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MANHATTAN DISTRICT HISTORY

BOOK I - GENERAL

VOLUME 13 - PATENTS

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MANHATTAN DISTRICT HISTORY

BOOK I - GENERAL

VOLUME 18 - PATENTS

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FOREWORD

It has been the policy of the United States to control by means of patents the inventions and discoveries made in the course of the Manhattan District program. This volume is an account of the policy developed, the procedures used and the organization established to secure and maintain such control.

Prior to the organization of the Manhattan District patents were secured by the Office of Scientific Research and Development. Since the same personnel executed the same functions under both organizations no distinction has been made herein between the two operations.

The data on which this account is based are available in the files of the Central Office of the Manhattan District Patent Division, c/o Capt. Robert A. Lavender, USN (Ret.), Advisor on Patent Matters, United States Atomic Energy Commission, 1901 Constitution Avenue, Washington, D. C.

Basic documents essential to an understanding of the operations of the Patents Division are included in appendices following the text and are referred to in the text by the note "(App. ___)". A summary has been inserted ahead of the main text. The summary is keyed to the text by using paragraph numbers and titles in the summary corresponding with section numbers and titles of the text.

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SUMMARY

1. Introduction. - The Patent Division of the Manhattan District, created when the District undertook the manufacture of the final product of the Special Project and the research and development incident thereto, was initially staffed with patent personnel originally associated with the Office of Scientific Research and Development. It comprised commissioned Navy and Army officers and civilians, exhaustively screened on a basis of loyalty and ability, the original number being augmented as necessary during the progress of the work. The purpose of the Division is to assist in the protection of the Government's interest in inventions made as a result of the research and development under the Project, to secure through patents the maximum control of the Project obtainable thereby, to carry out decisions in the field of international relations, and to negotiate the purchase of patent rights from independent inventors. Problems of security, the lack of precedent for what constituted largely virgin soil as to both science and patent law, and the necessity for dealing with contractors having rigid patent policies, complicated the Division's task.

2. Policy. - Patent policy of the Manhattan District was to some extent inherited from the National Defense Research Committee and the OSRD. All Government patent rights arising from project inventions are, by order of the President of the United States, in the custody of the Director of OSRD. The Patent Division of the Manhattan District has investigated the origin of early inventions to secure to the Government its due rights, concentrating them in the custody of the Director of

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OSRD. It has also supervised the request of secrecy order issuance as to applications filed in the Patent Office. The presidential directive ordering control of the Project through patents led to adoption of a short-form clause of assignment of rights in all subsequent contracts, plus similar appropriate renegotiation of all outstanding contracts embodying the long-form patent clause (2-2b(1)), a task still being carried out by the Patent Division. Patent clauses were standardized and four types of contracts embodying them were adopted upon creation of the Manhattan District. The types of contract were: production of standard apparatus or material, production and development, production and research, and research. Contracts were renegotiated where changes in the character of work thereunder warranted it. Contracting Officers of the District and Areas were authorized to select appropriate patent clauses for subcontracts. Government rights in inventions of loaned employees and consultants were defined. In a few instances exceptions to the use of the standard patent clauses were made, notably in the cases of duPont, General Electric, Area Engineers using the GE clause, and certain other miscellaneous cases.

With respect to participation in the research by foreign countries the Division made arrangements for the protection of the Government's interest as to the exchange of information not falling within the Patent Interchange Agreement (2-4b). It also participated in the establishment of an international committee and the adoption of a system for filing foreign applications.

3. Applications for Patents. - Inventions are reported to the

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Central Office for docketing, search, classification and a decision as to patentability. As to those ruled patentable the Report on Patentability is referred to the originating Group for preparation and review of the application, which is then forwarded to the Central Office for filing. The Technical Advisor examines the application for scope and conflicts, return of the application to the field for correction being necessary in rare instances. Amendments to applications as required by Patent Office action are similarly prepared by the initiating Group.

Assignments of inventions are to the Government, represented by the Director of OSRD, but are not recorded until necessary in the handling of the case. Where it is decided not to file any application by the Government the contractor is so informed and may file its own application subject to a license in favor of the Government.

4. Contract Administration. - The Patent Advisor generally represents the Director of OSRD and the Officer in Charge of the Manhattan District with respect to negotiation and renegotiation of patent clauses in contracts, employer-employee agreements, loaned employee and consultant agreements, and the keeping of visitors' records. The Advisor passes upon the clearance of contracts from a patent standpoint, checks the examination and custody of notebooks and examines reports of research, reports on filed applications and assignments, and the reports on subcontracts.

5. Records. - The complexities of the Project of necessity resulted in a somewhat extensive system of records, listed hereinafter for the sake of completeness. Possibly the most important are the indices to and copies of project research reports, and the index of inventions

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by classes and subclasses, contractors, and inventors.

As of 31 December 1946 the number of inventions docketed by the Division amounted to 5600, representing 493 different classes of inventions. Invention searches in the Prior Art seemed advisable and have been made in 3700 cases. The total of inventions approved for filing thus far was 2100, of which 1766 applications had been actually filed. This total comprised 1250 applications filed in the United States, 257 in England, and 259 in Canada, respectively. Conflicts between reported inventions arose in 89 cases, concerning 68 of which formal opinions have been issued. Patent administration extends to 2424 contracts, comprising 1390 prime and 1034 subcontracts. As of said date the Division has reviewed a total of over 6524 project technical reports and 6305 notebooks.

6. Organization. - Patent Division activities are divided between the Central Office in Washington, D. C., and the various Field Groups. The Central Office is comprised of the Patent Advisor, the Deputy Advisor, the Technical and Administrative Assistant Chiefs, the Technical Advisors, and patent attorneys. Invention reporters in the field are usually civilians although some have been enrolled as officers. Officers and enlisted men assigned to the Division are under the local Army or Navy senior officer present for purposes of pay, leave, and discipline, but are otherwise directly supervised by the Patent Advisor, including assignments to the locale of duty, made so far as possible with due consideration of rank and past patent practice.

The Administration of the Division is set forth in the formal Manual of Office Organization and Procedure. The Central Office is under the

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direct supervision of the Deputy Chief and is comprised of six technical divisions and the administrative personnel.

7. Cooperating Agencies. - The Patent Division has received the fullest cooperation from other Government departments and agencies, including the Patent Office, National Bureau of Standards, Navy Department, Department of Interior, Office of Scientific Research and Development, State Department, Office of Emergency Management, War Production Board, Department of Agriculture, and the Patent Division of the Office of the Judge Advocate General of the Army.

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MANHATTAN DISTRICT HISTORY

BOOK I - GENERAL

VOLUME 13 - PATENTS

SECTION 1 - INTRODUCTION

1-1. General. - The Patent Division of the Manhattan District is the outgrowth of a group of patent attorneys and technical advisors organized by the Advisor on Patent Matters to the Director of the Office of Scientific Research and Development, Office for Emergency Management. This group was assembled in OSRD when that office had the active supervision of the research and development of the Project. When the Project reached the stage of production and the Manhattan District was formed, the group was assigned additional duties with the Manhattan District. The duties and the responsibilities of the Patent Division have been unusually exacting and severe, as so much research and development by so many outstanding scientists and engineers in so many highly technical fields have been crowded into so few months. Virgin soil was being broken in many fields of science in which there were no available trained and qualified patent attorneys and there were no precedents for the organization of a patent group for the handling of the large volume of inventions from so many technical sources as were utilized by the District. The negotiations attending the letting of such a wide variety of research and development contracts, accompanied with or without production, required a great deal of time and attention, especially because the negotiations were with so many contractors that had already fixed and well established patent policies. Security regulations were necessarily very strict. Compartmentation of information

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and activities added to the difficulties of organization. Scientists and engineers were moved on short notice or were temporarily away from their regular sites for extended periods of time or otherwise unavailable at their sites for consultation in the interest of getting the desired results at the earliest possible hour. It was realized that the prime purpose of the Project was "to get the answer" as quickly as humanly possible and, therefore, compromises from a patent point of view were necessary from time to time in favor of that prime purpose. However, the administrative officers, the scientists, and the engineers and all their staffs as well as contractors' representatives cooperated and assisted in the work of the Patent Division. The Patent Division had especially the unreserved support and encouragement of Dr. Vannevar Bush and Major General Leslie R. Groves. It is impracticable to list the names of individuals who were outstanding in their cooperation, but special mention should be made in this regard of Dr. Irvin Stewart, Executive Secretary of OSRD, and Dr. Harry T. Wensel, Chief of the Research Control Section of the District.

1-2. Purpose. - The purpose of the Patent Division is to assist the Director of OSRD and the Officer in Charge of the Manhattan Project in establishing and administering a sound patent policy. The Patent Division through the Director of OSRD and the Officer in Charge of the Manhattan Project, is charged with the responsibilities of carrying out the directives received by them as to the control of the use of atomic energy through patents, the carrying out of international relations decisions, the protection of the Government's interests in inventions and discoveries made under the Project, through the execution of contracts and

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through the filing and prosecuting of applications for patents, and the securing of rights from independent inventors for the protection of the Government's interests in the Project as a whole.

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SECTION 2 - POLICY

2-1. General.

a. Early History. - The patent policy of the Manhattan District had its origin in the National Defense Research Committee and the Office of Scientific Research and Development. The Government, through the Navy Department and National Bureau of Standards, had previously sponsored some experiments through research contracts with Columbia University under which contracts the Government obtained licenses under resulting inventions. The Navy also carried on limited research at the Naval Research Laboratory at Anacostia, D. C. At the time of these early contracts the direction of the Project was under the Advisory Committee on Uranium of which the Director of the National Bureau of Standards was chairman and the members of which were made up of Army and Navy representatives and scientists, principally from universities. Inventions made by assisting personnel of the Bureau of Standards were, in accordance with the policy of that Bureau, assigned to the Government, but no contracts were entered into with the committee members and their assistants for the assignment of their inventions to the Government. However, all of the inventions made by the committee members have later been assigned voluntarily to the Government and without profit to the individual members. Assignment of rights under some of the inventions made by some assistants to the members are still under negotiation.

b. Custody of Patent Rights Owned by the Government. - The Government holds patent rights, the same as other property rights, in the custody of some Government department or agency and the custody of

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such rights is initially in the department or agency that contracted for them. As some of the rights to inventions came into the Government as represented by the Secretary of the Navy and by the Secretary of Commerce, the President issued instructions that all patent rights relating to the Project should be in the custody of the Director of OSRD. These instructions were not changed when the Manhattan District was formed and patent rights arising out of contracts let by the District have become vested in the Government in the custody of the Director of OSRD.

c. Secrecy Orders Issued by the Commissioner of Patents.

