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IP Government Contracts

Doing business with the US government raises a number of issues relating to the allocation and protection of rights in intellectual property:

- Allocating rights in inventions conceived or reduced to practice under contracts or grants
- Allocating rights in technical data and computer software developed or provided under government contracts
- Protecting rights in information included in proposals submitted to the government
- Disclosing company-confidential business information or trade secrets to competitors under the Freedom of Information Act (FOIA)
- Negotiating nondisclosure agreements
- Allocating and protecting rights in intellectual property in connection with subcontracts or teaming agreements

Protecting intellectual property in the government procurement and grant arenas is subject to a number of procedural requirements, including, for example, requirements for disclosure of inventions and for identification or marking of information. Failure to comply with those requirements puts a company at risk of losing valuable intellectual property rights.

Representative Matters

Our attorneys have represented and advised clients on numerous government contract and grant-related intellectual property issues:

Managing

- The portfolio of several hundred issued patents and applications for a business unit of a large defense contractor, including preparing, filing, and prosecuting patent applications with the US Patent and Trademark Office

Preparing

- NDAs in connection with discussions of potential government and commercial business opportunities and potential teaming and/or cooperative agreements
- An opinion on a contractor's rights to patented aircraft technology used in performance of a government contract

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Advising

- An R&D contractor in negotiation of a firm, fixed-price, government-purpose license for computer software developed at private expense
- An R&D contractor in negotiation of a license allocating rights in and providing for payment of a royalty for use of technical data to be developed under a joint government/contractor R&D effort
- Contractors on licensing patented technology to the US government relating to products and technologies including specialty printing inks, cryptography, and detection of chemical warfare agents
- A government contractor on a proposed transfer by ARPA of unlimited rights data to a third party and a request that the contractor agree to grant the third party an exclusive license for purposes of commercialization
- On clients' rights and obligations under patent rights clauses and in preparation of patent applications on inventions conceived or reduced to practice under government contracts and grants
- On issues of allowability of costs of preparation of invention disclosures, preparation and filing of patent applications, and for general advice on intellectual property issues
- On use of appropriate markings in connection with submissions to the government, including proposal legends

Representing

- A leading aerospace company in several FOIA and Trade Secrets Act injunctive actions in US District Court and the DC Circuit Court of Appeals
- A government contractor in a US Claims Court proceeding that telecommunications service infringed a patent
- Government contractor clients in trade secret litigation between prime contractors and subcontractors and between competing contractors involving former employee and proprietary data issues
- Government contractors in bid protests involving proprietary data and unfair competitive advantage issues

IP Government Contracts

- A medical-research institute in negotiation of collaborative research agreements
- Contractors in assertion of claims of patent infringement by the US government, including assertion of administrative claim
- Various clients in preparation of administrative submissions to government agencies opposing release of propriety or business confidential information under FOIA