



## Intellectual Property Checklist

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by Michael Schiff

Originally published in *Blaneys on Business* (March 2011) - [Read the entire newsletter](#)

Creative ideas in product development and marketing provide opportunities for a company to get ahead of the competition. If your company is developing new technologies or new brands, you can build a portfolio of intellectual property protection to sustain your lead. You should also determine whether other companies have IP rights in your field of business, since this is potentially a minefield through which you need to chart a carefully planned course.

The following checklist provides some points your company should consider to help protect your own intellectual property, and keep clear of IP owned by others. It is not a comprehensive list of all the IP issues that may affect your business — but it is a good starting point for some strategic IP planning with your legal counsel.

### Patents: Protect your technology by function

A patent can prevent others from copying your technology by making products that are built in a similar way, or perform a similar task. If your technology has features that are both new and critical to its operation, patent protection may be available. But there are some tight timelines.

- Have a **notebook policy** that prescribes how new data and ideas are to be recorded in notebooks on a daily basis
- Have an **internal disclosure system** to bring new discoveries to the attention of technology supervisors and legal counsel
- Review new technology** regularly to identify features that can provide a competitive advantage if kept exclusive. If these features are new and inventive, file an initial **patent application**
- In view of the potential world-wide market, consider filing a foreign or **international patent application** within a year of each priority application
- Periodically review pending patent applications to **reallocate expenditures** to newer technology, when appropriate
- Periodically review matured patents to identify protected but unused **technology that can be licensed out** as an additional source of revenue

### Trade-marks: Establish a brand

Each name and distinguishing feature of what you sell may be protectable as a trade-mark, establishing an identity through which to win brand loyalty.

- Develop a compelling **corporate image** for your products and services by having a structured process to create the names you use, your advertising slogans, packaging, advertising, and website design
- Before committing to a new product name or logo, consider commissioning a **trade-mark search** to avoid names and designs already used by other companies
- File a **trade-mark application** for each brand name, logo, and product ornamentation that identifies or has come to distinguish what your company sells
- Consider whether **licensing a trade-mark** to another company may help promote the brand or increase your market share
- Periodically conduct **quality control audits** on products and services sold under the trade-marks you have licensed to others

### Ensure freedom to operate

Having patents and trade-marks of your own doesn't mean that you won't infringe patents and trade-marks owned by others. Dealing with third-party IP in a proactive way can avoid complicated legal issues later on.

- Periodically **search and evaluate patents owned by others** that may block a product or service that you intend to commercialize
- For patents that are potentially problematic, decide how to manage your position: file for patent revocation, design a work-around technology, or obtain a license
- Periodically **search and review trade-marks owned by others** that may be similar to your own
- For trade-marks that are potentially problematic, decide how to manage your position: file for opposition or expungement, or consider rebranding

### Protect your trade secrets

Rather than disclosing your technology in a patent application, some features may be more suited for temporary or long-term protection as a trade secret — but only if you actively maintain its privacy.

- Establish an internal policy to **identify and safeguard trade secrets** (such as underlying technology, unpublished patent applications and data, ideas, know-how, computer code, and customer lists)
- Have **confidentiality and non-compete agreements** with business partners, potential business partners, contract employees, consultants, visitors, and others who may have access to your trade secret information
- Establish a **chain of authority for approving publication** or other public disclosure of your technology. Have written agreements with your business partners about the publication and patenting of joint inventions

### Other forms of IP protection

There are several other types of protection in Canada and internationally that may be especially appropriate for your area of technology. Consider these questions:

- Is there an ornamental or non-functional design feature of a product that is worthy of **industrial design protection**?
- Should you register the **copyright** of your company's written and creative works?
- Does your technology qualify for other forms of protection: for example, **integrated circuit topographies**, **data exclusivity** for clinical trial data, or **plant variety protection**

### Keep control of your assets

Your company needs to ensure that it has full ownership and control of important inventions and intellectual property created on its behalf.

- Employment, consulting, and contract research agreements should explicitly transfer rights in inventions, copyrights and other intellectual property to the company
- Trade-mark license agreements should specify quality standards for branded products and how quality will be monitored
- Joint research or development agreements should clearly state which party will own joint discoveries, and who will control the patent application and enforcement process

### Optimize your website

The Internet establishes a strong public presence. Websites should be constructed to enhance branding, safeguard intellectual property, and avoid misunderstandings by website users.

- Register or acquire a **family of domain names** that reflect not only your company name, but also branded products, trade-marks, and derivative names
- Empower your public affairs and marketing group to take charge of your company's presence on the Internet so that **the site reflects your corporate image**
- Have a **Terms of Use** section that indicates IP rights owned by the company, acknowledges third-party trade-marks, and includes disclaimers and limitations appropriate for the products and services you provide
- Have a **Privacy Policy** section informing users about how you collect and use order information and other data from the site

### Assert your intellectual property rights

Putting IP protection into place may not be enough to keep aggressive competitors at bay. Make sure other companies know about your patents and trade-marks. Keep a lookout for infringers — and take action to protect your exclusive rights when necessary.

- Mark each product** with the serial number of each issued patent that protects the product or its use
- Identify all trade-marks** used with your products, services, packaging, promotional material, and website with the symbol ® if the mark is registered. Otherwise, use the symbol ™

- Survey competing products and services** periodically to see if they are using technology covered by the claims of your patents
- Survey competing products and services** periodically in your channel of trade to see if another company is using a trade-mark or guise that resembles your own

Your IP portfolio may enable you to stop infringers, collect damages, or both. But the Canadian Intellectual Property Office is not in the business of enforcing IP protection. If you suspect infringement of your patent, trade-mark, or copyright, consult your legal counsel about what action to take to **assert and protect your rights.** ■