Under the provisions of Public Law 700 (76th Congress), as amended (35 USC 42), the Commissioner of Patents is authorized to issue orders of secrecy against the inventors, their heirs and assignees, prohibiting the disclosure of information contained in applications for patents. The Commissioner of Patents had requested the recommendations of the Director of OSRD, who delegated the examination of such applications as might be referred to him to certain technical aides. The Director of OSRD delegated the preparation of recommendations and the signing of correspondence with the Commissioner of Patents to his Advisor on Patent Matters, in accordance with the recommendations of the technical aides. As applications for patents were also being filed by the Patent Advisor as the Attorney of Record, it became important that neither he nor any of his assistants examine any applications in the Patent Office for the purpose of making recommendations regarding secrecy orders, so that there would be no chance that information in such applications would be incorporated in applications filed by him. This procedure has been

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scrupulously observed.

2-2. NDRC and OSRD Participation.

a. General. - When the NDRC was assigned the administration of the Project in June 1940, formal research and development contracts were made with laboratories, both university and commercial, for the investigation of the various phases of the Project. Later, when OSRD was organized and absorbed NDRC, the same policy was followed. Each contract contained a patent clause providing for the disposition of rights under inventions made in carrying out the work under the contract.

b. Standard Patent Clauses.

(1) Long-Form. - The standard OSRD "long-form" patent clause (App. A1) provides that the contractor shall report all inventions made under the contract and that it shall elect whether or not it will file applications for patents thereon; if it elects and does file applications, the title to the invention, and any patent that may issue thereon, shall be retained by the contractor, subject to a non-exclusive, irrevocable, and nontransferable license in favor of the Government for Military, Naval, and National Defense purposes; if the contractor elects not to file, the title to the invention, and to any patent that may issue thereon, shall be in the Government, subject to a limited license in favor of the contractor.

(2) Short-Form. - The standard OSRD "short-form" patent clause (App. A2) provides that the Government Contracting Officer shall have the sole power to determine whether an application shall be filed and to determine the disposition of rights in and to the invention

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and under any patents that may issue thereon. As the inventions to be made under these short-form contracts were expected to be basic and as usually a great deal of technical information already in the possession of the Government was expected to be imparted to the contractor, it was normally expected that all rights in and to inventions made under these contracts would become the property of the Government. However, it was understood that the determination of the disposition of the patent rights by the Contracting Officer would be separately made for individual inventions, and under appropriate circumstances, such as, for example, a case in which the invention was traceable to the know-how of the contractor, it would be determined that the contractor would retain rights under the inventions made.

c. Directive of the Control of the Project Through Patents.

(1) Directive of the President. - In the summer of 1942 the President issued a directive that as much control as possible of the Project should be through patents. As the control of the use of a patented invention is vested in the holder of the title thereof, and as some of the earlier NDRC and OSRD contracts contained the long-form patent clause, the long-form patent clause contracts were renegotiated to the short-form patent clause and made retroactive to the effective dates of the respective contracts.

(2) Negotiations. - Some organizations and individuals that had worked independently on the problems of the Project before OSRD contracts were signed, realized the importance of the Project to the Nation and assigned their previously made inventions to the Government. Negotiations for rights under some such inventions have been delayed

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because of secrecy restrictions as the inventions have not been defined in allowed claims. Negotiations as to others are being conducted.

d. Contractor-Employee Relations. - The contracts provided that contractors had not entered into and would not enter into any agreements that would prevent them from carrying out the provisions of the contract. It was found that employer-employee agreements as to the disposition of patent rights varied so much with the contractors that each contractor was required to secure the approval of its employer-employee invention agreements.

e. Government-Employee Relations. - Paid technical employees of OSRD are required to assign to the Government the titles to inventions and discoveries made by them in the line of their duties (App. A5).

f. Subcontracts. - The patent clauses in subcontracts involving any research or development required the approval of the Contracting Officer.

2-3. Manhattan District Participation.

a. General. - When the Manhattan District was formed and became the contracting agency for the construction and operation of quantity production plants and for the purchase of the necessary equipment and raw products, it was decided that nearly all of the research and development of the Project should be taken over by the Manhattan District, OSRD retaining only certain specific phases of the research. Most of the OSRD contracts were transferred to the District or were terminated and new contracts entered into by the District.

b. Product Contract Patent Clause. - The production phase

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of the work on the Project brought out new situations that required new types of patent clauses. There were contracts to be negotiated for the supply of the standard products of manufacture of well established companies and it was apparent that no inventions would be involved. It would manifestly be unfair to demand that the title to any incidental invention that might possibly be made in new manufacturing methods be assigned to the Government as they would have been made in the normal course of the contractor's manufacturing business. In other cases, companies were called upon simply to manufacture material or equipment according to specifications already worked out and standardised by the District and did not require any research or development. The companies selected for these contracts were those generally familiar with the class of material or equipment involved, and usually no time was available for the company to determine whether any valid patents would be infringed. It was, therefore, decided that contracts requiring the production of standard articles of manufacture or the mere production of the District's standardised equipment would contain no provision requiring the contractor to assign all patent rights to the Government. It was also decided, however, that if the contractor were to supply its standard products, it had had an opportunity to investigate the infringement of valid patents and that the contractor would be required to indemnify the Government for the infringement of any involved patent (App. A4). If the contractor were to supply a product manufactured according to specification furnished by the District and if there were no time for the contractor to determine its involved patent liability, a clause was included in the contract to the effect that the Government would hold the contractor

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harmless from any liability arising from the infringement of any patent required in the performance of the contract (App. A5).

c. Production and Development Contracts. - It was also desired to let other contracts for the quantity production and supply of the standard products of well established companies with some development work involved in adapting those products to a particular need and use on the Project or for the construction of plants and their operation that required definite skill and know-how by personnel of well established companies. Under such circumstances the long-form OSRD patent clause (App. A1) would normally have been used were it not for the directive to secure control of all inventions made on the Project. It was, therefore, decided that the standard OSRD long-form patent clause would be modified into Manhattan District Standard Patent Clause C; to provide that the disposition of the titles to inventions made under the contract would be determined by the Contracting Officer but that the contractor as a matter of contract right would retain "at least" the sole license in fields outside the field of the project (hereinafter referred to as "outfield" rights) and the sole right to grant sublicenses in outfields. The Government would, of course, obtain titles to the inventions for purposes of control as well as a license in both infields and outfields. This provided for control of the infield rights as well as a right by the Government in outfields (App. A6).

d. Production and Research Contracts. - Other contracts were desired to be let for the quantity production and supply of material and apparatus with which well established companies were generally familiar but which involved considerable development and perhaps research and

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to which companies it would be necessary to impart considerable detailed knowledge of the Project. It was also desired to let contracts to well established companies for the construction and operation of plants involving operations with which they were generally familiar but which required considerable technical knowledge of the Project not previously in possession of the contractor, and involving operations that were desired to be improved. It was decided that the contractor was entitled to some outfield rights in inventions made under the contract, because of the supplying of the technical background and know-how of its employees, but the rights should not be as extensive as provided for under Standard Clause C. It was, therefore, decided that the contractor should retain as a matter of contract right "at least" a nonexclusive license in outfields (App. A6, Clause B, Paragraph 4).

e. Research Contracts. - The Manhattan District assumed the patent administration of practically all of the OSRD basic research contracts which provided that the Contracting Officer had the sole power to determine the disposition of rights under inventions made under the contract, with the contractor retaining no rights as a matter of contract right. The patent clauses in renewals and extensions of the involved research were similar to the standard OSRD short-form patent clause (App. A6, Clause A, Paragraph 3). It was decided that the same principles established by OSRD for the administration of Standard Clause A would apply to the administration by the District.

f. Interpretation of Patent Clauses. - It was understood in negotiation of the patent clauses with the contractors that under certain circumstances the contractors could retain more than the

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"at least" rights reserved as a matter of contract right. It was anticipated that certain inventions would be made by employees of contractors of such doubtful patentability, because of prior issued patents or published literature, that the Government would not desire to file a patent application. It was anticipated that some of such doubtful inventions might be of value to the contractor in its manufacturing position and would be worth a very determined effort on the part of the contractor to file and prosecute a patent application even though only very specific and limited claims would be granted by the Patent Office. It was, therefore, understood in the negotiations that in such cases the Contracting Officer would determine that the title to the invention would remain in the contractor and if the contractor filed a patent application and a patent were granted, the Government would have a non-exclusive license under the invention and any patent that might issue thereon. It was also contemplated, even under contracts containing the short-form patent clause (App. A6), that the contractor might retain, for example, a nonexclusive license in outfield. An example of circumstances under which the contractor might retain such right is if the invention were traceable to the particular prior knowledge or know-how of the contractor's employees.

g. Renegotiation of Patent Clauses. - It is not always possible at the time of negotiating contracts to determine in detail the nature and the scope of the subject work of the contract. The patent clause to be included in the contract was initially selected in accordance with the principles set forth in Subparagraphs b, c, d, and e of this subsection (2-3). If the scope of the work changed during the

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carrying out of the contract, such as requiring more research or development, or less, the patent clause was renegotiated when appropriate.

h. Subcontracts. - The particular patent clauses to be used in subcontracts followed the same principles as applied to prime contracts, i.e., the subject work of a subcontract is controlling rather than the type of patent clause included in the prime contract. The Contracting Officers of the District and Areas were authorized to select the appropriate clause to be used in contracts and subcontracts and were required to refer to the Patent Advisor only those cases in which the Contracting Officers had a doubt as to the appropriate clause to be used (App. A6).

