



DEFENSE INFORMATION SYSTEMS AGENCY

P. O. BOX 549
FORT MEADE, MARYLAND 20755-0549

DISA INSTRUCTION 100-205-1*

24 February 2017

RESEARCH AND DEVELOPMENT

Ownership of an Invention Made by a DISA Employee or Employees

1. **Purpose.** This Instruction prescribes policy on ownership of an invention made by a DISA employee or employees. It also details the process for recording and disclosing an invention and provides guidelines for determination of rights to an invention.
2. **Applicability.** This Instruction applies to DISA activities.
3. **Authority.** This Instruction is published in accordance with the authority contained in 28 U.S.C. 1498 (a); 37 CFR Part 501; Executive Order 10096, 23 January 1950; Executive Order 10930, 28 March 1961; DoD Directive 5535.3, DoD Domestic Technology Transfer (T2) Program, 21 May 1999; DoD Instruction 5535.8, DoD Technology Transfer (T2) Program, 14 May 1999; and DoD Directive 5105.19, Defense Information Systems Agency (DISA), 25 July 2006.
4. **Scope.** This Instruction pertains to all inventions made by DISA employees, whether or not an invention is made during an employee's official duty time or during an employee's off duty time or any combination thereof.
5. **Definitions.**
 - 5.1 **Employee.** A military or civilian, full- or part-time employee, including part-time consultants.
 - 5.2 **Invention.** Any art or process, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.
 - 5.3 **Invention Disclosure.** A written description of an invention or discovery in such full and complete terms as to allow an easy understanding thereof, a thorough evaluation of DISA interest therein, and a patentability search thereon.
 - 5.4 **Inventor.** An employee or other person, acting alone or in concert with another, who makes an invention or discovery whether or not patentable under the patent laws of the United States.
 - 5.5 **Made.** As it is used in the context of official duties, "made" means that point in time when the employee (1) has performed all of the mental or experimental work or a combination thereof necessary to accomplish his or her purpose so that he or she is able to clearly demonstrate to

a person of ordinary skill in the art or science that his or her invention is operable and practicable and (2) has actually disclosed the invention fully and completely to others in some tangible form.

5.6 Patent. A grant issued by the Government giving the owner the right to exclude all others from making, using, selling, offering to sell, or importing the patented invention within or into the United States and its territories and possessions. The term "patent" includes utility, design, and plant patents.

6. Policy.

6.1 DISA has the discretion to obtain ownership of any invention made by an employee either (1) during work hours; (2) with a contribution by the Government of facilities, equipment, materials, funds, or information or of time or services of other employees on official duty; or (3) that bears a direct relation to or is made in consequence of the official duties of the inventor.

6.2 In any case where DISA determines, based upon the criteria set forth in subparagraph 6.1, that the contribution of the Government is insufficient to justify a requirement of assignment to DISA of the entire ownership of the invention or in any case where DISA has insufficient interest in an invention, DISA shall leave title to such invention to the employee. If DISA chooses not to claim ownership, DISA shall reserve a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes. DISA's license shall apply to any patent, domestic or foreign, which may be issued on the invention.

6.3 In applying the provisions of subparagraphs 6.1 and 6.2 to the facts and circumstances relating to the making of any particular invention, it shall be presumed that an invention made by any employee who is employed or assigned (1) to invent or improve or perfect any art, machine, manufacture, or composition of matter; (2) to conduct or perform research, development work, or both; (3) to supervise, direct, coordinate, or review government financed or conducted research, development work, or both; or (4) to act in a liaison capacity among governmental or nongovernmental agencies or individuals engaged in such research, development work, or both, falls within the provisions of subparagraph 6.1.

6.4 For any invention made by any other employee who is not employed or assigned as described in subparagraph 6.3, that invention shall be presumed to fall within the provisions of subparagraph 6.2.

6.5 Either presumption in subparagraphs 6.3 or 6.4 may be rebutted by a showing of the facts and circumstances in the case and shall not preclude a determination that these facts and circumstances justify leaving the ownership of the invention to the employee, subject to applicable law.

7. Record of Invention. An accurate record regarding research, development, or other activity concerning an invention is to be kept by the employee. All records should be signed and dated by at least two competent witnesses who shall attest that they read and understood the description of the invention, its function, and the method of using the invention. If the invention was

actually reduced to practice and operated, the witnesses should state not only that they understood the invention, but also that they saw the invention work successfully on a specific date. Witnessed documents should be safeguarded to serve as proof of either or both conception and reduction to practice. Employees may not use an electronic laboratory or invention notebook for purposes of recording an invention unless the General Counsel has approved the specific electronic notebook application for such use.

8. Disclosure of Invention. All inventions made during the period of an individual's employment are to be documented by completing a DISA Form 335: Disclosure and Record of Invention. Documentation, such as sketches, prints, drawings, flow charts, or other illustrations, will supplement the form to provide a full and complete statement regarding the invention.

8.1 An employee will indicate his or her intention to assign the ownership of the invention to DISA by completing the "Certification of Inventor (s)" section of the DISA Form 335. If the employee does not agree to assign ownership of the invention, then the procedures set forth in paragraph 9 apply.

8.2 An employee will forward the DISA Form 335 and all supplemental documentation describing the invention to the General Counsel. After submission to the General Counsel, a DISA Form 335 disclosing an employee invention may not be duplicated, used, or disclosed in whole or in part for any purpose other than internal governmental technical and security review, invention evaluation, and patent prosecution, unless prior written permission is obtained from the employee and the General Counsel.

9. Determination of Ownership Rights. An employee who does not agree to assign ownership of an invention to the Government must complete a DISA Form 338: Invention Rights Questionnaire, and provide all information necessary to permit a determination of the respective rights of the Government and the employee in the invention. The employee will submit a DISA Form 338, together with his or her job description that was in effect at the time the invention was made, to the General Counsel. A review will be conducted and a determination will be rendered by the General Counsel that either (1) the Government shall obtain the ownership to the invention; (2) the employee shall retain ownership of the invention, subject to the reservation by the Government of a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes; or (3) the employee shall retain ownership of the invention, subject to applicable law.

9.1 If DISA determines that the employee is entitled to ownership of the invention, the General Counsel shall notify the employee, in writing, of this determination. In cases where DISA has insufficient interest in the invention, evidenced by a decision not to file a patent application therein, DISA may impose on the employee any or all of the following conditions: (1) a patent application be filed in the United States or abroad or both, if the Government has determined that it has a need or may need to practice the invention; (2) the invention not be assigned to any foreign-owned or controlled corporation without the prior written permission of the Agency; and (3) any assignment or license of right to use or sell the invention in the United States shall contain a requirement that any product embodying the invention or produced through the use of the invention be substantially manufactured in the United States.

9.2 If DISA determines that ownership of the invention will remain with the Agency or that DISA will allow the employee to retain all rights, title, and interest in the invention, subject to the reservation by the Government of a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, the General Counsel shall promptly provide the employee with a signed and dated statement of its determination and reasons therefore and a copy of 37 CFR Part 501 explaining the employee's rights to appeal such a determination.

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Date: 2017.02.27 15:06:31 -0500

MARK E. ROSENSTEIN
Colonel, USA
Chief of Staff

*This Instruction replaces DISAI 100-205-1, 4 March 2013.
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