



A Procurement Technical
Assistance Center (PTAC)

INTELLECTUAL PROPERTY FOR GOVERNMENT CONTRACTORS AND SUBCONTRACTORS ACQUISITION HOUR WEBINAR

February 12, 2019



WEBINAR ETIQUETTE

PLEASE

- Log into the GoToMeeting session with the name that you registered with online
- Place your phone or computer on MUTE
- Use the CHAT option to ask your question(s). We will share the questions with our guest speaker who will respond to the group

THANK YOU!

ABOUT WPI SUPPORTING THE MISSION

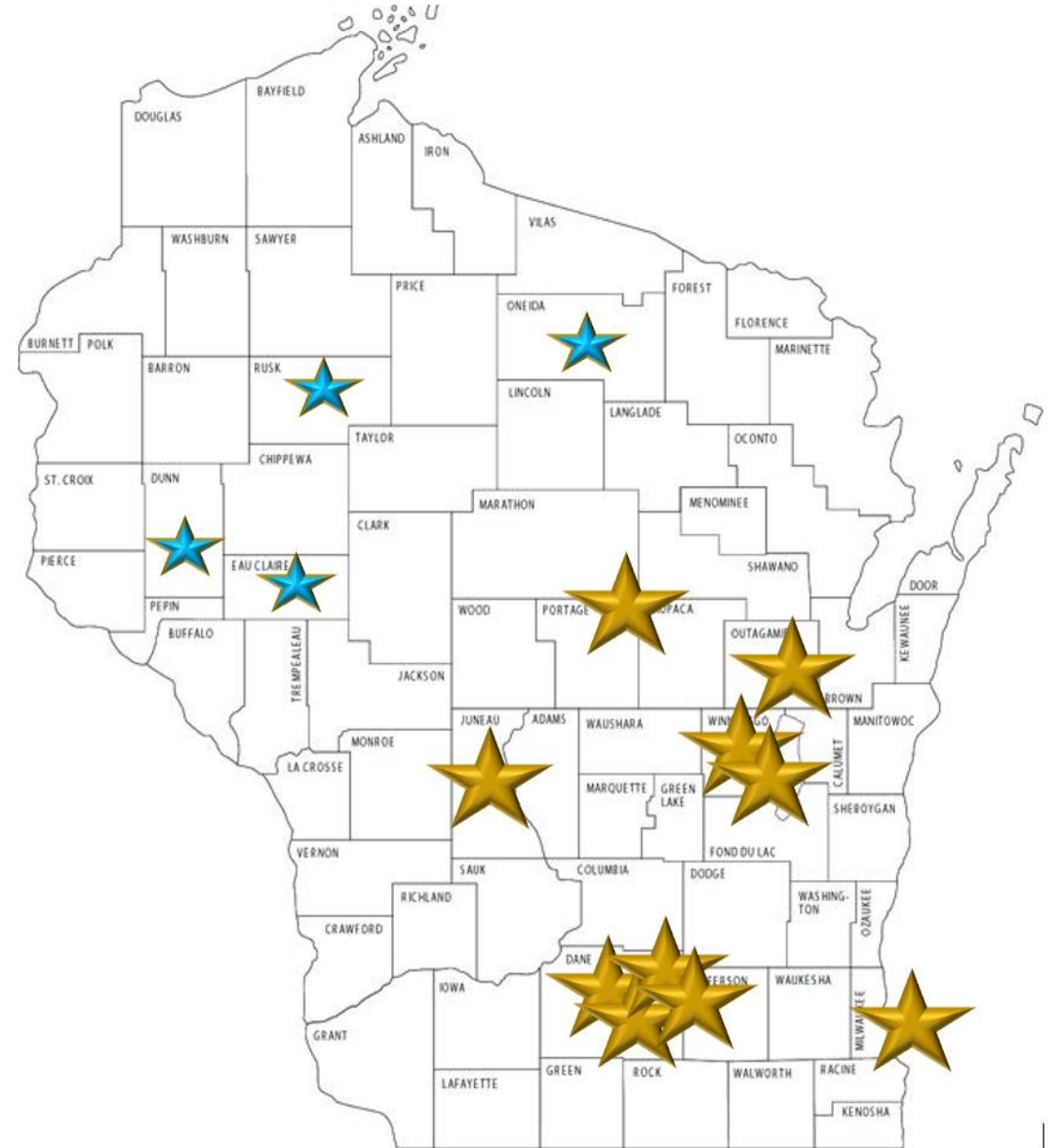
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Assist businesses in creating,
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state and local government contracts.