i. Government Employees. - All Civil Service employees and all officers and enlisted personnel of the Services associated with the Project are required to assign all inventions to the Government that are made by them while so employed or assigned (App. A7).

j. Loaned Employees. - It was often found necessary in the solution of pressing problems to transfer temporarily the employees of the contractor to work under another contractor. It was apparent, in the Government's interests, that an invention made by an employee of a production contractor loaned to a basic research contractor should not be subject to a sole license in favor of his employer, and, likewise, the Government might not be entitled as a matter of contract right to all the rights under an invention made by an employee of a research contractor that had been loaned to a production contractor. It was, therefore, decided that inventions made by a loaned employee would be reported by the contractor to whom the employee was loaned and the disposition of

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patent rights under inventions made would be determined as provided for by the contract of the contractor to whom the employee was assigned (App. AS).

k. Consultants. - It was also found necessary at times to use special scientists and engineers, not otherwise available, to assist in the solution of pressing problems. Some of the personnel were willing to and did give their services without charge either by themselves or by their regular employers. In other cases a group of consultants was desired from a single company, in which cases definite arrangements were made for their compensation. It was decided that before any consultant was given any information of the Project, he sign an agreement to disclose all inventions that might be made while acting as a consultant, and assign all rights to such inventions to the Government. If the consultant were employed by a company or other organization, the assent by his employer was obtained in writing (App. AS).

l. Exceptions in Patent Clauses.

(1) duPont. - In negotiating the patent clause in the contract for the construction and operation of the Hanford Engineer Works, the duPont Company insisted that it retain no patent rights whatever, would have no responsibility in reporting of inventions, and would perform no duty usually required of a patent attorney. This clause is not included in other duPont contracts, in which are incorporated the appropriate standard patent clause. In the administration of this contract, the duPont Company insisted that before applications for patents, prepared by the Patent Division, be presented to its employees for signature, the applications would have to be passed upon by a representative

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of the University of Chicago and a formal statement be made by such representative that the invention covered by the application was found to be that of the employee of the duPont Company and not that of any employee of the University of Chicago. However, duPont is insisting that all such applications be presented to its employees through the company and that the company examine the applications.

(2) General Electric. - In negotiating three contracts, one of which was research and the other two of which were production and development contracts, General Electric requested that the clause provide that a distinction be made between an invention "which either controls or is of importance to" the Project and inventions that were not. General Electric insisted that it retain the titles to the inventions in the latter class, subject to a license in favor of the Government and that the Government obtain the titles to the inventions in the former class, subject to a nonexclusive license, with the right to grant sub-licenses in outfields in favor of General Electric (App. A9). Later, General Electric accepted the standard district patent clauses in involved contracts. However, in some quantity production contracts with General Electric with only minor incidental development, the original General Electric patent clause (App. A9) has been used when appropriate.

(3) Area Engineers. - Certain Area Engineers have let a few production and development contracts that include the General Electric patent clause (App. A9), under the impression that it had become standardized. These contracts have either been renegotiated to include the appropriate patent clause, or are in process of renegotiation.

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Several such contracts were completed before the details of the included patent clauses were made known to the Patent Advisor. However, it was determined in some instances that no inventions had been made under the contracts and, therefore, the contracts were cleared without renegotiations.

(4) Miscellaneous. - When a contractor was in the established business of consultant engineering and a nonexclusive and non-transferable license would be of no value to it because it did not manufacture or sell material or apparatus, the license retained included the right to grant nonexclusive sublicenses. There are also three contracts outstanding that include the standard OSRD long-form patent clauses. The subject work of these contracts is a continuation of OSRD contracts initially let for work not associated with the Project. Special patent clauses were negotiated with two foreign companies.

(5) Employees. - A few exceptions have been made in the approved employment agreements, such as, for example, where the employee had established a professional consultant status in a particular field before he became an employee of a contractor. In such cases he was considered as a contractor having a well established business. A corresponding appropriate patent clause was, therefore, authorized. In most cases, as a further consideration flowing to the Government, it was provided that the employee grant to the Government a license under related inventions made by him before employment by the contractor.

m. Visitors. - Official visitors, both American and foreign, were admitted from time to time to certain areas of the Project for conference and other purposes. Arrangements were made to record the names

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of the visitors, the dates of the visits, and the subjects discussed. If the visitors attended any seminars or discussions, notes of the subjects discussed were taken (App. A8).

2-4. Foreign Participating Countries.

a. General. - By direction of the President, OSRD and the District cooperated with foreign countries in certain phases of the Project. A great many British and Canadian scientists and engineers visited various sites of the Project and exchanged technical information with American scientists and engineers. It was felt that some formal arrangements should be made as to the procedures to be followed to adjust any overlapping of subject matter in inventions, in order that conflicts of the subject matter and claims in application could be adjusted without formal interference proceedings, and, at the same time, in order that the interests of the individual governments might be protected.

b. Exchange of Information. - It was determined at the Quebec Conference (August 1942) that the exchange of information on the Project would not come within the provisions of the Patent Interchange Agreement, which was an agreement entered into between Great Britain and the United States for the exchange of technical information between the two countries and the requisitioning of patent rights owned by nationals of the requisitioned country.

c. Combined Policy Committee. - At the Quebec Conference, there was authorized a Combined Policy Committee, to be made up of members representing Great Britain, Canada, and the United States, to consider procedures in administering the international aspects of the Project and to make recommendations to their respective Governments for

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approval. After extensive conferences between representatives of the three countries, a procedure was adopted for the processing of invention reports and the filing of applications for patents in the several countries. This procedure was approved for the Combined Policy Committee. The details are not set forth herein as they are classified as Top Secret. They are available in the files of the committee.

d. Filing of Foreign Applications. - It was appreciated from the forming of the Patent Division of the Project that grave risks would be run in the establishing of rights in foreign countries under inventions made under the Project if the filing of applications for patents in foreign countries were delayed. There was not at that time and there is not at the present time any statute in the United States, England, or Canada providing for the mandatory extension of the Convention Date in these countries. It was thought advisable to file applications in England and Canada, as security measures in those countries were deemed adequate, to build up the foreign patent structure for the protection of participating countries without depending upon the passing of any legislation similar to the Nolan Act (35 USC 80-87) by the several countries. It was also appreciated that the establishing of a foreign patent position would create a trading position with nationals of those countries for infield rights in the United States in exchange for outfield rights in the foreign countries. It was, therefore, decided to file a limited number of applications in England and Canada corresponding to certain U. S. applications. The applications were filed through representatives of the State Department acting as agents until the passage of the Atomic Energy Act of 1946. Since the passage of that Act foreign filings have been deferred pending a clarification of the provisions of the Act.

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2-5. Security.

a. General. - Following the policy of OSRD and the District, the sources of technical information were compartmented, each Group having access to only that information that is necessary for the proper preparation of the class of cases assigned to it. This procedure has not worked any particular hardship on the Patent Division as Patent Groups are assigned to Area Engineer Offices that supervise the work concentrated in and specialized in that area. At some sites, such as at Oak Ridge, work is carried on in more than one compartment or phase of the Project. At such a site, the Head of the Patent Group, and perhaps one other attorney, is cleared for more than one phase of the work at the site.

b. "Super" Secret Cases. - Certain cases are so important from a security point of view that their preparation and handling are limited to the Head of a Group and one selected assistant and to the Patent Adviser, Deputy Adviser, and the Head of the appropriate division in the Central Office in Washington.

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SECTION 3 - APPLICATIONS FOR PATENTS

3-1. General.

a. Scopes of Applications. - As it has been directed that through patents as much control of the Project as possible should be secured, the importance was stressed of the filing as promptly as possible of applications covering basic inventions, and also adaptation and improvement of inventions, that were being incorporated into equipment being built and used. In the earlier stages of the research and development of the Project, it was impossible to determine which of several basic inventions would be used. It was, therefore, deemed advisable to file applications on all basic inventions and give high priority to improvement or detail inventions as they became of importance as time progressed. A system of priority of consideration of preparation and filing of cases was established which provided four classes of priorities: P-1, P-2, P-3, and P-4. In deciding whether or not it was worthwhile to prepare and file an application on a minor invention in a crowded art, the doubt as to value was resolved in favor of filing, as the future value could only be approximated and the issued patent, though not a strong defensive document, would serve as a publication.

b. Locale of Preparation and Review. - It was at first planned to have the applications prepared by the Groups and have the applications reviewed in rough draft form by specially selected attorneys in the Central Office. It was found that the filing of applications was being delayed, because review attorneys were not in close touch with the inventors, and it was decided to transfer the review attorneys to the

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various Groups and to have each Group forward applications to the Central Office in final form, executed and ready for filing. Group prepared applications are still referred to the Technical Divisions for "examination" as to scope and conflicts as distinguished from "review." If some defect is found during this examination that cannot be corrected by later amendment, which is rare, or if the claims are found to be in conflict with claims of other cases, the application is returned to the originating Group for correction or for the submission of evidence to dispose of the conflict.

