

Patents, Copyrights & Publications – export control considerations

2012 Export Control Coordinators Organization (ECCO)
Training Seminar
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by Alan Rither



Pacific Northwest
NATIONAL LABORATORY

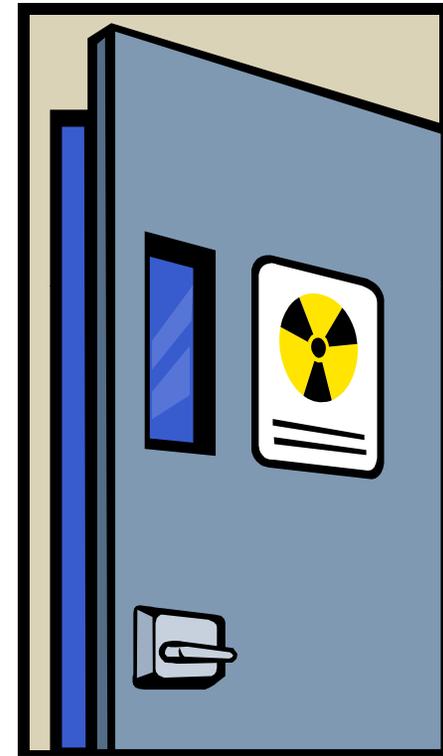
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Disclaimer

As a lawyer friend likes to say at the bottom of his e-mails, “It is only legal advice if I say so.”
Accordingly:

**This presentation is not
intended to provide legal advice.**

Enter at your own risk. 😊



Slide 2

VB1

Do you have the author's permission to use this cartoon? It would be very entertaining get nabbed for copyright infringement in an IP-related presentation.

Vincent Branton, 4/20/2012

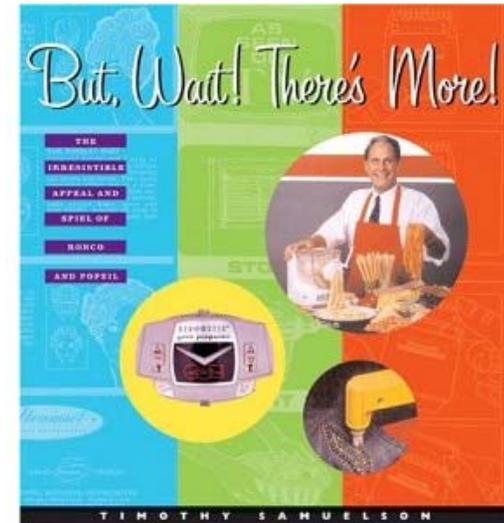
Patent apps are easy (even if you're queasy)



- ▶ Under 35 U.S. Code § 184, whenever a U.S. patent application is filed, a foreign filing license is deemed issued 6 months after the patent application is filed, unless there is a secrecy order under § 181.
- ▶ Failure to get the license may result in an invalid patent in the United States even if the technology was not export controlled.
- ▶ Any technical data that needed an export license violates the EAR, the ITAR or 810 unless § 184 approval was first obtained
- ▶ 15 CFR 734 (b)(1)(v) delegates export authority to the USPTO for patent applications, not for other material

But you're not out of the woods yet!

- ▶ Your troubles have just started if you filed a foreign application without the foreign filing license.
- ▶ Criminal charges can be filed under § 186 if a secrecy order was issued but you disclosed it without authority.
- ▶ Besides no RD, foreign filing cannot contain “technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954 and the Nuclear Non-Proliferation Act of 1978, as implemented 10 CFR part 810, in effect at the time of foreign filing” unless licensed by DOE.



What about “outsourcing”?

Outsourcing Your Intellectual Property Work May Be Illegal



Dec 19, 2008

Jacob Erlich and Stephen F.W. Ball, Jr.

While outsourcing has become somewhat of a national trend, outsourcing patent work has the potential for severe criminal and civil penalties

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For a number of years, inventors, businesses, and even some patent law firms have used overseas companies to conduct novelty searches and to assist in drafting and prosecuting U.S. patent applications. This outsourcing practice has developed into a multi-billion dollar annual business with foreign countries, particularly India. Recently, the American Bar Association officially authorized the long-standing use of outsourcing by the legal profession, noting that the "outsourcing trend is a salutary one for our globalized economy." (*ABA Ethics Opinion 08-451.*)

<http://www.ipfrontline.com/depts/article.aspx?id=21842&deptid=3>

Preparation of U.S. patent applications by foreign practitioners

DEPARTMENT OF COMMERCE United States Patent and Trademark Office [Docket No.: PTO-P-2008-0024] Scope of Foreign Filing Licenses

AGENCY: United States Patent and Trademark Office, Commerce. **ACTION:** Notice.

SUMMARY: Applicants and registered patent practitioners are reminded that the export of subject matter abroad pursuant to a license from the United States Patent and Trademark Office (USPTO), such as a foreign filing license, is limited to purposes related to the filing of foreign patent applications. Applicants who are considering exporting subject matter abroad for the preparation of patent applications to be filed in the United States should contact the Bureau of Industry and Security (BIS) at the Department of Commerce for the appropriate clearances.

DATES: *Effective Date:* July 23, 2008.

Federal Register / Vol. 73, No. 142 / Wednesday, July 23, 2008 page 42781



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Why should you get an export license or exception for even domestic IP licenses?

- ▶ Because, according to export authorities,



...to apply rather than take a chance of making a “deemed export” without one.

What about Technical Data under an NDA?