*WPI is a Procurement Technical Assistance Center (PTAC) funded in part by
the Defense Logistics Agency (DLA), WEDC and other funding sources.*

WPI OFFICE LOCATIONS

- MILWAUKEE – *Technology Innovation Center*
- MADISON –
 - *FEED Kitchens*
 - *Dane County Latino Chamber of Commerce*
 - *Wisconsin Manufacturing Extension Partnership (WMEP)*
 - *Madison Area Technical College (MATC)*
- CAMP DOUGLAS – *Juneau County Economic Development Corporation (JCEDC)*
- STEVENS POINT – *IDEA Center*
- APPLETON – *Fox Valley Technical College*
- OSHKOSH –
 - *Fox Valley Technical College*
 - *Greater Oshkosh Economic Development Corporation*
- EAU CLAIRE – *Western Dairyland*
- MENOMONIE – *Dunn County Economic Development Corporation*
- LADYSMITH – *Indianhead Community Action Agency*
- RHINELANDER – *Nicolet Area Technical College*



CURRENT EDITION OF THE WPI NEWSLETTER

www.wispro.org



UPCOMING EVENTS

- TUE 12** **Acquisition Hour: Intellectual Property for Government Contractors and Subcontractors**
February 12 @ 1:00 pm - 2:00 pm

- TUE 12** **WPI and NCMA Wisconsin Chapter CFCM Study Session One – Webinar**
February 12 @ 6:00 pm - 7:30 pm

- WED 13** **Acquisition Hour: Overview of CPARS**
February 13 @ 12:00 pm - 1:00 pm

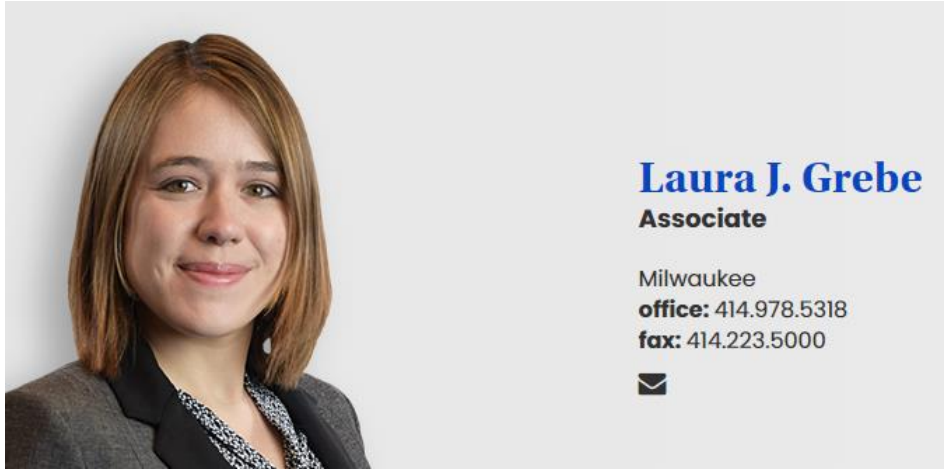
- TUE 19** **WPI and NCMA Wisconsin Chapter CFCM Session 2: FAR Parts 1-9 – Webinar**
February 19 @ 6:00 pm - 7:30 pm

[View More...](#)

CURRENT OPPORTUNITIES (6)

SERVICES OFFERED BY WPI

- FREE Bid Matching Services
- Individual Counseling and Assistance
- Locating Local, State and Federal Opportunities
- Government Market Strategy Development
- Training in use of Government websites and tools
- Assistance with System for Award Management (SAM) Registration
- Assisting in Market Research Process
- Development of Market Profile
- Small Business Subcontracting Plans Development, Outreach and Reporting
- Small Group Training
- Outreach and training with Local, State and Federal agencies
- Assist with Pre and Post Award Functions
- Assistance with Agency Specific Contracting Requirements
- Assistance with Contracting Regulations and Requirements, including FAR, DFAR, CFR
- Assistance with GSA Schedule Preparation and Administration
- Assistance with Local, State and Federal Certifications, including:
 - Service Disabled & Veteran Owned Small Business, HUBZone, Woman Owned Small Business, 8(a) Business Development Program
 - State
 - Local
 - DBE
- Bid review and Submission Assistance
- Proposal review and Submission Assistance
- Capabilities Statement and Related Government Marketing Material Development
- Assistance in Locating and Developing Teaming Partners and Subcontractors
- Updated Government Market Information



Laura works with clients to secure protection for intellectual property assets.

While her practice focuses primarily on patent prosecution, Laura also assists clients in securing and defending trademarks and copyrights.

In addition to patent prosecution, Laura has experience managing large domestic and international trademark portfolios, conducting and reviewing trademark searches to evaluate registration opportunities and issues of infringement, preparing and prosecuting trademark applications before the USPTO and representing clients in trademark opposition and cancellation proceedings. Laura also evaluates copyright matters and counsels clients in protecting copyrightable assets.

