

CHAPTER 3

UNIFORM PATENT POLICY

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SUBCHAPTER 1. GENERAL PROVISIONS

Authority

Unless otherwise expressly noted, all provisions of this subchapter were adopted pursuant to authority of N.J.S.A. 27:1A-1 et seq. and were filed and became effective June 11, 1975, as R.1975 d.160. See: 7 N.J.R. 345(b).

16:3-1.1 Definitions

The following words and terms, when used in this subchapter, shall have the following meanings unless the context clearly indicates otherwise.

“Department” means the Department of Transportation of the State of New Jersey.

“Employee” means all personnel of the Department of Transportation including, but not limited to, members of the classified and unclassified civil service, appointed personnel and consultants as defined in N.J.A.C. 16:2-1.1.

“Government” means the Government of the State of New Jersey.

“Invention” means any art, machine, manufacture, design or composition of matter, or any new or useful improvement thereto, or any variety of plant, which is or may be patentable under the laws of the United States.

“Other governments” mean the governments of the other 49 states and their subdivisions, the Government of the United States of America and its agencies, and the Government of Canada, its subdivisions and agencies.

“Patent” means patents obtained in both the United States and Canada.

16:3-1.2 Departmental findings

The department is cognizant of the fact that inventive advances in scientific and technological fields frequently result from governmental activities carried on by government employees. It is also evident that the broad range of department activities and the department's expanding re-

sponsibilities will increase the likelihood of inventions being made by department employees. Additionally, large sums of public money are being spent on such activities. All these factors dictate that inventions which result from departmental activities should be public resources available not only to the government and people of the State of New Jersey but also to other governments. The department further finds that under appropriate circumstances the rights of department employees in their inventions should be recognized.

16:3-1.3 Purpose

This regulation establishes a uniform patent policy for all employees of the department presently employed or who will be employed in the future. It represents a term and condition of their employment.

16:3-1.4 Policy

(a) The following basic policy is established for the department with respect to inventions hereafter made by any department employee.

1. The State of New Jersey shall obtain by assignment the entire right, title and interest in and to all inventions made by any department employee:

- i. During working hours; or
- ii. With a contribution of government facilities, equipment, materials, funds or information, or of time or services of other government employees on official duty; or
- iii. Which bear a direct relation to or are made in consequence of the official duties of the inventor.

2. In any case where the contribution of the State of New Jersey, as measured by any one or more of the criteria set forth in paragraph 1 of this subsection, to the invention is insufficient equitably to justify a requirement of assignment to the State of New Jersey of the entire right, title and interest to such invention, or in any case where the State of New Jersey has insufficient interest in an invention to obtain the entire right, title and interest therein (although the State of New Jersey could obtain such right, title and interest under paragraph 1 of this subsection), the department, acting on behalf of the State of New Jersey, upon a determination to this effect by the commissioner, shall leave title to such invention in the employee, subject, however, to the reservation to the State of New Jersey of a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes (including those of other governments), such reservation, and the terms thereof, to appear, where practicable, in any patent, domestic or foreign, which may issue on such invention.

3. In applying the provisions of paragraphs 1 and 2 of this subsection, to the facts and circumstances relating to the making of any particular invention, it shall be presumed that an invention made by an employee who is employed or assigned to invent or improve or perfect any art, machine, manufacture or composition of matter to conduct or perform research, development work, or both, to supervise, direct, coordinate or review government financed or conducted research, development work, or both, or to act in a liaison capacity among governmental or nongovernmental agencies or individuals engaged in such work, or made by an employee falls within the provisions of paragraph 1 of this subsection, and it shall be presumed that any invention made by any other employee falls within the provisions of paragraph 2 of this subsection. Either presumption may be rebutted by the facts or circumstances attendant upon the conditions under which any particular invention is made and, notwithstanding the foregoing, shall not preclude a determination that the invention falls within the provisions of paragraph 4 of this subsection.

4. In any case wherein the government neither pursuant to the provisions of paragraph 1, obtains entire right, title and interest in and to an invention nor pursuant the provisions of paragraph 2, reserves a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, the government shall leave the entire right, title and interest in and to the invention in the government employee, subject to law.

5. Actions taken, and rights acquired, under the foregoing provisions of this section, shall be reported to the Secretary of State in accordance with procedures established by him.

16:3-1.5 Procedure

(a) The following basic policy is established to provide a procedure for the filing of patent applications, the assignments of patents to the State of New Jersey, the dedication of patents so assigned to the public and the dissemination of information on such patents to other State agencies, other governments and the public.

1. When an invention is made under circumstances defined in section 4(a) of this subchapter giving the State of New Jersey the right to title thereto:

i. The department shall either prepare and file, or cause to be prepared and filed, an applicant for patent therefore in the United States Patent Office. Said application shall be made in the name of the inventor in accordance with the patent laws of the United States.

ii. Together with the application, the department shall file an assignment prepared by a deputy attorney general and executed by the inventor assigning all of his rights, title and interest in said invention to the State of New Jersey.

iii. The commissioner, in his discretion, may dedicate the patent so assigned to the public. Such dedication shall be executed by the Secretary of State.

2. When an invention is made under circumstances defined in section 4(b) of this subchapter, the patent application and patent shall note thereon the reservation of rights by the State of New Jersey.

3. All costs of application and filing for inventions under paragraph 1 of this subsection shall be borne by the department; however, the costs of application and filing for inventions under paragraph 2 of this subsection may be borne by the department to the extent, if any, the commissioner, in his discretion, deems advisable, based on the value of the reservation to the department and the State of New Jersey.

4. The commissioner shall insure that all agencies of the State of New Jersey and that other governments which are interested in, or may have an interest in, all inventions or rights therein, including licenses, owned or controlled by the State of New Jersey, are advised of the nature of the invention and of the rights and interests of the State of New Jersey therein.