

Intellectual Property Rights - Research And Technology

DEFCON 705
Edition 06/21

Definitions

1. For the purpose of this Condition, the following definitions apply:
 - a) 'Technical Information' means information of a scientific or technical nature (including information in the form of know-how, inventions, designs, secret formula and processes, and other confidential information) which is recorded or documented in any medium and whether or not in human readable format, but excluding unrecorded information communicated solely by oral communications. It may be presented in the form of documents, pictorial reproductions, drawing and other graphical representations, disc and film recordings (magnetic, optical and laser), computer software both programmatic and data base, and computer memory printouts or data retained in computer memory, or other form.
 - b) 'Foreground Technical Information' means Technical Information which is generated in the performance of work under the Contract.
 - c) 'Technical Deliverable' means a document or product comprising Technical Information which is required to be provided to the Authority under the terms of the Contract.
 - d) 'Full Rights Information' means Foreground Technical Information together with the following (which may not wholly consist of Foreground Technical Information):
 - i. data and information resulting from studies analyses or tests that are conducted in the performance of work under the Contract;
 - ii. any item which is specifically required to be produced in the performance of work under the Contract, such as a mathematical model, algorithm or software program; and
 - iii. a requirement document or specification which is specifically required to be produced in the performance of work under the Contract.
 - e) 'Full Rights Version' means a version of a Technical Deliverable which comprises Full Rights Information and which is coherent in itself.
 - f) 'Limited Rights Information' means Technical Information which is neither in the public domain nor Full Rights Information, whether owned by the Contractor a subcontractor or a third party, and which comprises details of any of the following:
 - techniques of design or test or data management,

manufacturing methods and processes, products (including software) or materials; and any other category specifically identified in the Contract as being Limited Rights Information when the requirements for Technical Deliverables are agreed.

- g) 'Limited Rights Version' means a version of a Technical Deliverable specifically comprising or including Limited Rights Information.
- h) 'Intellectual Property Rights' ('IPR') means all patents, utility models, rights (registered and unregistered) in any designs; applications for any of the foregoing; copyright; confidential information and trade secrets; and all rights and forms of protection of a similar nature to these or having equivalent effect anywhere in the world.
- i) 'Foreground IPR' means all IPR in Foreground Technical Information, including patents for any inventions generated in the performance of work under the Contract, and patents for any inventions conceived out of the technical requirements of the Contract if these have been first enabled in the performance of work under the Contract.
- j) 'UK National Defence Agreement' means any invitation to tender, agreement, or contract, issued or entered into by or on behalf of the Authority in any territory pursuant to its own defence, civil defence, or security or intelligence purposes and which may provide, without limitation, for information awareness or assessment, or research, or design development, integration, manufacture, provision or support of any equipment materials tools or services.
- k) 'Collaborative Defence Agreement' means any treaty, agreement, MOU or other like formal arrangement entered into by or on behalf of the UK Government, the Authority or any other UK Government Department with another government, government agency, intergovernmental organisation or its agency, for the UK Government's own or its shared defence, civil defence, or security or national or international intelligence purposes.
- l) 'Research and Technology Agreement' means a Collaborative Defence Agreement, not being one established for the development or procurement of a specific equipment, which is within the field of research and technology and which may provide, without limitation, for information exchanges, information awareness or assessment, research projects, or technology demonstrator projects.
- m) 'Use' means utilisation of Technical Deliverables and Technical Information in accordance with this Condition for the purposes provided hereunder and, within these limitations, shall include the reproduction and modification of Technical Deliverables.
- n) 'for the Services of the United Kingdom Government' means anything done by the Authority, under the authority of, or to the order of, a Minister of the Crown in pursuance of the authority

vested in the Minister by Parliament.

Ownership of IPR

2. All Foreground IPR shall belong to the Contractor and shall be subject to this Condition.
3. The Contractor shall ensure that the terms of engagement of all individuals carrying out work for them under the Contract are such as to vest the ownership required by Clause 2.
4. The Contractor shall ensure that no part of the work to be performed under the Contract is subcontracted to a legal entity without the prior written agreement of the Authority, except as follows:
 - a) by first ensuring that the subcontractor has entered into an agreement with the Authority, in the form of DEFFORM 177, which invokes this Condition in regard to the subcontract work; or alternatively
 - b) by placing a contract which provides that the Contractor shall own the Foreground IPR arising from the performance of work under the subcontract, and subject to these being licensed to the Authority by the Contractor under the terms of this Condition.
5. In the event that the Contractor assigns their ownership of any Foreground IPR they shall secure for the Authority the continuance of its rights under this Condition.

