



PHILLIPS KAISER

(IP)

Intellectual
Property
Checklist



THE INTELLECTUAL PROPERTY CHECKLIST



In developed countries around the world, there is an ever-growing shift toward the knowledge economy or industries based on innovation and intangible assets.

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In the United States, intellectual property-intensive industries account for over 1/3 of the national GDP; the figure is even more staggering in the European Union.

In such a climate, businesses that base their operations on intangible assets and innovation have a higher likelihood of thriving. Intellectual property can help management legally protect and capitalize on these inventions. The following checklists are intended to assist in capturing intellectual property protections and the advantages they entail.



THE INTELLECTUAL PROPERTY CHECKLIST

PATENTS

Patent law protects new and non-obvious ideas that have utility or an ornamental design.

- ▶ Implement policies and processes for identifying, disclosing and assigning to the company from employees or others inventions as an integral part of the company's efforts.
- ▶ File U.S. patent applications within one year of public disclosure of the invention.
- ▶ Confer with intellectual property counsel on the availability of international rights.
- ▶ Obtain patent clearance before investing heavily in a new product.
- ▶ Mark all products, as applicable, with patent numbers.
- ▶ Develop customized patent licensing terms, as applicable.
- ▶ 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.



THE INTELLECTUAL PROPERTY CHECKLIST

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 services and to distinguish the product or services of one provider from another. Trademark, trade dress, and service mark rights can be lost if not enforced, or if assigned improperly.

- ▶ Implement a process for identifying all names, marks, logos, slogans, trade dress and other sources.
- ▶ Implement a process for clearing names and marks, including the full, and, if applicable, international searches before adopting and investing in new names and marks.
- ▶ Seek U.S. federal registration for marks, and state registration if federal registration is not available; consider foreign registration as appropriate.
- ▶ Consider recording your registered trademark with U.S. Customs to protect against the importation of infringing products.
- ▶ Establish and communicate a policy for the appropriate use of all company trademarks.
- ▶ Use the ® symbol for all registered marks covered by a registration.
- ▶ Use the ™ symbol for all unregistered marks.
- ▶ Implement a docketing and other systems to ensure timely renewal of filings and payments.
- ▶ Police the company marks, including using trademark watch services; monitor competitors' activities and websites.
- ▶ Monitor quality control on all licensees, distributors and other third parties authorized to use the company's marks.
- ▶ Verify and document your right to use the marks of others and under any licenses.
- ▶ Maintain and regularly update records and samples of trademark usages for your marks across all relevant jurisdictions.
- ▶ Record assignments and other ownership changes with the U.S. Patent and Trademark Office.



THE INTELLECTUAL PROPERTY CHECKLIST

COPYRIGHTS

Copyright law protects original works of authorship in a fixed medium such as print, recordings, and writings.

- ▶ Establish and communicate a policy for marking all copyrightable works, including websites, software, advertisements, manuals, company literature, artwork, etc.
- ▶ Mark all copyrightable works with the copyright symbol ©, Year of First Publication and Owners.
- ▶ Implement a process to consider U.S. registration of copyrights for all key works of the company.
- ▶ Implement a system to archive copies of each version of copyrightable works.
- ▶ Require all employees and contractors, especially those engaged to create or contribute to copyrightable works such as software or art, to enter into a works-made-for-hire agreement with express language assigning ownership rights to the company.
- ▶ Verify and document the company's right to use the copyrightable works of others, including for graphics and logos, artwork, software, etc.



THE INTELLECTUAL PROPERTY CHECKLIST

TRADE SECRETS

A trade secret is information, such as financial data, formulas, customer lists, and other information, that is not generally known to the public about the company. This information derives economic value for the company by being kept secret.

- ▶ Limit disclosure of trade secret information to parties with only a need to know.
- ▶ Require parties to sign non-disclosure 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 the physical access to it (e.g., locked doors and cabinets, visitor sign-in, putting it in vaults or safes, etc.) and computer access (e.g., encryption, password protection, etc.).



OTHER INTELLECTUAL PROPERTY ISSUES

EMPLOYEES

- ▶ Require all employees and contractors to execute certain agreements that (a) require assignment of all intellectual property rights developed while working for the company, and (b) restricting their use or prohibit disclosure of company confidential information.
- ▶ Require certain key employees to execute non-compete and non-solicitation agreements.
- ▶ Implement and enforce company security policies to protect the company intellectual property assets, including the appropriate use of company computers and mobile devices, passwords, etc.
- ▶ Take steps to secure intellectual property when an employee is terminated. Conduct exit interviews with departing employees for intellectual property issues, including trade secrets, inventions, technology, return of company property, etc.
- ▶ Be aware of local and state laws regarding employee intellectual property rights.



