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

ROBERT L. MORRISON APPELLANT
v.
DEPARTMENT OF THE AIR FORCE APPELLEE
GPB No. 12-2269
April 2, 1990

Donald Singer, Esq.

***1** Department of the Air Force

AF/JACP

1100 Half Street S.W. - Room 5160

Washington, D.C. 20324-1000

Lee W. Mercer

Deputy Under Secretary for Technology

REQUEST FOR RECONSIDERATION FROM DECEMBER 18, 1989 DECISION

This is a request for reconsideration from the Department of the Air Force to our December 18, 1990 decision which vacated and remanded a determination of the Air Force that the Government is entitled to a nonexclusive, irrevocable, royalty-free license in the patent invention of Mr. Robert L. Morrison.

In its request for reconsideration, the Air Force has taken the position that contribution by the Government to the making of the invention which is sufficient to take a license is under criteria (iii) of 37 C.F.R. 501.6 (a)(1) as evidenced by the Morrison job description.

I have reviewed the submitted position description of Mr. Morrison and agree that it relates to the inspection and maintenance of vehicles. No duties relating to trailers-the subject matter of the invention under consideration-or the requiring of Mr. Morrison to perform research and/or development duties is indicated in the position description. Nor are any of the categories of duties set forth in 37 C.F.R. 501.6(a)(3)(i)-(iv) found in this description. Nevertheless, Air Force contends that since the inventor's work related to vehicles, the experience he gained on the job could not but have contributed to his invention. No evidence is presented to support this opinion.

The record is replete with evidence that the invention is not directly related to the official duties of the inventor nor was it made in consequence of his duties. The inventor and his supervisor both agree to this statement as well as the assertion that there had been no government contribution to the making of the invention including information gained by the inventor by virtue of his employment. Clearly, there is no explicit indication in the inventor's position

description that he was to work on trailers of any kind. After reviewing the record, I can find nothing but a tenuous relationship between working on vehicles and inventing a new trailer. The fact that there conceivably could be some relationship between the inventor's position description and the invention is insufficient in and by itself to allow for a license in the government. I find no error in my decision of December 18, 1989 nor any basis for the Air Force's request for reconsideration thereof. I have reviewed the cited opinion of the Comptroller General of January 19, 1956, (108 USPQ 271) and do not believe it is contrary to or in any way conflicts with the decision I have reached.

The decision of the Air Force that it is entitled to a license in the invention of Mr. Robert L. Morrison as disclosed and claimed in U.S. Patent No. 4,779,889 is reversed. This is a final decision of the U.S. Department of Commerce as provided for in 37 C.F.R. Part 501.

Lee W. Mercer

Deputy Under Secretary for Technology

DECISION ON APPEAL FROM GOVERNMENT EMPLOYEE RIGHTS DETERMINATION

***2** This is an appeal by Robert L. Morrison (Morrison) under 37 CFR 501.8 from a determination by the Department of the Air Force (Air Force) that all right, title, and interest in and to the invention be left with the inventor subject to a royalty-free license to the government as defined by 1(b) of Executive Order 10096, as amended by Executive Order 10930. The invention is entitled Trailer Swivel Wheel and is described in U.S. Patent No. 4,779,889 issued October 25, 1988.

The determination is vacated and remanded to the Air Force.

Background

a. Nature of Invention

The invention relates to a swivel wheel assembly for use with a trailer. The assembly is mounted to the trailer frame and has a swivel shaft and lock pin which allows the wheel to be fixed in a plurality of different vertical positions as the wheel is pivotally moved about the swivel shaft. A gooseneck axle connected between the wheel and trailer mount also allows for the positioning of the wheel under the trailer frame.

b. Invention Rights Questionnaire

An Invention Rights Questionnaire (AF form 1280) was signed by the inventor on 10 January 1989 and submitted to our Department. This form reveals the following:

(1) No Government time, services, equipment, facilities, funds, materials, or information was used by Mr. Morrison in making the invention;

