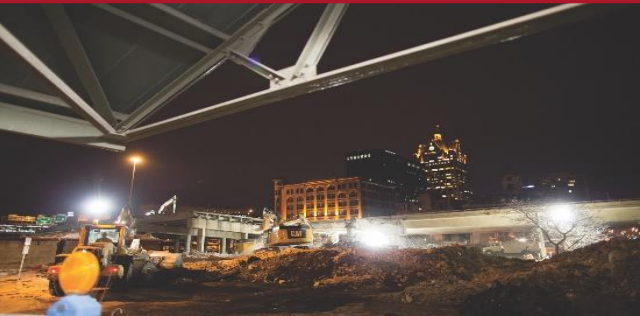


INTELLECTUAL PROPERTY FOR GOVERNMENT CONTRACTORS & SUBCONTRACTORS & THE STTR/SBIR STAKEHOLDER

Acquisition Hour Webinar

June 16, 2020



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!

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serving Wisconsin Business!**



Assist businesses in creating, developing and growing their sales, revenue and jobs through Federal, State and Local Government contracts.

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Last year WPI provided training at over 100 events and provided service to over 1,200 companies

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▪ MADISON

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- *Wisconsin Manufacturing Extension Partnership (WMEP)*
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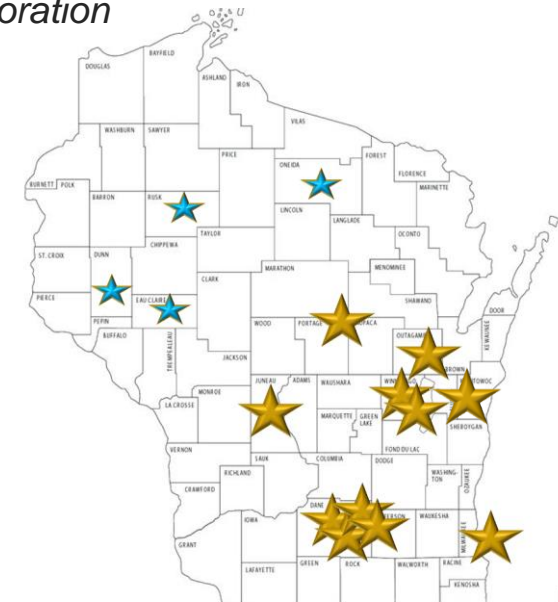
- *Indianhead Community Action Agency*

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UPCOMING EVENTS

- WED 21** Acquisition Hour: Government Property Management for Federal Contractors and Subcontractors
August 21 @ 12:00 pm - 1:00 pm
- THU 22** Advancing Cybersecurity in the Industry, Energy, Water Nexus – Oshkosh, WI
August 22 @ 9:00 am - 3:00 pm
Oshkosh WI
- THU 22** NDIA Great Lakes Chapter 10th Anniversary – Milwaukee, WI
August 22 @ 12:30 pm - 7:30 pm
Brookfield Wisconsin
- SEP 11** Acquisition Hour: The End of the Fiscal Year is Here – What is Hot and What is Not
September 11 @ 12:00 pm - 1:00 pm

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CURRENT OPPORTUNITIES (1)

GET STARTED WITH THE BASICS

Questions & answers on how to get started.

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HAVE A QUESTION? WE'RE HERE TO HELP.

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LAURA J. GREBE

Partner; Husch Blackwell

A registered patent attorney, Laura conducts and reviews patentability and freedom to operate searches, and prepares and prosecutes patent applications, both domestic and international, in a number of complicated technologies across industries. Laura also counsels clients and coordinates with foreign counsel on European oppositions in a variety of technological fields.

In addition to patent prosecution, Laura manages 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 U.S. Patent and Trademark Office (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 the National Aeronautics and Space Administration (NASA), 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

Education

J.D., Marquette University Law School

B.S., Marquette University



HUSCH BLACKWELL

**Intellectual Property for
Government Contractors
and Subcontractors and the
STTR/SBIR Stakeholder**

Wisconsin Procurement Institute Acquisition Hour
June 16, 2020

Presented by
Laura Grebe | Husch Blackwell LLP

Overview

- What is “intellectual property?”
- How are intellectual property rights allocated when contracting with the government?
- How are intellectual property right allocations different under STTR/SBIR 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 are the types of patents?

