

INTELLECTUAL PROPERTY

I. Purpose

This Directive establishes the Department of Homeland Security (DHS) policy regarding the treatment and disposition of all forms of intellectual property, including, but not limited to, identifying, obtaining, using, maintaining, defending and licensing trademarks, patents, copyrights, technology transfer, and rights in data.

II. Scope

This Directive is applicable throughout DHS.

III. Authorities

- A. Title 6, United States Code (U.S.C.), Section 182(6)), "Responsibilities and Authorities of the Under Secretary for Science and Technology" (relating to technology transfer)
- B. Title 15, U.S.C., Chapter 22, "Trademarks"
- C. Title 15, U.S.C., Chapter 63, "Technology Innovation"
- D. Title 17, U.S.C., "Copyrights"
- E. Title 35, U.S.C., "Patents"
- F. DHS Delegation 0400.2, "Delegation to the General Counsel"
- G. DHS Delegation 10002, "Delegation to the Under Secretary of Science and Technology to Facilitate Technology Transfer"

IV. Responsibilities

A. The **Under Secretary for Science and Technology** establishes and manages the DHS technology transfer and intellectual property programs for the entire Department. This includes, in consultation with the General Counsel, entering into Cooperative Research and Development Agreements, licensing DHS intellectual property, managing and executing DHS' implementation of the Stevenson-Wydler Technology Innovation Act of 1980, and implementing the Technology Transfer Act of 1986.

B. The **General Counsel** provides counsel on all legal matters concerning DHS technology transfer and intellectual property programs. This includes establishing DHS intellectual property policy and interacting with DHS components, other agencies and others to identify, obtain, and maintain intellectual property rights on DHS' behalf.

C. The **Chief Procurement**, in consultation with the General Counsel, provides guidance on technology transfer and intellectual property programs as those programs relate to contracts, financial assistance, reimbursable agreements, and other like instruments.

V. Policy and Requirements

A. **DHS Employee Inventions**. Due to the considerable legal significance associated with disclosure of employee inventions, it is imperative that the Office of the General Counsel (Intellectual Property Counsel) be consulted at the earliest stage of the process and informed of employee inventions.

1. All DHS employees whose duties may result in an invention keep a laboratory notebook or other record to reflect their activities and document any resulting invention.
2. Employees report inventions to the Office of the General Counsel (Intellectual Property Counsel) when inventions are made:
 - a. During official duty hours; or
 - b. Using Government facilities, equipment, materials, funds, information; or
 - c. Using the assistance of any Government employees on official duty or contractors billing hours or proceeding under a contract with the Government; or

d. Performing actions which bear a direct relation to, or are made in consequence of, the official Government duties of the inventor.

3. Employees and co-employees do not disclose the existence of the potential invention to anyone until the invention is reported to the Office of the General Counsel (Intellectual Property Counsel).

4. If the Government applies for a patent on a DHS employee's invention, the employee is required to assign ownership of the invention to the United States and is entitled to a share of any royalties resulting from the licensing of the invention.

B. **Inventions under DHS Funding Agreements.** The intellectual property provisions of DHS contracts, grants, cooperative agreements, and other instruments require the contracting party to report promptly to the DHS contracting officer any inventions first conceived or reduced to practice during performance.

C. **Copyrights and Trademarks.** If there is a programmatic reason to use a patent, copyrighted work, trademark, or data owned by others that contains restrictive markings, and the use of the material is to be inconsistent with those markings, DHS employees must consult with the Office of the General Counsel (Intellectual Property Counsel) prior to usage. DHS employees acting within the scope of their duties:

1. Respect the intellectual property rights of others including patents, copyrighted materials, trademarks, or data subject to confidential markings which limits usage.

2. Do not copy, prepare derivative works, distribute to the public, or perform publicly or display publicly copyrighted works without the permission of the owner. Copyrighted works may be distinguished by the copyright symbol "©".

3. Do not use a trademark, usually distinguished by a registration symbol, reflecting Federal registration "®" or "TM" as a common law trademark, without the permission of the owner.

D. **Non-Disclosure Agreements**. The execution of a non-disclosure agreement is commonly used outside of Government to protect the trade secret or other confidential data of one party when the protected data is made available to another party or its employees. Because Federal employees are subject to criminal and civil sanctions for unauthorized disclosure or misuse of protected data of others, DHS employees are not required to execute a non-disclosure agreement for gaining access to the intellectual property of others in the course of their employment. Although not required to execute a non-disclosure agreement, DHS employees that need access to the protected data of others must consult with the Office of the General Counsel (Intellectual Property Counsel).

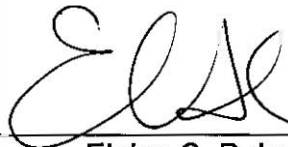
E. **Intellectual Property Fees and Infringement Liabilities and Costs**.

Costs, fees, and damages are:

1. Paid by the Component to which the employee is assigned when DHS prosecutes a patent application for an employee invention.
2. Paid by the Component accused of infringing the intellectual property rights of others.
3. Shared on a on a pro rata basis if more than one Component is responsible.
4. Allocated to the Components based upon the determination of the General Counsel.

VI. Questions

Address questions concerning this Directive to the Office of the General Counsel, Assistant General Counsel for Intellectual Property.



Elaine C. Duke

Under Secretary for Management

4/1/2010
Date