

INTELLECTUAL PROPERTY & DATA RIGHTS

Basic introduction to the world of patents, trademarks, copyrights, trade secrets, and data rights



WHAT IS “INTELLECTUAL PROPERTY?”

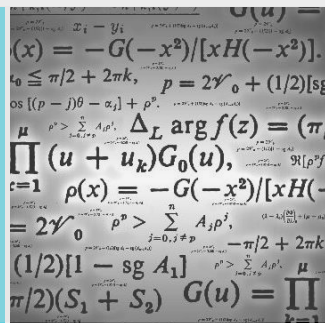
WIPO

- + IP refers to “creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce. IP is protected in law and enables people to earn recognition or financial benefit from what they invent or create. By striking the right balance between the interests of innovators and the wider public interest, the IP system aims to foster an environment in which creativity and innovation can flourish.”

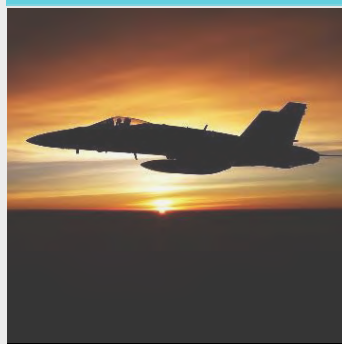


HOW IP HELPS YOUR BUSINESS

PROTECT
CORE
PRODUCTS
& SERVICES



DETER
OTHERS
FROM
COPYING



EXPAND
MARKET
SHARE



ACQUIRE
VENTURE
CAPITAL



GENERATE
REVENUE
STREAM






CREATE
VALUABLE
ASSETS

BE
LITIGATION
READY



SHOW
TECH
LEADER-
SHIP

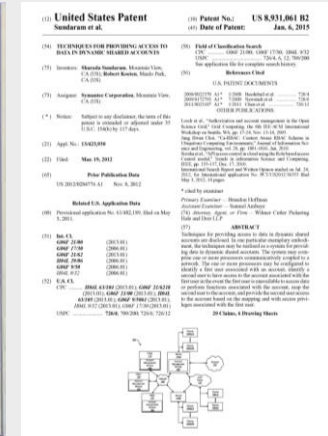
TYPES OF INTELLECTUAL PROPERTY

Type	Protectable Subject Matter (U.S.)	Example
Patent	New and useful processes, machines, manufactures, or compositions of matter, or any new and useful improvements thereof.	
Copyright	Original works of authorship fixed in any tangible medium of expression including 1) literary works (includes software); 2) musical works; 3) dramatic works; 4) choreographic works; 5) pictorial, graphic, and sculptural works; 6) motion pictures and other audiovisual works; 7) sound recordings; and 8) architectural works.	
Trademark	Words, names, symbols, or designs, used to identify and distinguish the source of goods or services.	
Trade Secret	Information, including formulas, patterns, compilations, programs, devices, methods, techniques, or processes, that: 1) derives independent economic value, actual or potential, from not being generally known to the public; and 2) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.	
Data (content)	Data is not technically IP, but it can be owned and licensed. Note: database structure is protectable by copyright (if qualify as “compilation”).	

PATENTS

Key Features

- + An exclusive grant by the government to make, use, or sell an innovation in exchange for public disclosure
- + National in scope
- + Specific in subject matter
- + Does not grant the right to use, but the right to exclude others
- + Term: Twenty (20) years from patent application filing date



PATENTS

SBIR/STTR Funding Affects Patent Rights

- + If an invention was originally conceived of or actually reduced to practice in connection with a SBIR/STTR grant, awardee must take affirmative steps to secure title to patent rights:



DISCLOSE

Disclosure of invention in writing to government within 2 months of discovery per FAR 52.227-11. Using iEdison is okay.



ELECT

Election to retain title within 2 years of invention disclosure (if invention has not yet published) per FAR 52.227-12.



APPLY

Apply for patent application to the USPTO. Expertise of patent professional highly recommended.

- + Failure to abide by any of the above gives the government the right to receive title
- + If you meet all these requirements, you will have title but government has at minimum a non-exclusive, non-transferable, irrevocable, paid-up license to practice throughout the world.