Publication

6. The Authority may, at any time, publish or have published a brief summary indicating the nature of work to be carried out under the Contract.
7. The Authority may publish, or have published, an abstract, of a commercially non-sensitive nature, of the Full Rights Versions of the Technical Deliverables. The Contractor may supply an acceptable abstract of that Full Rights Version for this purpose. In the absence of such an acceptable abstract, the Authority may produce an abstract itself but it shall not publish this without first consulting the Contractor allowing 45 Business Days for response.
8. The Contractor may publish the Foreground Information or any part of it, provided that the Contract, or the pertinent work package within the Contract, is 'OFFICIAL', unless exceptionally the Authority considers that the publication is not in the national interest. The Contractor shall give written prior notice of intended publication to the Authority and allow 45 Business Days for the Authority to raise an objection on national interest grounds. In the absence of such an objection from the Authority within this period, the Contractor shall be entitled to proceed with publication.

Provision and Use of Technical Information and Retention of Records

9. The Contractor shall provide Full Rights Versions of Technical Deliverables as required by the Contract. The Contractor shall not be required to include, and

shall not include, Limited Rights Information in Full Rights Versions. Where a Full Rights Version does not contain all deliverable Technical Information, the Contractor shall provide a Limited Rights Version of such other deliverable Technical Information.

10. To allow for the provision of further Foreground Technical Information under Clause 11 the Contractor shall retain, for the duration of the Contract and for a period of five years thereafter (or such alternative period as may be specified in the Schedule of Requirements), a record of the work performed under the Contract and of the results obtained.

11. The Authority shall have the right to acquire from the Contractor additional Full Rights Information not contained in the Technical Deliverables comprising data and information resulting from studies analyses or tests that are conducted in the performance of work under the Contract, for so long as this exists. This right shall be exercisable by separate order and on agreement of a fair and reasonable price and other relevant terms.

12. The Authority shall have the right to Use all Full Rights Versions and Full Rights Information in confidence, as provided below:

- a) to disclose to and authorise Use within any United Kingdom Government Department (which term shall include the United Kingdom Armed Forces) and the UK police and civil defence agencies, for any purposes;
- b) to disclose to and authorise Use by any party under, and solely for the purposes of, any UK National Defence Agreement;
- c) to disclose to any governmental or intergovernmental body under any Research and Technology Agreement, and to allow onward release in confidence to contractors to the extent only that such onward release is authorised by the Authority in the circumstance that the Research and Technology Agreement provides for these releases on a reciprocal basis, and to authorise Use by these parties in accordance with, and solely for the purposes set out in, the Research and Technology Agreement concerned;
- d) to disclose to any governmental or intergovernmental body under any Collaborative Defence Agreement other than a Research and Technology Agreement, to allow onward release in confidence to a contractor to the extent only that such onward release is authorised by the Authority and complies with the Collaborative Defence Agreement, and to authorise Use by these parties in accordance with, and solely for the purposes set out in, that Collaborative Defence Agreement, providing that:
 - i. unless the Collaborative Defence Agreement is one which has been identified in the Contract at the time of Contract placement or exceptionally is one subject to security restrictions to a degree which precludes its identification to the Contractor, the Authority shall not exercise its rights under this sub-Clause without first informing the Contractor adequately of its intentions and giving the Contractor an opportunity to make

representations; and

ii. whilst the Authority's decision shall be final between the parties it shall pay due regard to the Contractor's representations when making its decision;

e) where any Technical Information is to be disclosed to a contractor of another governmental or inter-governmental body under sub-Clauses 12.c) or 12.d), the Authority will use all reasonable endeavours to release to the Contractor and other contractors to the Authority relevant Technical Information received from the other body under the relevant Collaborative Defence Agreement commensurate with the terms of release and use set out in that Agreement; and

f) to disclose to and permit Use by any party as reasonably necessary in connection with the sale or disposal of anything made pursuant to sub-Clause 12.b), which is surplus to requirements.

13. Subject to the availability of the relevant expertise and on a request made by the Authority within the period specified in Clause 10, the Contractor shall provide assistance in understanding any Full Rights Versions to the Authority or any other person to whom the Authority may provide it in accordance with Clause 12. The degree of assistance shall be limited to that required for a person competent in the relevant area of technology to interpret the results of the Contract. The assistance shall be made available within a reasonable period of the request and on fair and reasonable terms and conditions.

