utilization of a subject invention or on efforts at obtaining such utilization that are being made by the recipient or its licensees or assignees. Such reports shall include information regarding the status of development, date of first commercial sale or use, gross royalties received by the recipient, and such other data and information as NASA may reasonably specify. The recipient also agrees to provide additional reports as may be requested by NASA in connection with any march-in proceeding undertaken by NASA in accordance with paragraph (j) of this clause. As required by 35 U.S.C. 202(c)(5), NASA agrees it will not disclose such information to persons outside the government without permission of the recipient.

(i) Preference for United States Industry

Notwithstanding any other provision of this clause, the recipient agrees that neither it nor any assignee will grant to any person the exclusive right to use or sell any subject inventions in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by NASA upon a showing by the recipient or its assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

(j) March-in Rights

The recipient agrees that with respect to any subject invention in which it has acquired title, NASA has the right in accordance with the procedures in 37 CFR 401.6 and any supplemental regulations of NASA to require the recipient, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the recipient, assignee, or exclusive licensee refuses such a request NASA has the right to grant such a license itself if NASA determines that:

- (1) Such action is necessary because the recipient or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use.
- (2) Such action is necessary to alleviate health or safety needs which are not reasonably satisfied by the recipient, assignee or their licensees;
- (3) Such action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the recipient, assignee or licensees; or
- (4) Such action is necessary because the agreement required by paragraph (i) of this clause has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of such agreement.

(k) Special Provisions for Awards with Nonprofit Organizations

If the recipient is a nonprofit organization, it agrees that:

- (1) Rights to a subject invention in the United States may not be assigned without the approval of NASA, except where such assignment is made to an organization which has as one of its primary functions the management of inventions, provided that such assignee will be subject to the same provisions as the recipient;
- (2) The recipient will share royalties collected on a subject invention with the inventor, including Federal employee co-inventors (when NASA deems it appropriate) when the subject invention is assigned in accordance with 35 U.S.C. 202(e) and 37 CFR 401.10;
- (3) The balance of any royalties or income earned by the recipient with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to the administration of subject inventions, will be utilized for the support of scientific research or education; and
- (4) It will make efforts that are reasonable under the circumstances to attract licensees of subject inventions that are small business firms and that it will give a preference to a small business firm when licensing a subject invention if the recipient determines that the small business firm has a plan or proposal for marketing the invention which, if executed, is equally as likely to bring the invention to practical application as any plans or proposals from applicants that are not small business firms; provided, that the recipient is also satisfied that the small business firm has the capability and resources to carry out its plan or proposal. The decision whether to give a preference in any specific case will be at the discretion of the recipient. However, the recipient agrees that NASA may review the recipient's licensing program and decisions regarding small business applicants, and the recipient will negotiate changes to its licensing policies, procedures, or practices with NASA when NASA's review discloses that the recipient could take reasonable steps to implement more effectively the requirements of this paragraph (k)(4). In accordance with 37 CFR 401.7, NASA or the recipient may request that the Secretary review the recipient's licensing program and decisions regarding small business applicants.

(l) Communications

A copy of all submissions or requests required 37 CFR 401.14, plus a copy of any reports, manuscripts, publications or similar material bearing on patent matters, shall be sent to the Center Patent Counsel and NASA Grant Officer in addition to any other submission requirements in the award terms and conditions (e.g., as specified in this term and condition and in term and condition under Appendix D24 of the GCAM "Designation of New Technology Representative and Patent Representative"). If any reports contain information describing a "subject invention" for which the recipient has elected or may elect to retain title, NASA will use reasonable efforts to delay public release by NASA or publication by NASA in a NASA technical series until an application filing date has been established, provided that the recipient identify the information and the "subject invention" to which it relates at the time of submittal. If required by the Patent Representative or requested by the New Technology Representative, as designated under Appendix D24 of the GCAM "Designation of New Technology Representative and Patent Representative," the recipient shall provide the filing date, serial number and title, a copy of the patent application, and a patent number and issue date for any "subject invention" in any country in which the recipient has applied for patents. Additionally, NASA shall have an irrevocable power to inspect and make copies of the patent application file, when a Federal Government employee is a co-inventor.

(m) Designation of New Technology Representative and Patent Representative

- (1) For purposes of administration of the term and condition entitled "New Technology," or "Patent Rights" whichever is included, the following named representatives are hereby designated by the Grant Officer to administer such term and condition -
  - New Technology Representative: [nasa-contract-compliance-T2@mail.nasa.gov](mailto:nasa-contract-compliance-T2@mail.nasa.gov)
  - Patent Representative: See table below.

Project/Center	Name	Email Address
NIA	Robin Edwards	<a href="mailto:Robin.W.Edwards@nasa.gov">Robin.W.Edwards@nasa.gov</a>

- (2) Reports of reportable items, and disclosure of subject inventions, interim reports, final reports, utilization reports, and other reports required by the term and condition, as well as any correspondence with respect to such matters, should be directed to the New Technology Representative, with notification to the NASA Grant Officer, unless transmitted in response to correspondence or request from the Patent Representative. Inquires or requests regarding disposition of rights, election of rights, or related matters should be directed to the Patent Representative. This term and condition shall be included in any subaward/subcontract hereunder requiring a “New Technology” term and condition or “Patent Rights - Retention by the Contractor (Short Form)” term and condition unless otherwise authorized or directed by the Grant Officer. The respective responsibilities and authorities of the above-named representatives are set forth in the NASA Grants and Cooperative Agreement Manual.