(2) The invention was not directly related to the official duties of the inventor nor was it the result of a problem the inventor by his duties could reasonably be expected to solve;

(3) The inventor's position description indicates no responsibility to: invent, improve, or perfect any process, (b) conduct or perform research or development, or (c) act in a liaison capacity for research or development;

(4) At the time the invention was made the inventor's official duties were said, by his supervisor, to be that of an automotive equipment repair inspector; and

(5) A prototype of the invention was made on 19 February 1986.

c. Rationale for Decision of Air Force to take a Non-exclusive License

The Air Force (A.F.) states that it is entitled to a license because of the official duties of the inventor and their relationship to the making of the invention. It has cited the provisions of 37 C.F.R. 501.6b(a)(1) as the basis for this contribution of the Government to the making of the invention. It further states that the reported facts raise an unrebutted presumption supporting this position and their determination was influenced by the prohibition recited in 28 U.S.C. 1498(a) involving inventions by Government employees.

d. Patent Application Filed by Mr. Morrison

The record indicates Mr. Morrison filed for a patent on January 12, 1987 and was granted U.S. Patent No. 4,779,889 on October 25, 1988. Apparently the expenses to do so were borne entirely by Mr. Morrison with no government contribution.

DISCUSSION

***3** The sole issue to be answered is whether the U.S. Air Force is correct in leaving title rights in the invention with the employee and asserting it is entitled to a license to practice the invention.

The record is clear that the invention was not made during working hours by Mr. Morrison nor was it made with a contribution from the Government. At the time the invention was made Mr. Morrison was employed as an Automotive Equipment Repair Inspector whose reported duties were mainly concerned with the inspection and diagnosing of vehicles and their major assemblies and components. None of his duties set forth in the submitted position description relates to inventing or improving of vehicles or machines, performing or directing research or development work, or acting in a liaison capacity for research and development work. In fact, the inventor and his supervisor agree that the invention did not bear a direct relation to nor was it made in consequence of the inventor's official duties as a government employee.

The invention was said to be made for the personal use of the inventor independent of his official duties.

Under the provisions of 37 C.F.R. 501.6(a)(2), the Government is entitled to a license in an employee's reported invention if one or both of two factual situations are present. Both situations presuppose that one or more of the three criteria justifying that the Government is entitled to an assignment of title in the invention (see section 501.6(a)(1) exist before it could possibly obtain the right to a license. The first of these factual situations is when the contribution by the Government is insufficient equitably to justify a requirement of assignment. The second is where the Government even though it could have taken an assignment, has insufficient interest in the invention to obtain title. If neither factual situation is present, then the Government is not entitled to a license right under the Executive Order 10096 or its implementing regulations in 37 C.F.R. Part 501.

Our review of the record fails to find either of the two factual situations by which the regulations allow the Government to take a license. There is no supported determination by the Air Force of a finding of insufficient equitably to justify a license or that the Government has insufficient interest in the invention. Our holding therefore is that the presented facts do not justify a license right in the Government. Section 501.6(a)(2) presupposes there has been some contribution as set forth in (a)(1), by the Government to the making of the invention. If there is none, as here, it does not apply and the section's paragraph (a)(4) governs and the Government shall leave the entire right, title, and interest in and to the invention in the Government employee, subject to law. This conclusion is in line with the previous unpublished decision of August 30, 1977 (GPB 3-410) involving two Bureau of Mines research employees, Wallace W. Roepke and Patrick J. Cain, wherein the Commissioner denied a license to the Government based solely upon "some relationship"' between the invention and the official duties of the inventors.

Decision

***4** The determination of the Air Force that the Government is entitled to a nonexclusive, irrevocable, royalty-free license in the above-identified invention is vacated and remanded.

Any request for reconsideration or modification of this decision must be filed within 30 days from the date herein. If such a request is not made, the Air Force is required to make a new rights determination within two (2) months. A copy of this new determination is to be supplied to our Office for review under 37 CFR Part 501.

15 U.S.P.Q.2d 1392

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