- 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
 - Assignment agreements
 - Research agreements
 - Government contracts

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
 - Government contracts??
 - ...use, not ownership, is generally the issue...

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”
 - Assignment agreements
 - Government contracts

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
- Ceases to exist once the secret is leaked

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

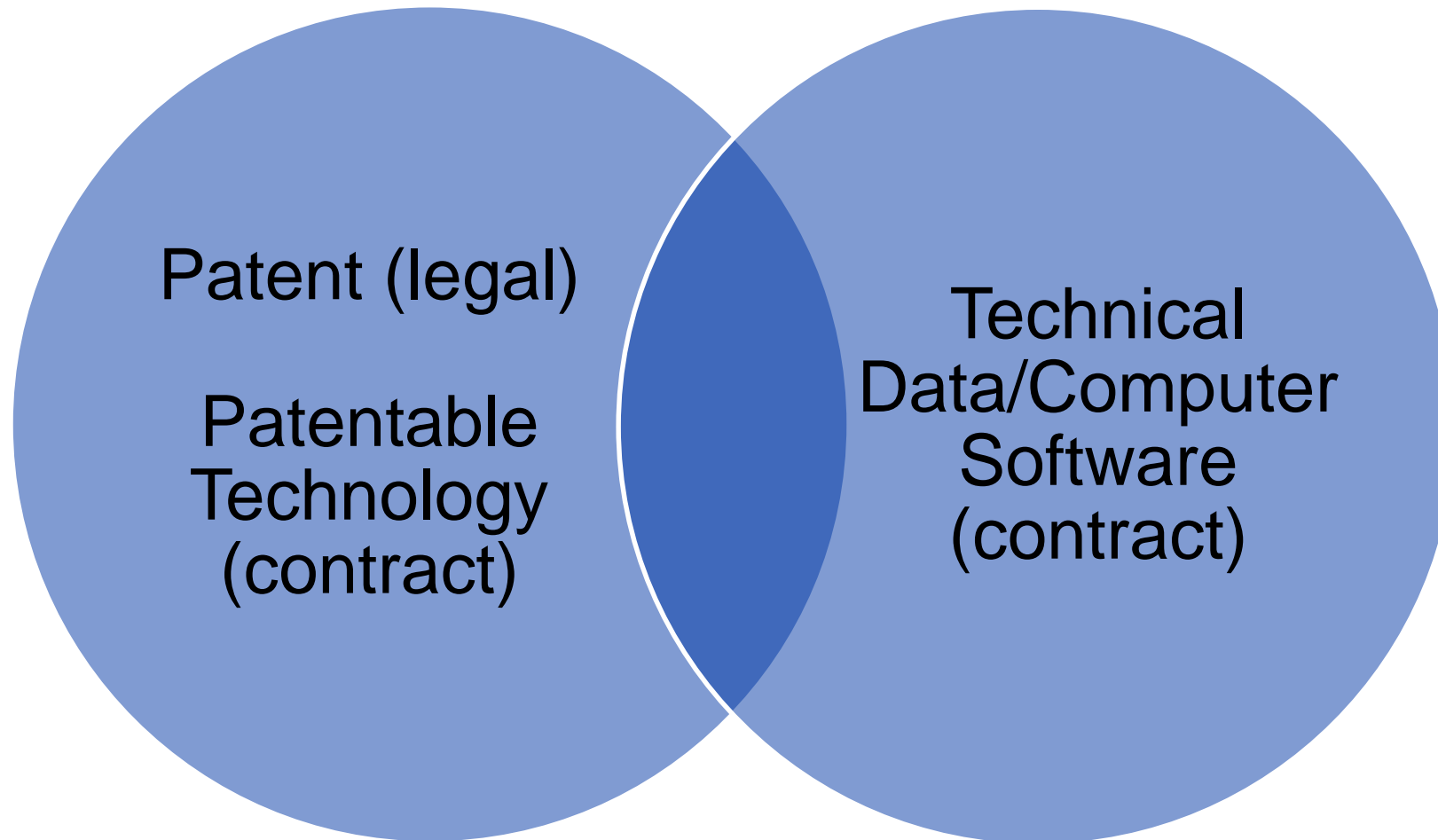
Technical Data/Computer Software

- **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

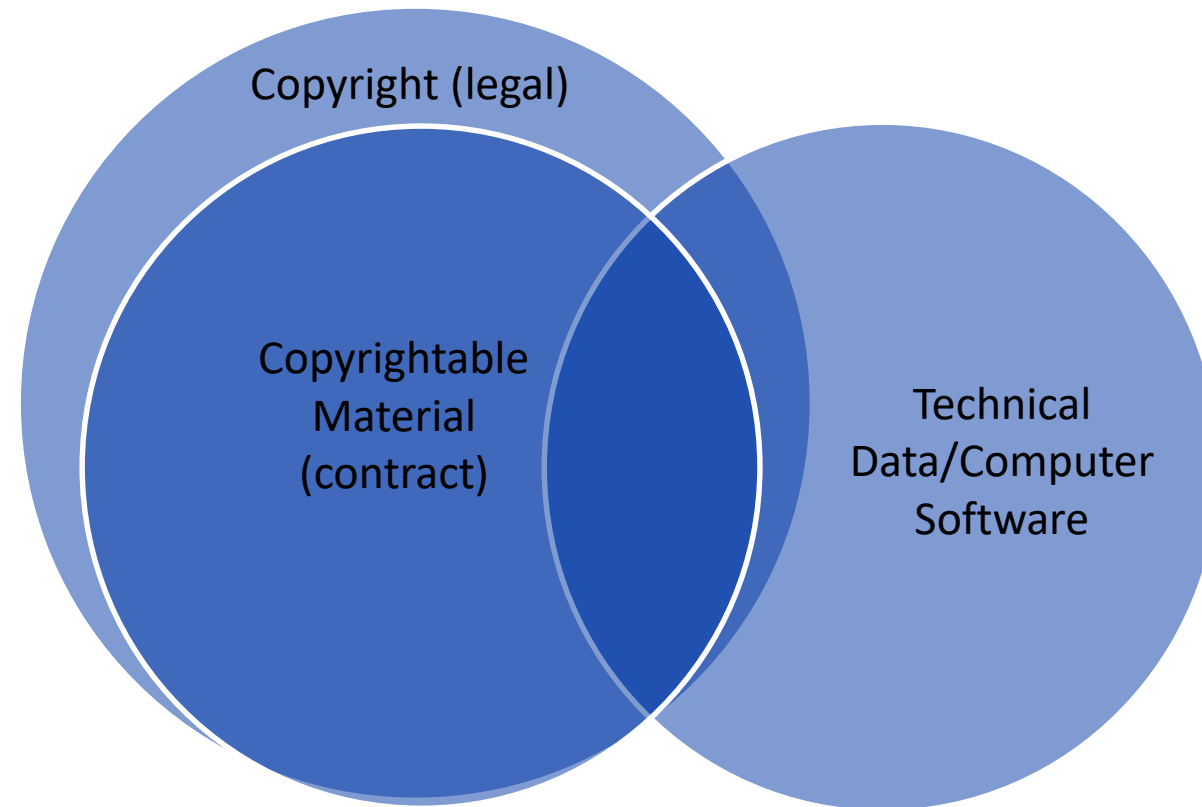
Copyrightable Material

- **How do the FARs/DFARS define copyrightable material?**
 - No true definition
 - Referred to as “Copyrighted Works”
 - Usually discussed in the context of data and expression of data.
 - Copyrightable material made before/outside contract
 - Copyrightable material produced during performance of a contract

Intellectual Property in Government Contracting



Intellectual Property – The Contracting Perspective



Patentable Technology

- **Recall:**
 - Patentable Technology = Invention that is or could be protected by US patent laws
- **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. Technical data is not computer software or financial, administrative, cost or pricing, or management data.
 - Computer software refers to computer programs and recorded information that enables the computer program to be produced.
 - Computer software does not include computer databases or computer software documentation.

Technical Data/Computer Software

- **A few other definitions...**
 - 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 (Noncommercial 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

- **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

STTR/SBIR IP Considerations

- STTR = Small Business Technology Transfer program
- SBIR = Small Business Innovation Research program

These programs are designed to encourage small businesses/nonprofit research institutions to conduct R&D and commercialize the results.