COPYRIGHTS

Key Features

- + A bundle of exclusive rights to (i) produce copies; (ii) adapt or create derivative works; (iii) distribute copies; (iv) publicly display the work; and/or (v) publicly perform the work
- + Generally exists upon creation; does not require registration or a government grant, but registration is important for recovery of damages
- + Worldwide (practically) in scope
- + Specific in subject matter (original works of authorship fixed in any tangible medium of expression)
- + Term: Life of the author + fifty (50) years



Protecting Software

Utility patents, design patents, copyrights, and trade secret can and should all be used to protect software innovations



TRADEMARKS

Key Features

- + Exclusive grant to a word, phrase, symbol, or design, that identifies and distinguishes a source of goods
- + Generally exists upon usage
- + Registration is not required for common law (state) protection, but federal registration provides broader protection, ability to develop brand beyond local state, and is incontestable after five (5) years of use
- + Protectable in areas of usage
- + Term: Survives as long as use continues – potentially indefinitely!



TRADE SECRETS

Key Features

- + Protected if reasonable efforts are used to maintain its secrecy
- + Exists as soon as it is created
- + Does not require a government grant
- + Term: Protected indefinitely, so long as it can be kept secret



PATENTS VS. TRADE SECRETS

	Patents	Trade Secrets
Criteria for protection	Must be patentable subject matter and be new, useful, and non-obvious	Must have value and efforts must be taken to maintain its secrecy
Duration of protection	20 years from filing	Indefinitely, as long as it can be kept a secret
How I can lose my rights	Publicly use, sell, or offer for sale the invention <u>before</u> filing	Public disclosure; lose key employees
How competitors can thwart	Invent and file patent before me; challenge validity; design around; publish prior art before me	Steal key employees; reverse-engineer; patent my trade secret
How I can make money from it	Make and use products/solutions protected by patent(s); license patent for royalties; patent enforcement (infringement)	Make and use products/solutions protected by TS; sue for breach of contract (non-compete, confidentiality)

RIGHTS TO TECHNICAL DATA & SOFTWARE

Two Main Rights to Data

- + (1) Ownership Rights
- + (2) Licensee Rights

FAR/DFARS generally allows the contractor to maintain ownership of technical data or computer software that the contractor develops

The government's standard use rights may be divided into three categories:

- + (a) Unlimited rights
- + (b) Limited/restricted rights
- + (c) Government purpose rights.

RIGHTS TO TECHNICAL DATA & SOFTWARE

Government Rights Determination Summary

**Performance under Government contract
(FAR) or Government funds (DFAR)**

Unlimited rights

(Government may give rights to 3rd parties)

Private expense

Limited rights to tech data

(Government may reproduce and use only
within government)

Restricted rights to software

(Government may use on only one computer
at a time)

Mixed Government and contractor funding

Government purpose rights

(Government may use material and may
authorize 3rd parties to use materials for
“government purposes”)

**Goods/services are for “commercial”
purposes**

Typical commercial licensee rights

(Government accepts same license as
available on commercial market)

RIGHTS TO TECHNICAL DATA & SOFTWARE

What Exactly Constitutes Protectable SBIR/STTR Data?

