

# The Patent Lawyer

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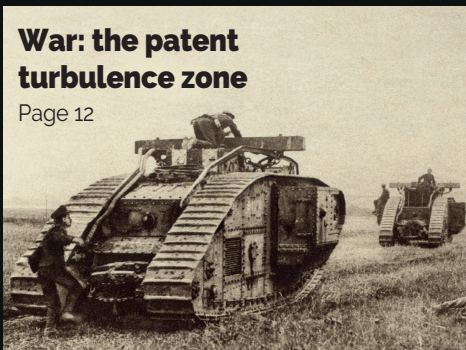


## Road to the future: SEP licensing and litigation in the automotive field

Shaobin Zhu & Bo Tang, Morgan Lewis & Bockius LLP, address the advances in vehicular technology and the correlating increase in standard-essential patent licensing and litigation in the automotive industry for continued innovation and protection of these enhancements.

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# Jurisdictional Briefing, US: parameters of export control: considerations when patenting dual-use technologies

**Dr. Grant Ehrlich and Maggie Russell of Cantor Colburn reflect on the parameters of export and the results of violation along with foreign filing licenses at the USPTO.**

**D**ual-use technologies, i.e., those with both civilian and military end-uses, have become increasingly widespread. Avoiding a disclosure contrary to U.S. export control laws is critical for patent applicants. Recent world events in Ukraine and elsewhere highlight the shrinking differences between commercial and military technologies, and have prompted renewed interest in ensuring appropriate export controls are applied to applicable technology. However, what disclosure in a patent application is subject to export control can be subtle. To protect inventors and applicants, companies can review and update their Technology Control Plan to avoid a disclosure contrary to U.S. export control laws.

## Export control

Export control laws aim to protect national security and provide trade protection. An invention may be subject to export controls based on the technology's end-use. The Export Administration Regulations ("EAR") provide trade protection, while export of military technology is controlled by International Traffic in Arms Regulations ("ITAR"). Export can occur in tangible ways, such as publishing, or intangible ways, such as discussions by phone or email. Also, what is a "deemed export" can be subtle. A plant tour, a presentation to a foreign national legally in the U.S., or emailing a colleague can be a "deemed



**Dr. Grant Ehrlich**



**Maggie Russell**

export" and result in a violation. The consequences of violation of export control laws can be severe, with penalties of up to \$1 million and potential prison time, even if the violation is inadvertent.

Once a patent application becomes publicly available the contents are no longer export controlled. However, this does not mean that products or information beyond the application can be exported. Thus applicants may need to obtain an export license prior to export of a dual-use technology, regardless of its patent status. Export licenses can take time to acquire, and there are no exemptions or general licenses for export of technical data in connection with the preparation of U.S. patents.

## Foreign filing license

The U.S. Patent and Trademark Office ("USPTO") can provide a foreign filing license to file a patent application in a foreign country. The USPTO's licensing authority is limited. A foreign filing license must be obtained prior to filing a patent application abroad if there is U.S. inventorship. Penalties for filing without a foreign filing license are significantly less severe, though still significant, than those provided for violation of export control laws, and foreign filing licenses can be obtained retroactively.

A foreign filing license should not be confused with an export license. To confirm, a foreign

<sup>1</sup> See 22 C.F.R. § 127 (2012); see also Penalties (doc. gov); see also Understand The ITAR - DDTC Public Portal (state.gov).

filing license allows for foreign patent filing, does not authorize the disclosure of export controlled information, and is distinct from an export license.

### Practice tips

When patenting dual-use technologies, practitioners are advised to confirm the inventors are aware of applicable export controls and to confirm inventors are aware of the company's Technology Control Plan or other mechanism governing dissemination of information. A Technology Control Plan will often indicate the export controls to be considered, a primary contact responsible for the technology, project information, and procedures to be followed. As applied to the patent process, a Technology Control Plan should provide for internal review to confirm whether an invention disclosure contains information subject to export control prior to disclosure to outside counsel. Internal review can also confirm that the invention disclosure contains only civilian end-use information and avoids information subject to export control.