Prior to her time at Husch Blackwell, Laura prepared and prosecuted patent applications on behalf of NASA, the Naval Undersea Warfare Center (NUWC), Naval Surface Warfare Center Dahlgren Division (NSWCDD) and National Institute of Standards and Technology (NIST). Laura also worked with the U.S. Army Corps of Engineers in managing their international trademark portfolio. She has counseled the Securities Exchange Commission (SEC) with respect to various trademark registrations and assisted the SEC in updating their trademark licensing policies and managing their licenses with third parties.



HUSCH BLACKWELL

Intellectual Property for Government Contractors and Subcontractors

Wisconsin Procurement Institute Acquisition Hour
February 12, 2019

Presented by
Laura Grebe | Husch Blackwell LLP

Overview

- What is “intellectual property?”
 - Legal framework
 - Contracting framework
- How are intellectual property rights allocated when contracting with the government?
- What are some intellectual property concerns when participating in SBIR/STTR programs?

Intellectual Property

- Intangible products of the human mind
 - Examples: inventions, ideas, writings, drawings, music, brand names, industrial secrets, customer lists, processes, configurations, formulas, identifying phrases, etc.
- Group of legal rights which provide protection over things people create

Intellectual Property

- Patent – inventions
- Trademark – designators of origin
- Copyright – artistic creations
- Trade Secret – anything which derives value from being secret

What is a patent?

“Whoever invents or discovers any **new** and **useful** process, machine, manufacture, or composition of matter, or any new and useful **improvement thereof**, may obtain a patent therefore, subject to the conditions and requirements of this title.” 35 USC § 101

What is a patent?

- Utility (provisional or non-provisional)
 - Protect how something is built, how something works, and otherwise functional aspects of an invention
 - Term of 20 years from earliest filing date
- Design
 - Protect the design or non-functional aspects of an invention
 - Term of 15 years from grant
- Plant
 - Protects...plants....
 - Term of 20 years from earliest filing

Who owns a patent?

- Inventors are default owners
 - Can be more than one owner
 - Each is an equal co-owner with same rights
- Agreements can change default ownership

What is a trademark?

The term “trademark” includes **any word, name, symbol, or device, or any combination thereof**—(1) **used** by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, **to identify and distinguish his or her goods**, including a unique product, from those manufactured or sold by others **and to indicate the source of the goods**, even if that source is unknown. 15 U.S. Code § 1127

What isn't a trademark?

- Limitations?
 - Immoral, deceptive or scandalous marks
 - Disparaging or falsely suggests a connection with a person (without consent)
 - Identifies a place other than the true place of origin
 - Falsely suggests a connection with beliefs or national symbols or otherwise brings them into contempt or disrepute
 - Consists of or comprises the flag or coat of arms or other insignia of the United States, any state or any foreign nation
 - Includes the name or portrait of a deceased U. S. president while the widow is still alive (without consent)
 - Is confusingly similar with an existing mark
 - Is functional
 - Is merely descriptive or deceptively misdescriptive of the goods being sold under the mark

Who owns a trademark?

- The user is the default owner
- Agreements may change ownership
 - Assignment agreements – but new owner needs to be the user
 - License agreements – but licensor needs to use with owner supervision

What is a copyright?

“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographed works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.” 17 USC § 102

Who owns a copyright?

- The author is the default owner
- Situations/agreements may change ownership
 - “Work made for hire”
 - Other agreements

What is a trade secret?

What is a trade secret?

A trade secret is a formula, pattern, physical device, idea, process, or complication of information which is not generally known or reasonably ascertainable, by which a business can obtain an economic advantage over competitors or its customers.

“Trade Secret” means information (e.g., formula, pattern, method, technique, etc.) that (i) derives independent economic value, actual or perceived, from not being generally known or readily ascertainable by proper means by other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of reasonable efforts to maintain its secrecy.

Who owns a trade secret?