3-2. Prosecution in the U. S. Patent Office.

a. General. - The prosecution of applications in the Patent Office is in accordance with the rules of that office. Arrangements have been made with the Commissioner of Patents to furnish duplicate copies of Office Actions. One copy of the Office Action and the cited references become part of the file wrapper in the Central Office and the second copy and patent references are forwarded to the application-initiating Group for the preparation of a proper amendment. If the invention arose under a contract providing that the contractor shall retain rights under the invention, the second copy of the Patent Office Actions is furnished to the contractor together with a proposed amendment. If no change is suggested by the contractor or if changes are received from the contractor before the statutory time limit for filing amendments, the proposed amendment is filed or the changes are given consideration. The Patent Advisor, as the Government representative, is the Attorney of Record and has the sole and irrevocable right to prosecute the application. Applications are prosecuted until at least

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two Patent Office Actions or a notice of allowability or notice of allowance is received. Applications are not initially placed within the provisions of Revised Statute 4894 (35 USC 37) authorizing delays in prosecution of applications, as the scope of allowable claims is desired to be known in relation to improvement-invention applications. In case a final rejection is received and grounds for appeal are apparent, a Notice of Appeal is filed in the Patent Office and the application-initiating Group is directed to prepare an appeal brief while the matter is fresh in the minds of the preparing and prosecuting attorney. This brief is kept in the application file wrapper in the Central Office. Certificates for placing applications within the provisions of Revised Statute 4894, authorizing delays in the prosecution of applications, are furnished the Commissioner of Patents when appropriate.

b. Security Provisions. - All applications are, except for a very few, placed, or eventually will be placed, under secrecy orders by the Commissioner of Patents, at the request of the District through OSRD. The only exceptions are made in cases covering a minor improvement, on a mechanism or process that is so well developed in the art that the issue of the patent would not disclose anything of value to an enemy. By arrangements with the Commissioner of Patents, certain designated cases are examined and acted upon by the Examiner of the Divisions only, or by a designated assistant. Cases covering the most secret inventions are kept in separate safes in the Patent Office.

3-3. Prosecution in Foreign Countries.

a. General. - Applications for patents corresponding to U. S. filed applications are filed in England and Canada, on the more

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important inventions, upon the advice and clearance of the Research Control Section of the District. The patent agent in England was until the fall of 1945 the London Office of OSRD. The Second Secretary of the U. S. Embassy in London was appointed as Agent in the fall of 1945. The patent agent in Canada is the Charge D'Affaires of the U. S. Embassy in Ottawa, Canada.

b. Security Provisions. - In England and Canada the applications are presented to the Comptroller of Patents General (England) or the Commissioner of Patents (Canada) with the request that they be kept in a secret status similar to that in the U. S. Patent Office. In both England and Canada the applications are sealed and the prosecution of the applications is withheld.

3-4. Issuing of Patents. - 35 USC 42 (Patent Office Secrecy Order Act) is effective during the war and when the Act is no longer in effect the applications will either be permitted to issue or be placed under Revised Statute 4894 (35 USC 37) according to the nature of the technical information in the individual application.

3-5. Assignment of Inventions.

a. General. - Assignments of inventions are required at the time of filing of applications covering them. For secrecy reasons, assignments are not recorded in the Patent Office until it is necessary in the handling of the case, such as placing the application under the provisions of 35 USC 37.

b. Form. - Assignments are either direct to the Government, as represented by the Director of OSRD, or through the contractor, according to circumstances, such as existing approved employer-employee

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agreements. If the assignment is direct from the inventor to the Government, the form provides for the assent and approval of the contractor. All assignments are accepted for the Government by the Director of OSRD.

c. When Assignments Not Required. - Assignments are not required when it is decided by the Patent Division that no application will be filed. In such cases the contractor is so notified and is advised that it may file an application, subject to a license in favor of the Government. The contractor is requested to advise the Patent Division of the serial number, filing date, name of the inventor, and short title of the application, and, upon receipt of such advice, a formal license is prepared by the Patent Division and forwarded to the contractor for execution.

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SECTION 4 - CONTRACT ADMINISTRATION

4-1. General. - As Advisor on Patent Matters to the Director of OSRD and to the Manhattan District Engineer and as the representative of the Contracting Officer of the District as to the patent clauses in District contracts, the Chief of the Patent Division assisted in the negotiations of the patent clauses of contracts and administrated the patent clauses in accordance with the delegated authority. This phase of the work came directly under the supervision of the Administrative Assistant Chief.

4-2. Negotiations of Patent Clauses. - When the Manhattan District was formed, standard patent clauses were drawn up and approved, and copies were furnished all Area Engineers, for use by Area Contracting Officers. Whenever there was a doubt in the minds of the Area Contracting Officers, all of the facts upon which the proposed contract was to be let were to be furnished the Patent Division for a decision. Considering the large number of contracts made, the great variety of technical subjects involved, and the unusual and new requirements under the contracts with highly specialised and well established manufacturing companies, the contracts made by the Area Contracting Officers were remarkably consistent.

4-3. Renegotiation of Patent Clauses. - When contracts were reported to the Patent Division that were inconsistent with the policy of the District, renegotiations were initiated by the Patent Division. As a further guide to Contracting Officers and to the Heads of Field Groups, a circular letter was issued quoting the standard clauses and the circumstances in which they were to be used (App. 18). In some cases the

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subject work of contracts underwent changes during the contract period, calling, for example, for research as distinguished from development. This change would become obvious to the Patent Division as technical and invention reports were received and being processed into applications. The actual work under the contract would then be examined by the Patent Division and, when circumstances so warranted, renegotiation of the patent clause would be initiated by the Patent Division. The matter was usually adjusted at the time an extension to the old contract was under negotiation or a new contract was being made, in which case the new patent clause was agreed upon and made retroactive to cover the original contract as part of the consideration of the extension of the new contract.

4-4. Personnel Contractual Relations.

a. Government Employees. - The rights of the Government to inventions made by its employees and members of the Armed Services are defined by OSRD Administrative Circular 10.06, Navy General Order 31, and Army Regulations 860-50 (App. A7). No individual contracts with Government personnel are required.

b. Contractors' Employees. - The standard employer-employee agreements between contractors and their employees are reviewed and require the approval of the Patent Advisor.

c. Expert Engineers. - Whenever a contractor's employee has developed a position as to previous inventions in a particular field to the same extent as a proposed contractor, his employment contract is considered the same as a subcontract under a prime contract and may provide for his retention of patent rights under the same principles as

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apply to subcontracts.

4-5. Loaned Employees' Contracts. - The negotiation for and administration of special contracts providing for the loaning of employees to the Government or to contractors are within the duties of the Patent Division.

4-6. Consultants' Contracts. - The negotiations for and administration of special contracts providing for the services of consultants are within the duties of the Patent Division.

4-7. Visitors. - The Patent Division receives, examines, and has custody of the reports of visitors (App. A8).

4-8. Clearance of Contracts.

a. General. - Before the final payment is made under a contract, the Contracting Officer must receive a clearance from the Patent Division stating that all the patent obligations of the contractor have been fulfilled (App. A10).

b. Requirements for Clearance. - Before a clearance is issued by the Patent Division the following is required:

(1) Examination of Notebooks. - Certification by a qualified representative of the contractor that all notebooks have been examined and that no inventions, other than those previously reported, have been made and itemizing the previously reported inventions.

(2) Custody of Notebooks. - A statement by the contractor as to the person having custody of the notebooks and their future availability to the Patent Advisor.

(3) Examination of Reports. - A statement by a qualified representative of the contractor that all reports rendered under

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the contract (and listed) have been examined, that no inventions, other than those reported, have been made, and that such reports shall be transmitted to the Government on request.

(4) Report of Filed Applications and Delivery of Assignments. - Evidence that all inventions have been reported on the District standard forms, patent applications have been filed, and assignments have been executed.

(5) Report on Subcontracts. - Similar data as to all subcontracts containing patent assignment provisions (App. A8).

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SECTION 5 - RECORDS

5-1. Statistics (as of 31 December 1946). - There are tabulated below the significant statistics of the patent program, which reflect its scope and size.

- a. Classes of inventions considered - 493.
- b. Inventions docketed - 5600.
- c. Inventions searched in the Prior Art - 3700.
- d. Inventions approved for filing - 2100.
- e. Applications filed in U. S. - 1250.
- f. Applications filed in England - 267.
- g. Applications filed in Canada - 259.
- h. Conflicts between reported inventions - 88.
- i. Formal opinions - 88.
- j. Contracts under patent administration -

Prime	1390
Subs	1034
	<hr/>
Total	2424

- k. Project technical reports reviewed - 8524.
- l. Notebooks examined - 6305.
- m. Average amendments filed per month - 30.

5-2. Records Kept. - The complexities of the Project of necessity resulted in a somewhat extensive system of records, as follows:

- a. All formal technical reports rendered to the District by contractors.
- b. Master chart showing main technical phases and processes of the Project from the raw ore as mined to the atomic bomb with 493

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subclasses.

- c. Reported inventions on Record of Invention and Disclosure form, with supporting reports and drawings.
- d. Patentability reports of inventions.
- e. Conflicts of subject matter of inventions.
- f. Formal opinions deciding conflicts.
- g. Formal opinions as to validity and infringement.
- h. Application jackets for U. S. patents with associated secrecy orders, Patent Office Actions, amendments, appeals, and correspondence with inventors and contractors.
- i. Application jackets for British applications and associated documents.
- j. Application jackets for Canadian applications and associated documents.
- k. Routing slips showing location, dates acted upon, and by whom.
- l. Application amendment docket by serial number.
- m. Foreign filing docket by serial number.
- n. Application amendment docket by date of Patent Office Action.
- o. Foreign filing docket by date of U. S. filing date.
- p. Case ledger of exact definition of individual inventions and contract history.
- q. Assignment of applications.
- r. Licenses under applications.
- s. Index of inventions by classes, subclasses.

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- t. Index of inventions by contractors.
- u. Index of inventions by inventors.
- v. Index of inventions by project docket number.
- w. Index of U. S. applications by serial number with cross indexes.
- x. Index of U. S.-British applications by British serial number.
- y. Index of U. S.-Canadian applications by Canadian serial number.
- z. Index of contracts by contractors.
- aa. Index of contracts by contract number.
- bb. General correspondence by contractors.
- cc. Index of books and published articles on subjects associated with the Project, both U. S. and foreign.
- dd. Index of U. S. patents relating to the Project.
- ee. Index of foreign patents relating to the Project.
- ff. Library consisting of:
 - (1) U. S. and foreign publications.
 - (2) U. S. and foreign patents.
 - (3) Patent law text books.
 - (4) U. S. Code Annotated.
 - (5) Patent Law Quarterly.
 - (6) Patent Office Gazette.
- gg. Circular letters issued by Patent Division.
- hh. Circular letters of District.
- ii. Circular letters of War Department.