OTHER INTELLECTUAL PROPERTY ISSUES

DOMAIN NAMES

- ▶ Register domain names incorporating the company name and important marks in all major domains, such as .com, .net, .org, .biz, .us, etc. Consider international markets as applicable. (e.g., .ca for Canada, .co.uk for United Kingdom, etc.).
- ▶ Implement systems for tracking and maintaining all domain name registrations and renewal dates.

WEBSITES

- ▶ Include appropriate legal notices, including copyright notices, trademark notices, and symbols, patent notices, and disclaimers on company websites.
- ▶ Comply with all data privacy laws for the website's activities for information collected and privacy terms and terms of use for the website.

Note: The above is not all-inclusive and if you have any questions regarding your obligations under the law or about best practices regarding intellectual property matters, please consult an attorney. Further, the information and materials contained herein are provided for general information purposes only and are not intended to constitute legal or other advice or opinions on any specific matters and are not intended to replace the advice of a qualified attorney or any other professional advisor. There is no guarantee as to the accuracy of any information provided, and should not be relied upon for any purpose other than for general information purposes only.



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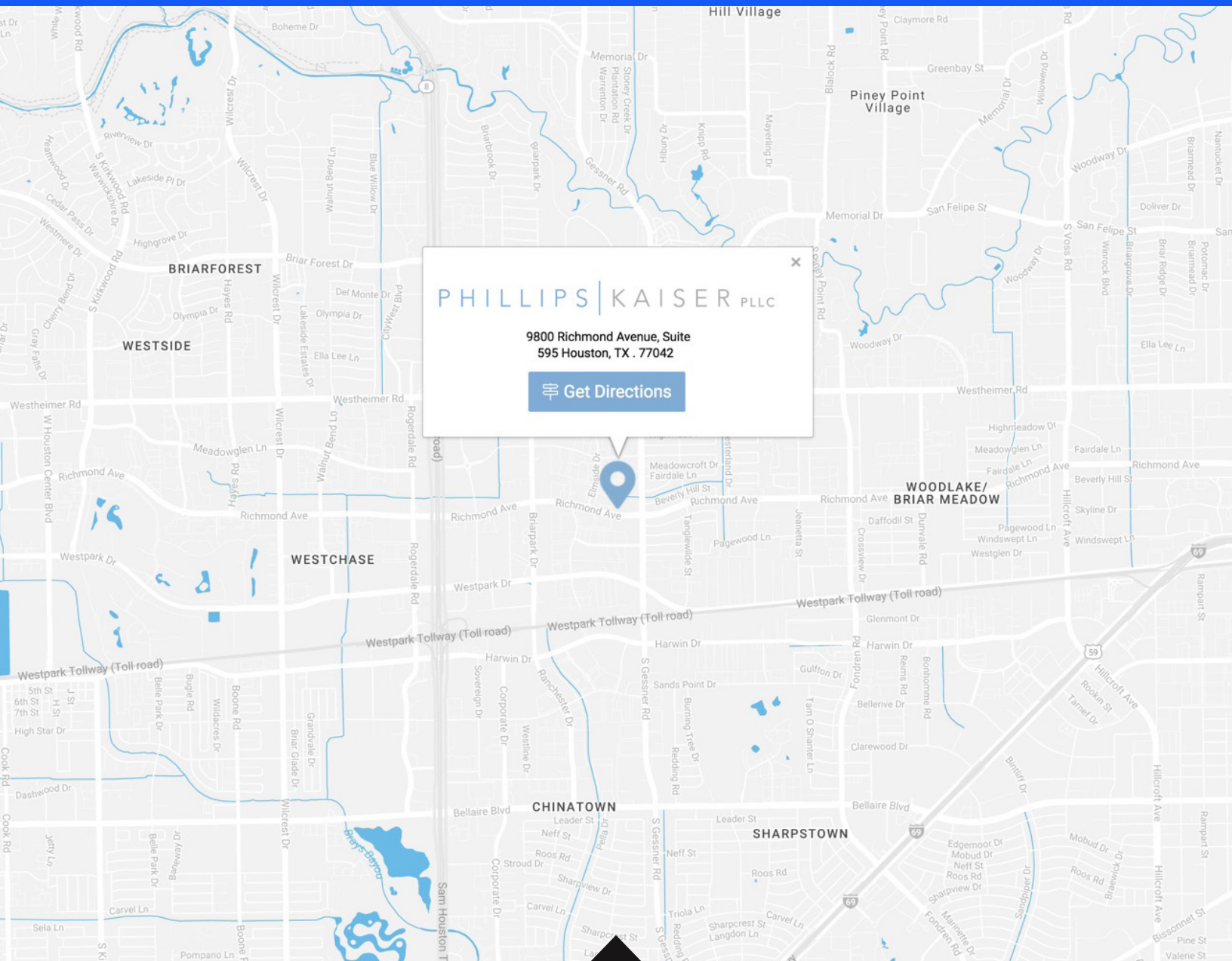
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