- A little murky, but generally...
 - Employer if (1) agreement is in place, (2) the person(s) who developed the secret were hired to do so, or (3) the person(s) who developed the secret did so in the general course of employment
 - Otherwise, the individual
- Agreements can always change ownership

Intellectual Property in Government Contracting

3 main areas of IP identified by the government for purposes of contracting:

- Patentable Technology
- Technical Data/Computer Software
- Copyrightable Material

Patentable Technology

- **How do the FARS/DFARS define patentable technology?**
 - “Invention’ means any invention or discovery that is or may be patentable or otherwise protectable under title 35 of the U.S. Code, or any variety of plant that is or may be protectable under the Plant Variety Protection Act.” (FAR 27.301)
 - DFARS essentially the same

Technical Data/Computer Software

- **How do the FARs/DFARS define technical data and computer software?**
 - "'Data' means recorded information, regardless of form of the media on which it may be recorded. The term includes technical data and computer software. The term does not include information incidental to contract administration, such as financial, administrative, cost or pricing, or management information." FAR 52.227-14
 - "'Technical data' means recorded information (regardless of the form or method of the recording) of a scientific or technical nature (including computer databases and computer software documentation). This term does not include computer software or financial, administrative, cost or pricing, or management data, or other information incidental to contract administration. The term includes recorded information of a scientific or technical nature that is included in computer databases." FAR 52.227-14

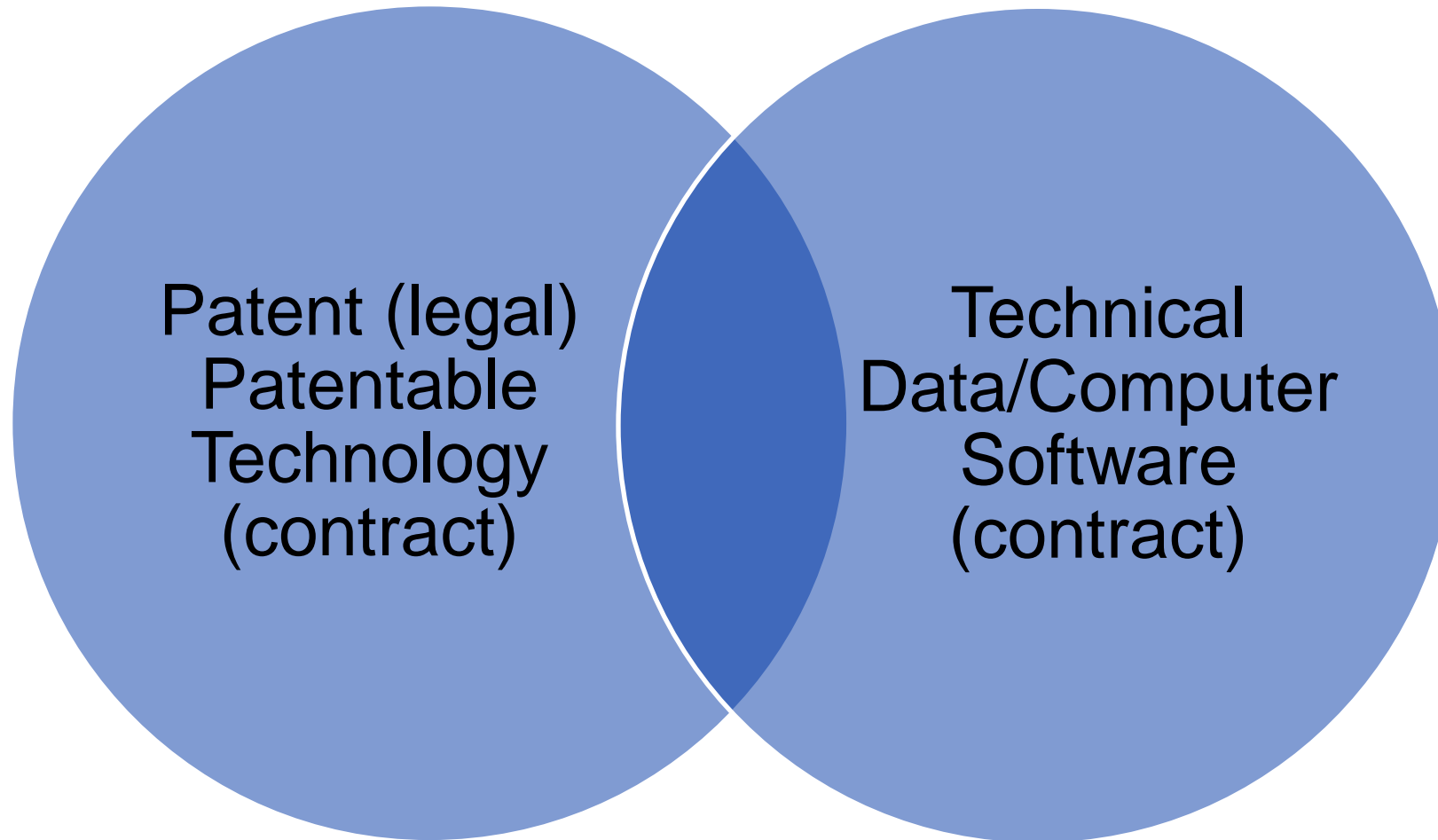
Technical Data/Computer Software

- **How do the FARs/DFARS define technical data and computer software?**
 - “Computer software’ (1) means (i) computer programs that comprise a series of instructions, rules, routines, or statements, regardless of the media in which recorded, that allow or cause a computer to perform a specific operation or series of operations; and (ii) recorded information comprising source code listing, design details, algorithms, processes, flow charts, formulas, and related material that would enable the computer program to be produced, created, or compiled. (2) Does not include computer databases or computer software documentation.”
FAR 52.227-14