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- jj. Circular letters of Navy Department.
- kk. Circular letters of OSRD.
- ll. Correspondence with contractors.
- mm. Correspondence with personnel.
- nn. Correspondence with Patent Groups.
- oo. Weekly and monthly reports by Heads of Groups.
- pp. Correspondence with foreign Patent Advisors (British and Canadian).
- qq. Reports on visitors, U. S. and foreign.
- rr. Reports on consultants.
- ss. Reports of use of inventions in applications filed by independent inventors and tendered to the use by the Government.
- tt. Certificates as to notebooks, reports, inventions, and clearance of contracts.
- uu. Digest of technical reports by subject and contractor.
- vv. Cross index of technical reports (CC-A-OO-M-CD-LA-K, etc.)
- ww. Index of final reports.
- xx. Index of opinions by inventors.
- yy. Index of opinions by office number.
- zz. Index of British Special Project cases filed in U. S. by U. S. serial number.
- aaa. Index by serial numbers of independent inventors.
- bbb. Index of allowed applications.
- ccc. Appeal index.

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SECTION 6 - ORGANIZATION

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6-1. General.

a. The Patent Division. - The administration of the Patent Division is divided between the Central Office in Washington, D. C., and Patent Groups in the field. Located in the Central Office are the Patent Advisor and the Chief of the Patent Division, the Deputy Advisor, Technical Advisors, and Division Heads and their assistants. In the field are Group Heads in charge of groups detailed at research and other centers and their assistants.

b. The Patent Advisor. - Captain Robert A. Lavender, U. S. Navy (Ret.) has been designated as Advisor on Patent Matters to the Director of OSRD and as such has been designated as Advisor on Patent Matters to the District Engineer and, as provided for in district contracts, the representative of the Contracting Officer of the District as regards patent matters, but without authority to make financial commitments. In this capacity he, as the Chief of the Patent Division, makes all policy decisions on matters arising in the Division, and supervises the work being carried on by the Division.

c. The Deputy Advisor. - Mr. Roland A. Anderson has been designated as Deputy Advisor and is responsible for the operation and organization of the Central Office and the Field Groups of the Patent Division as well as liaison with Manhattan District representatives, other Government agencies, and representatives of foreign governments in connection with patent matters. As Deputy Chief, he assists the Advisor in matters of policy, negotiations of contracts, licenses and the handling of the work of the Division.

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d. The Technical Advisors. - Dr. William B. Holton and Dr. Robert D. Richtmyer are designated Chemical Advisor and Physics Advisor, respectively.

e. Personnel.

(1) Attorneys. - Practically all of the Patent Attorneys were commissioned officers in the Army or Navy until the fall of 1945. When the patent work was started, officers already enrolled in the Services were detailed to this duty, but it was soon found that a sufficient number of attorneys were not available for assignment. Both the Navy Department and the War Department authorized special officer procurement programs under which additional attorneys were recruited for enrollment both from civilian life and from the enlisted personnel of both services. Until the fall of 1945, a few civilian patent attorneys, employed by contractors, worked under the direction of the Patent Division. Since the fall of 1945, most of the Army and Navy officers have been relieved from active duty and civilian patent attorneys have been employed either under Civil Service or by arrangements with the contractors.

(2) Invention Reporters. - As a great deal of the preliminary work in the preparation of an application for a patent can be done by scientists and engineers without extensive training in patent law, Invention Reporting Sections were organized in all Groups. Most of the personnel for these sections were drawn from civilian employees of the contractor as, with the exception of one contract, (see Par. 2-31) the contractor was required to report inventions to the Contracting Officer. When it was found impossible to recruit qualified personnel or when deferments could not be obtained from induction into the Armed Services, some Invention Reporters were commissioned and assigned to the Field Groups.

(3) Duty Status of Officers. - Officers assigned to the

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Patent Division were ordered to report for duty to an appropriate Naval or Army officer in the area in which the Group was located and to report by letter to the Chief of the Patent Division. The officers were under the local Naval or Army officer for pay, discipline, and leave purposes and under the Chief of the Patent Division for all other purposes.

(4) Assignment of Officers. - Officers were assigned positions according to rank as far as practicable. However, as the grade held by an officer depended greatly upon his length of service rather than his experience in patent matters in general, it was decided to assign the officer to a position in accordance with his previous experience in patent practice and in the particular problems of the Patent Division. The whole-hearted cooperation of seniors-in-rank working under juniors-in-rank bespeaks the highest American spirit to accomplish an assigned mission.

(5) Enlisted Personnel. - Draftsmen and the clerical staff were usually employed by the contractors. Where necessary, they were supplemented by enlisted personnel of the Navy or Army.

6-2. Directives. The administration of the Patent Division is through the Manual of Office Organization and Procedure (App. B), circular letters issued by the District (App. A7, 8 and 10), Patent Division circular letters (App. A6), correspondence, and oral instructions.

6-3. Central Office.

a. General. - The administration of the Central Office is through the Deputy Advisor and the Technical and Administrative Branches under their respective chiefs.

b. Technical Assistant Chief.

(1) Duties. - The Technical Assistant Chief is responsible for the processing of all technical information. This includes: (a) the

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examination of all reported inventions with their Record of Invention and Disclosure; (b) determination of priority of processing the reported inventions into application; (c) searching of inventions and the preparation of Reports on Patentability (see Page 20 of App. B); (d) determination of conflicts in or overlapping of subject matter in reported inventions; (e) preparation of formal opinions on conflicts; (f) examination, before filing, of applications that have been prepared in Field Groups; and (g) the prosecution of applications in the Patent Office.

(2) Technical Sub-Sections. - Under the Technical Assistant Chief were organized the following Technical Sub-Sections and their respective heads:

- a. Chemical I - Mr. Warren Seaton succeeded Lt. Robert J. Leahy, USNR upon his release from active duty.
- b. Chemical II - Mr. Wilbur F. Smith succeeded Lt. Thornton F. Holder, USNR, upon his release from active duty.
- c. Mechanical III - Harmon S. Potter, formerly Major, AUS. The following, until released from active duty, preceded: Lt. Thomas R. O'Malley, USNR; Lt. Charles Howson, USNR; Comdr. Donald E. Land, USNR; Lt. Richard G. Radue, USNR.
- d. Electrical IV - Lt. (j-g.) Milton Gross, USNR, succeeded Lt. Col. Walter E. Mueller, AUS, upon his release from active duty.
- e. Physics V - Comdr. Gerald D. O'Brien, USNR, succeeded Lt. Robert S. Dunham, USNR, upon his release from active duty.
- f. Classification - Kenneth S. Klarquist succeeded Lt. Rey Eilers, AUS, upon his release from active duty.
- e. Administrative Assistant Chief. - The Administrative Assistant Chief is responsible for the following: (a) the negotiation, adminis-

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tration, and clearance of contracts; (b) the formulation of and supervision of execution of general policy matters; (c) directing supervision and operation of the Field Groups; (d) liaison with District and Area Engineers, contractors, OSRD, and other Government agencies; (e) preparation of formal opinions on general patent matters; (f) initiation of invention reports concerning inventions under contracts not assigned to a Field Group; (g) international relations and arrangements; (h) the preparation, filing, and prosecution of foreign applications; (i) preparation of assignments, licenses, and agreements; (j) the general management of the office and handling of personnel; (k) supervision and maintenance of office ledger, docket, and records as to inventions, applications, contracts, reports, patents, literature, correspondence, etc.; (l) arrangement for filing of applications and payment of fees; (m) supervision and administration of the procurement, recording, and distribution of information; and (n) the handling of security problems.

6-4. Field Groups.

a. General. - The Heads of Field Groups are responsible in their respective fields for the following: (a) obtaining data for and the submission of invention reports and Records of Invention and Disclosure; (b) preparation and review of applications based upon Reports of Patentability and other instructions; (c) preparation of amendments to applications; (d) supervision of contracts and personnel assigned to their respective fields; and (e) security.

b. Location of Field Groups. - Field Groups have been established with assigned Group Heads, in geographical order, as of 31 December 1966, as follows:

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(1) New York (Columbia-SAM-Nash) - Gordon K. Lister succeeded Lt. Robert J. Mawhinney, USNR, upon his release from active duty.

(2) Wilmington (closed May 1946) - Major George B. Campbell, AUS, until released from active duty in May 1946.

(3) Oak Ridge - Mr. Stuart W. Scott, formerly Captain, AUS, succeeded Major Harold Powell, AUS, and Lt. Col. Sylvester M. Evans, AUS, upon their release from active duty.

(4) Chicago - Mr. Francis W. Test succeeded Lt. Raymond S. Chisholm, USNR, Lt. Henry W. Johnson, USNR, Col. Herbert E. Metcalf, AUS, upon their release from active duty.

(5) Los Alamos - Lt. Col. Ralph C. Smith, AUS.

(6) California - William E. Elliott, formerly Lt. Col., AUS, succeeded Major Douglas O. Baird, AUS, upon his release from active duty.

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SECTION 7 - COOPERATING AGENCIES

7-1. The following Government departments and agencies have cooperated with the Patent Division.

a. The Patent Office in the arrangement of security and special handling of applications, the furnishing of copies of patents, the furnishing of photostats of applications, and the issuing of secrecy orders.

b. The National Bureau of Standards in the furnishing of correspondence and other records of the Advisory Committee on Uranium and the assignment of applications covering inventions made by Bureau of Standards employees.

c. The Navy Department in its furnishing of officer and enlisted personnel and duty and travel orders therefor, the furnishing through the various commandants of districts of administrative services for Naval personnel, the furnishing of information of the early work on the Project by the Navy, and the furnishing of valuable space and security services for the Central Office.

d. The Department of Interior by the personnel in the Bureau of Mines furnishing invention reports of its employees working on the Project.

e. The Office of Scientific Research and Development was responsible for the initial setting up of a going patent organization for the Project, and handled the transfer of military personnel from OSRD staffs to the roster of the Manhattan Engineer District. Throughout the existence of the Patent Division the OSRD's services have been

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constantly available, including both administrative facilities and consultations, notably with the Director of OSRD, concerning matters of policy and administration. The OSRD furnished the services of the Advisor on Patent Matters, technical advisors and clerical personnel. It also supplied library, mail service, office supplies, funds for filing applications, etc.

f. The State Department in acting as local agents for the filing of applications in England and the United States and transmittal of classified documents by State Department diplomatic pouch.

g. Office for Emergency Management and War Production Board in furnishing library services.

h. Department of Agriculture in furnishing photostats and photolithograph services.

i. Patent Division of the Office of the Judge Advocate General of the Army in furnishing records as to applications examined in the Patent Office by that division covering inventions of independent inventors.

