INTELLECTUAL PROPERTY CHECKLIST FOR STARTUP COMPANIES AND ESTABLISHED BUSINESSES

This simple checklist is intended to provide basic guidance to startup companies and established businesses in ensuring that they are taking the proper steps to identify and protect their intellectual property, as well as avoiding infringement of intellectual property owned by others.



INVENTIONS, DEVICES, AND PROCESSES – PATENT AND TRADE SECRET PROTECTION

- [ ] Employees – particularly engineers and scientists – should sign agreements requiring them to assign inventions made in the course of employment to your business.
- [ ] Negotiate and execute nondisclosure agreements with customers, vendors, and outside consultants so that they are obligated to protect your confidential information, and so that you are free to have discussions regarding customer needs and the best ways to meet those needs.
- [ ] Consider performing freedom to operate searches before incurring significant expenses in research and development, and analyze patents owned by competitors before developing new products
- [ ] Have procedures in place to identify patentable inventions – particularly those that will provide a competitive advantage for your business – in advance of any offers of sale, publication, or other public disclosure.
- [ ] Document inventions by engineers and scientists as well as communications with third parties about these inventions.
- [ ] Prioritize inventions so that those which are critical to your business are protected promptly, and other inventions can be protected depending on available resources and other priorities.
- [ ] Discuss with your attorney which inventions are best protected by patent, and which are best protected by trade secret.

YOU SHOULD CONSIDER PATENT PROTECTION IF:

- [ ] You need the strongest possible protection for your innovations, including protection from the possibility of independent discovery of your innovations by your competitors
- [ ] Your innovations are potentially subject to reverse engineering
- [ ] The limited duration of a patent (20 years from the filing date, subject to certain extensions of patent term) is acceptable.

YOU SHOULD CONSIDER TRADE SECRET PROTECTION IF:

- [ ] You are willing to accept the risk that your competitors may independently discover your innovations
- [ ] Your innovations are not easily subject to reverse engineering
- [ ] You wish to keep your innovations secret for a time period longer than the period of enforceability of a patent
- [ ] Your innovations have independent value derived from the fact that they are secret
- [ ] You are willing to take steps to identify trade secrets and to protect the secrecy of these secrets
- [ ] Consider prioritized examination for particularly valuable inventions or when a patent is needed quickly.
- [ ] Maintain a calendar of critical dates for application filing, foreign filing due dates, amendment filing, issue fee payments, and maintenance fee payments.
- [ ] Have procedures to locate and review patent filings by competitors so that those that will affect your business can be challenged.

TRADEMARKS, SERVICE MARKS, AND TRADE DRESS – YOUR BUSINESS NAME, PRODUCT OR SERVICE NAMES, PRODUCT APPEARANCE, AND BUSINESS REPUTATION

- [ ] Before beginning use of any business name, product name, tagline, or logo, have a clearance search performed to identify any other trademark that might raise the issue of likelihood of confusion.
- [ ] If the results of the clearance search are favorable, then promptly file applications for registration to preserve your rights to your name.
- [ ] Maintain a calendar of critical dates such as statement of use due dates, declaration of incontestability due dates, and renewal due dates.
- [ ] Limit use of competitor trademarks to the minimum extent necessary to accurately describe your competitor’s goods or services.
- [ ] Avoid use of competitor trademarks in Metatags and other search engine optimization techniques.
- [ ] Act promptly to stop the use of trademarks that create a likelihood of confusion by others.

COPYRIGHTS

- [ ] Licenses should be obtained for any significant use of material created by third parties within materials created by your business. For some forms of expression, such as music, even small uses can be considered to be significant.
- [ ] Copyright applications should be submitted for books, user’s manuals, advertisements, musical compositions, visual displays, or other creative expressions being generated by your business. For software, consider both copyright and patent

protection. Applications for registration should be filed before publication, public distribution, or providing the materials to third parties.

- [ ] Document and maintain records of any communication of copyrighted materials to third parties. If the third party attempts to wrongfully use the copyrighted material, such records will help to prove access to the materials, simplifying proof of copying.
- [ ] If you play music or feature musicians in your business, obtain copyright licenses or ensure that licenses are obtained by the musicians.
- [ ] If your business prepares software using publicly available code or code created by others, check to see if any of the code is covered by a license agreement. Even a license agreement that is categorized as “open source” can impose requirements on how programs containing such code is distributed. Some open source license agreements require only that portions of your code covered by the open source license are made available, while others obligate you to reveal all source code, including your own code, when distributing your software.
- [ ] Any photographs used on your website must be appropriately licensed or in the public domain.
- [ ] Before providing a copy of software to any employee, installing a copy of the software on an employee’s computer, or permitting the employee to install software on a computer, ensure that your business has licenses for an adequate number of users of the software
- [ ] Pay careful attention to the audit provisions (and other provisions) of software license agreements, and attempt to negotiate reasonable provisions where possible.
- [ ] If you include any third party generated content (for example, customer comments) on your website, include information about who to contact regarding takedown notices under the Digital Millennium Copyright Act. Designate an agent to receive such notices, and inform the Copyright Office of the designation so that the agent can be included in the Directory of Agents. Act promptly in response to any notice you receive alleging copyright infringement, defamation, or other content that could result in liability.
- [ ] Wireless Internet connections should be password protected to prevent illegal activity by third parties.
- [ ] Employees should be prohibited from using music or movie file sharing websites at work or on business-owned computers or mobile devices.

TRADE SECRETS

- [ ] Evaluate new and/or critical technologies for patent and/or trade secret protection.
- [ ] Identify trade secrets as such.
- [ ] Disclose trade secrets only on a need to know basis.
- [ ] Require employees to sign confidentiality (and possibly noncompetition) agreements when hired.
- [ ] Ensure that customers, vendors, and business partners sign confidentiality agreements prior to disclosure of trade secrets.
- [ ] Control access to your business facilities during normal business hours.
- [ ] Utilize locks and alarm systems during non-business hours.
- [ ] Store sensitive information in locked containers.
- [ ] Password protect computers.
- [ ] Utilize antivirus, firewall, and anti-spyware software.

ORNAMENTAL DESIGNS AND AESTHETIC ASPECTS OF PRODUCTS

- [ ] Distinguish the appearance of your products from those of your customers so that customers are not likely to confuse your products for your competitor's products.
- [ ] Consider both design patent protection and copyright protection before public disclosure or distribution of your designs. Design patent protection is more appropriate for useful articles, while copyright protection is more appropriate for purely aesthetic articles. For some articles, such as jewelry, both may be appropriate.
- [ ] Consider filing an international design application if your business has reasons to seek protection in specific foreign countries. Such applications must be filed within six months of the US design application in order to claim the benefit of the US design application's filing date.
- [ ] Consider trade dress registration once a design has become well known and serves to identify the goods as originating from your business.

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