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POINT OF VIEW

A Quarterly Newsletter

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INTELLECTUAL PROPERTY CHECKLIST

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Developing a system to protect the intellectual property rights of your company has become increasingly important in today's competitive climate. Are the intellectual assets of your company protected? Are the intellectual assets being captured and exploited so as to increase the value of your company?

The following **Intellectual Property Checklist** may be used as a tool to review the areas within your company where intellectual property rights typically arise. You may recognize the need to take steps to minimize the loss of such rights. You may discover rights which can be protected and enforced and which may give rise to revenue.

TRADEMARKS

- Conduct trademark availability searches before adopting a new mark or trade name.
- Register your marks with the United States Patent and Trademark Office or your state.
- Preserve the right to any potential marks by filing an intent-to-use trademark application.
- Use your marks in foreign countries and obtain rights in such countries.
- Use the proper notice (™ or ®) with your marks.
- Use your marks consistently and properly in advertising materials.
- Maintain your registrations by the timely payment of maintenance fees.
- Maintain a list of all agreements that contain trademark licenses, including distributor, dealer, franchising and web site linking agreements.
- Monitor your dealers, distributors and licensees for proper use of your marks.
- Hire a watch service to monitor the marketplace and detect unauthorized use of your marks by others.
- Conduct Internet searches for use of your marks by competitors, including unauthorized use of your marks in search engine caches, metatags, keyword triggered advertising and watermarkings.

DOMAIN NAMES

- Perform a clearance search prior to obtaining your domain name.
- Keep track of renewal dates.

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- Register all possible top level domains (.com, .net, .us, etc.) and country codes.
 - Register common misspellings of your domain name.
 - Identify and prohibit any third party from using your identical registered mark as a domain name.
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WEB SITES:

- Use of artwork, photographs, text, video or music on your site may require legal steps and approvals.
 - Sign a written agreement with your web site developer giving you ownership.
 - Obtain permission for third party trademarks or service marks used on your site.
 - Establish terms and conditions that limit your liability from errors or unavailability of the site.
 - Establish linking or framing agreements with other web site owners.
 - If you collect data or use "cookies", comply with EU privacy regulations.
 - If you maintain a chat room, establish a posting policy.
 - Address the use of metatags of competitors in your hidden text, or internet search engine caches or with keyword based advertising or use watermarkings.
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TRADE SECRETS

- Maintain a written employee policy and manual for handling confidential information.
 - Place locks on your private file cabinets and limit access to corporate plants.
 - Have all employees sign non-disclosure agreements.
 - Establish agreements with consultants or programmers who have access to information.
 - Adopt a practice of requiring agreements prior to providing a product, service or program or prior to taking meetings with those offering a product, service or program.
 - Place obvious markings of "Confidential" on highly sensitive documents.
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SOFTWARE:

- Obtain written agreements with developers assuring your ownership of software.
 - Register all versions of created software with the Copyright Office.
 - Acquire written permission from all licensors to use their software in your program.
 - Conduct an audit to assure that the number of users does not exceed your software license limitations.
 - Monitor end users to assure compliance with licensing provisions.
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PATENTS:

- Periodically assess and identify new technology and conduct novelty searches to determine patentability.
 - Protect new designs of products with design patents.
 - Use provisional patents to protect developing and emerging ideas for one year before filing utility or design patents.
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- Check for critical due dates for maintenance fees to avoid the unintentional lapsing of patents.
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COPYRIGHTS

- Register your artwork, graphics, manuals, advertising materials, literature, web pages and software with the Copyright Office.
 - Use the proper copyright notice and place it properly on the copyright material.
 - Establish written assignments with employees, independent contractors, developers and vendors assuring your ownership of works created.
 - Understand the limitations relative to copying trade journals, newspapers, newsletters or technical journals and circulating them throughout the office.
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CORPORATE TRANSACTIONS (IP CONSIDERATIONS)

- Assure acquisition ownership and any expiration date of intellectual property assets.
 - Record ownership of newly acquired assets with the appropriate federal agency.
 - Obtain assignments of IP rights from all employees and consultants.
 - Verify terms and transferability of license agreements.
 - Take a security interest in intellectual property assets and perfect the interest.
 - Record with the federal government all intellectual property assets as appropriate.
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ADVERTISEMENTS

- Control the use of the name or obvious reference to a competitor in advertising.
 - Use verifiable, accurate client testimonials.
 - Confirm that all statements are true.
 - Refrain from the use of defamatory or obscene material.
 - Use the proper copyright or trademark notices.
 - Use trademarks consistently and properly in advertising.
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WORKPLACE ISSUES

- Establish employee policy for the use of e-mail, employee computers and the Internet at work.
 - Adopt an e-mail disclaimer protecting the confidentiality of content.
 - Develop agreements with every employee requiring the assignment of work place inventions.
 - Draft agreements with current and terminated employees assuring confidentiality.
 - Obtain an acknowledgement from every employee that no intellectual property of his/her prior employer will be used in your business.
 - Place copyright warning notices on copiers, and in company library and reference centers.
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For more information or if we can provide any assistance with any of the issues raised in this publication, please contact the author at 413-733-3111, dbasile@dwpm.com.