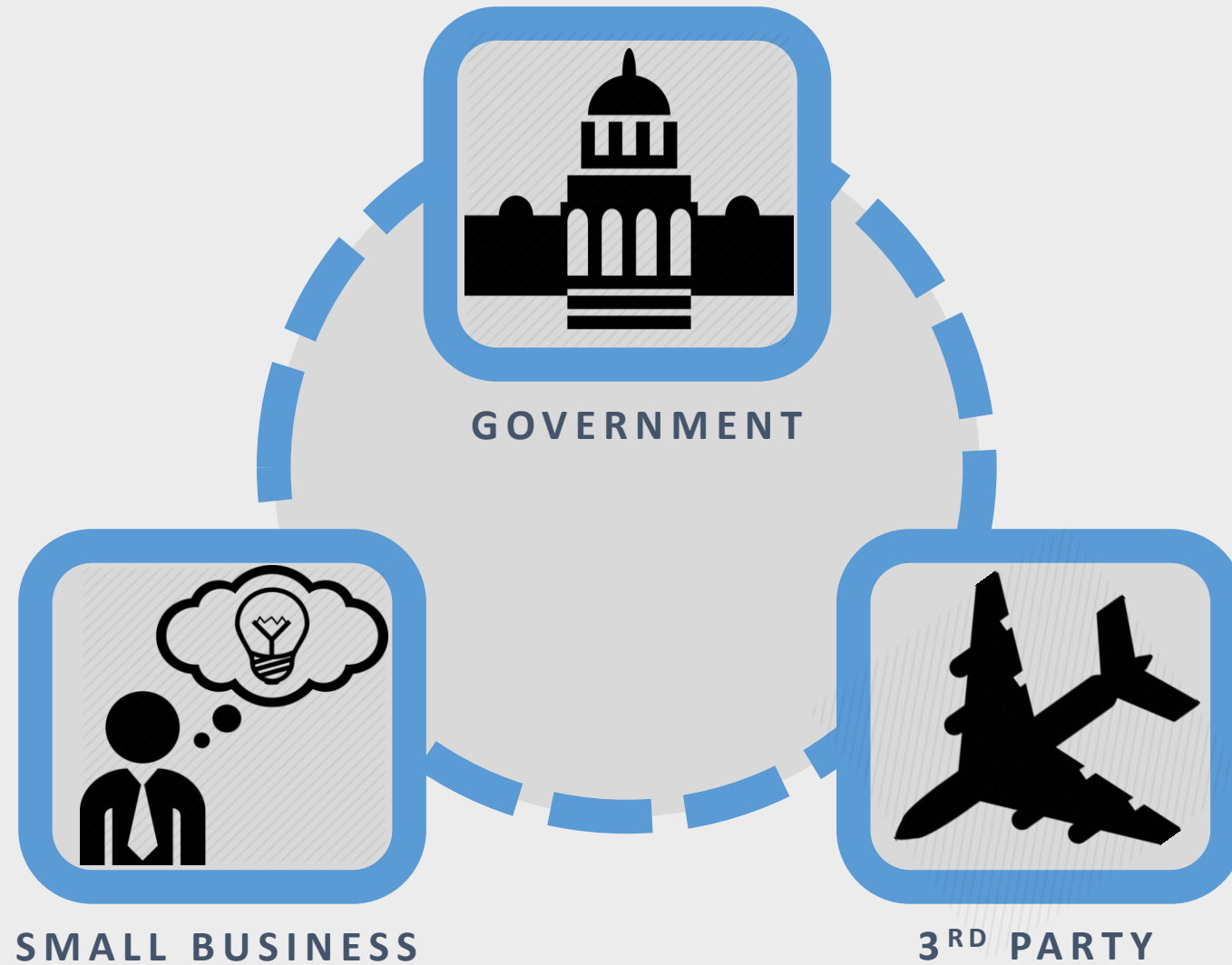
+ “SBIR/STTR Data” has three basic attributes:

- 1) it is recorded information
 - e.g., source code, sketches, drawings, formulas, equations, reports, descriptions of SBIR technologies, SBIR final reports);
- 2) of a technical nature
 - Company background, cost & pricing data not “technical”
- 3) that is generated under an SBIR or STTR funding agreement
 - Note: SBIR funding may include grants, contracts, cooperative agreements, or any other type of funding award the government chooses to make

PATENTING VS. SBIR/STTR DATA PROTECTION

	Patents	SBIR/STTR Data Protection
Type of Information Protected?	New and useful processes, machines, manufactures, or compositions of matter, or any new and useful improvements thereof	Technical data that is recorded and SBIR/STTR-funded
What criteria is needed to obtain?	Disclosure of your invention to PTO and public when file patent application	Disclosure of only your technical data to the Government
How long am I protected?	20 years from filing	5 years (DoD contracts)
Government's rights?	License to use or practice patent for free	Government can use internally for evaluation and "government purposes" during protection period; unlimited rights after protection period
How I can lose my rights?	Publicly use, sell, or offer for sale the invention <u>before</u> filing	Not qualify as SBIR/STTR data, not properly marked, or becomes public (disclosure to non-government entities)

PATENTING VS. SBIR/STTR DATA PROTECTION



BONUS: LICENSING

Licensing Tips

- + No IP, no licensing
- + Know the different types of technology licenses
- + Licensing occurs within business relationship
- + Negotiate agreements that benefit both sides
- + Advance preparation is essential
- + Technology license is not the same as tech transfer

HELPFUL RESOURCES

- + SBA: <https://www.sba.gov>
- + SBIR/STTR Web Site: <https://www.sbir.gov>
- + USPTO On-Line Training Modules:
<http://www.uspto.gov/learning-and-resources/global-intellectual-property-academy-gipa/uspto-webinars-and-ip-e-learning>
- + SBA FAQ on Data Rights: <https://www.sbir.gov/faqs/data-rights>
- + iEdison Website: <https://public.era.nih.gov/iedison/index.jsp>
- + DISA on IP & Data Rights: <http://www.disa.mil/about/legal-and-regulatory/datarights-ip/datarights>
- + DPAP Determinations & Findings Listing (FAR & DFARS):
http://www.acq.osd.mil/dpap/ccap/cc/jcchb/HTML/Topical/df_listing.html
- + Federal Acquisition Regulation Site (FARSite) (<http://farsite.hill.af.mil/>)



SBIR Beyond Phase II and Mentor Protégé Training Week



Introduction to IP & Data Rights Thank You

George Y. Wang, Esq.
ByteCubed, LLC
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george.wang@bytecubed.com