

Buchalter

Maintaining IP Rights in Government Contracting

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- **COMMERCIAL** (follow the money)
 - Ownership – inventorship
 - Right to use – license/contract
 - Disclosure – NDA
- **GOVERNMENT**
 - Ownership – contract terms predetermined by FAR/DFARS
 - Trade Secret & Confidential Business/Financial Information (exempt under Freedom of Information Act)

- **INVENTION USE & OWNERSHIP** (given with option to loose)
 - Government retains right to use
(nonexclusive, royalty-free right to use)
 - SBIR awardee retains ownership rights
 - Subcontractor retains rights to their contributions
- **DISCLOSURES** (must mark/identify)
 - Data Rights (4-5 years w/roll over)
 - Government cannot disclose data to competitors
 - Government cannot use data to develop technical specs for competing procurement => must award sole-source
 - Trade Secret & Confidential Business/Financial Information (exempt under Freedom of Information Act)
- **MONOPOLY** (must register)
 - Patent / Copyright / Trademark

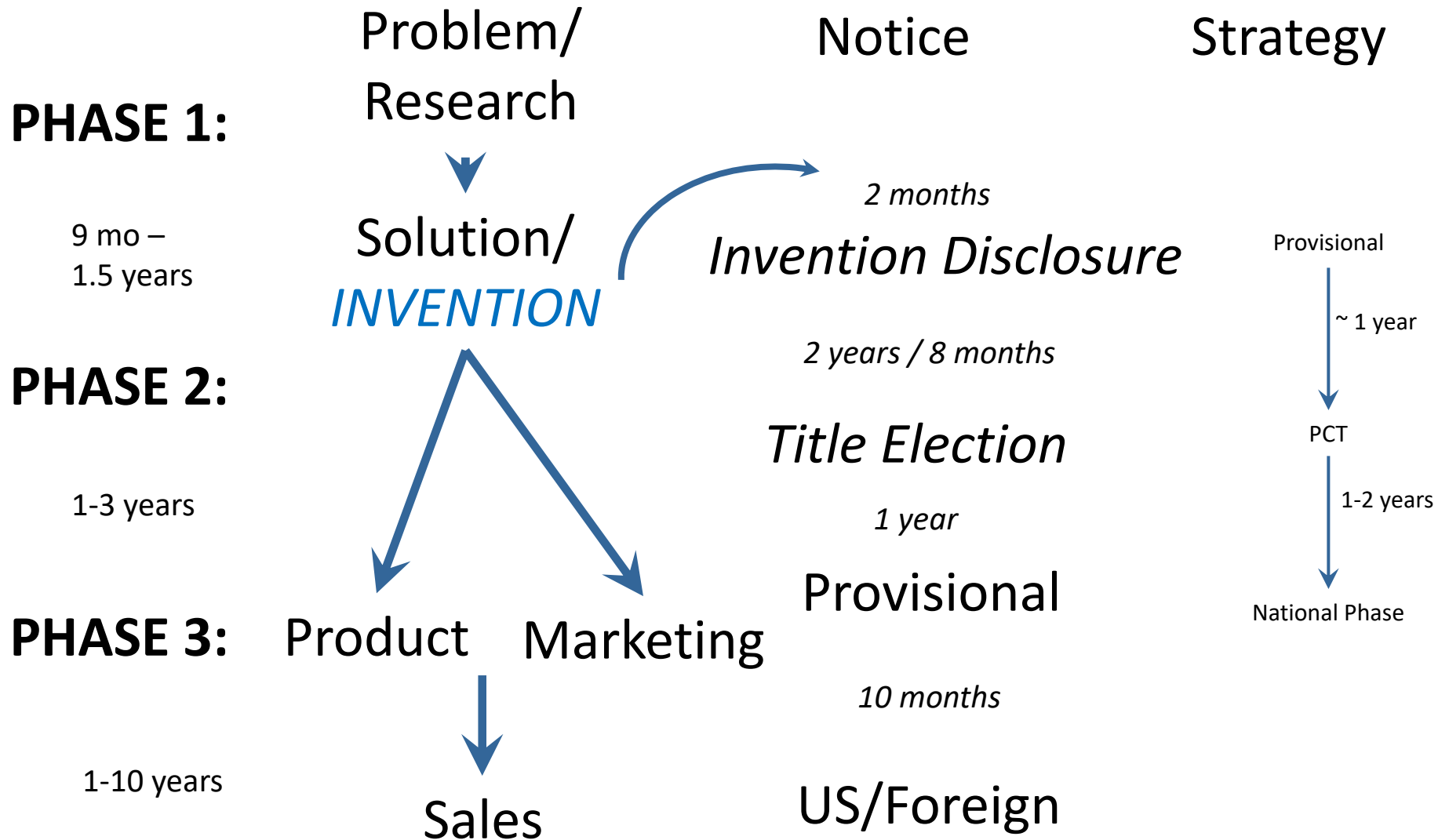
- **Proposal**
 - Each defined class has its own rights – designate intention
 - Identify rights brought to the contract
 - Manage use of sub-contractors / use of funds / licensing
- **During Contract**
 - Maintain ownership by following through on proposal
- **Deliverables**
 - Preserve confidences by asserting SBIR data rights (& update)
 - Preserve confidences by exempting from Freedom of Information Act
 - Preserve rights to data/IP brought to the SBIR contract
- **Protect/Monitor**

