

# IP CHECKLIST

HERE ARE SOME SUGGESTIONS FOR ACQUIRING, PROTECTING AND ENFORCING YOUR INTELLECTUAL PROPERTY RIGHTS.

## TRADEMARKS

A mark is any word, symbol, name, logo or product feature used in commerce to identify the single source of a product or service and to distinguish one provider from another. Trademark 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 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.
- Consider recording your registered trademarks with U.S. Customs to protect against importation of products infringing the registered trademarks.
- Consider seeking appropriate foreign registrations.

### USE

- Establish and communicate a policy for appropriate use of all trademarks.
- 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.
- Use trademarks as adjectives (e.g., KLEENEX facial tissue).

### MAINTENANCE AND ENFORCEMENT

- Implement docketing and other systems to ensure timely renewal filings and payments.
- Police your mark, including using trademark watch services and monitoring competitors' activities and Web sites. There are third-party services available to assist you, and simple steps, such as signing up for search engine alerts on your key marks, can be useful (e.g., [www.google.com/alerts](http://www.google.com/alerts)).
- Implement systems and policies to utilize existing networks (distributors, customers, dealers, etc.) to monitor 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 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.

## 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.
- Be aware that many countries bar registration if there is any public disclosure before the filing of a patent application, and the United States may change its laws to be consistent with this practice. If it is not possible to file before public disclosure:
  - File U.S. patent applications within one year of 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.

## 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

- Consider requiring all employees to execute agreements that (a) require assignment of all IP rights developed while they are employees, and (b) prohibit use or disclosure of confidential information.
- Consider requiring certain employees to execute noncompete and nonsolicitation agreements.
- Require all new employees 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 appropriate use of computer and mobile devices, passwords, etc.
- Take steps to secure IP when employment ends. Conduct exit interviews of departing employees concerning IP issues, including trade secrets, inventions, technology, return of company property, etc.
- Multistate employers: Be aware of differences in various states' laws.

### 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.
- 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.).
- Consider employing a watch service to notify you when key brands are incorporated into third-party domain names.

### WEB SITES

- 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.

## CONTACT US

For more information on our intellectual property capabilities, please visit [www.perkinscoie.com/ip](http://www.perkinscoie.com/ip).