14. The Authority shall have the right to Use in confidence all Limited Rights Versions and Limited Rights Information as provided below:

a) to disclose to and authorise Use within any United Kingdom Government Department (which term shall include the United Kingdom Armed Forces) and the UK police and civil defence agencies, for any purposes; and

b) to disclose to and authorise Use by a service provider, under a UK National Defence Agreement, solely for the purposes of the provision of a service to the Authority which, unless otherwise identified in the Contract or agreed by the Contractor, shall be limited to managing, monitoring, evaluating, assessing or auditing the work under the Contract, provided that the service provider is identified for this purpose in the Contract at the time of Contract placement or is one later agreed with the Contractor with a view to avoiding any conflict of interests.

15. Subject to the limitation imposed by Clause 16, the rights granted under Clauses 12 and 14 shall be free of payment to the Contractor in respect of any IPR owned or controlled by them.

16. The freedom from payment granted under Clause 15 shall not extend to Use of any patents, or registered designs other than those comprising Foreground IPR, but shall be without prejudice to the rights of the Authority arising under any separate contract or agreement or arising under statute.

Marking of Information

17. The Contractor shall mark each Technical Deliverable with a proprietary legend in which the owner of the rights shall be identified and references to the Contract and this Condition included. The legend may also make other IPR statements reserving rights to the Contractor provided that these are stated in terms consistent with the Authority's rights under this Condition. All Limited Rights Versions shall be clearly marked as such.

18. The Authority shall not remove or modify any marking properly applied to Technical Deliverables in accordance with Clause 17, shall perpetuate the marking on any copies it makes of Technical Deliverables and their contents, and shall require any third parties to whom the Technical Deliverable or Technical Information is provided to preserve that marking on all copies.

Applications for Patents and Registered Designs

19. The Contractor shall provide the Authority's Director of Intellectual Property Rights (1) with the following notifications and copies:

- a) a notification of the first application for patent or like protection (wherever made) for an invention comprising Foreground IPR, which identifies the country and the application number and number of the Contract, together with a copy of the application;
- b) a notification of the first application for registration of a design (wherever made) for a design generated in the performance of work under the Contract, which identifies the country and the application number and the number of the Contract, together with a copy of the application; and
- c) a notification of the grant of any patent or like protection effective in the UK secured for an invention comprising Foreground IPR or the grant of registered design protection effective in the UK for a design generated in the performance of work under the Contract, which gives identification details for the rights granted.

20. All notifications under Clause 19, together with the accompanying material as required, shall be provided by the Contractor within 45 Business Days of receipt by them of the corresponding certificate of filing or grant, save as provided in Clause 21.

21. In lieu of providing individual notifications under Clause 19, the Contractor shall be entitled to provide a notification, aggregated across the Contract and any other contracts, of all applications and grants which are subject to this Condition (such as a notification in the form of a data base print or extract), as long as this is provided no less frequently than quarterly and as long as the copies required by Clause 19 are provided at the same time.

22. The Authority undertakes to hold all copies provided under Clause 19 in confidence and to use them only for the purpose of ascertaining the Authority's rights, unless and until they are published in the normal way.

23. The Contractor shall, at the request and expense of the Authority,

take all reasonable steps necessary to enable the Authority to register, at the UK Patent Office or elsewhere, its interest in inventions or designs notified under this Condition.

24. If the Contract, or a package of work under the Contract, has a national security grading of or equivalent to 'OFFICIAL-SENSITIVE' or higher then the Contractor shall prepare and file all patent applications for any invention generated in the performance of work under the Contract or that package of work, in accordance with their appropriate national security laws and procedures, using persons having appropriate security clearance for the purpose. This obligation on the Contractor shall apply also to the making of any patent applications for other inventions which discloses any matter connected with the Contract, or a package of work under the Contract, so graded.

25. If the Contractor's national security laws and procedures require them to make a patent application for an invention to which Clause 24 applies otherwise than to the UK Patent Office, they shall secure the Authority's consent (which shall not be unreasonably withheld) before making the patent application.