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MANHATTAN DISTRICT HISTORY

BOOK I - GENERAL

VOLUME 15 - PATENTS

APPENDIX "A-1 TO A-10" - DOCUMENTS

<u>No.</u>	<u>Title</u>
1	OSRD Long-Form Patent Clause
2	OSRD Short-Form Patent Clause
3	OSRD Administrative Circular 10.06 (Inventions and Discoveries)
4	Manhattan District Standard Clause "Contractor - Hold Harmless Clause"
5	"Standard B" Government Indemnity
6	Patent Division Circular Letter, 10 March 1944
7	District Circular Letter (Control 44-7)
8	District Circular Letter (Legal 44-4)
9	Special General Electric Patent Clause
10	District Circular Letter (Legal 44-5)

~~SECRET~~

OSRD Long Form Patent Clause

(a) The Contractor hereby grants to the Government of the United States an irrevocable option to purchase a non-exclusive license or licenses, subject to the payment of royalties, to make, have made, and use, for military, naval, and national defense purposes, and to sell in accordance with law, material, and to use processes, under all United States patents and applications for patents owned or controlled by the contractor covering inventions heretofore developed and actually or constructively reduced to practice and concerned with the subject matter of this contract. Any such license shall be granted upon reasonable terms subject to negotiation at the time the Government may desire to exercise its option hereunder.

(b) The contractor agrees to and does hereby, in consideration of the premises and in consideration of payments to be made by the Government under this contract, grant unto the Government a non-exclusive, irrevocable, royalty-free license, to make, have made, and use, for military, naval, and national defense purposes, and to sell or otherwise dispose of in accordance with law, material, and to use processes, under all inventions made in carrying out the work contemplated by this contract, including all inventions ~~exclusive~~ of inventions covered by subparagraph (a) which for the first time were actually or constructively reduced to practice as a result of the work contemplated by this contract, whether patented or unpatented. The contractor agrees to make to the Government, prior to the final settlement under this contract, a complete disclosure of all inventions made in carrying out the work contemplated by this contract and to designate in writing which of the said inventions have been or will be covered by applications for patents filed or caused to be filed by the contractor. The contractor shall have the right, upon notification by the Government, to elect whether it or the Government shall file applications for patents on inventions in addition to those designated by the contractor as aforesaid.

(c) As to all such inventions that are not covered by applications for patents as specified in subparagraph (b) the contractor agrees that the Government shall have the right, at the Government's expense, to file, prosecute, and act upon applications for patents thereon, and the contractor shall secure the execution of the necessary papers and do all things requisite to protect the Government's interest in prosecuting such applications to a final issue. When an application for patent is filed by the Government as aforesaid, all right, title, and interest in and under the patent shall be assigned to the Government by the contractor except that the contractor may retain a non-exclusive license non-transferable except to an assignee of the entire business to which said license is appurtenant.

(d) The contractor covenants that he has not entered into and will not enter into any arrangement to evade the intent of this Article for the Government to obtain without further payment a non-exclusive license to patents, applications for patents and inventions as called for in subparagraph (b) above.

(e) It is agreed that the execution of this contract shall not constitute a waiver of any rights the Government may have under patents or applications for patents.

~~SECRET~~

OSRD SHORT FORM PATENT CLAUSE

Patent Provisions. Whenever any patentable discovery or invention is made by the Contractor or its employees in the course of the subject work, the Contractor shall furnish the Contracting Officer with complete information thereon and the Contracting Officer shall have the sole power to determine whether or not a patent application shall be filed, and to determine the disposition of the title to and the rights under any application or patent that may result. The judgment of the Contracting Officer on such matters shall be accepted as final, and the Contractor, for itself and for its employees, agrees that the inventor or inventors will execute all documents and do all things necessary or proper to carry out the judgment of the Contracting Officer. The Contractor shall include the provisions of this Article in all contracts of employment with persons who do any part of the subject work.

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Office for Emergency Management
OFFICE OF SCIENTIFIC RESEARCH AND DEVELOPMENT
1530 P Street, N. W.
Washington, 25, D. C.

ADMINISTRATIVE CIRCULAR 10.06
(Inventions and Discoveries)

Effective Date: September 15, 1943

**SUBJECT: INVENTIONS AND DISCOVERIES MADE BY PAID TECHNICAL PERSONNEL
OF OSRD DURING THE PERIODS OF THEIR EMPLOYMENT**

**Note: The provisions of this circular apply to OSRD
technical personnel receiving compensation from the
Government.**

1. Technical personnel are employed by OSRD to assist this Office and its contractors in reaching an early solution of the problems involved in the work undertaken. Among the duties of the technical personnel are those of making suggestions and giving general directions to contractors concerning the technical aspects and solutions of the problems forming the basis of projects, interpreting the efforts of the contractor with those of the Armed Services in arriving at the best solutions of the problems undertaken.

2. Much of the effectiveness and smooth functioning of OSRD is due to the competence, diplomacy and impartiality of these technical personnel who enjoy to a high degree the confidence of OSRD contractors and of the Armed Services. An important factor in creating this confidence is the realization that the technical personnel of this Office are not seeking to establish rights for themselves as individuals in the fields of research and development for which they are acting as the Government's representatives. It has been and is, therefore, the policy of the OSRD that its technical personnel assign to the Government the titles to inventions and discoveries made by them in the line of their duties.

3. It is, of course, understood that technical personnel are not expected to convey titles to the Government to inventions and discoveries made by them that are not concerned with the projects of this Office.

V. Bush
Director

Date: September 1, 1943

(END)

MANHATTAN DISTRICT STANDARD CLAUSE

CONTRACTOR - HOLD HARMLESS CLAUSE

The Contractor shall hold and save the Government, its officers, agents, servants and employees, harmless from liability of any nature or kind, including costs and expenses for or on account of any patented or unpatented invention, article, design, or method furnished by the Contractor and used in the performance of this contract, including their use by the Government. The Contractor hereby releases the Government, its officers and agents from any and all claims that it has or may have because of the use by the Government, now or in the future, of any of the patented or unpatented methods, designs, or inventions of the Contractor in connection with this project.

"STANDARD B"

GOVERNMENT INDEMNITY

In view of the fact that the Contractor has not made an investigation as to the possibility of patent infringement, and both parties desire to avoid the delay incident to a patent investigation, and further in view of the fact that the Contractor has not included in its price any provisions for the settlement of possible patent claims, it is agreed that the Government shall hold and save the Contractor harmless from liability of any nature or kind, including costs and expenses for infringement of patent rights arising in the performance of this contract.

~~SECRET~~

10 March 1944

TO: Patent Group Heads
Manhattan District Area Engineers
FROM: Captain Robert A. Lavender, USN, (Ret.)
Advisor on Patent Matters
SUBJECT: Patent Clauses for Prime Contracts, Subcontracts and
Purchase Orders on the Special Project.

1. To assist in determining the type of patent clauses to be inserted in contracts, the three following categories are defined:

A. The nature of the services to be performed or the material or apparatus to be furnished may involve inventions that relate directly to and concern some phase of the basic research and development of the Special Project.

B. The nature of the services to be performed or the material or apparatus to be furnished relate only indirectly to some phase of the basic research and development of the Special Project but may involve possible inventions in a field relating to the contractor's business position and the contractor has an established patent position or business in the field of research that is the subject matter of the contract.

C. The nature of the services to be performed are merely routine work of the contractor, including, for example, installation of equipment and operation of a plant or the nature of the apparatus to be furnished involves only minor alterations of the apparatus furnished generally in the regular field of business of the contractor, and any invention that may be made will relate to or concern such field of business.

2. The decision whether a particular contract comes within the category A, B or C will be primarily determined by the nature of the work to be done under the contract and particularly as to whether the contract is predominantly for basic research, incidental research or quantity production and the patent and business position of the contractor in the field of the subject matter of the contract.

3. When the contractor falls within category (A) the contract shall contain the "Short Form" patent clause, which reads as follows:

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App. A6

Patent Group Heads
Manhattan District Area Engineers

10 March 1944

"It is understood and agreed that whenever any patentable discovery or invention is made by the Contractor or its employees in the course of the work called for in this contract, the Contractor shall furnish the Contracting Officer of the U. S. Corps of Engineers, Manhattan District, with complete information thereon, and the Contracting Officer, U. S. Corps of Engineers, Manhattan District, shall have the sole power to determine whether or not and where a patent application shall be filed, and to determine the disposition of the title to and the rights under any application or patent that may result. It is further understood and agreed that the judgment of the Contracting Officer of the U. S. Corps of Engineers, Manhattan District, on such matters shall be accepted as final, and the Contractor, for itself, and for its employees, agrees that the inventor or inventors will execute all documents and do all things necessary or proper to carry out the judgment of the Contracting Officer of the U. S. Corps of Engineers, Manhattan District. The Contractor agrees that it will include the provisions of this paragraph in all contracts of employment with persons who do any part of the work called for in this contract."