- ▶ This is what we ordinarily do when we consider whether something is an export of technology.
- ▶ An NDA does not prevent the USPTO from deciding that material in a U.S. patent application needed prior approval and invalidate any U.S. patent issued prior to such approval.
- ▶ So consider carefully or you may relinquish patent rights and face a shut door in other countries as well



Slide 8

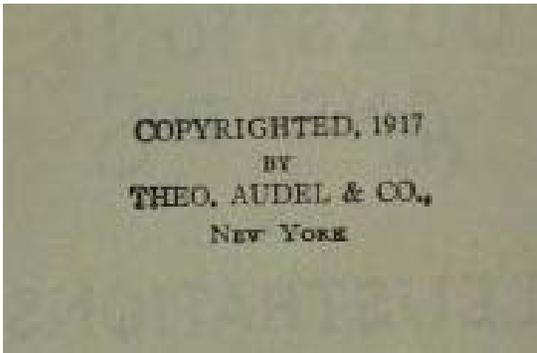
VB2

One statement we normally include in NDAs is that the proprietary information will be disclosed only to US citizens or permanent resident aliens having a green card. The recipient is responsible for its compliance with export control laws.

Vincent Branton, 4/20/2012

Exporting Copyrights or Copyrighting Exports?

- ▶ A copyright is intangible personal property that can be sold or licensed.
- ▶ There is no export control issue with copyrights, *per se*
- ▶ Copyright protects the form, not the content of information
- ▶ Export control is concerned with the content, not the form

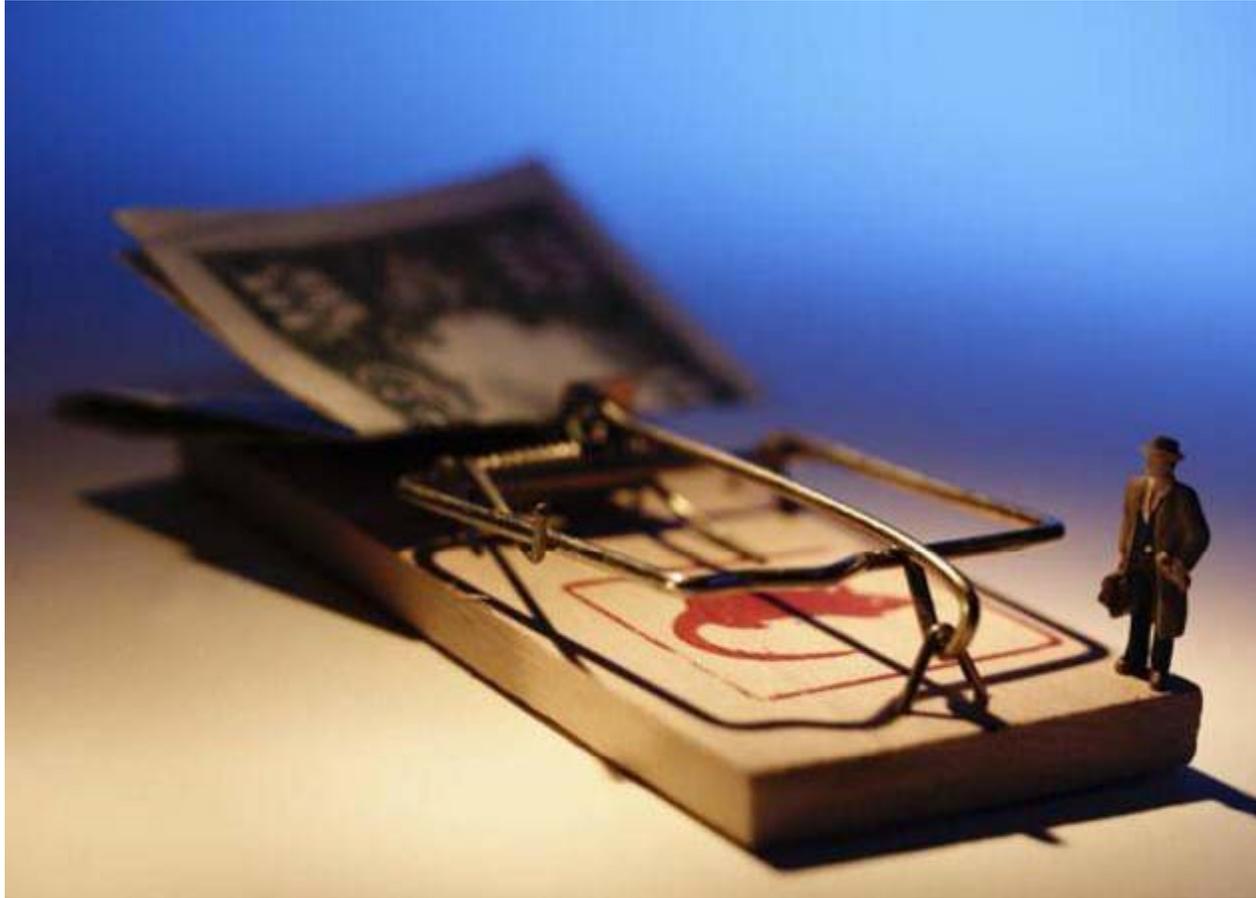


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What about publications?

▶ 15 CFR § 734(b)(2) lists things “not subject to the EAR”

Prerecorded phonograph records reproducing in whole or in part, the content of printed books, pamphlets, and miscellaneous publications, including newspapers and periodicals; **printed books, pamphlets, and miscellaneous publications including bound newspapers and periodicals;** children's picture and painting books; newspaper and periodicals, unbound, excluding waste; music books; sheet music; calendars and calendar blocks, paper; maps, hydrographical charts, atlases, gazetteers, globe covers, and globes (terrestrial and celestial); exposed and developed microfilm reproducing, in whole or in part, the content of any of the above; exposed and developed motion picture film and soundtrack; and advertising printed matter exclusively related thereto.



Questions?