- Must preserve rights to IP brought to the contract
 - Describe the basis for the assertion
(unlimited rights presumed unless designated:
limited rights data, restricted computer software, SBIR data)
 - FARS 52.227-15 Representation of Limited Rights Data and Restricted Computer Software
 - Provide the name/company asserting the rights
- IP developed concurrently/separately with SBIR
 - Improvements (cheaper, faster, robust, rugged, scalable)
 - Strategic/identified use of IRAD moneys
- Contribution of Subcontractors (IRAD \$ / licensing / purchase)
- Strategically Identify Deliverables
(can withhold limited rights data)

- Must preserve rights developed during the contract
- Timeline – FAR 52.227-11 / DFARS 252.227-7038
 - Inventor discloses invention to Small Business (SB)
WITHIN 2 MONTHS
 - SB discloses invention to contracting officer
WITHIN 2 YEARS / WITHIN 8 MONTHS
(or 60 days prior to statutory bar)
 - SB elects to retain title
WITHIN 1 YEAR (or before statutory bar)
 - SB files provisional/non-provisional patent application
WITHIN 10 MONTHS
 - SB files non-provisional / foreign applications

- **Identify IP Brought to the Contract**
- **SBIR Data Rights**
 - Government cannot disclose data to competitors
 - Government cannot use data to develop technical specs for competing procurement => must award sole-source
 - Rights provided for 4-5 years (roll-over available)
 - MARK EVERYTHING – use exact language
 - FAR 52.227-20 / DFARS 252.227-7018
 - Full clause language on cover page
 - Specifically identify paragraph or page with asserted rights
- **Freedom of Information Act**
- **Copyright**

- **Proposal** *be aware of the phase*
 - Identify rights brought to the contract (phase II has SBIR data)
 - Segregate IP for non-government use / use of funds
 - Manage use of sub-contractors / use of funds / licensing
- **During Contract**
 - Maintain ownership interest by disclosing and retaining title
 - Obtain protection by properly filing IP
- **Deliverables**
 - Preserve confidences by asserting SBIR data rights (& update)
 - Preserve confidences by exempting from Freedom of Information Act
 - Preserve rights to data/IP brought to the SBIR contract
- **Protect/Monitor**



❖ Representation of Limited Rights Data and Restricted Software

This solicitation sets forth the Government's known delivery requirements for data (as defined in the clause at [52.227-14](#), Rights in Data—General). Any resulting contract may also provide the Government the option to order additional data under the Additional Data Requirements clause at [52.227-16](#), if included in the contract. Any data delivered under the resulting contract will be subject to the Rights in Data—General clause at [52.227-14](#) included in this contract. Under the latter clause, a Contractor may withhold from delivery data that qualify as limited rights data or restricted computer software, and deliver form, fit, and function data instead. The latter clause also may be used with its Alternates II and/or III to obtain delivery of limited rights data or restricted computer software, marked with limited rights or restricted rights notices, as appropriate. In addition, use of Alternate V with this latter clause provides the Government the right to inspect such data at the Contractor's facility.

- Identify protected data
- Identify basis
- Identify owner

❖ SBIR Rights Notice

These SBIR data are furnished with SBIR rights under Contract No. _____ (and subcontract _____, if appropriate). For a period of 4 years, unless extended in accordance with FAR [27.409\(h\)](#), after acceptance of all items to be delivered under this contract, the Government will use these data for Government purposes only, and they shall not be disclosed outside the Government (including disclosure for procurement purposes) during such period without permission of the Contractor, except that, subject to the foregoing use and disclosure prohibitions, these data may be disclosed for use by support Contractors. After the protection period, the Government has a paid-up license to use, and to authorize others to use on its behalf, these data for Government purposes, but is relieved of all disclosure prohibitions and assumes no liability for unauthorized use of these data by third parties. This notice shall be affixed to any reproductions of these data, in whole or in part.

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❖ Restricted Rights Notice (Short Form)

Use, reproduction, or disclosure is subject to restrictions set forth in Contract No. _____ (and subcontract, if appropriate) with _____ (name of Contractor and subcontractor).

❖ Freedom of Information Act

This proposal contains trade secret and confidential business or financial information exempt from disclosure under the Freedom of Information Act

❖ Copyright

Questions?

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Thank You!



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