26. When a patent application for an invention to which Clause 24 applies is made at the UK Patent Office, the Contractor shall ensure that it is filed directly with the Security Section. When making such a patent application the Contractor shall comply with the following:

- a) they shall provide authorisation to the UK Patent Office, at the appropriate stage in the proceedings, to provide a copy of the patent application to the Authority in confidence, solely for the purpose of assessing the correct national security grading; and
- b) for inventions which constitute Foreground IPR, they shall state in writing when the application is made that the invention concerned is related to UK Government work and they shall quote the number of the Contract and the name and address of the appropriate representative of the Authority as identified in Box 2 of DEFFORM 111.

27. For the purposes of Clause 3 of DEFCON 659A any patent application made in accordance with Clauses 24 to 26 shall be considered to have been made with the prior consent of the Authority.

28. The Contractor shall have no right to compensation under Section 22(7)(b) of the Patents Act 1977 in relation to any invention comprising Foreground IPR.

29. The provisions of Clauses 24 to 26 do not apply to any individual patent application made or proposed to be made if the whole content of that application has been reviewed and assessed by an appropriate UK national classification authority as having a national security grading of or equivalent to 'OFFICIAL'.

Patents etc – Rights of the Authority

30. The Authority shall have an irrevocable, world-wide non-exclusive payment-free licence with the right to sub-license, for the Services of the United Kingdom Government as follows:

- a) to do in relation to any patent or like protection of the Contractor for an invention comprising Foreground IPR, any act as defined in Section 55(1) (a) to (e) of the Patents Act 1977 or
- b) to make, use, have used, import, keep, offer to sell or sell a registered design comprising Foreground IPR;

and this shall include the right to grant a licence, with the right to sub-license, to another government, government agency, intergovernmental organisation or its agency under the terms of a Collaborative Defence Agreement to permit use of the invention or registered design in any joint activity with the Authority under the Collaborative Defence Agreement (including the provision to all parties to that Agreement of any defence equipment which is produced by the joint activity).

31. The Authority shall inform the Contractor when the Authority exercises its rights under Clause 30.

Exploitation

32. The Contractor shall notify the Authority promptly if it is not able, or does not wish, to take responsibility for the utilisation, management and exploitation of the Foreground Technical Information or Foreground IPR so that the Authority can consider alternative options. Unless such a notification has been given, Clauses 33 to 36 shall apply.

33. The responsibility for securing effective utilisation, management and exploitation of the Foreground Technical Information and Foreground IPR shall fall to the Contractor concomitant upon their ownership of these under Clause 2.

34. The Authority shall be entitled to require the Contractor, at reasonable intervals during the Contract and for a period of five years thereafter or such other period as may be set down in the Contract, to inform it of the plans for and the extent to which the Foreground Technical Information and Foreground IPR are being exploited in both the defence market and other markets. The Authority may review from time to time the technology arising from the Contract and may require the Contractor to engage in discussions with a view to promoting commercial exploitation. The Authority may conduct this review itself, or may engage a contractor to conduct a review on its behalf providing that this contractor is reasonably acceptable to the Contractor and is bound by an obligation of confidence.

35. If the Contractor wishes to grant a licence including any provision which conflicts with a provision of this Condition, they shall inform the Authority's Director of Intellectual Property Rights giving full details of the proposed licence and the conflict of provisions. If, having regard to the territories and/or goods or services to which the licence relates, it appears to the Authority that the proposed licence is unlikely to inhibit its defence interests it will consent to the licence or consent to the grant on modified terms. No such licence may be granted unless the Authority's consent has been given.

36. Subject always to the Authority's existing obligations at the time of the request, the Authority will favourably consider the grant of a licence to the Contractor (with the right to sub-license) to use information provided by and belonging to the Authority as necessary to enable the Contractor to exploit

Foreground Information and Foreground IPR commercially. Such a licence shall be non-exclusive and on fair and reasonable terms, taking account of all the circumstances.

General

37. For the avoidance of doubt, nothing in this Condition shall:

- a) restrict the entitlement of either party to make use of information once it enters the public domain;
- b) extinguish any entitlement to use information and IPR which has been acquired under any separate contract or agreement; or
- c) override any applicable security restriction or constitute an export licence for Technical Information.

38. This Condition shall constitute 'an agreement to the contrary' for the purposes of Section 48(5) of the Copyright, Designs and Patents Act 1988.

39. The terms of this Condition shall survive the cessation of the Contract.

Notes

(1) The agreement of the Authority is to be sought from and the information addressed to: Patent Security Unit, Directorate of Intellectual Property Rights, Poplar 2 #2214, MOD Abbey Wood, BRISTOL, BS34 8JH.