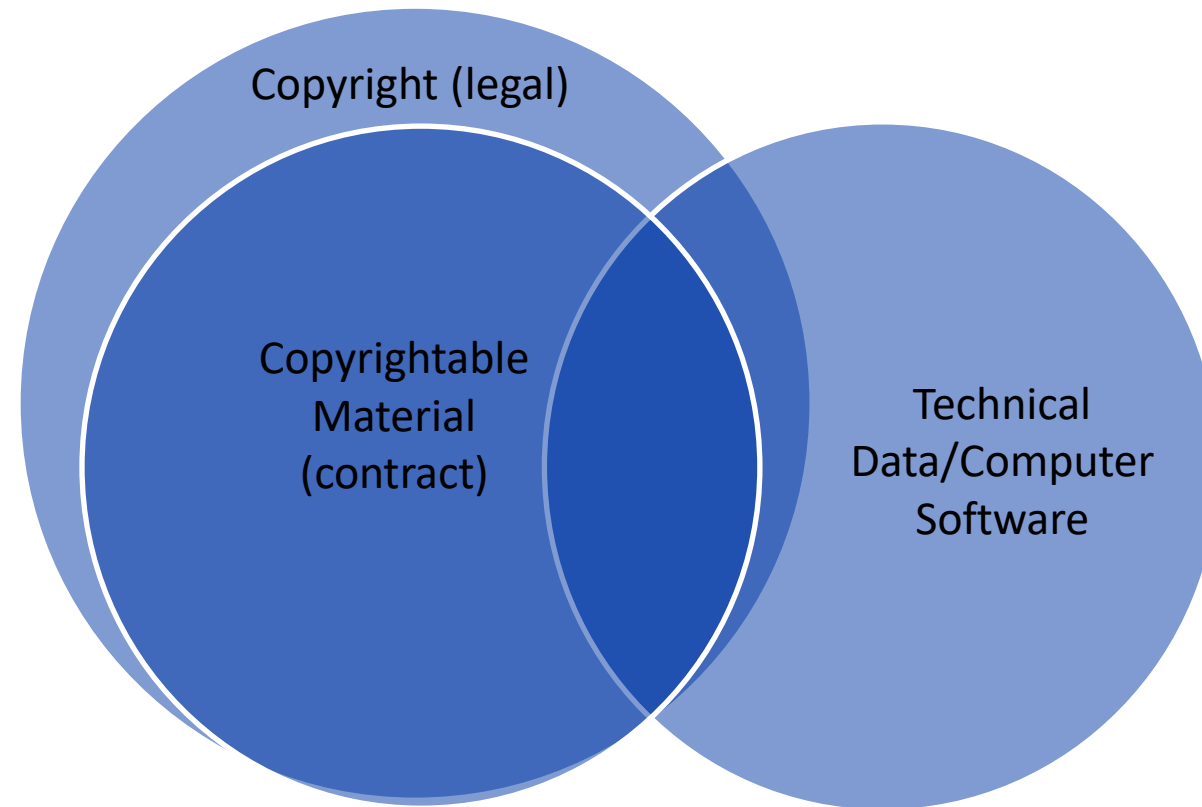
Copyrightable Material

- **How do the FARs/DFARS define copyrightable material?**
 - No true definition
 - Referred to as “Copyrighted Works”

Intellectual Property in Government Contracting



Intellectual Property – The Contracting Perspective



Patentable Technology

- **Recall:**
 - “‘Invention’ means any invention or discovery that is or may be patentable or otherwise protectable under title 35 of the U.S. Code, or any variety of plant that is or may be protectable under the Plant Variety Protection Act.” (FAR 27.301)
- **Rights Allocation (Generally)**
 - Contractor retains ownership
 - Government may get a license

Patentable Technology

- **Rights Allocation (Less Generally)**
 - Government license applies to inventions *conceived or first reduced to practice in performance of the contract* (“government use rights”)
 - typically developed with federal funding
 - contract may be for the development of a certain technology/technological solution
 - Government can obtain ownership or require contractor to license to third parties (“march-in rights”)
 - only when contractor elects to not retain title, fails to pursue patent protection, etc.

