

## Intellectual Property (IP) checklist for technology companies

The rights for intellectual property (IP) that is created and/or owned by your company can be a very important source of income as well as a powerful tool for deterring competitors. The ownership of some IP requires registration, which is dependent of the information relating to the IP being kept confidential. To secure all benefits from your IP, you need to keep it confidential and be able to prove its origin and ownership. Below are some basic tips on how you can improve your internal processes and procedures to maximise your ability to secure your IP rights and related benefits.

### General considerations

- Ensure that all employees have signed a contract assigning to the company all rights in the IP they create as employees.
- Ensure that all third party service providers (e.g. consultants, agencies, etc.) have signed a contract assigning to the company all IP rights that they create while acting under instructions and for payment from the company. Check for inconsistent provisions in the terms and conditions of agreements that you have with third parties.
- Ensure that all employees and third parties who have access to potentially valuable IP have signed a binding confidentiality agreement.
- Ensure that all people who come in contact with any confidential information understand that this piece of information is confidential

- Ensure that all IP development work is undertaken using an audit trail that enables the company to verify who did the development and that it is original rather than a copy of any third party IP.
- If you plan to develop IP in partnership, agree in writing with all prospective partners that who will own the IP rights, the basis of the ownership and ensure that binding multi-way confidentiality agreement is in place between the parties.
- Check the licence provisions of any products (software, parts, processes, etc.) that is used for developing new IP in your company. Ensure that you have the right to use them for development purposes and check that their owner cannot acquire interest in the IP developed with it.
- Check that you have appropriate permission to use any third party product that your products include for commercial purposes (such as photographs, videos, software, database, etc.).

### **Patents**

- Keep all potentially patentable inventions absolutely confidential and secure.
- Limit the number of employees and third parties who can have access to information on patentable materials only to those who absolutely need to know.
- Emphasize regularly the need for confidentiality and security on all potentially patentable material to all employees and third parties who have access to it.
- Do not make any unnecessary disclosures and public disclosures about any potentially patentable material until patentability has been confirmed or patent application has been filed.
- Consult a patent agent as soon as potentially patentable material has been created. Discuss with him/her what claims can feasibly be made, the territories in which it is likely to be exploited, the filing priorities and related costs.
- Consider carefully the expected life-time of the product(s) developed from the patentable invention and that how easy it is to copy them (e.g. can you make money from the product(s) for less than a year, or over 20 year, etc.)

**Copyright**

- Ensure that all original, tangible works are copyright marked.
- Consider assertion/waver of author's moral rights as and if relevant.
- Keep details of copyrighted material, such as date of creation, author, any amendments or updates, any third party interests in them.
- Consider creating independent proof of creation date, such as depositing a copy with your solicitor or bank, or sending a copy to yourself with registered mail (Do not open the envelop when you receive it).
- Consider what additional means of protection you may obtain for the copyrighted material (database right, patent, design right etc.)

**Trademarks**

- If any artistic or other original work was commissioned for creating the trademark or logo or your company, make sure that your company doesn't just own the result but also owns all corresponding IPR as well (including the right to modify it).
- Consider registering domain names, company names, trademarks etc. that correspond to the trademarked name of your company or product for future applications and to reduce the risk of infringements or hostile acts from competitors.
- Ensure that your trademark or logo is registered in all territories where your company or products may trade under these names.

**Know-how**

- Keep as much know-how in tangible form as possible.
- Record all know-how in some tangible form s that it can be identified and some form of IPR protection (copyright etc.) can be gained for it. Emphasize the importance of

secrecy regarding trade secrets to all employees, consultants and agencies who have information about them.

- Establish trade secret management policies and enforce them in the company.
- Don't disclose any know-how either verbally, visually or via other means (demonstrations, factory visits, etc.) to anyone without a written confidentiality agreement in place, which restricts its use.
- Ensure that all contracts with employees contain carefully drafted confidentiality provisions limiting their right to disclose know-how acquired by them at your company and detailing what rights (if any) they have in that know-how.
- Ensure that all commercial discussions with third parties (including prospective agents and consultants!) are pre-empted by the signing of confidentiality agreement.