ABSTRACT

This chapter provides a set of guidelines to assist information assurance and security researchers in creating, negotiating, and reviewing non-disclosure agreements, in consultation with appropriate legal counsel. It also reviews the use of non-disclosure agreements in academic research environments from multiple points of view. Active academic researchers, industry practitioners, and corporate legal counsel all provided input into the compiled guidelines. An annotated bibliography and links are provided for further review.

INTRODUCTION AND OBJECTIVES

Non-Disclosure Agreements (NDAs) are an important and necessary tool for researchers, particularly in information security and assurance. Research subjects may require agreement to a NDA before allowing researchers access to data, to protect the research subject’s proprietary data, procedures, and identity. Likewise, researchers may require agreement to a NDA to protect the creation of intellectual property as a result of the research. Failure to execute a proper NDA could result in legal disputes, fees, and liability, as well as an inability to use the data collected for research purposes.

The objective of this chapter is to provide the reader with a set of guidelines and observations about NDAs that are specific to the needs of the academic. Most NDAs are executed between commercial enterprises, and as a result it is difficult to find reference material that provides guidance appropriate to information security researchers on this critical topic.

BACKGROUND

These guidelines were developed as the result of a research project to seek out information about academic NDAs. The research was conducted as an e-mail-based survey, using open-ended questions. A request for suggested guidelines went to the ISWorld distribution list, an e-mail distribution delivered to a global community of Information Science (IS) researchers, students, and
faculty members. The request was not country-specific, nor specific to any particular segment of IS.

Eleven contributors, including 10 in academia, self-selected and responded to the initial request. Of those 10, at least two had some industry experience as well. One contributor is a corporate legal counsel who provided significant reviews and provided guidance both from the corporate perspective and what academics should consider.

Of the 11 contributors, nine were based in the United States, one in the United Kingdom, and one in Canada. Of the 10 in academia, eight were faculty members, and two were students.

The research is exploratory in nature, and is not intended as an exhaustive guide to the topic. The research focuses primarily on United States legal definitions and practices, but we anticipate that many of the guidelines may apply in other jurisdictions.

LEGAL OVERVIEW

A Non-Disclosure Agreement is an “agreement restricting the use of information by prohibiting a contracting party from divulging data” (Beyer, 2001). NDAs arise out of a relationship whereby one or both parties to the agreement seek to contractually articulate the respective rights and responsibilities of the parties with regard to some kind of intellectual property. Generally speaking, Intellectual Property is any property that can be protected by law including copyrights, ideas, inventions, and other forms of the intellect that has independent commercial value and is not generally known.

For the researcher, it is very important to determine what rights apply to the work to be produced that is, the researcher’s results, papers, and products. The researcher should ask the question as to whether the property is primarily functional or aesthetic. Functional elements are protected by utility patents and trade secrets. Nonfunctional or aesthetic elements are protected by trademarks, copyrights and patents. The researcher may ask the question: “Does this creation accomplish a task or goal or is it done primarily to appeal to the senses or provide information or entertainment?” (Milgrim, 2006a, Chapter 9.04).

Thus courts apply property rules when it comes to intellectual product. Because intellectual product is considered property, the issue for the researcher is to identify who is the “owner” of the property. This is critical because the owner of intellectual property has the right to use it and disclose it to others or restrict its use and disclosure as the case may be (Milgrim, 2006b, Chapter 2.01).

Consequently, the identification of the type of intellectual property law applicable to the researcher’s activity is very important. Intellectual property law involves several distinct legal disciplines which at times overlap (Milgrim, 2006a, Chapter 9.02). There are four types of Intellectual Property laws which are generally applicable to the activities of researchers: patent law; copyright law; trademark law; and trade secret law.

Briefly, patents are of two types of interest to security researchers: utility and design. The most common patent is utility patents and is granted to the inventor of a new, non-obvious invention. A design patent is granted for a new but nonfunctional design (USPTO, 2006b).

Copyrights are granted to authors of “original works of authorship” that include dramatic, musical, artistic, computer programs, and certain other intellectual works, both published and unpublished. Copyrights protect the form of expression rather than the subject matter of the writing, that is, copyrights do not protect ideas and facts, only the manner in which the ideas and facts are expressed (USPTO, 2006a).

Trademark or Servicemark law protects a word, name, symbol, or device that is used in trade with goods to indicate the source of the goods as distinguished from the goods of others (USPTO, 2006c).

Lastly, which will be of most interest to researchers, trade secret law protects any confidential information that gives the creator or holder of the secret a competitive advantage, that is, the information has independent economic value derived from the fact that it is secret. By definition, trade secrets are confidential information, and the owner of the trade secret can prevent others from using the information (NCCUSL, 1985, Section 1[4]).

As is often the case, intellectual property overlaps and the researcher should be aware that patent, copyright, trademark/servicemark, and trade secrets can overlap with regard to a particular product, service, or information. For instance, it is very difficult, if not impossible, to pursue a patent application, while at the same time keeping the invention as a trade secret. In addition, it is not unheard of for a product to be protected under both trademark and copyright law. Finally, patent law can intersect with copyright and trademark/servicemark law in the manner or appearance of an item as well as its design and non-obvious functionality (Milgrim, 2006b, Chapter 9.04).