When developing an application for a dual-use technology, patent practitioners can request that applicants confirm the application does not include information subject to export control. This confirmation can serve as a reminder of the need to avoid disclosure of information that could be subject to ITAR or EAR. Confirmation may be provided by consulting with persons indicated in the company's Technology Control Plan, or a client's export control counsel, for example. Further, a panel including technical leaders, patent counsel, and export control personnel to oversee patent applications can be useful in screening applications to avoid unintended disclosure of export controlled information.

### Conclusion

Avoiding the unintended disclosure of export controlled information is critical, as the penalties can be severe. A Technology Control Plan, which

## Résumés

**Grant M. Ehrlich**, Ph.D., Esq. is a Partner and Chair of Cantor Colburn's Energy Storage, Batteries, and Materials Practice Group. He supports technology-based companies in the development and implementation of effective intellectual property strategies. He has drafted and prosecuted patents and has prepared non-infringement, invalidity, and freedom-to-operate opinions in fields spanning batteries, fuel cells, thermoelectrics, displays, sensors, medical devices, metallurgy, magnetic and magnetocaloric materials, ceramics, water treatment, heating systems, lubricants, detergents, coatings, and phosphors. His counsel is informed by his engineering experience at Pratt & Whitney in the Systems Design and Component Integration (SD&CI) Group, at UTC Fuel Cells where he led an electrode development team, his scientific experience at Yardney Technical Products where he led a lithium-ion battery technology development effort, and his Ph.D. in chemistry. He also has litigation experience as an expert in batteries, electrochemistry, and materials characterization.

**Maggie Russell** is an Associate who focuses her practice on drafting and prosecuting patent applications for chemical and material science technologies. Maggie has experience in a wide range of fields including chemistry, chemical engineering, semiconductor devices, mechanical engineering, and material science. Prior to joining Cantor Colburn, she worked as a semiconductor engineer at BAE Systems and authored multiple publications in the *Journal of the Electrochemical Society*.

governs dissemination of information, can avoid unintended disclosure. Practitioners are advised to consider export controls when patenting dual-use technologies and to confirm with applicants that the applications avoid disclosure of export controlled information.

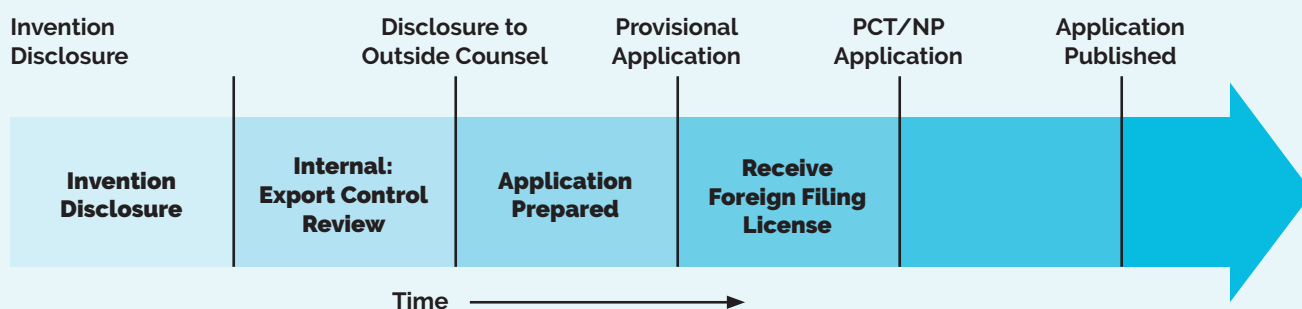
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During the patent process, an invention disclosure is first reviewed internally for consistency with the company's intellectual property strategy, then it should be reviewed to confirm it does not include information subject to export control. Externally, an application is prepared by patent counsel, filed, and a foreign filing license is obtained, prior to filing outside the U.S. Throughout the above process, export controls may apply.