4. When the contractor falls within category (B) the contract may contain a modified "Short Form" patent clause with the provision for the retention by the contractor of a non-exclusive license, which reads as follows:

"It is understood and agreed that whenever any patentable discovery or invention is made by the Contractor or its employees in the course of any of the work referred to in this contract, the Contracting Officer of the U. S. Corps of Engineers, Manhattan District, shall have the sole power to determine whether or not and where a patent application shall be filed, and to determine the disposition of the title to the rights under any application or patent that may result; provided, however, that the Contractor, in any event, shall retain at least a non-exclusive, irrevocable, royalty-free license, under said discovery, invention, application or patent, limited to the manufacture, use and sale for purposes other than the purposes for which the apparatus, process and/or product manufactured and/or used by the Contractor, under this contract are now intended for use by the Government. Subject to the license retained by the Contractor as above provided, it is further understood and agreed that the judgment of the Contracting Officer of the U. S. Corps of Engineers,

Patent Group Heads
Manhattan District Area Engineers

10 March 1944

Manhattan District, on these matters shall be accepted as final, and the Contractor, for itself and for its employees, who may be obligated by the provision of this paragraph, agrees that the employee inventor or inventors will execute all documents and do all things necessary or proper to carry out the judgment of the Contracting Officer of the U. S. Corps of Engineers, Manhattan District."

5. Where the contractor falls within category (C), the contract may incorporate a modified "Short Form" patent clause providing for the reservation by the contractor of a sole license, with the sole right to grant sublicenses, which reads as follows:

"It is understood and agreed that whenever any patentable discovery or invention is made by the Contractor, or its employees in the course of any of the work referred to in this contract, the Contracting Officer of the U. S. Corps of Engineers, Manhattan District, shall have the sole power to determine whether or not and where a patent application shall be filed, and to determine the disposition of the title to and the rights under any application or patent that may result; provided, however, that the Contractor, in any event, shall retain at least a sole, irrevocable, royalty-free license, and the sole right to grant sublicenses, under said discovery, invention, application or patent, limited to the manufacture, use and sale for purposes other than the purposes for which the apparatus, process and/or product manufactured and/or used by the Contractor, under this contract are now intended for use by the Government. Subject to the license retained by the Contractor as above provided, it is further understood and agreed that the judgment of the Contracting Officer of the U. S. Corps of Engineers, Manhattan District, on these matters shall be accepted as final, and the Contractor, for itself and for its employees, who may be obligated by the provision of this paragraph, agrees that the employee inventor or inventors will execute all documents and do all things necessary or proper to carry out the judgment of the Contracting Officer of the U. S. Corps of Engineers, Manhattan District."

6. It is to be noted that in all instances the title to all inventions vests in the Government and the Government has exclusive rights in the field of the Special Project.

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Patent Group Heads
Manhattan District Area Engineers

10 March 1944

7. Sub-contracts are from time to time negotiated by prime contractors for certain services or special apparatus or equipment under a prime contract and, in general, the patent clause of the sub-contract should conform to and be the same as the patent clauses of the prime contracts under which the sub-contract is made. However, in certain instances the patent clause of the sub-contracts may be modified in view of the nature of the services to be performed or the articles to be furnished by the sub-contractors and the foregoing principles should likewise govern the type of patent clause to be employed in the sub-contract.

8. Purchase orders covering the furnishing of materials "off the shelf" need not contain any patent clause even though the material may be altered in structure to meet the specific adaptation. However, where purchase orders are issued covering any apparatus where research and inventions may be involved appropriate patent clauses shall be incorporated in which case the foregoing patent clauses will be changed by substituting "Vendor" for --contractor-- and "purchase order" for --contract-- .

9. In cases where there is a doubt in the mind of the Contracting Officer of the type of patent clause that should be used it is suggested that you communicate with me, setting forth the details in support of the use of a modified "Short Form" patent clause or the reasons for modifying one of the foregoing types of clauses.

10. In all contracts or purchase orders incorporating a patent clause in addition to the hold harmless and notification of infringement clauses, it is deemed advisable to incorporate the following clause:

"The Patent Advisor attached to the Office of Scientific Research and Development, Washington, D.C., will act as the representative of the Contracting Officer of the U.S. Corps of Engineers, Manhattan District, for the purpose of administering the foregoing patent provisions, unless another representative is appointed in writing by the Contracting Officer of the U.S. Corps of Engineers, Manhattan District. It is understood, however, that such Patent Advisor shall not be considered a representative of the Contracting Officer of the U.S. Corps of Engineers, Manhattan District, for the purpose of making any financial commitments or incurring any financial obligations hereunder."

Robert A. Lavender

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WAR DEPARTMENT
U. S. Engineer Office
Manhattan District
Oak Ridge, Tennessee

21 February 1944

DISTRICT CIRCULAR LETTER (Control 44-7)

Subject: Rights of the Government in Inventions Arising Through the Assignment of Military Personnel (Officer and Enlisted) to, and the Employment of Civilians by the Manhattan District on the Special Project.

To: All Military Personnel and Others Concerned, Manhattan District.

1. All military personnel detailed to or assigned to work under the Manhattan District and all civilians employed in a technical or professional status by or for the Manhattan District are hereby formally advised of the rights of the Government in inventions made while assigned to work under or detailed to or employed by or for the Manhattan District, particularly those inventions as may arise from knowledge gained from information received as a result of their position of trust within the project.

2. a. The rights of the Government in and to inventions made by the military personnel of the Army or Navy and civilian employees of the War Department, the Army, the Navy or the Office of Scientific Research and Development are defined in Army Regulations 850-50, Navy General Order #31, or O.S.R.D. Administrative Circular 10.06.

b. The special project undertaken by the Manhattan Engineer District requires the complete control of all phases of the special project to be within the Government and it is necessary in order that the Government may realize all the benefits anticipated that would flow to it by such assignment or employment that all rights, titles and interests in any inventions relating to the special project made by such military or civilian personnel shall become the property of the Government.

c. The detailing or assigning of military personnel to and the employment of civilians by or for the Manhattan Engineer District is for the promotion of the research and development of the special project and the control of inventions made thereunder and places such personnel in a particular and responsible position of trust with respect to the benefits to be derived by the Government in the solution of the problems of the special project. The solution of the specific problems in connection therewith is interpreted to be within the meaning of paragraph 7 (a) of Army Regulations 850-50, within the meaning of Section 2, (a) of Navy General Order #31, and within the meaning of paragraph 2 of O.S.R.D. Administrative Circular 10.06.

DISTRICT CIRCULAR LETTER (Control 44-7)--(Cont'd)

d. In the interest of the Government every person in the military service detailed to or assigned to work under the Manhattan Engineer District and every employee of the War Department, the Army, the Navy, or the Office of Scientific Research and Development detailed to or assigned to work under the Manhattan Engineer District who makes an invention relating to the special project is hereby required to furnish information thereof to and report the same to his immediate superior or supervisor and execute all necessary documents including the making of all proper assignments to the Government.

e. All persons administering contracts involving research shall satisfy themselves that all persons connected with the project through contractors are fully informed of the Government's rights of assignment to inventions and shall permit no technical or scientific personnel to become associated with the project through contractors unless the involved contractor has in his possession an executed assignment agreement, approved by the Advisor on Patent Matters, that provides that the Government Contracting Officer, or his representative, has the sole power of determining the disposition of rights under inventions made by such persons while associated with the project.

For the District Engineer:

/s/ E.H. Marsden,
E.H. Marsden,
Colonel, Corps of Engineers,
Executive Officer.

(END)

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ARMY SERVICE FORCES
U. S. Engineer Office
Manhattan District
Oak Ridge, Tennessee

7 April 1944

EIDMC-2

DISTRICT CIRCULAR LETTER (Legal 44-4)

Subject: Patent Protection for the Manhattan District Project.

To: All Area Engineers and all Contracting Officers and Representatives of Contracting Officers on Contracts Containing Patent Assignment Provisions.

1. It is necessary that positive action be taken to secure to the fullest extent to the United States all rights in any inventions or perfection of inventions within the field pertaining to the Manhattan District Project which are made, solely or jointly with others, by consultants, engineers or technicians employed:

a. By contractors or subcontractors whose contracts on any phase of the Manhattan District program provide for the determination by the Contracting Officer of the disposition of the title to, and rights under, any application or patents that may result therefrom.

b. By domestic corporations, associations, or individuals, and loaned to the Manhattan District Project.

c. By foreign governments or foreign companies, and loaned to the Manhattan District Project.

2. It is possible that certain of the contractors and subcontractors, described in Paragraph 1 a, are not properly protecting the government by making adequate patent agreements with their employees who are working on matters relating to the Project.

Therefore, it is desired that you determine that all such contractors and subcontractors under your jurisdiction have obtained from consultants, technicians, and engineers in their employ, adequate signed agreements assigning to the contractors or subcontractors all rights to inventions or perfection of inventions relating to or arising from work under the Manhattan District Project, thereby permitting reassignment of these rights by the contractors or subcontractors to the United States, and avoiding a situation in which such contractors or subcontractors may find themselves unable to fulfill contractual obligations due to a lack of binding patent agreements between themselves and their employees.

DISTRICT CIRCULAR LETTER (Legal 44-4)--(Cont'd)

In the event such assignments of patent rights have not been executed by the contractors or subcontractors under your jurisdiction with their engineering, consulting, and technical personnel, it is desired that you expedite preparation and signing of such agreements without delay. The form actually in use or the form as proposed for use will be forwarded to the Patent Advisor, Office of Scientific Research and Development, 1550 "P" Street, N. W., Washington, D. C., for review and approval if not already approved.

3. In the case of persons employed as described in Paragraph 1 b, arrangements will be made for the execution of a Memorandum Patent Agreement with each such person and the execution of a Consent and Waiver Agreement with the individual's employer. The attached forms will be used.

4. In the case of persons employed as described in Paragraph 1 c, negotiations leading to a specific agreement should not be attempted at this time. However, in order to protect the interests of the United States, the following information should be submitted to the Patent Advisor for the year 1943 and the months of January, February and March 1944 insofar as this can be done, and in the future at the end of each calendar month for that month's activities.

a. The days on which the foreign personnel were present at any installation or activity of the Manhattan District Project under your supervision.

b. Insofar as practicable, particular parts of installations that were inspected by such personnel.

c. The identity of any papers, records, or reports pertaining to the Manhattan District Project that were examined by them.

d. The identity of all persons present at any conferences under your jurisdiction in which such personnel participated and the general matter discussed at such conferences. This record will include consultations that have previously occurred to the extent that the required information is available.