Patentable Technology

- **What does a contractor have to do to keep title?**
 - Disclose invention and past/upcoming disclosures (e.g., publications, public use, sale, etc.)
 - FARS provide examples
 - Must be done within a specified time limit (circumstantial)
 - Failure to disclose may result in forfeiture of rights
 - Written notice to government of intent to maintain title
 - Must be done within specified time limit
 - File appropriate patent application (circumstantial)

Patentable Technology

- **How does the government get title?**
 - Contractor can decide not to keep title
 - Contractor doesn't follow the rules pertaining to disclosure, written notice and/or filing of application in the specified time limit
 - Government can pursue patent rights in countries not of interest to Contractor
 - Government can take over patent prosecution of Contractor decides to drop

Patentable Technology

- **Limited Situations Require Assignment to Government**
 - Foreign contractor
 - Exceptional circumstances
 - National security
 - Government-owned, contractor-operated R&D facilities

Patentable Technology

- **Be Aware of Government “March-In” Rights**

A contractor may be required to license to the government and/or permit the government to sublicense in limited situations (e.g., contractor fails to act, health/safety concerns, etc.)

Patentable Technology

- **If government gets title, what does the contractor get?**
 - Revocable, nonexclusive, royalty-free license
 - Rights to sublicense
 - Limits on transferability

Patentable Technology

- **Practical Steps for Maximizing Your Protection/Limiting Government Rights**
 - READ YOUR CONTRACT
 - Disclose invention and past/upcoming disclosures to government (e.g., publications, public use, sale, etc.)
 - Written notice to government of intent to maintain title
 - File and prosecute patent application(s)

Patentable Technology

- **Practical Steps for Maximizing Your Protection/Limiting Government Rights**
 - In performance of contract, use solutions developed before entering the contract or otherwise developed outside performance of the contract
 - Document development of inventions
 - Document funding sources

Technical Data/Computer Software

- **Recall:**
 - Technical data is recorded information of a scientific or technical nature (including computer databases and computer software documentation). Technical data is not computer software or financial, administrative, cost or pricing, or management data. FAR 52.227-14
 - Computer software refers to
 - computer programs that comprise a series of instructions, rules, routines, or statements, regardless of the media in which recorded, that allow or cause a computer to perform a specific operation or series of operations and
 - recorded information (e.g., source code listing, design details, algorithms, processes, flow charts, formulas) that enables the computer program to be produced, created, or compiles.
 - Computer software does not include computer databases or computer software documentation." FAR 52.227-14

Technical Data/Computer Software

- **How do the FARS/DFARS define technical data and computer software?**
 - Computer software documentation = user manuals, etc.
 - Computer database = collection of information capable of being stored on a computer

Technical Data/Computer Software

- **How do the FARs/DFARS define technical data and computer software?**
 - DFARS 252.227-7013 for noncommercial items
 - DFARS 252.227-7015 for commercial items
 - Definitions similar to FARs

Technical Data/Computer Software

- **Rights Allocation (Generally)**
 - Contractor retains ownership
 - Government may get a license
 - Scope of government's rights depends on
 - is the technical data/computer software “commercial” or “noncommercial”?
 - was the data/software developed with private or federal government funds?

Technical Data/Computer Software

- **Rights Allocation (Commercial Items)**
 - What is “commercial”?
 - not first produced (data) or developed (software) in performance of the contract
 - Contractor retains ownership
 - Government gets standard license rights (i.e., license rights generally granted to public) or rights as negotiated with contractor

Technical Data/Computer Software

- **Rights Allocation (Commercial Items)**
 - What is “noncommercial”?
 - first produced (data) or developed (software) in performance of the contract
 - Scope of government rights depends on level of funding
 - unlimited rights = produced/developed with 100% federal funding
 - government purpose rights = produced/developed with mixed funding
 - limited rights/restricted rights = produced/develop with 100% private funding

Technical Data/Computer Software

- **Unlimited Rights**
 - In essence, the government can do anything including license to a third party
- **Limited/Restricted Rights**
 - Essentially, government use only
 - Not disclosed outside of government
 - Contractor must mark data/software as such
- **Government purpose rights**
 - Government can use without restriction (unlimited rights)
 - Government can authorize others to use for a government purpose

Technical Data/Computer Software

- **Practical Steps for Maximizing Your Protection/Limiting Government Rights**
 - READ YOUR CONTRACT
 - Try to use commercial technical data/computer software or otherwise have the technical data/computer software identified as commercial prior to entering a contract

Technical Data/Computer Software

- **Practical Steps for Maximizing Your Protection/Limiting Government Rights**
 - Identify commercial/noncommercial items in the contract
 - Label all technical data/computer software developed with mixed funding as limited or restricted rights, as appropriate
 - Use private funding when possible
 - Document funding sources