STTR/SBIR Technical Data

- Technical data funded by STTR/SBIR awards is protected under STTR/SBIR programs
 - Government cannot share technical data outside of the government for 4 years (FAR 52.227-20 or 5 years (DFARS 252.27-7018))
 - Protection can extend indefinitely

STTR/SBIR Technical Data

- STTR/SBIR rights for Technical Data are non-negotiable.
- Data must be marked in accordance with FAR 52.227-20 or DFARS 252.227-7018.
 - No deadline to mark
 - No recourse if disclosure took place prior to marking
- Pre-existing data is not protected

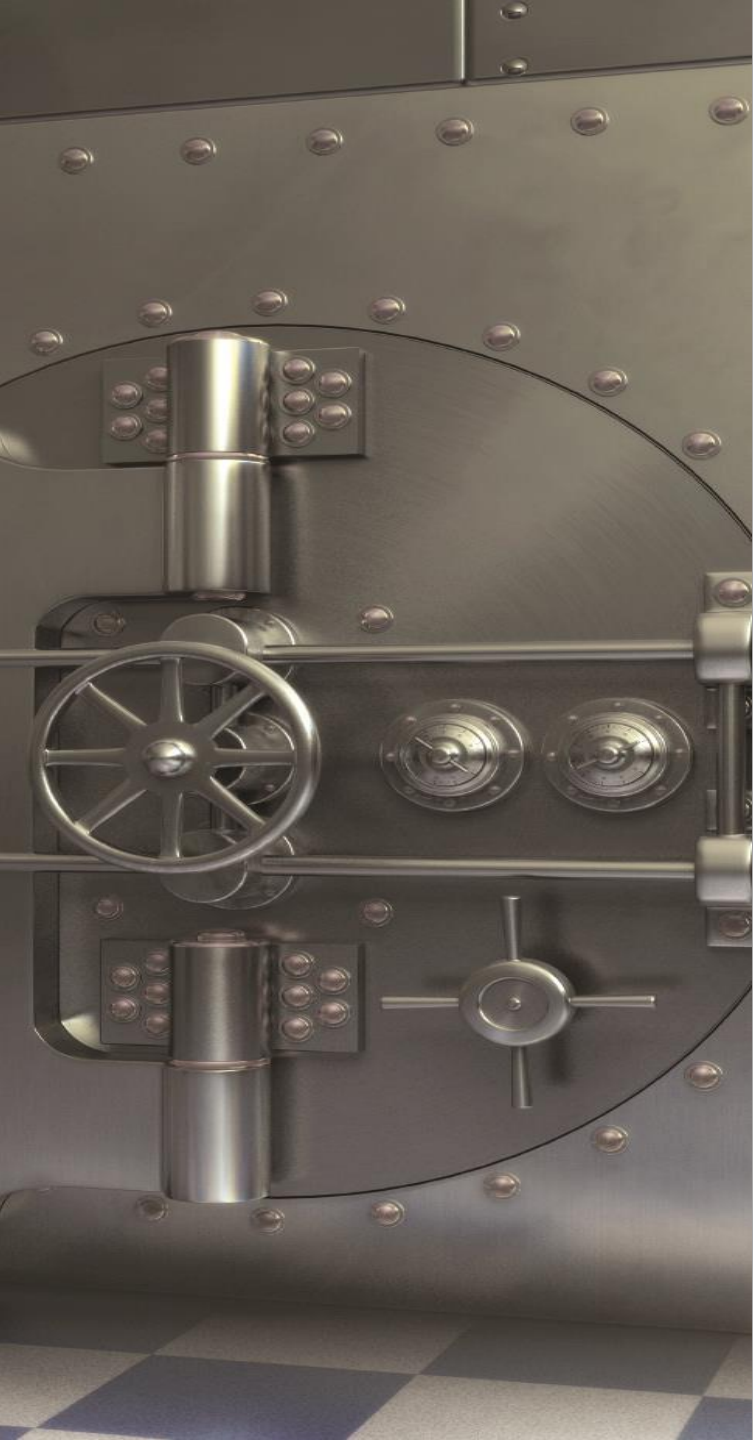
STTR/SBIR Patentable Technology

- Patentable Technology = “Subject Invention”
 - 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)

STTR/SBIR

Other IP Considerations

- **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



THANK YOU!



