

# Intellectual Property

## IP CHECKLIST

### PATENTS

Patent law protects new and nonobvious ideas that have utility or an ornamental design.

#### ACQUISITION

- Implement policies and processes for identifying, disclosing and assigning patentable inventions as an integral part of research and development efforts.
- File U.S. patent applications before public disclosure of an invention.
- Confer with counsel as to the availability of international rights.
- Seek invalidity and/or noninfringement opinions before launching potentially infringing products.
- Seek patent clearance before investing heavily in a new product.

#### USE

- Mark products with patent numbers.
- Draft patent license terms carefully.

#### MAINTENANCE AND ENFORCEMENT

- Implement docketing and other systems to ensure timely payment of U.S. and foreign patent maintenance fees.
- Seek counsel before notifying an infringer, threatening litigation or offering to license.
- Seek counsel immediately upon being put on notice of possible infringement of another party's patent.

### TRADEMARKS

A mark is any word, symbol, name, logo or product design feature used in commerce to identify the single source of a product or service and to distinguish the product or services of one provider from that of another. Trademark, trade dress and service mark rights can be lost if not enforced, or if assigned improperly.

#### ACQUISITION

- Implement a process for identifying all names, marks, logos, slogans, trade dress and other source identifiers.
- Implement a process for clearing names and marks, including full and, if applicable, international searches, before adopting and investing in new names and marks.
- Seek federal registrations for marks; consider state registration if federal registration is not available and appropriate foreign registrations.
- Consider recording your registered trademarks with U.S. Customs to protect against the importation of infringing products and with ICANN's Trademark Clearinghouse to protect against third-party registration of infringing domain names.

#### USE

- Establish and communicate a policy for the appropriate use of all trademarks, including using as adjectives (e.g., KLEENEX facial tissue).
- Use the ® symbol for all registered marks, but only for those goods and/or services covered by the registration(s).
- Use the ™ symbol for all unregistered marks.

#### MAINTENANCE AND ENFORCEMENT

- Implement docketing and other systems to ensure timely renewal filings and payments.
- Police your mark, including using trademark watch services, monitoring competitors' activities and Web sites, and tapping existing networks (distributors, customers, dealers, etc.) to watch for possible infringements.
- Monitor quality control on all licensees, distributors and dealers
- Verify and document your right to use the trademarks of others and licenses granted for the use of your marks.
- Maintain and regularly update records and samples of trademark usage for each of your marks across all relevant jurisdictions.
- Record assignments and other ownership changes with U.S. Trademark office.

HERE ARE SOME suggestions for acquiring, protecting and enforcing your intellectual property rights.

## COPYRIGHTS

Copyright law protects original works of authorship in a fixed medium.

- Establish and communicate a policy for marking all copyrightable works, including Web pages, source code, software, advertisements, manuals, company literature, artwork, etc.
- Mark all copyrightable works with the copyright symbol ©, year of first publication and legal owner.
- Implement a process to consider U.S. registration of copyrights in all key works, preferably within three months of publication.
- Consider recording your registered copyrighted works with U.S. Customs.
- Implement a system to archive copies of each version of copyrightable works.
- Require all nonemployees, especially those engaged to create or contribute to copyrightable works such as software or art, to enter into work-for-hire agreements with an express assignment of IP ownership rights.
- Verify and document your right to use the copyrightable works of others, including graphics, artwork, software, photographs, etc.

## TRADE SECRETS

A trade secret is information, such as financial data, formulas or customer lists that is not generally known or readily ascertainable. This information derives economic value from being kept secret.

- Limit disclosure of trade secret information to parties with a need to know.
- Require parties to sign nondisclosure and/or confidentiality agreements.
- Establish a policy for labeling all documents containing trade secret information as CONFIDENTIAL or TRADE SECRET.
- Control access to trade secret information, including physical access (locked doors and cabinets, visitor sign-in, etc.) and computer access (encryption, password protection, firewalls, etc.).

## OTHER INTELLECTUAL PROPERTY ISSUES

### EMPLOYEES

- Require all employees and contractors to execute agreements that (a) require assignment of all IP rights developed while they are rendering service to the company, and (b) restrict use or prohibit disclosure of confidential information.
- Consider requiring certain employees to execute noncompete and nonsolicitation agreements.
- Require all new employees and contractors to acknowledge that they do not have and/or will not use any trade secret or proprietary information from any prior employer.
- Implement and enforce company security policies to protect IP assets, including the appropriate use of computer and mobile devices, passwords, etc.
- Take steps to secure IP when employment ends. Conduct exit interviews with departing employees in regard to IP issues, including trade secrets, inventions, technology, return of company property, etc.
- Multistate employers: Be aware of differences in various states' laws including required notices to employees regarding assignment of rights in inventions.

### DOMAIN NAMES

- Register domain names incorporating company name and important marks in all major top-level domains, such as .com, .net, org, .biz, .us, .info, etc. If international markets are important, consider registering in available country code top-level domains (ccTLDs), such as .ca (Canada), .co.uk (United Kingdom), .jp (Japan), etc. Track launches of and consider registrations in new gTLDs.
- Implement systems for tracking and maintaining all domain name registrations, renewal dates and appropriate Whois data.
- Employ defensive domain name registration strategies (register common misspellings, register mark plus descriptors, etc.).

### WEBSITES

- Include appropriate legal notices, including copyright notices, trademark notices and symbols, patent notices and disclaimers.
- Consider appropriate terms for your Web site depending on the nature of your Web site's activity and the information collected, such as privacy and terms of use agreements.

### LICENSES AND INSURANCE

- Ensure that any licenses allowing you to use another party's IP include indemnities against IP infringement and related claims.
- Ensure that any licenses allowing another party to use your IP include indemnities against tort and product liability claims.
- Purchase insurance that covers IP risks.