Technical Data/Computer Software

- **Be Aware of Alternative Clauses**
 - FAR 52.227-17
 - Unlimited rights to government in data delivered and/or produced in performance of a contract
 - Contractor's use limited to performance of contract
 - Reach-back Clauses
 - Allow government to require delivery of data produced but not delivered in performance of a contract
 - Agency-specific clauses can provide further limitations

Copyrightable Material

- **Recall: no definition of “copyrightable material” in FARs/DFARS**
- **What could be copyrightable material in a government contract?**
 - Typically data and computer software
 - Articles/publications including data produced in performance of a contract
 - Other “works” can be the subject of government contracts

Copyrightable Material

- **Rights Allocation (Generally)**
 - Contractor gets rights in certain articles/ publications based on and/or containing data first produced in the performance of a contract
 - May need written consent for other works

Copyrightable Material

- **Rights Allocation (Less Generally)**
 - To keep rights, contractor must label material with copyright notice
 - Government gets license to reproduce, prepare derivative works, distribute copies to public, perform and display in public

Copyrightable Material

- **Rights Allocation (Less Generally)**
 - Contract may include “special works” clauses
 - e.g., contracts for production/compilation of data for government’s internal use or instances when limited distribution of the material is necessary
 - e.g., histories of agencies, investigatory reports, etc.
 - Government gets unlimited rights

Copyrightable Material

- **What about data *not* first produced under the contract?**
 - Contractor prohibited from incorporating such data with data first produced under the contract unless
 - Data is identified as such
 - Contractor grants the government a license of appropriate scope (varies – can be governed by FARS/DFARS or negotiated in a collateral agreement)

Copyrightable Material

- **Practical Steps for Maximizing Your Protection/Limiting Government Rights**
 - READ YOUR CONTRACT
 - Keep records of how and when material is developed

Intellectual Property and SBIR/STTR Programs

- **Third-Party Intellectual Property**
 - Do you need third-party IP?
 - License in place
 - Third party has filed a patent application
 - Have you reviewed the competition?
 - Freedom to operate established

Intellectual Property and SBIR/STTR Programs

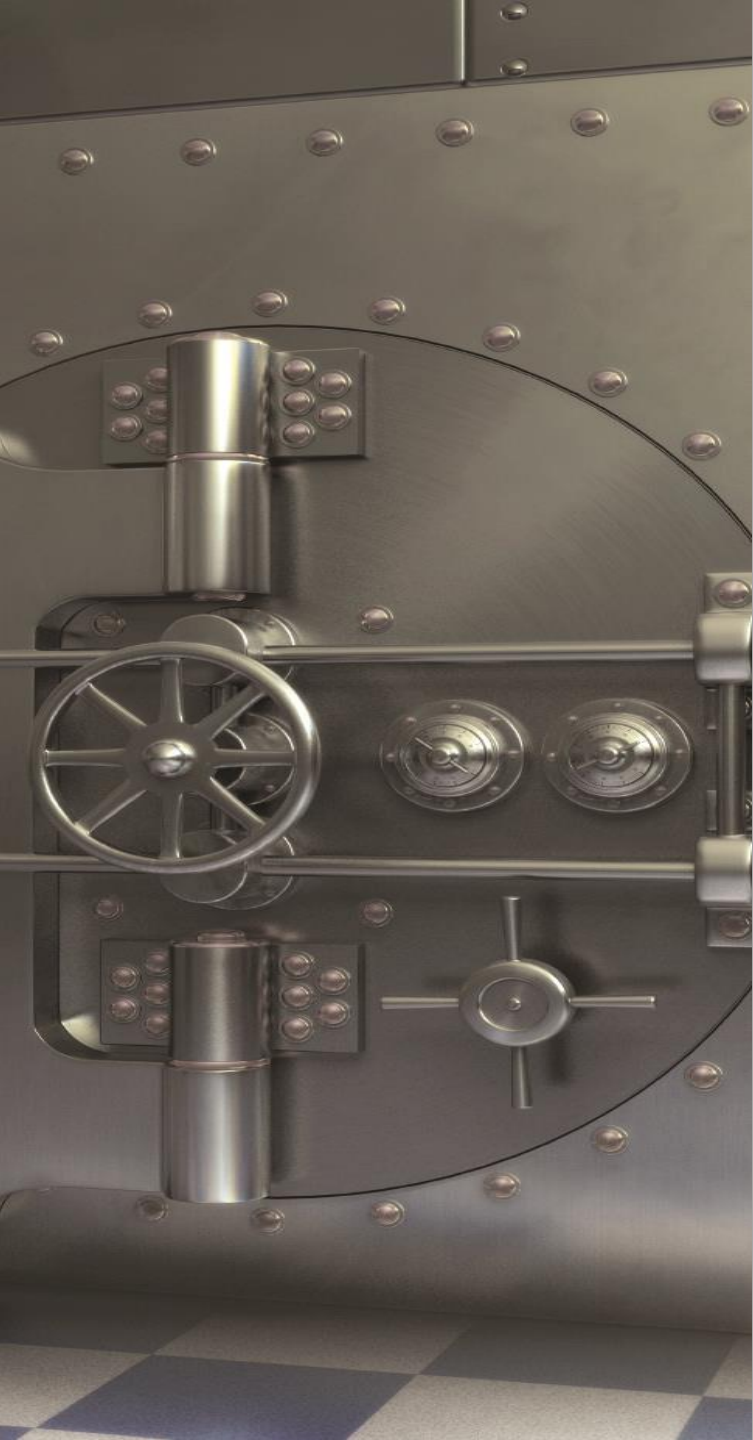
- Data Rights are generally the issue
 - RECALL, government gets unlimited rights in technical data and computer software developed under other non-SBIR/STTR programs
 - Technical data or computer software (1) developed with government money

