

## An Intellectual Property Checklist

### EMPLOYEE ISSUES

1. Require your employees, consultants, joint developers and manufacturers to execute an invention, copyright and trade secret assignment agreement.
2. Advise and frequently remind your employees and consultants that the information they acquire or create is confidential and proprietary and is to be treated as such.
3. Require that all of your employees execute an agreement preventing them from “raiding” your employees or competing unfairly after leaving your employ.
4. Take steps to ensure that a new employee does not use his or her prior employer’s trade secrets while in your employ.
5. Conduct termination interviews with departing employees concerning inventions and trade secrets.

### TRADE SECRETS

1. Use different non-disclosure agreements (NDA’s) depending upon whether you or the other entity is disclosing trade secret material, or a third type of an agreement if it’s a mutual or two-disclosure.
2. Stamp **CONFIDENTIAL** or **TRADE SECRET** on all documents containing information that is not generally known to your competitors.
3. Remember that a court will not give any greater protection to your trade secrets than you do.
4. Require that a submission agreement, prepared by your counsel and specifically governing confidentiality, be signed before accepting any disclosure from an outsider.

### PATENTS

1. Immediately evaluate the desirability of seeking U.S. and/or foreign patent protection on your inventions.
2. Remember that a U.S. patent application and certain foreign patent applications must be filed before any public disclosure or attempts to commercialize the invention if you wish to preserve the option to seek foreign patent protection.
3. Seek a written opinion of non-infringement or invalidity from your patent counsel before you manufacture, use or sell a potentially infringing product.
4. Remember that a U.S. patent is the only protection against legitimate reverse engineering.
5. Obtain from all licensees of your patents, trademarks and trade secrets a hold harmless indemnity against product liability claims.
6. Seriously consider patent protection for your valuable software products.

## **TRADEMARKS**

1. Conduct full searches before adopting and investing in a trade name, trademark or service mark.
2. Remember that you can file an application for Federal Registration of a mark before that mark has ever been used, if you have a bona fide intent to use that mark.
3. Seek Federal Registrations for your trademarks and service marks, including the non-functional, three-dimensional design aspects of your products, in the U.S. Patent and Trademark Office.
4. Mark your unregistered trademarks with a “™” and your unregistered service marks with an “K.”
5. Following Federal Registration of your mark, use the “®” symbol.
6. Use your trademarks and service marks as adjectives, and not as nouns, in your advertising and brochures.
7. Utilize domestic and international trademark watching services in order to monitor the unauthorized use and registration of your marks by others.
8. Consider recordation of your registered marks with the U.S. Customs Service in order to prevent unauthorized importation of counterfeit or gray market goods into the United States.
9. Be sure to consider “advertising injury” insurance coverage in connection with your general or comprehensive liability insurance package.

## **COPYRIGHT**

1. Mark the statutory copyright notice on all software, advertisements, brochures and other material which is protectable by copyright. The notice should include the “©” symbol, the year of first publication and the owner of the copyright.
2. Display the statutory copyright notice with any CRT display that is generated by copyrightable software.
3. Remember that the copyright in software written by a consultant probably belongs to the consultant unless you have obtained a specific written assignment from the consultant.
4. Seriously consider obtaining a Federal Copyright Registration for all copyrightable materials because such registration obtained either within three months of publication, or before the initiation of infringing activity, is the only way to recover statutory damages and attorney’s fees from the infringer.