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UPCOMING TRAINING - EVENTS

A CRITICAL NOTICE FROM WPI

- If you are a current **FEDERAL / DOD CONTRACTOR** or **SUBCONTRACTOR** – you may have **CYBER – DATA SECURITY REQUIREMENTS** in your contract.
- If you are responding to any **CURRENT FEDERAL SOLICITATIONS** - be aware of your obligations:
 - Key clauses are 52.204-21, 252.204-7008 and 252.204-7012
 - Review for other possible requirements
- If you are a **DOD CONTRACTOR** or **SUBCONTRACTOR** – you will have new **CYBER COMPLIANCE – CERTIFICATION REQUIREMENTS** that may impact your business as early as the end of this calendar year.
 - See: <https://www.acq.osd.mil/cmmc> and <https://www.cmmcab.org> for more up to date information.
 - *Contact Marc Violante at WPI - marcv@wispro.org or 920-456-9990*

ACQUISITION HOUR LIVE WEBINARS SERIES

« All Events

- *** NEW DATE * ACQUISITION HOUR: INTELLECTUAL PROPERTY FOR GOVERNMENT CONTRACTORS & SUBCONTRACTORS & THE STTR/SBIR STAKEHOLDER**
June 16 @ 1:00 pm - 2:00 pm
<https://www.wispro.org/event/intellectual-property-for-government-contractors-and-subcontractors-and-the-sttr-sbir-stakeholder/>
- June 26, 2020
How the CyberSecurity Maturity Model Certification (CMMC) Will Impact Your Business
[CLICK HERE](#) for additional information
Presented by Marc Violante, Wisconsin Procurement Institute (WPI)
- July 14, 2020
The SBA 8(a) Certification Program
[CLICK HERE](#) for additional information
Presented by Shane Mahaffy, US Small Business Administration (SBA)
- July 15, 2020
Responding to Sources Sought and Capabilities Statements
[CLICK HERE](#) for additional information
Presented by Mark Dennis, Wisconsin Procurement Institute (WPI)

ACQUISITION HOUR LIVE WEBINARS SERIES

- July 22, 2020

The HUBZone Certification Program

[CLICK HERE](#) for additional information

Presented by Shane Mahaffy, US Small Business Administration (SBA)

- August 25, 2020

State and Federal Certifications For Veteran and Service Disabled Veteran Owned Businesses

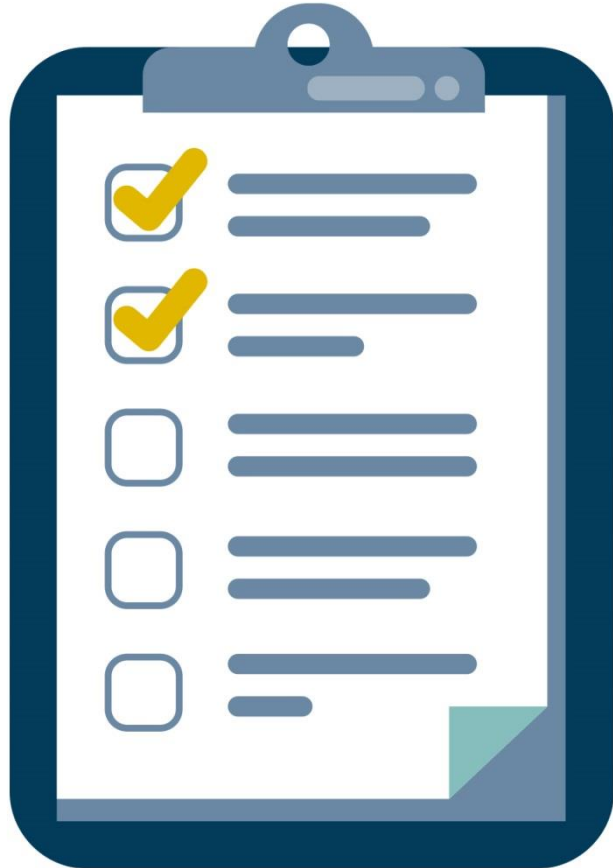
[CLICK HERE](#) for additional information

Presented by Shane Mahaffy, US Small Business Administration (SBA) and Mark Dennis,
Wisconsin Procurement Institute (WPI)

QUESTIONS?



SURVEY



CONTINUING PROFESSIONAL EDUCATION



CPE Certificate available, please contact:

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