Intellectual Property and SBIR/STTR Programs

- Data Rights are generally the issue
 - Government gets certain limited rights in technical data and computer software generated and delivered under these contracts
 - Restricted rights for computer software
 - Limited rights for technical data
 - Data is protected from disclosure by the agencies for not less than 4 years from the “last deliverable”

IP and the SBIR/STTR Programs

- “Subject Invention” = Patentable Technology
 - Must disclose the invention within 2 months of discovery
 - Must elect to retain title within 2 years of disclosure (assuming no outside disclosure)
 - Must apply for a patent (and continue to pursue)



THANK YOU!



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HUSCH BLACKWELL

UPCOMING TRAINING - EVENTS

ACQUISITION HOUR LIVE WEBINAR SERIES

- February 13, 2019 – **Overview of CPARS** – [CLICK HERE](#) for additional information – presented by Carol Murphy, Wisconsin Procurement Institute (WPI)
- February 26, 2019 – **Understanding Your Obligations When Quoting and Receiving Awards from Defense Logistics Agency (DLA) DIBBS** – [CLICK HERE](#) for additional information – presented by Jean Polka, Wisconsin Procurement Institute (WPI)
- February 27, 2019 – **Information Management for Federal Contractors** – [CLICK HERE](#) for additional information – presented by Marc Violante, Wisconsin Procurement Institute (WPI)
- March 12, 2019 – **Growing Your Small Business With the Disadvantaged Business Enterprise (DBE) Program** – [CLICK HERE](#) for additional information – presented by Benjamin Blanc, Wisconsin Procurement Institute (WPI)
- March 13, 2019 – **Preparing for a CPSR Audit** – [CLICK HERE](#) for additional information – presented by Mark Dennis, Wisconsin Procurement Institute (WPI)
- March 27, 2019 – **Doing Business With the United Nations** – [CLICK HERE](#) for additional information – presented by Carmela Mammias, Director, U.S. Commercial Service and Dmitri G. Dovgopoly, Director, UN Headquarter Procurement Division
- April 30, 2019 – **Update on the Hour Wage Labor Law** – [CLICK HERE](#) for additional information – presented by Corey Walton, Community Outreach and Resource Planning Specialist – U.S. Department of Labor/Wage & Hour Division

NCMA Wisconsin Chapter / WPI Federal Acquisition Regulations (FAR) Training Webinars

6:00 – 7:30 pm

- February 12, 2019 – **Session 1: Introduction – CFCM Requirements and Basics of Federal Government Contracting**
- February 19, 2019 – **Session 2: FAR Parts 1-9**
- February 26, 2019 – **Session 3: FAR Parts 16-18; 10-12**
- March 5, 2019 – **Session 4: FAR Parts 13-15**
- March 12, 2019 – **Session 5: FAR Parts 1-18 – Practice Test Review**
- March 19, 2019 – **Session 6: FAR Parts 19-29**
- March 26, 2019 – **Session 7: FAR Parts 30-33**
- April 2, 2019 – **Session 8: FAR Parts 34-41**
- April 9, 2019 – **Session 9: FAR Parts 42-53**
- April 16, 2019 – **Session 10: FAR Parts 1-51 – Practice Test Review**

<https://www.wispro.org/wp-content/uploads/2019/01/FAR-Training-Schedule-2019-1.pdf>



QUESTIONS?

SURVEY



CONTINUING PROFESSIONAL EDUCATION



CPE Certificate available, please contact:

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