If negative reports are applicable, they should be submitted at the end of each month so that the records of the Patent Advisor will be complete. Initial and monthly reports, giving the information called for in subparagraphs a to d above, will be submitted to the Patent Advisor through the District Engineer, Manhattan District, (Attention Control Officer), by the officer supervising the installation visited. To insure completeness of records, negative initial and monthly reports, where applicable, will be submitted by all Area Engineers. The initial report and the report for the

DISTRICT CIRCULAR LETTER (Legal 44-4)--(Cont'd)

month of April will be submitted to reach this office not later than 15 May. Subsequent monthly reports will be submitted to reach this office not later than the 15th of each month.

5. When any inventions are made in the course of work of persons referred to in Paragraph 4 on that part of the project under your supervision, a Record of Invention in the approved form, together with a Disclosure, will be prepared and forwarded to the Patent Advisor.

6. The action required by Paragraph 2 of this circular, will be initiated for each such contract by the representative of the contracting officer exercising direct technical supervision of the contract. In the case of contracts for which no representative has been designated, action will be initiated by the contracting officer. In cases where a question of dual supervision exists, officers concerned will consult and agree as to which will take action.

7. The action required by Paragraph 3 will be taken by the officer supervising the installation or program to which the desired services of the loaned individual pertains.

/s/ K. D. Nichols
K. D. NICHOLS,
Colonel, Corps of Engineers,
District Engineer.

(END)

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CONSENT AND WAIVER

The foregoing Memorandum Agreement of _____ is hereby consented to and approved this _____ day of _____ and the undersigned hereby waives any rights it may have under any agreement with said _____ and agrees that it will not disclose any information obtained as a result of the work of said _____ to any person without the written consent of the Contracting Officer of the United States Corps of Engineers, Manhattan District, War Department, or its authorized representative.

Corporation

By _____
Its

Corporate Seal

Attest

Secretary

Submit one copy of each completed Memorandum Patent Agreement and each Consent and Waiver Agreement to the Patent Advisor at the address given above. Retain one copy for your files.

Any changes in the Memorandum Patent Agreement or in the Consent and Waiver shall be referred to the Patent Advisor prior to execution.

MEMORANDUM AGREEMENT

WHEREAS the undersigned has heretofore executed an (Employee Patent Agreement), (Patent Agreement), or (Substitute whatever is applicable) with the _____, the undersigned hereby agrees in consideration of research data and facilities made now and hereafter available to him directly or indirectly by the United States Government in the work of the Manhattan District Project, and other good and valuable consideration, to report promptly to the United States Corps of Engineers, Manhattan District, War Department, any and all inventions and discoveries made by him that relate to or arise from the Project upon which he is or has been engaged whether said inventions and discoveries are made solely or jointly with others and further to make original records thereof available to the Government;

AND the undersigned further agrees to assign to the Government of the United States, as represented by the Director of the Office of Scientific Research and Development, Office for Emergency Management, the entire right, title, and interest in and to any and all inventions and discoveries made by him in the course of such work and to aid or assist the Government in the prosecution or defense of the right, title, and interest of the Government in any country in the world concerning the aforesaid inventions and discoveries, said assistance being, by proper arrangement, at the expense of the Government.

Witness

SPECIAL

GENERAL ELECTRIC CLAUSE

It is understood and agreed that whenever any patentable discovery or invention is made by the Contractor or its employees in the course of the work called for in this contract, which either controls or is of importance to the process of the project or the disclosure of which in an application for patent involves a disclosure of such process, the Contracting Officer or his duly authorized representative shall have the sole power to determine whether or not an application will be filed and to determine the disposition of the title to and the rights under any such application or patent that may result; provided, however, that the costs, fees, taxes and other expenses of taking out and maintaining patents for such discoveries or inventions shall be paid by the Government or the Contractor in accordance with the determination of the Contracting Officer as to the disposition of the titles thereto; provided, however, that the Contractor or its nominee in any event, shall retain at least a non-exclusive, irrevocable, royalty-free license, and the right to grant sub-licenses and receive and retain royalties thereunder under said discovery, invention, application or patent, limited to the manufacture, use and sale for purposes for which the apparatus manufactured by the Contractor under this contract is now intended for use by the Government; but as to any other patentable discovery or invention made by the Contractor or its employees in the course of the work called for in this contract, the Contractor or its nominee shall have the title to and the rights under any application or patent that may result, provided, however, that the Government shall have a non-exclusive, irrevocable, non-transferrable and royalty-free license thereunder to make, and have made for use for military, naval and national defense purposes and for the purposes for which the apparatus manufactured by the Contractor under this contract is now intended for use by the Government.

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ARMY SERVICE FORCES
United States Engineer Office
Manhattan District
Oak Ridge, Tennessee

EIDMG-25

12 June 1944

DISTRICT CIRCULAR LETTER (Legal 44-5)

Subject: Clearance of Contracts with regard to Patent Provisions.

To: All Area Engineers and all Contracting Officers and Representatives of Contracting Officers on Contracts containing Patent Assignment Provisions.

1. In order that the interest of the Government on patent matters may be fully protected and that final payment to the Contractor be made as expeditiously as possible, the following information is furnished for the guidance of Area Engineers, Contracting Officers, Representatives of Contracting Officers and Contractors.

2. Upon completion or termination of the work under a contract, notice thereof shall be forwarded immediately by the Area Engineer, Contracting Officer, or duly authorized representative of the Contracting Officer, (hereinafter referred to as "Government Representative") to Captain Robert A. Lavender, USN (ret), Advisor on Patent Matters, 1630 P. Street, NW, Washington, D.C., together with a request for patent clearance of the involved contract.

3. The Government Representatives are directed to advise the contractors that in order to secure patent clearance it will be necessary for the contractors to make the statements and certificates and take such other action as is required by Items (a) through (e), all of which are subject to the final approval of the Advisor on Patent Matters.

- (a) The notebooks kept during the performance of the work under the contract are to be examined by a qualified Representative of the Contractor who shall render a report directly to the Advisor on Patent Matters, certifying to the fact that the notebooks (listing the same) have been examined, and to the best of his knowledge, there are no inventions other than those already reported (such certifying report should itemize previously reported inventions by Case Number, Name of Inventor, and Title).
- (b) A statement of the official investigator under the contract or some other representative of the contractor is to be rendered to the Advisor on Patent

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~~CONFIDENTIAL~~

DISTRICT CIRCULAR LETTER (Legal 44-5)--(Cont'd)

Matters stating the present custody of the notebooks and that the same will be submitted to the Advisor on Patent Matters, upon request, subject of course to their use in additional research work under other Project contracts.

- (c) A certificate by a qualified Representative of the Contractor is to be furnished to the Advisor on Patent Matters certifying to the examination of the reports rendered under the contract (listing such reports) and certifying that, to the best of his knowledge, there are no inventions other than those reported under Item (a). If any reports listed in such certificate have not been transmitted to the Government Representative or to the Advisor on Patent Matters, the certificate should include a statement that such reports will be transmitted upon request to the Government Representative or the Advisor on Patent Matters.
- (d) All discoveries and inventions are to be reported, in the form of Records of Inventions and Disclosures, to the Advisor on Patent Matters by the Contractor unless other arrangements are made with the Advisor on Patent Matters for the reporting of inventions through the Local Patent Groups. If applications for patents are authorized by the Advisor on Patent Matters, applications will be prepared by Representatives of the Advisor on Patent Matters unless other arrangements are made with the Advisor on Patent Matters. Prior to patent clearance duly executed patent applications shall have been received by the Advisor on Patent Matters together with instruments transferring rights or title to inventions that conform to the determination made in accordance with the provisions of the involved contract.
- (e) If any subcontracts containing any patent assignment provisions are involved under prime contracts, certificates and statements as required by Items (a) (b) (c) for prime contracts, are to be furnished, and the provisions of Item (d) as to inventions, reports, disclosures, applications, and instruments, transferring rights or title are to be complied with, by the prime contractor on behalf of the subcontractor, unless the subcontractor shall have arranged to furnish the same directly to the Advisor on Patent Matters by arrangement with the Contractor and the Advisor

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DISTRICT CIRCULAR LETTER (Legal 44-5)--(Cont'd)

on Patent Matters, prior to the patent clearance
of the prime contract.

4. In localities where Local Patent Groups have been established for the handling of patent matters such Groups will assist contractors in reporting inventions and preparing necessary reports for the patent clearance of contracts pursuant to instructions of the Advisor on Patent Matters. Government Representatives are directed to request the Contractors to furnish Records of Inventions and Disclosures during the performance of the contract to the Advisor on Patent Matters, or, where Local Patent Groups are handling the designated patent matters, to the Local Patent Group. If contractors are particularly desirous of securing patent clearance at an early date after completion or termination of the involved contract the submission of interim reports as to notebooks and reports will greatly facilitate the disposition of patent matters.

5. Reimbursement under vouchers covering final payment under the applicable contracts will be withheld by the Government pending receipt of the written notice of patent clearance of the contract from the Advisor on Patent Matters. The Advisor on Patent Matters will transmit, in duplicate, written notice of patent clearance to the Government Representative for the transmittal of the original thereof with the final voucher to the office of the District Engineer.

6. Inquiries with respect to patent matters or any request for modification of the procedure hereinabove set forth to meet special circumstances should be directed to the Advisor on Patent Matters.

K. D. NICHOLS
Colonel, Corps of Engineers
District Engineer

~~SECRET~~

MANHATTAN DISTRICT HISTORY

BOOK I - GENERAL

VOLUME 13 - PATENTS

APPENDIX "B"

Patent Division - Manual of Office Organization and Procedure

NOTE: This Manual is available for consultation at the Office of the Advisor on Patent Matters, Manhattan District, Captain Robert A. Lavender, USN (Ret.), 1530 P Street NW, Washington, D. C.

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